THE LAW OF

TRADE MARKS

AND

TRADE NAME.

WITH CHAPTERS ON TRADE SECRET AND TRADE LIBEL, AND A FULL COLLECTION OF STATUTES, RULES, FORMS AND PRECEDENTS.

BY

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PREFACE.

THE last edition of this book was published in 1901. In the interval the Trade Marks Act, 1905, has become law, and its passage has effected a material improvement in the administration of a branch of jurisprudence which is of great and increasing importance to the commercial community. The present editors published in 1906 an edition of the Act with an introduction and a short commentary, and, as the main features of the Act are now well known, it will be sufficient to refer to that introduction without repeating it here, and to the introductory chapter of this work.

The principal objects of the Act were to enlarge the scope of the Register by admitting to registration a number of marks, and particularly of word marks which, though good Common Law trade marks, were excluded by the older Acts, to simplify the law of registration and improve its expression by separating it altogether from the statutes dealing with Patents and Designs with which it had most unfortunately been associated in 1883, and to effect a considerable number of minor amendments.

In order to incorporate the provisions of the new Act in the book it has been found necessary practically to re-write a great part of the earlier chapters. This has been done, and both throughout the text and in the tables of corresponding sections printed in the Appendix, a detailed comparison of the old Acts with that now in force has been made.

The following extract from the preface to the 2nd edition remains almost as true now as when it was written:

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

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

As many of the unregistered trade marks referred to in the passage cited have now been registered under section 9 (5) of the Act, it is possible that the operation of section 41 making registration conclusive after seven years, will in the course of time set some of the questions referred to at rest to the great advantage of the owners of the trade marks, and with little or no loss to other persons concerned in their respective trades.

The circumstances under which, if at all, a trader may be restricted in the honest use of his own name have not yet been debated in any judgment of the House of Lords, and as appears by the discussion in the chapter on "Passing-off" actions, the question remains an open one.

Very important Trade Mark Acts have also been passed by the United States and by the Commonwealth of Australia. These have been set out in the Appendix. And, generally, an attempt has been made to bring together in the Appendix so far as space permitted everything which appeared likely to be useful in connection with the subject in countries where the Common Law of England prevails.

In the present volume the commentary on the Merchandise Marks Act of 1887 has been omitted, although the Act itself is printed in the Appendix. The growing bulk of the book suggested this change, and it was thought, moreover, that the

separate edition of the Act which is in preparation might be found more convenient than one in less portable form.

The editors desire to record their grateful acknowledgment for assistance kindly given in connection with the present edition by Mr. Ralph Griffin, the Registrar of Trade Marks, Mr. Cunliffe, the Solicitor of the Board of Trade, and Mr. R. E. V. Bax, of the Chancery Bar.

The cases have been brought down to August, 1908.

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

Long Vacation, 1908.

NOTE.—Almost the whole of the work of preparing the present edition and carrying it through the Press has been undertaken by Mr. Underhay, to whose assistance the writer was much indebted in previous editions.

D. M. KERLY.

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THE LAW OF TRADE MARKS.

CHAPTER I.

INTRODUCTION.

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1. Trade Marks before the Registration Acts.

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

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

"No man," said James, L.J.[1] "is entitled to represent his goods as being the goods of another man; and no man is permitted to use any mark, sign or symbol, device or means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer. That being, as it appears to me, a comprehensive statement of what the law is upon the question of trade mark or trade designation, I am of opinion that there is no such thing as a monopoly or a property in the nature of a copyright, or in the nature of a patent, in the use of any name. Whatever name is used to designate goods, anybody may use that name to designate goods; always subject to this, that he must not, as I said,

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

make, directly or through the medium of another person, a false representation that his goods are the goods of another person."

Early trade mark cases at law and in equity.

The law on this subject cannot be traced back further than the nineteenth century. It is, indeed, sometimes alleged, upon the authority of *Southern* v. *How*,[1] that an action lay for the infringement of a trade mark as early as the reign of James I. In that case the defendant, a clothier, had applied the mark of another clothier to his own inferior cloth, and it was held that for this an action for deceit could be brought. According to one report,[2] the action was brought by the owner of the mark, and if this is correct the case does undoubtedly establish the proposition suggested. According to another report,[3] however, the plaintiff was the defrauded purchaser, and the action, therefore, an ordinary action of deceit. In the case of *Blanchard* v. *Hill*,[4] Lord Hardwicke refused to grant an injunction to restrain a trader from imitating the mark of another: but the language of his judgment suggests that if the defendant had used the mark with a fraudulent design to pass off inferior goods by that means, or to draw away customers from the owner of the mark, he might have granted the injunction.

Lord Eldon, who so greatly extended the jurisdiction of the Court of Chancery in regard to injunctions,[5] in several instances granted injunctions to restrain a defendant from pretending that his goods were those of, or were connected with the plaintiff;[6] and in *Cruttwell* v. *Lye*[6] he stated the principle on which he acted in similar language to that of James, L.J., cited above. "There can be no doubt," he said, "that this Court would interpose against that sort of fraud which has been attempted by setting up the same trade in the same place, under the same sign or name, the party giving himself out as the same person." The earliest reported case in which the infringement of a trade mark, in the particular case a label placed upon blacking, was restrained is *Day* v. *Day*,[7] in 1816.

Early cases at common law.

The interference of the common law courts for the protection of trade marks seems to have been a little later in date. The

[1] Popham, 144; Cro. Jac. 471: 2 Rolle, 28. See *Magnolia Metal Co.* v. *Tandem Smelting Syndicate, Ltd.*, 17 R. P. C. 477, at p. 484, (1900) H. L.

[2] Popham, p. 144.

[3] Cro. Jac. 471.

[4] 2 Atk. 484 (1742), Great Mogul Stamp on playing cards.

[5] See 2 Law Review, p. 282: Kerly's History of Equity, p. 258.

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

[7] Eden on Injunctions, ed. 1821, p. 314: Seb. Dig. p. 10.

first reported case is *Sykes* v. *Sykes*,[1] in 1824. The declaration in that case alleged that the plaintiff carried on the business of a shot-belt and powder-flask manufacturer: that he was accustomed to mark his goods with the words *Sykes' Patent*, to distinguish them from articles of the same description made by other persons; that they enjoyed a great reputation; that the defendants fraudulently marked their own inferior goods with the same mark in imitation of the plaintiff's, and sold them "as and for" goods of the manufacture of the plaintiff, and that the plaintiff thereby had suffered damage in loss of custom and loss of reputation. Bayley, J., who tried the case, asked the jury "whether the defendants adopted the mark in question for the purpose of inducing the public to suppose that the articles were not manufactured by them, but by the plaintiff," and the jury found a verdict for the plaintiff. A new trial was moved for on the ground that the evidence did not support the declaration, since the purchasers from the defendants knew whose manufacture the goods were. No authorities were cited, so far as can be judged from the report, but Abbott, C.J., who delivered the judgment of the Court, treated the law as fully settled. "I think," he said, "that the substance of the declaration was proved. It was established most clearly that the defendants marked the goods manufactured by them with the words *Sykes' Patent* in order to denote that they were the genuine manufacture of the plaintiff; and although they did not themselves sell them as goods of the plaintiff's manufacture, yet they sold them to retail dealers for the express purpose of being resold as goods of the plaintiff's manufacture. I think that is substantially the same thing, and that we ought not to disturb the verdict." This judgment has frequently been cited in subsequent cases as fully establishing, so far as it went, not only the jurisdiction of the Courts, but also the principle upon which they proceed in trade mark cases.[2]

Sykes v. *Sykes*.

In 1833, in *Blofeld* v. *Payne*,[3] the Court of King's Bench decided that it was not necessary for the plaintiff, in an action for damages at common law, to prove that the goods sold by the infringer were inferior to those to which the mark in question might rightly be applied, or to prove that he had suffered special

Inferiority of the infringer's goods.

[1] 3 B. & C. 541; 3 L. J. K. B. (O. S.) 46.

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

[3] 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 69.

damage by the defendant's acts; and in 1863, in *Edelsten* v. *Edelsten*,[1] the same rule was referred to as being settled beyond question in suits in equity.[2]

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

An important step was taken in 1838, by the decision of Lord Cottenham in *Millington* v. *Fox*,[3] that an injunction could be obtained to restrain infringement of a trade mark, even though the infringement was due to ignorance, and was without fraudulent intent.

Property in a trade mark.

This decision led, by an obvious deduction, to the establishment of a right of property in trade marks; and, although the nature of this right gave rise to much discussion, and was defined in different terms by Chancery judges in subsequent cases, it soon became firmly established, and the protection of trade marks in equity was expressly based upon it.[4] No similar step was taken by the common law courts, and in them fraud remained an essential ingredient of a cause of action for the infringement of a trade mark down to the date of the amalgamation effected by the Judicature Acts.

2. Registration of Trade Marks.

Development of the specialised action of infringement.

The principle stated at the beginning of this chapter, and the dicta there cited, have, obviously, a wider application than merely to the case of trade marks proper. Conduct of every kind, which is calculated to pass off the goods of the defendant as those of the plaintiff, falls within them, whether it consist of the imitation of the symbol expressly adopted by the plaintiff to distinguish his goods and to identify them with him, that is, his trade mark; or of the imitation of any other symbols which have become associated with his goods, so as, in fact, to distinguish and identify them; or of the imitation of the general appearance, the "get up," of his goods as they appear in the market; or of the imitation of the name under which he trades. The trade mark cases,

[1] 1 De G. J. & S. 185.

[2] See per Ld. Blackburn in *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 30; 52 L. J. Ch. 461, at p. 489 (1880).

[3] 3 My. & Cr. 338.

[4] *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Hall* v. *Barrows*, 4 De G. & S. 150; 32 L. J. Ch. 548; 33 L. J. Ch. 204; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; 32 L. J. Ch. 721; 33 L. J. Ch. 199; 35 L. J. Ch. 53 (all in 1863) and decisions of Ld. Westbury, L.C. And see *Day* v. *Riley and Whittaker*, 17 R. P. C. 517, at p. 520, (1900) *obiter* by Buckley, J. Also the judgments of Ld. Herschell in *Reddaway* v. *Banham*, [1896] A. C. p. 269; 13 R. P. C. p. 228; and of Kekewich, J., in *Saxlehner* v. *Apollinaris Co.*, [1897] 1 Ch. p. 903; 14 R. P. C. p. 656, as to whether there can be "property" in any common law trade mark.

however, were so much the more numerous and important, that, as already stated, a definite property-right in the use of a trade mark was set up, and the action for infringement became a specialised and distinct form of the more general action to restrain, or to obtain damages for "passing-off."

Difficulty and cost of the old trade mark suits.

The litigation of trade mark cases was, however, found to be extremely costly, and otherwise unsatisfactory. The essence of a trade mark right being the reputed association in the market of the symbol in question with the goods of the plaintiff, it was often necessary to call a large number of witnesses to give evidence of the reputation, especially if the defendant alleged that the pretended trade mark was either mere descriptive matter, or was, on any other grounds, a mark common to the trade; and, as infringers were usually persons of no substance, it was often impossible to recover the costs after the plaintiff had conducted his action to a successful issue. Moreover, success against one infringer did not relieve the owner of a trade mark from the necessity of proving his title afresh if, in any action against another infringer, the defendant chose to dispute it. Thus, the case of *Rodgers* v. *Nowill*[1] lasted five years and cost the plaintiff 2,211*l*., without in the end giving him any security that he might not have to incur equal delay and expense in proceeding against any subsequent infringer of his mark who should venture to run the risk of disputing his title to the exclusive use of it. And these dilatory and expensive proceedings were, practically, the only means available of preventing the infringement of a trade mark; for such infringement, except in cases where the spuriously-marked goods were sold to persons who were cheated by the seller into buying them under the belief that they were goods upon which the imitated trade mark might properly be put, was not within the reach of the criminal law.[2]

The Committee of 1862.

These evils, and the unsatisfactory state of the law in regard to the false marking of goods in general, led to an urgent demand from the traders of the country for more efficient protection, and in 1862 a Select Committee of the House of Commons were appointed to consider several Trade Marks and Merchandise

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

[2] See below, p. 16, and per Mellish, L.J., in *Fisher* v. *Apollinaris Co.*, L. R. 10 Ch. p. 303; 44 L. J. Ch. p. 502 (1875).

Marks Bills then before Parliament. The Committee were strongly urged to report in favour of the establishment of a Register of trade marks and the creation of trade mark rights by registration, in the manner already adopted by several foreign States, and long familiar, as regards cutlers' marks, in and within six miles of the lordship of Hallamshire, in England.[1] And Mr. Leonard Edmunds, then Clerk of the Patents, explained to the Committee a scheme which he had drawn up for registering and indexing trade marks in the manner at that time adopted for patents, many of the features of which were embodied in the Registration Acts subsequently passed. The proposals were, however, strenuously opposed by Mr. Hindmarch, Q.C., the leading patent and trade mark lawyer of the day, and by the Attorney-General, and they were not indorsed by the Committee. Registration of trade marks was, in consequence, postponed for some years; but the Bill upon which the Merchandise Marks Act of 1862[2] was founded was amended and favourably reported upon by the Committee, and was forthwith passed into law.

The Merchandise Marks Act of 1862.

The Act just mentioned dealt principally with the criminal law, but it contained some provisions affecting the civil law of trade marks. It provided that there should be implied, on the sale of any article with a trade mark attached to it, a warranty that the trade mark was genuine.[3] It gave a statutory right of action for damages, and for an injunction to any person aggrieved, against anyone who should apply a forged or counterfeited trade mark to any article, or to the covering of any article, for the purpose of sale, manufacture, or trade,[4] and empowered the Court to order the destruction of goods marked with spurious trade marks.[5] It also authorised Courts of Law to grant injunctions in trade mark cases.[5] These provisions are, however, believed to have been of as little practical service as were the amendments of the criminal law effected by the Act, which are referred to in a later section of this chapter.

The Registration Act of 1875.

Thirteen years later the Trade Marks Registration Act, 1875,[6] which came into operation on August 13th, 1875, established the present Register of Trade Marks. The object of this Act was twofold: it was directed, on the one hand, to diminish

[1] See "Sheffield Marks," below, p. 112.

[2] 25 & 26 Vict. c. 38.

[3] Sec. 19. see now M. M. A. 1887, s. 17; Chap. XVII., p. 552.

[4] Sec. 22.

[5] Sec. 21.

[6] 38 & 39 Vict. c. 91. See the chapter on "The Register," below, p. 57.

the difficulty and cost of, or to altogether remove the necessity for the proof of title by use and reputation, which had cast so great a burden upon the owners of trade marks in proceedings to restrain infringement; and, on the other, to secure the publication of marks which had been appropriated as trade marks, and to define the rights of their proprietors, for the information of traders, and, further, to limit the classes of marks which should be capable of being so appropriated.[1] The Act, accordingly, provided that registration should be *primâ facie* evidence of the right of the registered proprietor to the exclusive use of the trade mark[2] in connection with goods of the class for which it was registered and used,[3] and should, after the expiration of five years, be conclusive evidence of such right, so long as the trade mark remained upon the Register;[4] provided that the proprietor of the mark remained the owner of the goodwill of the business in which it was used. And, with a view to compelling registration, the Act provided that from and after July 1st, 1876 (a date which was extended by the amending Acts[5]), a person should not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by the Act until and unless such trade mark was registered in pursuance of the Act, or, according to a subsequent modification, in the case of any mark in use as a trade mark before the passing of the Act of 1875, until and unless registration of the mark as a trade mark should have been refused.[6]

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

The marks admitted to registration as trade marks under the first Registration Act were required[7] to consist of one or more of the following essential particulars: a name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or a written signature or copy of a written signature of an individual or firm; or a distinctive device, mark, heading, label, or ticket; and to these essential particulars there might be added any letters, words, or figures, or combination of letters, words, or figures; and it was further provided that any special

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

[2] Sec. 3.

[3] *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.; below, p. 327.

[4] *Palmer's Tm.*, 21 C. D. 47; 24 C. D. 504 (1882), C. A.; below, pp. 330 and 331.

[5] 39 & 40 Vict. c. 33, and 40 & 41 Vict. c. 37.

[6] 39 & 40 Vict. c. 33, s. 1. See now sec. 42 of the Act of 1905, below, p. 334, replacing sec. 77 of the Act of 1883.

[7] Sec. 10.

and distinctive word or words, or combination of figures or letters, used as a trade mark before the passing of the Act might be registered as such under the Act.

The Registration Act of 1883.

The Act attained a considerable measure of success, and 27,844 trade marks were registered under it, but its provisions did not allow words to be registered as trade marks[1] unless they were old marks, or were registered in combination with one or more of the enumerated essential particulars; and as word marks are exceedingly popular in this country, and were admitted and protected as trade marks abroad, an alteration of the definition clause was determined upon.[2] This was effected by the Patents, Designs, and Trade Marks Act, 1883,[3] which came into operation on the 1st of January, 1884. It repealed the Act of 1875, with its amending Acts of 1876 and 1877, but re-enacted, in substance, their principal provisions. It directed that the Register of trade marks, of which the old Register was to be deemed to be a part,[4] should be kept at the Patent Office established by the Act,[5] and should be under the control of the Comptroller-General of Patents, Designs, and Trade Marks, acting under the superintendence and direction of the Board of Trade.[6] It also introduced a number of new rules and provisions to regulate applications for, oppositions to, and rectifications of registration, and effected important changes with regard to the Sheffield cutlery marks,[7] which the older Act had, substantially, left untouched.

"Fancy words" allowed to be registered.

The most material alteration introduced by the Act of 1883 was the power it conferred to register a mark of which the essential particular should be a "fancy word or fancy words not in common use." What was intended by "a fancy word not in common use" the Act did not define, and the omission was the cause of a great deal of litigation; but a fairly definite meaning was at length put upon the phrase by the Court of Appeal, in the *Melrose* hair restorer, and the *Electric* velveteen cases.[8] To fall within the meaning, a word must, the Lord Justices held, be "obviously not intended to be descriptive," and must "speak for itself and be a fancy word of its own inherent strength," and be

[1] *Ex p. Stephens*, 3 C. D. 659 (1876), Jessel, M.R. (*Acilyton*).

[2] See the Comptroller's second report for 1884.

[3] 46 & 47 Vict. c. 57.

[4] Sec. 114 (2).

[5] Sec. 78.

[6] Sec. 82.

[7] Sec. 81, see below, p. 112.

[8] *Van Duzer's and Leaf's Tms.*, 34 C. D. 623; 4 R. P. C. 31 (1887). See, however, *Re Borril Tm.*, [1896] 2 Ch. 600; 13 R. P. C. 382; and below, p. 145.

"so obviously and notoriously inappropriate as neither to be deceptive or descriptive, nor calculated to suggest deception or description."

Lord Herschell's Committee, 1887.

Soon after the decisions just referred to, a very distinguished Committee, presided over by Lord Herschell, were appointed by the Board of Trade to inquire into the duties, organisation, and arrangements of the Patent Office under the Act of 1883, as far as related to trade marks and designs, and the Committee presented in August, 1887, an interim, and in March, 1888, a final report, dealing not only with the matters specified, but with the general question of the registration of trade marks. These important reports are frequently referred to in subsequent pages of this book,[1] and it will be sufficient here to refer to a few only of the suggestions made by the Committee. They recommended that a new definition clause should be enacted, stating what symbols might be registered, and substituting for the fancy word phrase in the Act of 1883 the phrases "An invented word or invented words; or a word or words having no reference to the character or quality of the goods, and not being a geographical name,"[2] and that additions to registered trade marks (that is, matter, other than their essential particulars, registered with them) should be expressly disclaimed by the applicants for registration.[3] The alterations and some minor changes were passed into law by the amending Act of 1888,[3] which came into operation on the 1st of January, 1889.

Invented word or words.

Doubtful marks to be rejected.

The Committee further reported, as principles which ought to govern the Comptroller in the acceptance for registration or the rejection of marks: that "inasmuch as the object of registration is to secure a distinctive mark, and the registration of a mark which may conflict with a mark already registered would not only be to the detriment of the owner of such prior mark, but of the applicant himself, we think that in cases where it is doubtful whether the mark ought to be accepted or not, the safer and more beneficial course would be to reject it";[4] and that, in their opinion, in comparing a new mark tendered for registration with a prior mark which it was alleged to resemble too closely, the question should be determined by considering what is the

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

[2] Act of 1888, s. 10.

[3] 51 & 52 Vict. c. 50.

[4] Interim Report, par. (2).

leading characteristic, or, as it is otherwise expressed, what is the idea, of each mark. The Acts, it has been held, vest in the Comptroller a discretion, to be exercised, of course, judicially and subject to appeal, whether to register or reject any mark first used since August 13th, 1875;[1] and this discretion, exercised in the light of the recommendations of the Committee, made the choice of a new trade mark, or the registration of an existing one, often a matter of considerable uncertainty and trouble.

For some time after the Act of 1888 was passed a construction was put upon the new clauses allowing the registration of "invented words" and "words having no reference to the character or quality of the goods" for which the mark was to be used, which made the amendment of the law almost wholly inoperative. It was held that no word was qualified to be the "essential particular" of a registered trade mark unless it satisfied both clauses simultaneously, and that even a remote suggestion of some real or assumed characteristic of the goods would make it objectionable. Thus the word *Somatose* was refused registration as a trade mark for a medical food.[2] In the year 1898, however, in *The Solio* case,[3] this decision was overruled by the House of Lords, and it was decided that the clauses referred to are alternative and independent, so that any really new-coined word, whether it has some reference to, or contains some suggestion of, the character or quality of the goods or not, as well as any existing word which has no such reference, may be registered as a trade mark, or may be the essential particular of a trade mark, unless it is objectionable on other grounds. This decision greatly increased the usefulness of the Register, by enlarging the area from which new marks might be chosen as well as by admitting to registration large numbers of word marks already in use.

The Trade Marks Act, 1905.

In the year 1905, practically the whole of the statutory civil law of trade marks[4] was repealed by the Trade Marks Act, 1905,

[1] *Eno* v. *Dunn*, 15 App. Ca. 253; 7 R. P. C. 311 (*Fruit-Salt Baking Powder*) (1890).

[2] See Chap. VIII., pp. 158 and 167.

[3] See Chap. VIII., p. 158.

[4] The exceptions are secs. 103 and 104 of the Act of 1883 relating to International and Colonial arrangements, and sec. 106 relating to the unauthorised assumption of the Royal Arms. Secs. 103 and 104 are now repealed by the Patents and Designs Act, 1907, and are replaced by sec. 91 of that Act; whilst sec. 106 is also repealed and is replaced by sec. 90 of the same Act. Sec. 98 of the Act of 1907 contains a saving of conventions and Orders in Council having effect under the enactments repealed by that Act.

intituled "An Act to consolidate and amend the law relating to Trade Marks."[1] This Act came into force, except as regards one or two minor matters, on April 1st, 1906. With the exceptions mentioned in the note, the trade mark law is now separated from the law of patents and designs. Although different departments of the same office, namely, the Patent Office, administer all these subjects, the separation is an advantage, as the principles underlying trade mark law are entirely different from those on which the patent and design laws are founded.

The new Act, whilst re-enacting a considerable part of the previous law in a much improved form, also introduced many new provisions. For the first time in Registration Acts a definition of a trade mark is given.[2] Moreover the policy of the Act is to enable all marks which are in fact trade marks to be registered, and this is effected by retaining with some modifications the classes of trade marks which were registrable under the existing law, and adding as a fifth and general class "any other distinctive mark" and by providing that the extent to which user has in fact rendered a trade mark distinctive is to be considered.[3]

The Act adopts the policy, which had broken down under the old Acts owing to their wording, of making registration after a given period conclusive of validity, subject to certain stated exceptions, for instance, that of fraud, the period chosen being seven years from registration or from the passing of the Act, whichever shall last happen.[4] It also contains an elastic provision for disclaimer of the exclusive user of matter included in a trade mark to which the proprietor has no exclusive right, and for any other disclaimer necessary for defining his rights.[5]

The important Manchester Branch for the registration of cotton marks now obtains statutory recognition, and the Act contains special provisions suited to the requirements of the cotton trade.[6]

Numerous minor changes are also effected in the law, among which those relating to associated trade marks, and standardisation marks, non-user of trade marks, and concurrent registration in certain cases of honest concurrent user, may be mentioned. All matters of mere procedure were left to be dealt with by rules made under the Act.[7]

[1] 5 Edw. VII. c. 15.

[2] See below, p. 24.

[3] See Chap. VIII., p. 127.

[4] Sec. 41. See Chap. XII., p. 322, Effect of Registration.

[5] See Chap. IX., p. 212, Disclaimers.

[6] Sec. 34, Chap. VII., p. 122.

[7] Trade Mark Rules, 1906, which came into operation on April 1st, 1906. See below, p. 655.

Unregistered trade marks are still numerous.

Down to the end of the year 1907, 126,046 trade marks had been registered under the Acts, and some eight or nine thousand applications are annually made for registration;[1] but at the commencement of the Act of 1905 a large number of trade marks in actual use in the country still remained unregistered, either because they were not capable of registration for the reason that they did not fall within the definition clause of the former Act,[2] or because their proprietors did not think it worth while to seek to register them. A considerable number of such marks have been registered under the Act of 1905, but many are still unregistered. These unregistered trade marks, notwithstanding the prohibitory sections of the Acts[3] already mentioned, which purport to make registration, in general, a condition precedent to litigation to restrain or to obtain damages for infringement, are in many cases protected by the Courts in the "passing-off" actions, next to be referred to. For it is well settled that if the use by the defendant upon his goods of an unregistered trade mark belonging to the plaintiff is calculated to pass off or cause to be passed off the defendant's goods as the goods of the plaintiff, an injunction may be granted to restrain such use,[4] and this whether the use be deliberately fraudulent and intended by the defendant to be deceptive, or not.[5]

3. Passing-off and Trade Name Actions.

Trade names and "get-up."

By the judgments in *Millington* v. *Fox*[6] and later cases in equity,[7] and by the Acts referred to above and the decisions upon them, the conditions under which a right of property in a trade mark may be acquired, and the manner and degree in which it would be protected, have been fully established; but the symbol which a trader adopts as his trade mark is only one of the badges or *indicia* by which his trade and the goods he deals in are identified with him, and distinguished from the trade of his rivals in business and similar goods which are not his but theirs.

[1] Comptroller's Report for 1907; 4,731 marks were registered in 1906, and 6,255 in 1907.

[2] Act of 1888, s. 10.

[3] Act of 1875, s. 1: Act of 1883, s. 77; Act of 1905, s. 42.

[4] *Montgomery* v. *Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ales*), where the plaintiff's mark was removed from the Register, but he succeeded in the action. See also sec. 45 of the Trade Marks Act, 1905, below, p. 14.

[5] *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503; C. A., see below, pp. 480 and 481.

[6] 3 My. & Cr. 338 (1838), Cottenham, L.C.

[7] See the next chapter.

These badges are generally numerous, and they comprise in particular the name under which he trades, that is, his trade name; the names or titles by which his goods are referred to, that is, the trade name of his goods; and the fashion or "get-up" in which the goods appear in the market, so far as these are distinctive of his trade and goods. The principles of the decisions cited above, from which the law of trade marks was specialised, apply also to these cases—of "trade name" and "passing-off" as they are comprehensively termed. The first reported judgment in which the two classes of cases were formally contrasted is that of Jessel, M.R., in *The Singer Manufacturing Co.* v. *Wilson*.[1] "The cases which have come before the Court," the late Master of the Rolls said, "may, I think, be conveniently divided into two classes; the first class, which is the more numerous one, consists of cases where the goods manufactured are distinguished by some description or device in some way or other affixed to the article sold. It may be, as I said before, description, that is, it may consist of a name or names, or a lengthy description consisting of names with superadded words, and that description may be either affixed to, or impressed upon, the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods. Now, as to this class, it is quite immaterial that the maker of the goods to which—what I will call for the sake of shortness—the trade mark is affixed did not know that it was a trade mark, and had not the slightest intention of defrauding anybody.

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

"The second class[2] of cases are of a totally different character: they are always cases of fraud. They are cases where the defendant, without putting any trade mark at all on his goods, or putting a trade mark which is admittedly different in substance from the trade mark, if any, of the plaintiff on the goods, has represented the goods as being goods manufactured by the plaintiff. . . . What the defendant has said or done must amount to a representation that the goods to be sold are the goods of the plaintiff, or that they are manufactured by the plaintiff. What amount of representation will be sufficient for that purpose must again depend, of course, on the facts of each particular case."

[1] 2 C. D. 434; 45 L. J. Ch. 490 (1874).

[2] 2 C. D. p. 443.

It will be seen that Sir George Jessel here limited the right to redress in the second class of cases to cases where the defendant had acted with fraudulent intention, and for the purpose of deceiving the customers, or intending customers, of the plaintiff, and in this his judgment was endorsed and approved by the Court of Appeal.[1] In the House of Lords, however, this distinction between the two classes of cases was not accepted. Lord Cairns said there was no such difference in point of principle,[2] and that since the decision in *Millington* v. *Fox*[3] it was necessary neither to aver nor to prove fraud. "In the present case," he added, "the question must, as it seems to me, be: Are the advertisements of the defendant, having regard to the evidence in the case, calculated to mislead an unwary purchaser of the machines?" The question came up again in *Singer Manufacturing Co.* v. *Loog*,[4] and although the case was decided on the ground that the evidence showed that the conduct of the defendant in question was not in fact calculated to deceive, several of the judgments delivered contain passages which are in accordance with Lord Cairns' opinion. James, L.J., summed up the law in the words quoted at the beginning of this chapter; and Lord Selborne used language to the same effect. "It was contended,"[5] he said, "that the acts of the defendant enabled his wholesale customers to show these documents to their own retail customers for the purpose of passing off the goods bought from the defendant as the plaintiffs' manufacture. The answer is, that, unless the documents were fabricated with a view to such a fraudulent use of them, or *unless they were in themselves of such a nature as to suggest, or readily and easily lend themselves to, such a fraud*, . . . the supposed consequence is too remote, speculative, and improbable to be imputed to the defendant, or to be a ground for the interference of a court of justice with the course of the defendant's business."

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

Section 45 of the Trade Marks Act, 1905, expressly provides that nothing in the Act 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, and it is and

[1] There are statements to the same effect in the judgments in *Cheavin* v. *Walker*, 5 C. D. 850 (1876), decided before the *Singer* case reached the House of Lords.

[2] 3 App. Ca. p. 389; 47 L. J. Ch. p. 487 (1877).

[3] Above, p. 4.

[4] 18 C. D. 395 (1879); 8 App. Ca. 15 (1882); 52 L. J. Ch. 481.

[5] 8 App. Ca. p. 21; 52 L. J. Ch. p. 484.

has long been settled that,[1] even where there is no question of a registered trade mark, or of any mark at all attached to the goods, a trader will not be allowed to act in a manner which leads, or is calculated to lead, to deception, although the deception is entirely unintended by him, unless he has some special justification for his conduct, as, for instance, an independent right to use a name similar to the plaintiff's name.[2] He does, in fact, commit a fraud when he continues his conduct after discovering its dangerous character.[3]

"No man," said Cotton, L.J., in the case of *Turton* v. *Turton*,[2] "must pass off his goods as the goods of another. Of course, that may be done unintentionally; but where there is a manifest and natural meaning in the words used that the goods are the goods of somebody else, and the man who uses those terms uses not his name only, but somebody else's, he would be stopped from doing so as soon as he is aware of the facts which make the *primâ facie* intention and result of what he is doing, passing off his goods as the goods of somebody else. It was formerly said that no action could be maintained unless a man had done so fraudulently and intentionally; but when he finds out that the natural construction of what he is doing, when the facts are known, is to represent his goods to be somebody else's, then he should be stopped, even though he had originally done that unintentionally and innocently." And in their final report, Lord Herschell's Committee said: "There can be no doubt that if a manufacturer or vendor has obtained for his goods a reputation amongst the public, he could, by process of law, quite apart from the Trade Marks Acts, prevent goods that were not his from being offered to the public on the representation that they were so."[4]

Trade names.

The protection of the trade names of individuals, firms, and companies from deceptive imitations is an important application of the principles just stated;[5] and in connection with them, the chief practical exception to the rule, that the defendant will not be allowed to continue conduct which is calculated to lead to his goods or trade being taken to be the goods or trade of the plaintiff, is found in the rule that a man may honestly trade under his own name, and describe his goods by it, whatever the

Right to trade under one's own name.

[1] See Chap. XII., p. 338, and Chap. XVI., p. 480.

[2] See below, pp. 532 *et seq.*

[3] See below, p. 402.

[4] Report of 1888, p. xii.

[5] See below, Chap. XVI., p. 492.

consequences may be.[1] But, possibly, even this exception must give way in extreme cases, where the use of the defendant's own name by itself and without qualification, is calculated to pass off his goods as those of the plaintiff. *Bass' Ale* and *Pears' Soap* have frequently been cited [2] as instances of names which could not be used without qualification and precautions against mistake by a Bass or a Pears entering into the trade in question and competing with the well-known firm of the same name.

4. The Criminal Law of False Marking.[3]

At the common law, as already stated, it was an offence to cheat by fraudulently selling the goods of A. under the pretence that they were the goods of B., or to sell goods under any material false pretence that they were different goods from what in fact they were, and such false pretences might have been effected by using spurious trade marks or other deceptive marks of origin or description upon the goods sold; but the mere imitation of a trade mark, unless it happened to be a Sheffield cutler's mark,[4] or the mere impression or use of a false mark, was not criminally punishable. The Committee of 1862, whose report has been already referred to,[5] were assured by the witnesses called before them that false marking had become extremely prevalent, to the serious detriment of honest trading. Not only were the trade marks of well-known English manufacturers frequently infringed at home and flagrantly copied abroad, so that the manufacturers both lost the custom of the buyers of the spuriously marked goods and suffered in reputation through the inferiority of the goods sold as theirs, but false marks of description, of length, quantity, material, make, and the like—what are now known as trade descriptions[6]—were applied to goods by unscrupulous traders with impunity. And the witnesses complained, with good reason, that the existing law was wholly inadequate to cope with these evils. Unfortunately, however, the Committee declined several drastic proposals for

[1] See below, pp. 532 *et seq.*

[2] See *Cash* v. *Cash*, cited below, p. 539, and the judgment of Vaughan Williams, L.J., in *Jamieson* v. *Jamieson*, 15 R. P. C. p. 192.

[3] This part of the law of trade marks was fully treated in Book II. of the 2nd edition, which it is now proposed to publish as a separate work. Although the present edition treats only of the civil law of trade marks, the general summary of the criminal law has been retained.

[4] See below, p. 589.

[5] Above, p. 5.

[6] Merchandise Marks Act, 1887, s. 3.

amendment, which were afterwards adopted with conspicuous success in the Merchandise Marks Act of 1887, as they refused to recommend the establishment of a register of trade marks, and the Merchandise Marks Act of 1862, which was passed upon their report, was, it is believed, a dead letter from its first enactment. At any rate, when another Committee on merchandise marks were appointed, in 1887, complaints precisely similar to those made to the former Committee were urgently repeated to them.

The Merchandise Marks Act of 1862.

As the Act of 1862 was repealed by that of 1887, it is unnecessary here to summarise its clauses. In substance the offences created by it were very nearly the same as those existing under the later statute; but it was vitiated by defects which have now been removed, for, while it enacted that the forgery of a trade mark with intent to defraud,[1] or the false application of a trade mark to goods,[1] or to the envelope of goods,[2] with the like intent, should be misdemeanours, it left the onus of proving the intent to defraud of the person charged upon the prosecutor, and it made no provision for the summary prosecution of these offences. The Act was also deficient in omitting to provide for the seizure of falsely marked goods upon importation from abroad,[3] and it was, moreover, a monument of complicated and redundant drafting.

The International Convention.

In 1884 Great Britain acceded to the International Convention For The Protection Of Industrial Property, to which all important civilised States, except Austria and Russia, now belong,[4] and thereby formally engaged to co-operate in the execution of the stipulations contained in the convention and protocol[5] agreed upon between the original parties thereto, at Paris, in the previous year. And by Article IX. of the convention it is provided that all goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where the mark or name has a right to legal protection, and that the seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country. It became necessary, accordingly, to amend the law, and out of several Bills introduced into Parliament for this purpose, the Committee of the

[1] Sec. 2.

[2] Sec. 5.

[3] The Customs Act of 1876, s. 42, forbade the importation of articles of foreign manufacture bearing the names, marks, or brands of manufacturers resident in the United Kingdom, &c.

[4] See list, Appendix, p. 741.

[5] See Appendix, p. 743.

House of Commons selected and amended the Merchandise Marks Law Consolidation and Amendment Bill, which subsequently became the Merchandise Marks Act of 1887.

The Merchandise Marks Act of 1887.

The last-mentioned Act[1] provides that any person shall be guilty of an offence, punishable on indictment or on summary conviction by fine or imprisonment, who either (1) forges a trade mark by making or imitating it without the consent of the proprietor, or by falsifying any genuine mark; or (2) falsely applies any trade mark to goods, by applying it, or an imitation of it, without the consent of the proprietor; or (3) applies to goods any false trade description, that is, a description or indication as to the number, quantity, measure, &c., or the place or country of origin of the goods, or the mode of manufacturing them, or their material, or as to their being the subject of an existing patent, privilege, or copyright, which is false in a material respect; or (4) sells or exposes, or has in his possession for sale, or any purpose of sale or manufacture, any goods to which a forged trade mark or false trade description is applied, or to which any trade mark, or imitation of a trade mark, is falsely applied.[2] A criminal intention on the part of the person charged is a necessary element of each of the above-mentioned offences;[3] but the burden of proving that he has acted with the consent of the proprietor of the trade mark, or without intent to defraud, or otherwise innocently, as also the burden of establishing any of the special excuses allowed by the Act, is cast upon the person charged as soon as it is established that he has done any of the acts which, coupled with such criminal intention and in the absence of these excuses, bring his case within the definition of an offence under the statute. The Act, moreover, forbids[4] the importation of goods by means of or in relation to which an offence against it has been committed, and also of all goods of foreign manufacture bearing any name or trade mark being or purporting to be that of a manufacturer or trader within the country, unless it be accompanied by a definite indication of the country where the goods were made or produced. It contains also some special provisions with regard to the marking of watch cases.

[1] Appendix XIX.

[2] Subsidiary offences, such as making dies for forging trade marks, are here passed over.

[3] *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L.C.J., and Grantham, J.; and see 2nd edition, p. 603.

[4] See. 16, below, Appendix XIX.

The Act is directed only against false marking.

It will be seen, therefore, that the Act is directed against false marking only. Deceptive marks or deceptive trade descriptions are forbidden by it to be placed upon goods, but it does not operate to make marking of any kind compulsory, and it does not extend to cases of verbal false descriptions.[1]

The Merchandise Marks Act Committee of 1890.

The Act appears to have attained a considerable success, but it did not fully satisfy the trading community, and three years after its passing another Committee of the House of Commons were appointed to consider its working. And by their report[2] the Committee stated that, while there was a consensus of opinion that the Act of 1887 had generally been most beneficial to the manufacturing interests of the country, and that the importation of fraudulently marked goods, or of goods bearing a false indication of origin, had materially diminished since the Act came into operation, yet complaint had been made that its operation in regard to goods in transit to foreign States had occasioned serious inconvenience and loss to the shipping industries. This complaint, however, the Committee believed to be ill-founded, and they refused to recommend the exemption from the Act of the goods referred to.

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

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

The Merchandise Marks Act, 1891.

[1] *Copper* v. *Moore* (No. 1), [1898] 2 Q. B. 300; 67 L. J. Q. B. 689, Wright and Darling, JJ.; *Longley* v. *Bombay Tea Co., Ltd.*, [1900] 2 Q. B. 460, Grantham and Channell, JJ.; and see *Cameron* v. *Wiggins*, [1901] 1 Q. B. 1, Lawrence and Kennedy, JJ.

[2] M. M. A. Report, 1890.

the Act should be undertaken by the State. The Merchandise Marks Act of 1891 was passed to carry these proposals into effect. By the Merchandise Marks (Prosecutions) Act of 1894 the Board of Agriculture has been authorised to undertake prosecutions.

5. International and Colonial Arrangements.

A foreigner who is the owner of a trade mark, acquired as such in England by use and consequent reputed connection with its owner, has always had the same right to protection in our Courts as a subject of the United Kingdom[1] (unless he happened to be an alien enemy), and neither the Registration Act of 1875 nor the Merchandise Marks Acts of 1862 or 1887 conferred any special privilege or right of protection for their trade marks or trade names upon subjects of this, as contrasted with subjects of other, States. Many treaties existed, moreover, by which this country agreed to give to the subjects of other countries the same right of protection in respect of their trade marks as were enjoyed by its own subjects.[2] On the other hand, when registration of the trade mark concerned became, in general, a condition precedent to the bringing of an action of infringement, as such,[3] it was required in the case of foreign as well as of other plaintiffs, and the acquisition of a trade mark abroad gave no title or right to priority of registration of a trade mark in the English Register.

When the Act of 1883 was passed the International Convention,[4] already referred to, had just been drawn up, and in contemplation of the accession of this country thereto, which took place in the following year,[5] sec. 103[6] was inserted, with the view, apparently, of fulfilling the obligations entered into by the United Kingdom with the other contracting States. The section, however, met those obligations but very imperfectly[7] and the bulk of its provisions were inapplicable to trade marks. Its only substantial operation in regard to them, indeed, was to confer upon an applicant for the protection of a trade mark, in one of

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

[2] See a paper presented to Parliament, 1872, C. 633.

[3] Act of 1905, sec. 42, replacing sec. 77 of the Act of 1883, Chap. XII., p. 334.

[4] See Appendix, p. 743.

[5] 17 March, 1884.

[6] See Chap. XX., p. 576.

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

the other contracting States, a priority over other applicants for registration here during the space of four months, without conferring any title to registration based upon the success of the application in the foreign State, or any exemption from the conditions and formalities to be fulfilled and complied with by ordinary applicants for registration here.[1]

Her Majesty was empowered by sec. 104 of the Act of 1883, by Order in Council,[2] to apply the provisions of the above-mentioned section, with such variations or additions as might seem fit, to any British possession.[3]

Secs. 103 and 104 of the Act of 1883 have been repealed and re-enacted with some changes of form by the Patents and Designs Act, 1907.[4] It is expressly provided by sec. 98 of that Act that the repeal shall not affect any convention or Order in Council having effect under any enactment repealed by that section, but any such convention or Order in Council in force at the commencement of that Act shall continue in force, and may be repealed, altered or amended as if it had been made under that Act.

The protection of the Merchandise Marks Act, 1887, referred to in the preceding section of this chapter, extends to any trade mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of the above-mentioned section (sec. 103) are, under Order in Council, for the time being applicable.[5]

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

[2] See the list, Appendix, p. 741.

[3] See the definition in sec. 117 of the Act of 1883. And see now sec. 18 of the Interpretation Act, 1889, and sec. 93 of the Patents and Designs Act, 1907.

[4] Secs. 91 and 98.

[5] M. M. A., 1887, s. 3 (1).

CHAPTER II.

THE DEFINITION OF A TRADE MARK.

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Definition of a common law trade mark.

The following definition of a trade mark was given in the earlier editions of this work:—

> A trade mark is a symbol[1] which is applied or attached to goods[2] offered for sale in the market,[3] so as to distinguish them from similar goods, and to identify them with a particular trader[4] or with his successors as the owners of a particular business,[5] as being made, worked upon, imported, selected, certified or sold[6] by him or them, or which has been properly registered under the Acts as the trade mark of a particular trader.[7]

The definition might be stated in the following form: "A trade mark is a symbol which is publicly used as the trade mark of a particular trader, or is properly registered as such under the Acts," so as to lay stress upon the element of public user which creates the trade mark, and to which registration was by the Acts of 1875 and 1883 to be deemed equivalent, with the addition of a definition of public user to the effect suggested in the definition selected. It appears to be preferable, however, to cast the whole definition into one in order to avoid the inconvenience of importing into it a reference to the term defined.

No statutory definition before 1905.

The Registration Acts, prior to the Act of 1905, contained no definition of a trade mark, although they contained enumerations of the classes of symbols capable of registration under them as trade marks. Trade marks could prior to the Act of 1905, and can still, be acquired by user independently of registration,[8] and,

[1] Below, p. 28.
[2] Page 29.
[3] Page 33.
[4] Page 35.
[5] See Chap. XIII., Assignment and Devolution of Trade Marks, p. 345; and *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), per Fry, L.J.
[6] Page 53.
[7] Page 55; and see Chap. XII., Effect of Registration, p. 321. As to Cutlers' corporate marks, see Chap. VI., p. 112.
[8] See below, p. 337.

although, with certain exceptions, the technical action for infringement cannot be maintained in respect of an unregistered trade mark,[1] yet protection can be secured for such marks by "passing off" actions;[2] moreover, preferential claims to registration or objections to registration of newer marks resembling them may arise from user of such marks.[3] Furthermore, among the symbols admitted to registration are "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 August 13th, 1875," which has continued to be so used,[4] and questions may still arise whether old marks registered or tendered for registration under this provision or the corresponding provisions of the earlier Acts were used as trade marks or not. Therefore, although the Act of 1905 defines a trade mark for the purpose of that Act, it is useful to consider also what constituted a symbol to be a trade mark apart from the Acts. The definition in the Act of 1905 will, however, first be considered.

The statutory definition of a trade mark.

By sec. 3 of the Act of 1905 "mark" in and for the purpose of that Act includes "a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof," and

> "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."

Mark.

The above definition of a "mark" enters not only into the definition of a trade mark quoted above, but also into the fifth class of essential particulars mentioned in sec. 9, namely, "any other distinctive mark." Practically all symbols of a permanent nature are covered by "mark" as defined in the Act.[5] "Device," "brand," "heading," "label," and "ticket," if distinctive, all formed essential particulars under sec. 64 (1) (c) of the Act of 1883. Their meanings are considered in Chapter VIII., under paragraph (5) of sec. 9.[6] Names,

[1] Sec. 42, sec. 77 of the Act of 1883.

[2] See sec. 45, and below, p. 481.

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

[4] Sec. 9, proviso; see also Act of 1888, sec. 10; Act of 1883, sec. 64; and Act of 1875, sec. 10.

[5] It is not a fatal objection to the registration of a mark that it is capable of registration as a design: *United States Playing Card Co.'s Application*, [1908] 1 Ch. 197, Swinfen Eady, J.

[6] Page 173.

signatures, and words were only registrable as essential particulars under the Acts of 1883 and 1888, if they possessed certain qualifications. They are now, if distinctive, all admitted to registration, but unless they fall within one of the paragraphs (1), (2), (3) and (4) of sec. 9, an order of the Board of Trade or the Court is necessary.[1] Except in the case of old marks, letters and numerals did not form essential particulars under the earlier Acts, and it was held that neither a single letter nor a collection of English letters constituted a device.[2] The letters B. S. A., being the initial letters of Birmingham Small Arms, have been registered as a distinctive mark by the company of that name under the present Act.[3]

Combination trade marks.

The words "or any combination thereof" are useful as enabling a mark composed of two or more of the enumerated elements to be registered, whether they are separately distinctive or not, provided that the combination is distinctive. It is customary in the Manchester trade to use marks in combination for piece goods.

Actual user not necessary.

Actual user is not necessary before registration; this was decided under the Act of 1875 in *Hudson's Trade Mark*.[4] Apart from the Acts user was necessary to constitute a mark to be a trade mark. The definition of "trade mark" quoted above includes a mark "proposed to be used"; this is much simpler than the earlier and somewhat clumsy provision that registration, or, in the Act of 1888, application for registration, should be deemed equivalent to public use.[5] Non-user of a trade mark may, after a certain time, render it liable to be removed from the Register.[6]

Use in connection with the goods.

The definition includes marks used in connection with goods as well as marks used upon them. As will be seen from the discussion of the earlier law in a later portion of this chapter, the decisions before the Act were to the effect that there must be some physical connection between the mark and the goods, or, as it has been expressed, the mark must sell the goods, otherwise there was no "use as a trade mark."[7] The definition

[1] Below, pp. 129, 172.

[2] *Ex p. Stephens*, 3 C. D. 659 (1876); *Mitchell's Tm.*, 7 C. D. 36 (1877).

[3] See *Birmingham Small Arms Co.'s Application*, [1907] 2 Ch. 396; 24 R. P. C. 563.

[4] 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.

[5] Act of 1875, sec. 2; Act of 1883, sec. 75; Act of 1888, sec. 17.

[6] Sec. 37, below, p. 293.

[7] *Powell's Tm.*, [1893] 2 Ch. 388; [1894] A. C. 8; 10 R. P. C. 63, 195; 11 R. P. C. 4; and below, pp. 29 *et seq.*

contained in the Act will probably be construed to cover use in connection, but not in physical connection, with goods, and thus to enable the registration of trade names used for goods, or used in advertisements of the goods, as on placards or in circulars.[1]

A trade mark is indicative of origin.

It has always been essential to the existence of a trade mark that it should indicate the origin of the goods,[2] and this idea is incorporated in the statutory definition by the words "for the purpose of indicating that they" (the goods) "are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale." The proprietor of a trade mark must, subject to an exception to be mentioned, have, or intend to have, a business concerned in the goods for which it is registered,[3] or, putting it in other words, he must have a trade connection with the goods as manufacturer, merchant, or selector.[4] The only exception is in the case of standardisation marks, that is to say, marks indicating examination and certification of the goods, registered under the special provisions of sec. 62; the word "certification" in the definition of a trade mark is specially appropriate to such marks.

"Registrable trade mark."

A "registrable trade mark" is defined as a trade mark which is capable of registration under the provisions of the Act;[5] and a "registered trade mark" as one which is actually on the Register.[5]

"Registered trade mark."

It may be useful to refer to the definitions of "mark" and "trade mark" under the Merchandise Marks Acts.

Definitions in the Merchandise Marks Act of 1862.

The Merchandise Marks Act, 1862,[6] enacts that for the purpose of that Act "The word 'mark' shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket or other mark of any other description; and the expression 'trade mark' shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket or other mark as aforesaid, lawfully used by any person to denote any chattel, or (in Scotland) any article of trade, manufacture or merchandise, to be an article or thing of the manufacture, workmanship, production or merchandise of such person, or to be an article or thing of any

[1] See below, pp. 328, 397.

[2] See below, p. 35.

[3] Cf. sec. 22.

[4] The vendors of vegetables on commission, who had the right of rejecting them, if not of good quality, were held to have, by virtue of "dealing with, or offering for sale," a property in the goods in connection with which they used their trade mark sufficient for the purposes of the Act: *Major Bros. v. Franklin*, 25 R. P. C. 406 (1908), Jelf, J. In the same case it was held that there may be a good trade mark for a natural product.

[5] Sec. 3.

[6] 25 & 26 Vict. c. 88, s. 1.

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

The Merchandise Marks Act, 1887.

The Act of 1862 was repealed by the Merchandise Marks Act of 1887, which, without further defining "trade mark," enacted that, for the purposes of the Act, the expression "trade mark" should mean a trade mark registered in the Register of trade marks kept under the Patents, Designs, and Trade Marks Act, 1883, and should include any trade mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of the 103rd section of the Patents, &c. Act are, under Order in Council, for the time being applicable.[1] From the commencement of the Act of 1905 the definition must be read as referring to the Register kept under that Act.[2]

Judicial definitions.

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

Lord Westbury.

In *The Leather Cloth Co.* v. *The American Leather Cloth Co.*,[3] Lord Westbury said "the word 'trade mark' is the designation of these marks or symbols, as and when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called property."

Bacon, V.-C.

And in *Ford* v. *Foster*,[4] Bacon, V.-C., described a trade mark in the following terms: "The meaning and use of a trade mark is that the same person dealing in goods, no matter of what kind, whether of his own manufacture or not, having a certain defined shape, if he stamps upon them some indication that that particular article is his and his only, may thereby acquire so far an exclusive right to it that no man may imitate his mark, and the legal right goes no further than that."

[1] Sec. 3 (1), below, Appendix XIX.

[2] Act of 1905, sec. 6, and Interpretation Act, 1889, sec. 38.

[3] 4 De G. J. & S. p. 142; 33 L. J. Ch. 199 (1863).

[4] L. R. 7 Ch. p. 616 (1872).

Kay, J., and Esher, M.R.

"User as a trade mark," Kay, J., said, in *Richards* v. *Butcher*,[1] "means, not what the person who uses has in his own mind about it, not what he has registered in a foreign country, but what the public would understand when the trade mark, or so-called trade mark, is impressed upon the goods, or upon some wrapper or case containing the goods, to be the trade mark. That is the trade mark proper; and user as a trade mark means, and must necessarily mean, the impressing of those words either upon the goods, or upon some wrapper or case containing the goods, in such a way that the public would necessarily understand those words to be, and alone to be, the trade mark of the person who uses them." And in the same case, on appeal, Lord Esher said: "You use the thing as a trade mark if you use it in business, or, as is often said, in the market, as a mark to denote your goods, and to distinguish them from the goods of anyone else."[2]

Rigby, L.J.

In *The Magnolia Metal Company's Trade Marks*,[3] Rigby, L.J., dealing with the case of a name, said: "In order that the name of an article may in any case be the trade mark of the manufacturer, it is essential that the name should indicate, not the article only, but also that the article is manufactured by the person claiming it as a trade mark, as distinguished from other persons also manufacturing or entitled to manufacture it."

Object of trade marks to protect trade.

The protection afforded to trade marks has for its object the protection of trade only. In *Batt & Co.* v. *Dunnett*, Lord Halsbury, in the course of the argument, observed: "The Trade Mark Acts are not for copyright in marks; they are to protect trade marks. If you have no goods you are claiming copyright only, you are not claiming for the purpose of protecting your trade."[4]

A Symbol.

What symbols may be trade marks.

Before the Trade Marks Registration Act, 1875,[5] no restriction was placed upon the kind or class of symbols which, if adopted and used as a trade mark, would be protected against infringement or piracy, except that the Courts refused to interfere where the symbols contained misrepresentation,[6] or were, or were so used as to be, calculated to deceive, and they would, no

[1] [1891] 2 Ch. p. 532; 8 R. P. C. 249 (*Monopole*).

[2] [1891] 2 Ch. p. 543.

[3] [1897] 2 Ch. p. 390; 14 R. P. C. p. 626.

[4] 16 R. P. C. p. 413 (1899).

[5] Sec. 10, replaced by sec. 64 of the Act of 1883, by sec. 10 of the Act of 1888, and now by sec. 9 of the Act of 1905.

[6] See below, pp. 426 *et seq.*

doubt, if any case had occurred, have refused to interfere also where the symbols themselves were scandalous or indecent. The only general limit, therefore, put upon the choice of a trade mark was that it should be capable of distinctive user in accordance with the terms of the definition.[1] Under the Act of 1905 "mark" includes device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.[2] This appears to cover all symbols.

Applied or attached to Goods.[3]

The phrase in the Act of 1905 is "used upon or in connection with" goods.

It is immaterial whether the mark is attached to the goods or to the covering in which they are sold.[4] It may be impressed, stamped, cut, drawn, painted or stained on the goods themselves, as the words *Sykes' Patent* were in *Sykes* v. *Sykes*,[5] or on their envelope, as are labels on bottles and brands on corks, or in any other way attached to the goods—for instance, by being marked upon tallies[6] tied on to them, or upon reels upon which the goods are wound, or on a card to which the goods are fastened.[7] All that was necessary was that there should be some physical connection between the goods and the mark, so that the mark should go with the goods into market.[8] Before the new Act a device was not "used as a trade mark" unless it was applied or attached to the goods in such manner, although it might be used by a trader in his advertisements, price lists, or trade circulars, so as to become commonly associated with him and his goods, as, for instance, lithographs of Millais' picture "Bubbles" are associated with Pears' Soap.

The mark must go to market with the goods

Thus, in *Thompson* v. *Montgomery*,[9] the ale of the plaintiffs had been known for many years as *Stone Ale*, and there was evidence

[1] See below, p. 35.

[2] See above, p. 24.

[3] See the *dicta* quoted above, pp. 27 and 28, and below, p. 203.

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

[5] 3 B. & C. 541; 3 L. J. K. B. (O. S.) 46 (1824).

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

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

[8] See *Powell's Tm.*, [1893] 2 Ch. 388, [1894] A. C. 8; 10 R. P. C. 63, 195; 11 R. P. C. 4. (*Yorkshire Relish.*)

[9] 41 C. D. 45; 6 R. P. C. 404 (1889). There was no appeal upon this point to the House of Lords. An injunction was granted notwithstanding the removal of the mark. See also *Verity's Tm.*, 19

that that name had been used in ordering goods from them, and in selling goods to their customers, as a description of the ale, or of a particular class of ale made by them. Beyond this there was no evidence of the use of the name as a trade mark, and the Court of Appeal accordingly held that the words had been wrongly claimed as a trade mark in use before 1875, and ordered them to be removed from the register. So in *Powell's* case[1] it was decided that the use of the words *Yorkshire Relish* upon the rough packing cases in which the bottles of sauce were placed for safe carriage was not, under the circumstances of the case, use of the words as a trade mark. "The function of a trade mark," Bowen, L.J., said,[2] "is to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods —to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market. Accordingly, it may either be marked on the goods themselves, or, if that is not possible or convenient, it may be marked on the vehicle of the goods, and may be, and sometimes, I dare say, is, marked upon a covering or exterior, such as a packing case. But when you are considering a mark upon the vehicle as distinct from a mark upon the goods, you must ask yourself carefully, Is this mark used as a trade mark?"

and must sell the goods.

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

Used in connection with.

The statutory definition now extends to marks used or proposed to be used in connection with goods as well as to marks used upon them. Apparently this is intended to bring trade names of goods, such as are above referred to, under the category of trade marks and to admit them to the advantages of trade marks, although they may never have been attached or applied to the goods themselves. And the corresponding section dealing with the infringement of a trade mark is framed to correspond with this view.[3] It was to some extent an open question before the Act whether there could be an infringement of a registered trade mark by the use of a mark which was not applied or attached to the defendant's goods, although used in connection with them

R. P. C. 58 (1902), Buckley, J., use in price list only.

[1] Note (8), p. 29; cf. *Richards* v. *Butcher*, [1891] 2 Ch. 522: 8 R. P. C. 249, Kay, J., and C. A., *Monopole* used on packing cases and wine corks, and *Day* v. *Riley and Whittaker*, 17 R. P. C. 517, Buckley, J., *Day & Sons* stencilled on packing cases *Black Drink*

[2] [1893] 2 Ch. p. 461.

[3] Sec. 39, infra, p. 32.

and as a mark of origin. 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.[1]

The question whether stamping a mark on the corks of wine bottles at the sides or ends where it cannot be seen is user of it as a trade mark has been discussed[2] but not decided. It is submitted that it may be if, in fact, the known presence of the mark, or the expectation of finding it, induces the customer to buy the wine as that of the proprietor of the mark. In a case in which three labels were registered as one trade mark, two of them being used outside the packet of goods and the third inside, it was held that, notwithstanding this, the mark was properly registered, being a combination trade mark.[3]

Use on corks.

The exclusive rights existing in respect of a trade mark are restricted to the class of goods to which it has been attached or applied.[4] It is, therefore, no infringement to apply the same or a similar mark to other goods. This rule was clearly stated in a dictum of Lord Westbury, in *The Leather Cloth* case, which has often been cited. "Property in a trade mark," he said,

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

[1] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J., a circular held to be an infringement. In *Bourne* v. *Swan & Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J., said in a case in which the plaintiffs failed, that it was not necessary to show that the defendants were using the mark as a trade mark, but that this was an element to be considered in deciding whether there was a probability of deception. The question was discussed by the C. A. in *Price's Patent Candle Co., Ltd.* v. *Joyce's Sanitary Compound Co.*, 19 R. P. C. 17 (1901). See also *Montgomerie* v. *Young*, 20 R. P. C. 781; 21 R. P. C. 285 (1904), Scotch. In *Kodak, Ltd.* v. *London Stereoscopic Co., Ltd.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., it was practically admitted by the defendants that the use of the plaintiff company's trade marks as the names of goods in invoices was an infringement, and an injunction was granted against infringement. It has, however, recently been held by Warrington, J., on an interlocutory application, that merely supplying goods in response to a written order in which the goods were described by the trade mark would not be an infringement of trade mark: *Peters* v. *Domestic Inventions Co.*, 25 R. P. C. 387 (1908). Under the Merchandise Marks Act a description in an invoice sent with the goods has been held to be "applied" within sec. 5 (1) (d). *Budd* v. *Lucas*, [1891] 1 Q. B. 408. See below, "Infringement," p. 397.

[2] *Kinahan & Co.'s Application*, 10 R. P. C. 393 (1893), Chitty, J.; *Richards* v. *Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A. Marks so used were protected in *Moet* v. *Clybourn*, Seb. Dig. p. 316 (1877), Jessel, M.R.; and *Moet* v. *Pickering*, 8 C. D. 372; 47 L. J. Ch. 527 (1878), C. A. See also *Findlater, Mackie, Todd & Co.* v. *Newman & Co.*, 19 R. P. C. 235 (1902), Kekewich, J. (F. M. T. & Co. on corks, a passing-off case).

[3] *Crompton's Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265, Swinfen Eady, J.

[4] *Somerville* v. *Schembri*, 12 App. Ca. 453; 4 R. P. C. 179 (1887), on appeal from Malta; and see *Coleman* v. *Brown*, 16 R. P. C. 619 (1899). As to registered trade marks, see below, pp. 326 and 392.

"is . . . . the right to the exclusive use of some mark, name, or symbol in connection with a particular manufacture or vendible commodity; consequently, the use of the same mark in connection with a different article is not an infringement of such right of property."[1] Thus, a trade mark used for flour and bread may be adopted as a new trade mark for carriages.[2]

So no one can acquire an exclusive right to affix the trade mark to goods which do not fall within the class indicated by the mark, or, in other words, to goods which do not possess the attribute the mark is understood and intended to connote. Thus, in *Cotton* v. *Gillard*,[3] the defendant had invented a sauce which was prepared from a secret recipe not known to the plaintiff, and was called the *Licensed Victuallers' Relish*. The plaintiff had purchased from the assignee in bankruptcy of the defendant's son all his interest in the sauce, and this, he contended, included the right to the trade mark used with the business. Jessel, M.R., however, held that this right could not exist or be transferred without the goods with which the mark was connected, and that the plaintiff could have no assistance from the Court to enable him to pass off under the mark, as the original sauce, an imitation of his own.[4]

The use of trade mark on other goods not protected.

Of course, the extent of the class of goods to which a trade mark is properly applicable will vary very much in different cases. If the mark means that the goods are made by its owner, then it will not rightly be applicable to goods which he has bought to resell, and on the principle of the case just cited it would seem that if, in such a case, the owner were to give up manufacturing he would lose his trade mark, although he commenced to deal as a merchant in the same goods.[5] If, again, the mark means that the goods are selected, shipped, or sold by the owner, then, probably, it may be rightly applicable to many different kinds of goods, and to kinds which may vary, and perhaps very widely, from time to time.[6] The principle is

[1] 4 De G. J. & S. 137; 33 L. J. Ch. p. 201 (1863).

[2] *Lake and Elliott's Application*, 20 R. P. C. 605 (1903), Kekewich, J., and see Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. p. 443; 45 L. J. Ch. 494 (1876); and Chap. XV., on Infringement, below, p. 392. Cf. *The Australian Wine Importer's Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), cited p. 227.

[3] 44 L. J. Ch. 90 (1874). So a trade mark cannot be separated from the goodwill of the business to which it has been attached; see below, pp. 346 and 367.

[4] Cf. *Birmingham Vinegar Brewery Co., Ltd.* v. *Powell*, [1897] A. C. 710; 14 R. P. C. 720; and Rule 16, p. 658.

[5] See below, p. 53.

[6] Below, p. 54; and see Chap. XII., p. 321, Effect of Registration.

illustrated by a recent case in which a name had long been used by a shipper in connection with port wine made from the grapes of a particular vineyard, and it was held that, after he had ceased to be supplied from the vineyard, he could not properly apply the name to wine made from other grapes.[1]

It is clear, however, that the rights arising out of the possession of a trade mark, registered or unregistered, are not limited to the exact kinds of goods for which the mark has been used; actions for infringement of a registered trade mark are by virtue of sec. 42 limited to the goods for which the mark is registered, but, subject to that limitation, the extent of the class of goods to which the rights are limited is a question of fact in each case, depending to a great extent on the commercial connection between the kinds of goods in question, as, for instance, whether they are usually sold by the same class of persons.[2]

Anyone may apply the mark to the right goods.

As the mark must not be applied to the wrong goods, so, on the other hand, it may be applied by anyone to the right goods. Thus, in *Farina* v. *Silverlock*,[3] Lord Cranworth refused an injunction to restrain the defendant, a printer, from printing labels in imitation of the labels on the plaintiff's Eau de Cologne, on the ground that the labels might be intended to be placed upon scent which had actually come from the plaintiff.[4] And the test of infringement laid down in all the cases is that the defendant's acts shall be calculated to pass off goods as the plaintiff's which are not his;[5] and that is all that an ordinary form of the injunction granted in trade mark cases restrains.[6]

Offered for Sale in the Market.

The mark must be applied to goods offered for sale.

An allegation that the plaintiff's goods were sold with the trade mark attached, and that they enjoyed a great reputation, was regularly inserted in the declaration in the old common law

[1] *Van Zeller* v. *Mason, Cattley & Co.*, 25 R. P. C. 37 (1908), Joyce, J.

[2] *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.; and *Eastman Photographic Materials Co., Ltd.* v. *John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer J.; and see below, Chap. X., p. 247.

[3] 1 K. & J. 509; 6 De G. M. & G. 214; 24 L. J. Ch. 632; 26 L. J. Ch. 11 (1855).

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

[5] See below, p. 400.

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

action for infringement.[1] And in *Lawson* v. *The Bank of London*,[2] an action to restrain the defendants from usurping the name of the plaintiff's bank, a demurrer was allowed because the declaration did not allege that the plaintiff had carried on business as a banker, but only that he had expended money in advertisements. "No action could, I apprehend," said Willes, J., in that case, "be maintained for the sale of goods branded or stamped with another manufacturer's mark, which mark had never been put forward to the world by the party complaining of the misuser of it."

This dictum was cited with approval by Lord Cairns, in *Maxwell* v. *Hogg*.[3] In that case the defendant registered at Stationers' Hall the word *Belgravia* as the name of an intended new magazine, in the year 1863. In 1866 the plaintiff began to advertise a different intended new magazine under the same name. The defendant thereupon hurriedly brought out a number of his magazine in September, 1866, and the plaintiff followed in October, and cross suits were then brought by each to restrain the other from using the name. Both suits failed. The plaintiff's was dismissed because his advertisements and expenditure gave him no title to the name before the defendant's first number appeared, and the defendant's because of his uncandid conduct in rushing forward his magazine, knowing of the plaintiff's undertaking, without giving him warning. That the trader's goods should have acquired any reputation for special excellence or quality in order that his mark should be protected was, however, Lord Cairns declared, unnecessary; but, he said,[4] all the definitions of trade mark rights given in Equity, "seem to me to be opposed to the idea that protection can be given where there has been no sale or offering for sale of the articles to which the name is to be attached." According to the decisions, he added, no property in a name (or mark) could be acquired except through the process of sale or offering for sale in the market.

And the second of the "essential qualities for constituting property in a trade mark" enumerated by Lord Westbury in

[1] See *Sykes* v. *Sykes*, 3 B. & C. 541; 3 L. J. K. B. (O. S.) 46 (1824); above, p. 3.

[2] 18 C. B. 84; 25 L. J. C. P. 188 (1856).

[3] L. R. 2 Ch. 307; 36 L. J. Ch. 433 (1867).

[4] L. R. 2 Ch. p. 314; 36 L. J. Ch. p. 436.

McAndrew v. *Bassett*[1] was that the article marked with the mark in question was actually a vendible article in the market.[2]

Long user of mark or proof of actual reputation unnecessary.

It is not, however, necessary that the goods should be in the market with the mark affixed for any definite or any considerable time. Thus it was no objection to the defendant's counterclaim in *Maxwell* v. *Hogg*,[3] that he had brought out but one number of his magazine, and that only a few days before the plaintiff's issue appeared; and in the same case, as already stated, Lord Cairns decided that reputation for quality was immaterial for the acquisition of the legal right.[4] The statutory definition extends to new trade marks provided that they are proposed to be used upon or in connection with goods.

Nor is it essential that the significance of the mark should be proved to have become known to any ascertained person or persons. It is sufficient, subject now to the provisions of the Act in regard to registration, to entitle a trader to protection for his mark that he has offered goods for sale with the mark so attached that it will, when known, indicate his connection with the goods. It would be an insoluble inquiry, as Lord Romilly declared in *Hall* v. *Barrows*,[5] to seek to discover when first a mark acquired a distinctive character in the market as denoting the goods of the trader who first used it.

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

Mark must be distinctive.

That it is of the essence of a trade mark that it shall have this distinguishing character, is fully established by the statements of the principles upon which the law of trade marks rests, stated in the last chapter, and the *dicta* quoted in an earlier part of this chapter.[6] The rule is further illustrated by the

[1] 4 De G. J. & S. 380; 33 L. J. Ch. 561 (1864), (*Anatolia liquorice*).

[2] See also *Powell's Tm.*, [1893] 2 Ch. 388; 10 R. P. C. 63, 195, cited above, p. 30; and the observations of Halsbury, L.C., in *Batt & Co.* v. *Dunnett* (1899), 16 R. P. C. p. 413, cited above, p. 28.

[3] L. R. 2 Ch. 307 (1867); 36 L. J. Ch. 433.

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

[5] 32 L. J. Ch. p. 551 (1863); and see per Wood, V.-C., in *McAndrew* v. *Bassett*, 33 L. J. Ch. 561 (1864).

[6] Pages 1 to 4, see also the statutory definition, above, p. 24.

question, which has always been regarded as the test of infringement: Will the use of the trade mark by the defendant lead purchasers to mistake his goods for those of the plaintiff?[1]

"The right which a manufacturer has in his trade mark," Lord Cranworth said, in *The Leather Cloth* case,[2] "is the exclusive right to use it for the purpose of indicating where, or by whom, or at what manufactory the article to which it is affixed was manufactured." And the same judge, in *Farina* v. *Silverlock*,[3] after distinguishing copyright from the right to a trade mark, added, "anyone who has acquired a particular mode of designating his particular manufacture, has a right to say, not that other persons shall not sell exactly the same article, better or worse, or an article looking exactly like it, but that they may not so sell it as to steal the plaintiff's trade mark, and make purchasers believe it is the manufacture of somebody else." And in *Massam* v. *Thorley's Cattle Food Co.*,[4] James, L.J., said, "That in truth is the meaning and object and result of a trade mark. It indicates this, that you may take this as a warranty that it has come from the particular manufacturer of the goods with which you have been hitherto pleased."[5]

The statutory definition requires that the mark shall be used or proposed to be used for the purpose of indicating that the goods are the goods of the proprietor of the trade mark, and the definition of "distinctive" in sec. 9 is "adapted to distinguish the goods of the proprietor of the trade mark from those of other persons."[6]

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

But it is not necessary that the public should know the name of the proprietor of the trade mark. In *Powell* v. *The Birmingham Vinegar Brewery Co., Ltd.*, there was evidence that many purchasers of "Yorkshire Relish" knew nothing of the plaintiffs, but in reference to this Lord Herschell said, "in the present case, it seems to me that 'Yorkshire Relish' means the manufacture of a particular person. I do not mean that in the minds

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

[2] 11 H. L. C. 523; 35 L. J. Ch. p. 57 (1865).

[3] 6 De G. M. & G. 214; 26 L. J. Ch. p. 12 (1855).

[4] 14 C. D. 748; 42 L. T. (N. S.) 851 (1880).

[5] See also the passage from the judgment of Rigby, L.J., in *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. p. 390; 14 R. P. C. p. 626, cited supra, p. 28.

[6] See *Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436, Kekewich, J.

of the public the name of the manufacturer was identified, but that it meant a particular manufacture and that when a person sold 'Yorkshire Relish' as the appellants did, by selling it as 'Yorkshire Relish' and calling it 'Yorkshire Relish,' they represented to the public that it was that manufacture which was known as and by the name of 'Yorkshire Relish.'"[1]

A provision in the Registration Acts allows any "special or distinctive[2] word or words, letter, numeral, or combination of letters or numerals, used as a trade mark" before the commencement of the Act of 1875, to be registered as a trade mark;[3] and it was held that the qualification as it stood in the earlier Acts, namely, "special and distinctive," did no more than embody the requirements of the existing law in regard to what were or might be trade marks.[4]

A name or device, therefore, which is merely descriptive of the goods themselves or of some quality or attribute which they possess, or are supposed to possess, or which is common to the trade,[5] cannot be a trade mark. And it follows that marks which were once distinctive may have fallen into one of these groups, and so ceased to be available as trade marks.

What are distinctive marks.

The element of distinctiveness is essential in any mark which is to be registered as a trade mark under the Acts, and its characteristics as established and illustrated by judicial decisions will be considered in a later chapter;[6] but it will be convenient here to state in outline the leading cases in which this branch of trade mark law has been discussed, apart from the operation of the Acts, since these cases are still frequently referred to, and turn upon principles of general application.

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

The question whether a mark is merely descriptive can hardly arise except with regard to word marks.[7] It may be stated in either of the following forms: Do the words which are claimed as a trade mark (or trade name of the goods, for the same principles apply to both) merely denote the goods, or have they a secondary meaning connoting a connection with the persons who

[1] [1897] A. C. p. 715; 14 R. P. C. p. 730.

[2] Act of 1905, sec. 9. In the earlier Acts "special and distinctive."

[3] As to what marks come within the proviso, see Chap. VIII., p. 198, below.

[4] *Hopkinson's Tm.*, [1892] 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.

[5] As to marks common to the trade, see below, pp. 177 and 214.

[6] Chap. VIII., p. 127.

[7] As to pictures of the goods, see *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A. (*Dome Black Lead*), and below, p. 187.

claim them as a trade mark? or, Are the words the known description of all goods of the class by whomsoever they are made or sold, or only of the species within it which are made or sold by those particular manufacturers or traders?

The question arose as early as the case of *Millington* v. *Fox*.[1] There the plaintiffs sued the defendants for infringing their trade marks consisting of the words *Crowley Millington*, or one of them, and certain marks which they and their predecessors had used as brands on steel since the seventeenth century; the defendants alleged that both *Crowley* and *Millington* were technical terms understood in the market to mean steel shaped in a particular way, and this would have been a good defence had the evidence been sufficient to support it.

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

In *Ford* v. *Foster*[2] the plaintiff sought to restrain the defendants from placing the word *Eureka* upon shirts of the defendants' manufacture. The plaintiff had introduced into the market shirts of a certain shape, which he sold as *Ford's Eureka Shirts*, and the defendants alleged that the word in question was the known description of shirts of that particular shape. They were at liberty to make and sell the shirts, and consequently, they urged, to use the name also. Bacon, V.-C., was in favour of the defendants upon the evidence as to this, but he decided the case on the ground that the word *Eureka* was only part of the plaintiff's trade mark, and that he had no right to its exclusive use. The plaintiff appealed, and the decision was reversed, the Lords Justices finding that retail buyers would be led to believe by the use of the word that the goods were goods made by the plaintiff.

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

The test whether a name has become *publici juris*, said[3] Mellish, L.J., must be "whether the use of it by other persons may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods." If not, he added, "however hard, to some extent, it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent the trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade mark, the right to the trade mark must be gone." An injunction was accordingly

[1] 3 My. & Cr. 338 (1838), Cottenham, L.C.

[2] L. R. 7 Ch. 611 (1872); 41 L. J. Ch. 682.

[3] At page 628. See also *Whitstable Oyster Fishery Co.* v. *Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 R. P. C. 434; (1901), Buckley, J., and C. A.

granted to restrain the defendants from applying the mark *Eureka* to any shirts not manufactured by the plaintiff;[1] but the defendants were left at liberty to advertise the name between themselves and the trade, as the Court thought that in the trade the name had the meaning contended for by them, and that the use of it in the manner stated could not lead to deception.

The *Singer* cases. *Singer* v. *Wilson.*

The most important of the earlier cases on the subject are two cases in which the Singer Manufacturing Co. sought to maintain a monopoly in the use of the name *Singer* for sewing machines manufactured by them. The cases were, in fact, trade name not trade mark cases, but the principles upon which they proceeded, and the judgments delivered in them, are equally applicable to both marks and names. The plaintiffs were an American company carrying on a business, originally founded by one J. M. Singer, in sewing machines which they and their predecessors had extensively advertised under the name in question, and they alleged that their machines were not of any particular type which was known as the *Singer Machine*, but were of many varieties, some of which had specific names appropriated to them. They were accustomed to place a distinctive trade mark, comprising their name and a particular device, upon each of their machines, but it was not alleged in either case that the defendant had infringed this trade mark. The defendant in the first case[2] had issued advertisements and price lists in which he professed to sell *Singer* and *New Singer* machines, but in which he described them as manufactured by himself. He had not infringed the plaintiff's distinctive trade mark. For the defence it was alleged that the name *Singer* meant one of two particular types of machine, that it had come to be like *Hansom* and *Brougham*, the "name of the article, and not a mark or sign indicating the manufacturer."[3] The case took a somewhat unusual course. It was dismissed by Jessel, M.R., without the defendant having been called upon, and this decision was upheld by the Court of Appeal, but reversed by the House of Lords, the House deciding that, upon the evidence of the plaintiffs,

[1] For form of injunction, see L. R. 7 Ch. p. 634; Appendix, p. 731.

[2] *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. 434; 45 L. J. Ch. 490 (1875); 3 App. Ca. 376; 47 L. J. Ch. 481 (1877). See also the Scotch case of *Singer Manufacturing Co.* v. *Kimball*, 11 Court of Sess. Cas. 3rd series, 267, where an injunction was granted. See below, p. 41, note 3.

[3] Per Ld. Cairns, 3 App. Ca. p. 385; 47 L. J. Ch. p. 485.

an answer was called for, and that, therefore, the defendant ought to be required to prove the allegation on which he relied.[1]

In non-suiting the plaintiffs, Jessel, M.R., proceeded on the ground that as the word *Singer* was not attached to the goods it was not a trade mark, and that the plaintiffs could, therefore, only succeed by making out a case of fraudulent representation.[2] The representations made in the defendant's price lists and advertisements were, he held, incapable of misleading anyone as to the origin of the machines. The Court of Appeal took the same view of the representations, and relied chiefly on that in upholding the decision. In the House of Lords, Lord Cairns said the question must be, "Are the advertisements of the defendant, having regard to the evidence in the case, calculated to mislead an unwary purchaser of the machines?" And this question might still be answered affirmatively, he thought, although when the advertisements came to be spelt out with care, there was no actual representation on them that the goods they referred to were made by the plaintiffs. And he rejected the distinction suggested by Jessel, M.R., between cases where a trade mark used on the goods was infringed, and cases where the name by which the goods were advertised and known was pirated. Fraud, or intent to deceive, need not, he said, be alleged or proved in either case.[3] The other law lords agreed that the plaintiffs had made out a case to show that the defendant's advertisements might lead to his goods being bought as and for theirs, and that, therefore, the defendant ought to have been called upon to displace this case, or to establish by evidence his own contention as to the meaning of *Singer*. The case was sent down for a new trial, but there is no further report of it.

Singer v. *Loog.*

Many of the same questions were discussed again in the case of *The Singer Manufacturing Co.* v. *Loog*.[4] There the defendant had placed upon the machines which he sold a plate marked *Singer machine*, but bearing also words referring to the foreign makers of the goods. This plate he offered to abandon, but he claimed the right to use the word *Singer* to describe his machines.

[1] The case does not appear to have been carried any further.

[2] See above, p. 13, where the judgment is quoted at length.

[3] 3 App. Ca. p. 391; 47 L. J. Ch. p. 488; and see above, p. 14.

[4] 18 C. D. 395 (1879); 8 App. Ca. 15: 52 L. J. Ch. 481 (1882).

He did not, in fact, call his machines *Singers*, but advertised them as *our Singer machines*, and as machines made on the *Singer system*. Both the Court of Appeal and the House of Lords, reversing the judgment of Bacon, V.-C., decided that the documents issued by the defendant were not calculated to deceive, and the action consequently failed. The question as to the secondary meaning of the word *Singer* did not, therefore, call for decision;[1] but it was agreed by all the judges, and was admitted by the plaintiffs themselves, that they could claim no exclusive use of the word if the defendant could show that the article in question was a specific article known by a specific name, and that, as in the case of the Wellington boots and Hansom cabs, he was unable to designate the article in any other way than by its known name.[2] Lord Selborne, however, found as a fact that the term *Singer* did signify a system of construction for sewing machines known to the trade.[3]

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

The obvious intention of the plaintiffs in both these cases was to monopolise, if possible, the reputation gained by the machines which they had been the first to introduce into the market by preventing other traders from using the name by which the machines were known, and this they were not allowed to do. "The reputation acquired by machines of a particular form or construction," said Lord Selborne,[4] "is one thing; the reputation of the plaintiffs is another. If the defendant has no right under colour of the former to invade the latter, neither have the plaintiffs any right under colour of the latter to claim (in effect) a monopoly of the former. If the defendant has (and it is not denied that he has) a right to make and sell, in competition with the plaintiffs, articles similar in form and construction to those made and sold by the plaintiffs, he must also have a right to say that he does so, and to employ for that purpose the terminology common to the trade, provided always that he does this in a fair, distinct, and unequivocal way."

[1] 18 C. D. p. 419.

[2] 18 C. D. p. 398.

[3] The question of fact is now settled by *The Singer Manufacturing Co.* v. *Spence & Co.*, 10 R. P. C. 297 (1893), where it was admitted that to an inner ring of the trade *Singer* means a system of manufacture; but Romer, J., found it means the plaintiffs' manufacture, to a large part of the public. And in *The Singer Manufacturing Co.* v. *British Empire Manufacturing Co.*, 20 R. P. C. 313 (1903), Kekewich, J., found that to ordinary purchasers there was nothing known as a *Singer* system.

[4] 8 App. Ca. p. 27; 52 L. J. Ch. p. 487; see also *Leonard and Ellis' Tm.*, 26 C. D. p. 297: 53 L. J. Ch. 603 (1884), C. A.

The Liebig's Extract case [1] affords a good example of a name which was held to be merely the name of the goods, common to all the world, and subject to no monopoly rights. There Baron Liebig, the inventor of the process by which the extract was prepared, had purported to confer upon the plaintiffs an exclusive right to use his name in connection with the goods, and they sought to restrain the defendant from using the words *Liebig's Extract*. The process of manufacture had, however, been long published and largely employed, and the goods were commonly known by the name in question. The injunction was accordingly refused.[2]

Change of meaning of word.

The meaning of a word may, of course, undergo changes from time to time, thus a name which in one case was held to indicate a system or type of motor, was in a later case held to have lost that meaning.[3]

Secondary meaning of words originally common.

On the other hand, a striking example of words, which in their primary meaning were purely descriptive, acquiring a secondary meaning—namely, that the goods described by them were the manufacture of a particular company—is afforded by the case of *Reddaway* v. *Banham*.[4] The plaintiffs in that case had for many years made belting, consisting mainly of camel-hair, for machinery, and sold it under the name *Camel-hair Belting*. The defendants, who had sold similar belting under other names, commenced to sell it under the name *Camel-hair Belting*, and in most cases put that name only on the belting. The plaintiffs commenced an action for an injunction to restrain the defendants from using the word *camel* in such a manner as to pass off their goods as and for the plaintiffs' goods. The jury found (1) that *Camel-hair Belting* meant belting made by the plaintiffs as distinct from belting made by other manufacturers, and that it did not mean belting of a particular kind without reference to any particular manufacturer; they also found that the description was likely to mislead purchasers, and that the defen-

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

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

[3] *Daimler Motor Car Co., Ltd.* v. *British Motor Traction Co., Ltd.*, 18 R. P. C. 465 (1901), Buckley, J., and *Daimler Motor Co.* (1904), *Ltd.* v. *London Daimler Co., Ltd.*, 23 R. P. C. 718; 24 R. P. C. 379 (1907), C. A.

[4] [1896] A. C. 199; 13 R. P. C. 218.

dants had endeavoured to pass off their goods as the plaintiffs' goods. In spite of these findings, it was held by the Court of Appeal that *Camel-hair Belting* was a true description of the defendants' goods, and that they could not be restrained from using it, and the Court dissolved the injunction granted by Collins, J.; the House of Lords, however, reversed the judgment of the Court of Appeal. In Lord Herschell's judgment the following passages occur: "The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves, without explanation or qualification, by another manufacturer, would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B."[1] And, replying to the argument that the defendants had only used a true description of their goods, he said, "I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification differing from its primary one, and that if it is used, to persons in the trade who will understand it, and be known and intended to understand it, in its secondary sense, it will none the less be a falsehood because in its primary sense it may be true."[2]

In *The Cellular Clothing Company* v. *Maxton & Murray*,[3] it was, however, pointed out that such a case as *The Camel-hair Belting* case was difficult to establish, and the House of Lords held that the plaintiffs in *The Cellular* case had failed to prove that the word *Cellular* had the secondary meaning of identifying goods so described with the plaintiffs'.[4]

Name of goods made under an expired patent.

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

[1] [1896] A. C. p. 210; 13 R. P. C. 228.

[2] [1896] A. C. p. 212; 13 R. P. C. p. 229.

[3] [1899] A. C. 326; 16 R. P. C. 337. See also *Parsons* v. *Gillespie*, [1898] A. C. 239; 15 R. P. C. 57.

[4] The decision in this case has been followed in several subsequent cases, see Chap. XVI., pp. 508 *et seq.* As to names obtaining a secondary meaning, see pp. 533 *et seq.*

On this subject, Lord Herschell's Committee said in their report[1]: "It has been suggested that there is a necessity for some statutory definition of the trade mark rights which are acquired in connection with words used as the names of patented articles. Where a patent has been obtained for some article of commerce, and the patentee gives it a name which he registers as his trade mark, has he a right, at the end of the term of his patent, to prevent other people from selling it under that name? It is clear that he obtains the patent upon the condition that, at the expiration of the term of his monopoly, the public shall have the right to manufacture and use it; and if the only name by which it is known is that which the proprietor has registered as a trade mark, it would certainly seem inconsistent with the right thus intended to be conferred on the public, if everyone, except the original patentee, were prevented from calling it or selling it by that name which alone it bears. The authorities appear, however, to show that such a claim could not be maintained."

The cases of *The Wheeler and Wilson Manufacturing Co.* v. *Shakespear*[2] and *The Linoleum Manufacturing Co.* v. *Nairn*[3] are the leading authorities on this head. In the former case, the plaintiffs were manufacturers of sewing machines made according to an expired patent, and in the manufacture, therefore, they had no monopoly. The defendant advertised himself as the "agent for the sale of the Wheeler-Wilson machine" in Birmingham, although he was not the plaintiffs' agent, and was not selling machines made by them. He alleged that his advertisement meant only that he sold the machines. The Court, while restraining him from advertising himself as agent, refused to restrain him from describing the machines he sold as *Wheeler and Wilson's*. It was not, said James, V.-C., the name of the makers but of the thing itself, and the monopoly under the expired patent could not be prolonged by granting a monopoly in the name.

The Linoleum case.

In *The Linoleum* case,[4] the plaintiffs used a trade mark containing the word *Linoleum* for a floor-cloth which had

[1] Report of 1888, p. xiv.
[2] 39 L. J. Ch. 36 (1870), James, V.-C.
[3] 7 C. D. 834: 47 L. J. Ch. 430 (1878), Fry, J.
[4] *Linoleum Co.* v. *Nairn*, 7 C. D. 834; 47 L. J. Ch. 430 (1878); cf. *Young* v. *Macrae*, 9 Jur. (N.S.) 332 (1862), Wood, V.-C., *paraffin* not a trade mark.

been first manufactured and sold by them under a patent, and they unsuccessfully endeavoured to restrain the defendants from selling similar cloth as *Linoleum Floor Cloth* after the patent had expired. Fry, J., found as a fact that the word *Linoleum*, which was taken by the defendants, was not an essential part of the plaintiffs' trade mark, but was descriptive only. It was, he said, the name of the thing, and the defendants were not bound to invent a new name for it if they made it. The name, he added,[1] "only secondarily means the manufacture of the plaintiffs, and has that meaning only so long as the plaintiffs are the sole manufacturers. In my opinion, it would be extremely difficult for a person who has been, by right of some monopoly, the sole manufacturer of a new article, and has given a new name to the new article, meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone after his competitors are at liberty to make the same article. It is admitted that no such case has occurred, and I believe it could not occur."[2]

The principle thus laid down has been approved and adopted in more recent cases.[3] Thus, Lord Herschell, in *Reddaway* v. *Banham*,[4] says: "Where a patentee attaches a particular name to the production he patents, that name becomes common property as the name of the patented article. It possesses, indeed, no other name. That name would necessarily be applied to it by all persons desiring to purchase the article. It is not descriptive of the production of a particular manufacturer, but of the article itself, by whomsoever it is manufactured."

In *The Magnolia Metal Co.'s Trade Marks*,[5] Rigby, L.J., delivering the judgment of the Court of Appeal, said:

[1] 7 C. D. p. 837; 47 L. J. Ch. p. 432.

[2] See below, p. 253.

[3] Besides the cases noticed in the text, the following are recent cases in which the principle has been followed or recognised: *Formalin Hygienic Co., Ltd.'s Application*, 17 R. P. C. 486 (1900), Farwell, J.; *Kodak, Ltd.* v. *London Stereoscopic and Photographic Co., Ltd.*, 20 R. P. C. 337 (1903); *Chesebrough Co.'s Tm.*, [1902] 2 Ch. 1; 18 R. P. C. 191; 19 R. P. C. 342, in which, however, the Court of Appeal held that vaseline was not the name of a patented article. See also the judgment of Lord Kyllachy in *Dunlop Pneumatic Tyre Co., Ltd.* v. *Dunlop Motor Co., Ltd.*, 23 R. P. C. 761, at p. 770; *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156.

[4] [1896] A. C. p. 214; and 13 R. P. C. p. 230.

[5] [1897] 2 Ch. 371; and 14 R. P. C. 621.

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

In a recent case[1] Neville, J., held that *Cyclostyle* was the name of a patented invention, and was not a fancy word registrable under the Act of 1883, nor an invented word registrable under the Act of 1905, and the decision was affirmed in the Court of Appeal.

The fact that the patent for the goods is bad is immaterial, for a practical monopoly may be obtained by a bad patent;[2] nor can a person who has given a name to an article which he has wrongly put forward as made under a patent be in a better

[1] *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156.

[2] *Formalin Hygienic Co., Ltd.'s Application*, 17 R. P. C. 486 (1900), Farwell, J.; see also *Magnolia Metal Co.'s Tms.*, supra, and *Winser & Co.* v. *Armstrong & Co.*, 16 R. P. C. 167 (1899), Byrne, J. The *Magnolia* patent was subsequently revoked: *Miller's Patent*, 15 R. P. C. 205.

position than if his statement were true.[1] During the maintenance of the monopoly, either by the continuance of the patent or the non-discovery of the secret process, no one, of course, can use the name of the article for a different article so as to pass it off as that of the person having the monopoly.[2] On the other hand, although the patent is unexpired, if it be for a process, and a method of making the article without infringing the patent be discovered, a name which indicates the article may be used notwithstanding the existence of the patent.[3]

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

Article formerly made under secret process.

It may, perhaps, be doubted whether the rule in the case of an article manufactured under a secret process is as absolute as in the case of a patented article,[4] and whether it is not open to the manufacturer of an article made by him under a process formerly secret but since discovered to show that the mere use of the name by another person would deceive purchasers into the belief that the goods were those of the original manufacturer, or, in other words, to show that the name indicates not merely the article but the article manufactured by him.[5]

Whether the name given to a new article can be monopolised.

The judgment of Fry, J., in *The Linoleum* case[6] supports the proposition that the principle is not confined to an article

[1] *Meaby & Co., Ltd.* v. *Triticine, Ltd.*, 15 R. P. C. 1 (1898), North J.; and see below, p. 429, as to misrepresentation respecting patents.

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

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

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

[5] The question was left open in the House of Lords in the *Yorkshire Relish* case; but the proposition as laid down by Lindley, L.J., in the Court of Appeal, [1896] 2 Ch. at p. 72; 13 R. P. C. at p. 252; and approved by Ld. Davey, [1897] A. C. at p. 717; 14 R. P. C. at p. 732, is not so absolute as in the case of a patented article. See also the judgment of Rigby, L.J., in the *Magnolia* case, quoted supra, p. 46, and Chap. XIX., p. 569.

[6] Above, p. 45.

protected by patent, or by a secret or otherwise, but is wide enough to cover the case of a new name applied to a new article. And in *The Valvoline* case[1] the same Judge, when a Lord Justice, said, in considering whether *Valvoline* was a special and distinctive word: "When a new material is invented, and at the same time a new single word is invented which is applied to that material alone, I am by no means satisfied at present that that single word can be treated as a special and distinctive word within the meaning of the section.[2] It is difficult to suppose that one word can both describe the thing as made by anybody and the thing as made by a particular maker. I am inclined to think that the words 'special and distinctive' import the specialising of the make and manufacture of a particular maker from all other manufacturers, and distinguishing the manufacture of one person from the manufacture of all others." In the same case Cotton, L.J., said: "In my opinion when a man invents a new article, and invents a word as descriptive of that article, then, if all the world are at liberty to make that article, he stands in a very great difficulty as regards claiming to himself the exclusive use of that name which he has invented to describe the article." The question was discussed again in *The Vaseline* case,[3] in which, however, the majority in the Court of Appeal held that the word *Vaseline* indicated not an article made by a particular process, but an article made by a particular manufacturer; and Stirling, L.J., in his judgment expressly reserved the question. Cozens-Hardy, L.J., dissenting on the facts from the other members of the Court, referred to *The Linoleum* case, and to the fact that linoleum had been a patented article, but said that he thought that the principle could not be limited to the case of a patented article, and he adopted the language of Fry, L.J., in *The Valvoline* case in the passage quoted above.[4]

Under registered design.

If a man registers a new design, and gives the article made in accordance with that design a name, that name describes the

[1] *Leonard and Ellis' Tm.*, 26 C. D. 337 (1903), it was contended for the defendants that "Kodak" as applied to films was a new name for a new article, and meant a film for a Kodak camera; but Swinfen Eady, J., found that the word indicated the plaintiffs' goods only.

288 at p. 304.

[2] Sec. 10 of the Act of 1875.

[3] *Chesebrough Co.'s Tm.*, [1902] 2 Ch. 1; 18 R. P. C. 191; 19 R. P. C. 342, Buckley, J., and C. A.

In *Kodak, Ltd.* v. *London Stereoscopic and Photographic Co., Ltd.*, 20 R. P. C.

article, and it may, after the expiration of the protection, be used for that purpose by other persons.[1]

Original.

The first introducer of goods which have come to be known by the name which he applied to them, so that that name has been lost to him as a distinctive mark, has in some cases been allowed to distinguish his goods by the name with the prefix *original*. Thus, in *The Reading Sauce* case,[2] Romilly, M.R., said: "Where there are a great number of persons who produce the same article, *original* means that the article so called is that made by the first inventor. That is the meaning of *original* which the Court of Chancery has always recognised."

Name of the place of origin.

The name of the place of origin of the goods would, on the principles discussed above, in general, be bad as a trade mark, for any importer from the same place would be at liberty to use it; but where a geographical name has acquired a secondary meaning, identifying the goods upon which it appears with a particular trader, the trader has frequently been protected against fraudulent imitators. In cases where this secondary meaning has been acquired, following the rule adopted in the analogous case of a trader using his own name,[3] the Courts would not interfere to restrain altogether the use of the name in question by a second trader who is honestly using the name merely for the purpose of indicating the place of origin of his goods, although they might require him to use it in such a way as that his goods are clearly distinguished from those of the other trader.[4]

Anatolia liquorice.

In *McAndrew* v. *Bassett*[5] the word *Anatolia* stamped upon liquorice was held to be a good trade mark. The plaintiff made

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

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

[3] See below, pp. 532 *et seq.*

[4] There are *dicta* in the *Stone Ales* case, in the House of Lords, which suggest that a practical monopoly might be acquired of the use of the name of a place where goods are manufactured: *Thompson* v. *Montgomery*, [1891] A. C. 217; 8 R. P. C. 365; above, p. 29. The case was one of deliberate fraud: but, in view of the *Valentine* case, cited below, p. 537, it would seem that the same result could have been reached without proof of fraud. See also p. 517. The case of *Cash* v. *Cash*, 18 R. P. C. 213; 19 R. P. C. 181 (1902), seems to show that the Court will not absolutely restrain a person from using his own name in trade. See below, p. 532.

[5] 4 De G. J. & S. 380; 33 L. J. Ch. 561 (1864), Wood, V.-C., and Westbury, L.C.

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

Seixo v. *Provezende.*

In *Seixo* v. *Provezende*,[1] part of the plaintiff's trade marks consisted of the word *Seixo*, which was his own name and was also the name of the estate from which the wine, in connection with which the mark was used, came. The defendants adopted the same word in their trade mark, and they alleged that their wine came from an estate adjoining the plaintiff's and also known as *Seixo*. It appeared that the produce of the defendants' estate was far less in quantity than that of the plaintiff, that the plaintiff's wine was well known by his trade mark, and that the district in which both estates were situate was known as "Sitio *do* Seixo," meaning "the stony country." Wood, V.-C., granted an injunction to restrain the defendants from using the word in question without clearly distinguishing the wines they sold under it from the wines of the plaintiff,[2] and, on appeal, Cranworth, L.C., upheld this decision. "Assuming the truth of what is contended for by the defendants," the Lord Chancellor said,[3] "that is, that parts of their vineyards are known by the name *Seixo*, that does not justify them in adopting a device or brand the probable effect of which is to lead the public when purchasing their wine to suppose that they are purchasing wine produced from the vineyards, not of the defendants, but of the plaintiff."

[1] L. R. 1 Ch. 192; 14 L. T. (N. S.) 314 (1865).

[2] See form of injunction which was approved by the H.L. in *Montgomery* v. *Thompson* (p. 51, note (3)), L. R. 1 Ch. p. 194; Appendix, p. 734.

[3] L. R. 1 Ch. p. 198; 14 L. T. (N. S.) p. 316.

Glenfield starch.

In *The Glenfield Starch* case,[1] the defendant was restrained from using the word *Glenfield* on the labels attached to starch made by him, and from calling such starch *Glenfield Starch*, although his starch was actually made, and that of the plaintiffs was not made, at the place of that name. The plaintiffs had formerly manufactured their goods at Glenfield, and had adopted the name *Glenfield Starch* and a label comprising the words to describe them; and the defendant, as the House of Lords found, set up a factory at Glenfield—an open place with a few cottages—for the express purpose of securing the name, and of profiting by the plaintiffs' reputation. He called his starch *Royal Palace Starch*, but placed the name *Glenfield* in large letters on his labels, and his agents sold his goods as *Glenfield Starch*.

"I take it to be clear from the evidence," Lord Westbury said,[2] "that, long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants."

This decision was followed and approved by the House of Lords in *The Stone Ales* case[3] in the year 1891, which was a very similar case.[4]

But a name which originally begins in its use as a geographical term, and long continues to be used as such, cannot readily cease to be a geographical term and acquire the secondary meaning above referred to;[5] and where the article is not a manufactured article but a product of the soil, *e.g.*, the water

[1] *Wotherspoon* v. *Curric*, L. R. 5 H. L. 508; 42 L. J. Ch. 130 (1872).

[2] L. R. 5 H. L. p. 521.

[3] *Montgomery* v. *Thompson*, [1891] A. C. p. 217; 8 R. P. C. 361; above, p. 29; see also *Huntley and Palmer* v. *The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J. (*Reading biscuits*); and *Worcester Royal Porcelain Co., Ltd.* v. *Locke & Co.*, 19 R. P. C. 479 (1902), Byrne, J. (*Worcester china*).

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

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

from a spring, and the name in question is the name of the locality and necessarily enters into the description of the article, persons cannot be prevented from fairly using it to describe the article.[1]

Geographical names are expressly excepted from the list of essential particulars for registered trade marks contained in the present Act.[2]

Advertisement of the goods not a trade mark.

A mere advertisement or description of the goods concerned, or of some quality which they possess, is not a trade mark. And on this ground Lord Westbury based his judgment in the House of Lords in *The Leather Cloth* case.[3]

Leather Cloth case.

The trade mark of the plaintiffs in that case consisted of a circle formed by the words *Crocketts' International Leather Cloth Company, Newark, N.Y., U.S.A., West Ham, England.* inside of which in the upper half was an eagle, with the word *Excelsior* over it, and the words *Crocketts & Co., tanned leather cloth*, below it, and in the lower half the words *Patented, January* 24, 56, *I. R. and C. P. Crockett, Manufacturers,* 12 *yards.* The defendants had a trade mark containing features similar to some of these. Wood, V.-C., granted an injunction,[4] but on appeal[5] this was rescinded by Lord Westbury on the ground that the plaintiffs' trade mark contained material misrepresentations which disentitled them to relief. When the case came before him again, in the House of Lords, however, Lord Westbury said:[6] "I am satisfied that I ought to have regarded this affix to the plaintiffs' goods, which is here denominated a trade mark, as something which, according to the anterior usage and application of the words trade mark, by no means resembles or comes within the description of anything that has hitherto been properly designated by that name." It was, he added, "in reality, an advertisement of the character and quality of their goods."

So the words *Nourishing Stout* were refused protection[7] by

[1] *Grand Hotel Co. of Caledonian Springs, Ltd.* v. *Wilson* (*Caledonia water*), [1904] A. C. 103; 21 R. P. C. 117.

[2] Act of 1908, s. 9 (4), below, p. 129; see also p. 170.

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

[4] 1 H. & M. 271: 32 L. J. Ch. 721.

[5] 4 De G. J. & S. 137; 33 L. J. Ch. 199.

[6] 35 L. J. Ch. p. 66.

[7] *Ruggett* v. *Findlater*, L. R. 17 Eq. p. 29; 34 L. J. Ch. 64 (1873). This case and the others here cited must be taken subject to the law established by *Reddaway* v. *Banham* (supra, p. 42), that words *primâ facie* of a descriptive meaning may acquire a secondary meaning if they lose their ordinary meaning and come to indicate the goods of a particular manufacturer.

Malins, V.-C., who distinguished the case before him from two earlier cases, in one of which[1] words meaning *exactly* 12 *yards*, printed in three foreign languages, and placed upon long cloth, and in the other[2] the words *Excelsior White Soap*, had been accepted as trade marks.

Chearin v. Walker.

And in *Chearin* v. *Walker*,[3] a tablet bearing the words *G. Chearin's Improved Patent Gold Medal Self-Cleaning Rapid Water Filter, Boston, England*, with the Royal Arms and the words *By Her Majesty's Royal Letters Patent*, was held by Jessel, M.R., in the Court of Appeal, not to be a trade mark. "What (the plaintiff) uses," he said,[4] "is an inscription which he chooses to place or bake on his filters, and which tells its own story. The inscription is not in distinctive characters, but in ordinary type. There is nothing in it to show that it was made by any particular manufacturer. It is not possible to say that such an inscription is a trade mark." The action failed also on the ground that the tablet falsely represented that the goods were made under an existing patent, whereas, in fact, the patent had expired.

The essential quality of distinctiveness as a necessary element in a trade mark has been carefully preserved by the Acts, and by the decisions upon them. These are dealt with in a subsequent chapter.[5]

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

The words in the statutory definition are "manufacture, selection, certification, dealing with or offering for sale."

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

The office of the trade mark is to indicate some connection between the goods to which it is applied and a particular trader;[6] but it is not necessary that the buyers should know the name of the trader, it is sufficient that the mark identifies a particular manufacture.[7] What this connection is, is immaterial; but it should be a constant one. If a maker chooses to sell under a trade mark which is identified with goods of his manufacture

[1] *Broadhurst* v. *Barlow* (1872), unreported; see L. R. 17 Eq. p. 38.

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

[3] 5 C. D. 850; 46 L. J. Ch. 686 (1876), C. A.

[4] 5 C. D. p. 862.

[5] Chap. VIII., What may be Registered, p. 127.

[6] See the *dicta* cited above, p. 27.

[7] See *Birmingham Vinegar Brewery Co.* v. *Powell*, [1897] A. C. 710, and 14 R. P. C. 720; and supra, p. 36.

goods made by others, his conduct will tend to destroy the original significance of the mark, and eventually to confer upon it a new meaning; but, until the alteration is known, buyers may justly complain of deception.[1]

The connection most commonly intended by a trade mark is that of origin or manufacture; but, as already said, many others may be connoted. This is succinctly expressed in the statement of Bowen, L.J., in *The Yorkshire Relish* case,[2] that the function of a trade mark is to give an indication of "the trade source from which the goods come, or the trade hands through which they pass on their way to the market."

Trade mark of selector of goods.

In some cases it is difficult to decide what the precise meaning of a trade mark is; for instance, where A. has selected and imported goods made by B. for many years, and has sold them under a particular trade mark. If A. has been the sole importer, does the reputation of the mark refer to his selection and importation, or to B.'s manufacture? Such a question arose in *Hirsch* v. *Jonas*.[3] There the plaintiff bought cigars of a foreign maker, who, at his request, placed a label bearing the words *Gloria de Inglaterra Havannah*, which had been designed and registered as his copyright by the plaintiff, upon the boxes. Subsequently, the maker began to supply to the defendants for sale in the market similar cigars, not purchased by the plaintiff, but bearing the same label, and this the plaintiff unsuccessfully sought to restrain. The name of the plaintiff did not appear on the boxes, but that of the maker did. "The trade mark of manufactured goods," said Jessel, M.R.,[4] "means, I suppose, that the goods are manufactured by the person whose trade mark it purports to be. I can understand a man saying, 'I am not the actual manufacturer of goods, but the selector of goods, and my reputation for cleverness and selection is so great, that goods marked with a mark to show that they have been selected and approved of by me will fetch a higher price in the market.' If Hirsch had put on the box '*Gloria de Inglaterra Havannah* Cigars selected by *Hirsch*,' he might have had a case to prevent

Hirsch v. *Jonas*.

[1] The deception may constitute the offence of applying a false trade description. See *Storey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90; 59 L. J. M. C. 13 (1890), Ld. Coleridge, L.C.J., and Mathew, J. See also *Johnson* v. *Raylton*, 7 Q. B. D. 438 (1881), a case of implied contract; and the Merchandise Marks Act, 1887, Appendix, p. 806.

[2] *Powell's Tm.*, [1893] 2 Ch. p. 404; 10 R. P. C. 195.

[3] 3 C. D. 584; 45 L. J. Ch. 364 (1876).

[4] 3 C. D. p. 586; 45 L. J. Ch. p. 365.

other people imitating that. It would show that the cigars selected were approved of by him. If he got a great reputation in that way, I can understand he would have a right of protection for that which indicates to the public that the cigars were selected and approved of by him. That is not his case. There is nothing on the boxes to show anything about Hirsch at all. All he says is that the trade knows this mark as denoting cigars sold by him, which I dare say it does."[1]

In *Robinson* v. *Finlay*[2] the marks in question were held to indicate a connection with three different persons—the manufacturer, the exporter, and the consignee, since they had always and only been used upon goods which had passed through the hands of all of these in their several capacities. The Court of Appeal, accordingly, decided that neither of the parties alone was entitled to the marks.

In a recent case the mark in question belonged to a salesman dealing on commission in Covent Garden, and its office was to indicate that the goods had been consigned to and sold by him.[3]

Designer for another person.

A servant who designs a mark which his employer adopts and uses has no claim in regard to it, and is not entitled after leaving his employment to use the mark on his own goods.[4]

Registered under the Acts as a Trade Mark.

Before the Registration Acts were passed, the only general way in which a trade mark could have been acquired was by public user, in the manner described in the earlier part of the definition given above,[5] or in the case of a Cutlers' Corporate Mark, for use by a cutler resident in or within six miles of Hallamshire, by assignment from the Cutlers' Company.[6] The repealed Acts contained provisions that registration, or the application for registration, should be deemed equivalent to the

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

[2] 9 C. D. 487; 39 L. T. (N. S.) 398 (1877), Bacon, V.-C., and C. A.; *Jones' Tm.*, 53 L. T. (N. S.) 1 (1885), C. A. Cf. *Van Zeller* v. *Mason, Cuttley & Co.*, 25 R. P. C. 37 (1908), Joyce, J.

[3] *Major* v. *Franklin*, 25 R. P. C. 406 (1908), Jelf, J.

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

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

[6] See Chap. VI., Sheffield Marks, below, p. 112.

public use of the registered trade mark,[1] and, although no such provision is contained in the Act of 1905, it expressly authorises the registration of a trade mark proposed to be used,[2] and, subject to certain provisions in the Act and to limitations and conditions entered on the Register, the registration of a person as proprietor of a trade mark is, if valid, to give to such person the exclusive right to the use of the trade mark upon, or in connection with the goods in respect of which it is registered.[3]

And registration is *primâ facie* evidence of validity,[4] and, subject to certain qualifications, the original registration is to be taken as valid in all respects after seven years from such registration, or from the passing of the Act, whichever should last happen.[5] The construction and effect of the sections are discussed in a later chapter.[6] It was decided that the corresponding sections of the Acts of 1875 and 1883[7] created a new method of acquiring trade mark rights.[8]

[1] Act of 1888, s. 17, replacing sec. 75 of the Act of 1883, and sec. 2 of the Act of 1875; below, p. 323.

[2] See above, p. 24.

[3] Sec. 39.

[4] Sec. 40.

[5] Sec. 41. See sec. 76 of the Act of 1883. The corresponding section of the Act of 1875 was sec. 3. The Act was passed on August 11th, 1905.

[6] Chap. VIII., What may be Registered, p. 127. Chap. XII., Effect of Registration, p. 321.

[7] Secs. 75 and 76 of the Act of 1883; sec. 3 of the Act of 1875.

[8] *Hudson's Tm.*, 32 C. D. 311: 3 R. P. C. 155 (1886), C. A., below, p. 323.

CHAPTER III.

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

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The Register.

THE Register of trade marks was established by the Act of 1875,[1] and it is now continued under sec. 4 of the Act of 1905,[2] which provides that there shall be kept at the Patent Office[3] 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. And the books of the original Register and those

[1] Secs. 1 and 7.

[2] Replacing with amendments sec. 78 of the Patents, &c., Act, 1883. The words "disclaimers, conditions, limitations," are new. See below, pp. 76 and 264.

[3] 25, Southampton Buildings, Chancery Lane, London, W.C.

under the Act of 1883 are treated as part of the present Register.[1]

The Manchester Branch Office and the Sheffield Register.

There are also Registers at Manchester and Sheffield. The former, kept at the Manchester Branch Office, is a duplicate of the Register at the Patent Office, so far as it relates to goods in Classes 23, 24, and 25[2] (*i.e.*, cotton goods); the latter is a branch Register for trade marks for metal goods registered by residents in Hallamshire, or within six miles of it.[3]

By sec. 60 of the Act of 1905,[4] the Board of Trade may from time to time make general rules, subject to the provisions of the Act, for regulating the practice under the Act, for classifying goods and for certain other purposes. The trade mark rules, forms, and classification at present in force under this section are those of 1906, which came into operation on April 1st, 1906.[5]

The Comptroller or Registrar.

The Register was formerly under the control of the Registrar appointed in pursuance of the Act of 1875, but it, as well as the whole of the Patent Office, of the business of which it forms part, has since the Act of 1883 been under the immediate control of the Comptroller-General of Patents, Designs, and Trade Marks, who is, however, in the Act of 1905 referred to as the Registrar.[6] He is appointed by, and acts under the superintendence and direction of, the Board of Trade.[7] He may in any case of doubt or difficulty arising in the administration of any of the provisions of the Act, apply to either of the law officers for directions in the matter.[8] The Registrar's address is, The Registrar, Patent Office, Trade Marks Branch, 25, Southampton Buildings, London.

Any act or thing directed by the Acts to be done by or to the Comptroller may be done by or to any officer authorised by the Board of Trade.[7] The business in relation to trade marks is, in

[1] Act of 1905. sec. 6, replacing sec. 114 of the Act of 1883.

[2] Below, pp. 121 and 699.

[3] As to the Manchester Branch Office, see below, p. 122, and as to the Sheffield registry, p. 117.

[4] Replacing sec. 101 of the Act of 1883.

[5] See Appendix, p. 655. The Rules repiaced the Rules of 1890, as amended by those of 1897 and 1898. The classification has, except in a minor point, in class 23, never been altered, although it is now very inadequate.

[6] Sec. 4.

[7] See sec. 74, and Patents and Designs Act, 1907, s. 62. Lord Herschell's committee recommended that the practice which had grown up of consulting the Board of Trade in particular instances, in regard to applications for registration, should cease, except so far as it might be necessary to bring such instances before them by way of illustration for the purpose of obtaining a direction on some point of general principle or practice: Report of 1888, p. vii.

[8] Sec. 56: See below, p. 77.

practice, undertaken by the Registrar of Trade Marks on behalf of the Comptroller.

Entries on the Register.

In addition to the matters directed by sec. 4, quoted above, to be entered upon the Register, there are under Rule 64 to be entered also the date of the application for registration, which is treated for the purposes of the Act as the date of registration,[1] a statement of the goods for which the mark is registered,[2] particulars of the trade, business, profession or occupation, if any, of the proprietor, and such other particulars as the Registrar may deem necessary. In conformity with some early decisions under the Registration Acts, notes were entered on the Register of undertakings by the proprietor to confine the use of his mark to goods forming part only of a class, or to restrict the manner of use of his mark,[3] and in regard to other restrictions on the full rights ordinarily conferred by a simple registration.[4] It was decided however in a later case[5] that notes expressing a condition of registration that the mark should only be used, or should not be used, within a certain geographical area ought not to be entered on the Register. The Act of 1905 expressly authorises registration subject to conditions[6] and limitations.[7] In a case under that Act in which Kekewich, J., upon an undertaking being given by the applicants, declared the mark to be distinctive within sec. 9, he directed the undertaking to be given to the Court in the usual way.[8] Disclaimers are authorised by sec. 15.[9]

No trusts to be entered.

No notice of any trust may be entered upon the Register or is receivable by the Registrar, whether the trust be express, implied, or constructive,[10] but equities may be enforced.[11] The entry of a reference to an agreement limiting the rights of the proprietor of

[1] Sec. 16.

[2] Sec. 8. See form of application, Form TM No. 2, Appendix, p. 678.

[3] See below, pp. 229 and 298; and *Re Rahone & Co.*, Seb. Dig. p. 395 (1879), Jessel, M.R.; *De Oladuy's Tm.* (1885), W. N. p. 177, Pearson, J.; *Mitchell & Co.'s Tm.* (2), 28 C. D. 666 (1885), Chitty, J.; *Keep's Tm.*, 26 C. D. 187 (1884), Pearson, J.

[4] In the recent case of *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905), Warrington, J., registration was allowed subject to a condition.

[5] *Deuchars's Tm.*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A.; and see below, p. 230.

[6] Secs. 12 (2) and (4), 13, 14 (4) and (6), 21, 23, 24. See below, p. 76.

[7] Secs. 10 (colour), 21. See below, pp. 209 and 264.

[8] *Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436.

[9] See below, Chap. IX., p. 212.

[10] Sec. 5. Cf. Companies Act, 1862, s. 30.

[11] Sec. 38, replacing a similar provision in sec. 87 of the Act of 1883.

the mark and not stating its terms, was under the former Acts held to be irregular.[1]

Title conferred by registration.

There is no patent or other document issued by the Registrar conferring a title to a trade mark, but on the registration of a trade mark the proprietor, according to the Act of 1905, receives a certificate of registration.[2] Under the Act of 1883, as amended by that of 1888, it was expressly provided that the application, followed by the registration of the trade mark, should be equivalent to the public user,[3] by which, and by which alone, title to a trade mark was acquired before the Acts.[4] But this provision has now been dropped, being deemed unnecessary.[5] Registration itself, if valid, confers the exclusive right to the use of the mark,[6] and, except in the case of an old mark of which registration has been refused, it is a condition precedent to any proceedings for the infringement of the trade mark.[7] The fact of registration is also *prima facie* evidence of validity, and after a certain period and subject to certain exceptions, a registration cannot be impugned.[8] The person registered as proprietor has power to assign the trade mark.[9]

Alterations of the Register.

Provision is made for the rectification of the Register,[10] and also for the correction of clerical errors, for the entry of a change of name or address, for cancellation of the mark or of some of the goods for which it is registered, and for the entry of a disclaimer or memorandum not extending the rights given by the registration. These last-mentioned matters may be done by the Registrar at the instance of the proprietor.[11]

Alterations of the mark itself, not substantially affecting its identity, may also be made by the Registrar on the application of the proprietor.[12]

Falsification of the Register.

The falsification of entries in, or of writings purporting to be copies of entries in, the Register, and the tendering or production

[1] *De Oladay's Tm.* and *Mitchell & Co.'s Tm.*, above, p. 59, note (3).

[2] Sec. 17, Rule 67, and Form O, No. 23, below, p. 683.

[3] Act of 1888, s. 17.

[4] See the last Chapter.

[5] See Chap. XII., p. 324.

[6] Sec. 39, replacing sec. 76 of the Act of 1883. See Chap. XII.; below, p. 321, Effect of Registration.

[7] Sec. 42, replacing sec. 77 of the Act of 1883. See Chap. XII.; below, p. 334.

[8] Secs. 40 and 41. See Chap. XII.; below, pp. 329 *et seq.*

[9] Sec. 38, replacing sec. 87 of the Act of 1883. See Chap. XIII., p. 345.

[10] Sec. 35, replacing sec. 90 of the Act of 1883. See Chap. XI.; below, p. 276, Rectification of the Register.

[11] Sec. 32. Cf. sec. 91 of the Act of 1883. See Chap. XI.; below, p. 313.

[12] Sec. 34. Cf. sec. 92 of the Act of 1883.

of any such entry or writing, knowing it to be false, is a misdemeanour.[1]

Devolution of title.

Devolutions of title to a trade mark by assignment, transmission, or other operation of law, are directed to be entered on the Register by the Registrar at the request of the person becoming entitled, and upon proof to the satisfaction of the Registrar of the title of the applicant.[2]

Period of registration.

Registration is for a period of fourteen years, but is renewable.[3]

Removal of entries.

A trade mark may be removed from the Register on the ground that at the time of registration the applicant had no *bonâ fide* intention of using it, and that there has been no *bonâ fide* user in fact, or on the ground of non-user for five years before the application to remove it, subject to a qualification in the case of special circumstances,[4] or it may be removed whenever the mark is on the Register without sufficient cause.[5] A trade mark can also be removed for non-payment of a renewal fee.[6] In all cases of removal a record of the removal and of the cause thereof is entered on the Register.[7]

Inspection of the Register

The Register is open to the inspection of the public on payment of the prescribed fee (which is at present one shilling for every quarter of an hour spent in inspecting) on every weekday between the hours of ten and four, except on the usual holidays and days of which due notice is given at the Patent Office.[8]

Searches.

It is generally advisable before offering a trade mark for registration to cause a search to be made through the Register, to discover whether any of its essential features have been anticipated in such manner as to be a bar to the application,[9] and it is often necessary for other purposes. Under the present rules an official search may be obtained as to the marks in any class on record (not merely registered marks) resembling a mark sent in to the Registrar.[10] Searches are greatly facilitated by the indexes with which the Register is provided. There are three of

Indexes.

[1] Sec. 66, replacing sec. 93 of the Act of 1883; below, p. 585.

[2] Sec. 33, replacing sec. 87 of the Act of 1883. See Chap. XIII.; below, p. 345, Assignment and Devolution of Trade Marks. Rules 76 to 81.

[3] Secs. 28 and 29.

[4] Sec. 37. As to the law under the previous Acts, see *Batt's Tm.*, [1898] 2 Ch. 432; 15 R. P. C. 262, 534, Romer, J., and C. A.; and in House of Lords, sub nom. *Batt* v. *Dunnett*, [1899] A. C. 428; 16 R. P. C. 411; and Chap. XIV., below, p. 362.

[5] Sec. 35.

[6] Sec. 30; and below, p. 372.

[7] Rule 74. Cf. Rule 47 of 1890.

[8] Sec. 7. Rule 96.

[9] Chap. X.; below, p. 221.

[10] Rule 95. Form TM No. 28, below, p. 691.

these, and they include both actually registered and advertised trade marks. They are:—

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

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

(1) Animals, including insects and reptiles.
(2) Birds.
(3) Buildings and landscapes.
(4) Crests, including crowns, coats of arms, and heraldic symbols.
(5) Fish.
(6) Geometrical forms, including suns, moons, stars, &c.
(7) Human figures.
(8) Miscellaneous.
(9) Monograms.
(10) Shipping, including anchors and flags.
(11) Trees, flowers, fruit, &c.

(and warning is given that, in using this index, it is often necessary to look under several heads in order to insure a complete search);

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

It is to be regretted that the recommendation of Lord Herschell's committee,[1] that a catalogue of words rejected should be kept, has not been followed.

Certified copies of the Register to be evidence.

Certified copies of the Register, sealed with the seal of the Patent Office, of any entry in the Register, are directed to be given to any person requiring the same on payment of the prescribed fee.[2] And printed or written copies of or extracts from the Register, purporting to be certified by the Registrar and sealed with the Patent Office seal, are receivable in evidence without proof or production of the originals.[3] And a certificate, purporting to be under the hand of the Registrar, of any entry, matter, or thing, which he is authorised by the Act or Rules to make or do, is *prima facie* evidence of the entry and of its

Registrar's certificate to be evidence.

[1] Report of 1888, p. ix. All applications to the Manchester Branch, whether resulting in registration or not, may be inspected: sec. 64 (11), below, p. 125.

[2] Sec. 7, replacing a similar provision in sec. 88 of the Act of 1883. For fees, see Appendix, p. 673.

[3] Sec. 50. Cf. sec. 89 of the Act of 1883.

contents, and of the matter or thing having been done or not done.[1] As already noticed,[2] a certificate of the fact of registration is now given on registration of a trade mark. This is given without fee.

Purpose of certificate of registration to be stated.

Rule 102 requires that every certificate of registration, other than such as last mentioned, shall have specified on the face of it a statement whether it is intended to be used in legal proceedings, or for the purpose of obtaining registration abroad, or for other purposes; and the fees payable for the certificates vary according to the uses which they are to serve.[3]

Patent Office seal.

The seal of the Patent Office and impressions thereof are to be judicially noticed and admitted in evidence.[4]

Notices and documents may be sent by post.

Any application, statement, notice, or other document, authorised or required to be left, made, or given at the Patent 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; and if so sent, is to 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 is sufficient to prove that the letter was properly addressed and put into the post.[5]

Addresses.

The Rules contain provisions as to the addresses of registered proprietors, and for addresses to be furnished to the Registrar,[6] and as to addresses for service of applicants, opponents, agents and proprietors not residing or carrying on business in the United Kingdom.[7]

Excluded days in computing time.

Where the last day fixed by the Act or Rules for leaving any document or paying any fee at the office falls on a public holiday, Saturday, or Sunday, such day is not counted.[8]

Agency.

Section 55 of the Act of 1905 provides that where by the 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

[1] Sec. 51, replacing sec. 96 of the Act of 1883.

[2] Supra, p. 60.

[3] For fees, see the Forms and the Table of Fees, Appendix, pp. 676 and 673; and for form of request for certificates, Forms TM Nos. 31 to 34; below, pp. 696 *et seq.*; and as to Cotton Marks, Form, Cotton, No. 4, below, p. 694. A special certificate of an application for registration of a cotton mark is provided for by sec. 64 (12). See Chap. VII., p. 125.

[4] Sec. 64 of the Patents and Designs Act, 1907, replacing sec. 84 of the Act of 1883.

[5] Rule 7. Cf. sec. 97 of the Act of 1883.

[6] End of Rule 7 and Rule 8, below, p. 656.

[7] Rule 9, below, p. 656.

[8] Rule 100, below, p. 668. Formerly provided for by sec. 98 of the Act of 1883.

thereto, such act may, under and in accordance with rules made under the 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.[1]

By Rule 10 of the Rules of 1906,[2] 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. The agent's authority is to be in Form TM No. 1,[3] or in such other form as the Registrar may deem sufficient.[4] Service upon the agent of any document relating to the trade mark is to be deemed to be service upon the person so appointing him, and all communications directed to be made to such person in respect of the trade mark may be addressed to the agent. The Registrar is not to 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,[5] and not since restored.

Exercise of discretionary power by Registrar.

When any discretionary or other power is given to the Registrar by the Act or Rules made thereunder he is not to 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.[6]

[1] The matter was previously one dealt with by the Rules. See Rule 2 of 1898.

[2] Below, p. 656, where the Rule is fully set out, and see Rule 2.

[3] Below, p. 677.

[4] As to the signature of the authority, where the principal is a firm, partnership or body corporate, see Official Instructions, below, p. 706.

[5] Now replaced by secs. 84 and 85 of the Patents and Designs Act, 1907. See the Register of Patent Agents Rules, 1908.

[6] Sec. 53. The prescribed time is one month from the date when the matter has arisen: Rules 83 to 86, Appendix, p. 666.

CHAPTER IV.

REGISTRATION OF TRADE MARKS.

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REGISTRATION of trade marks is now governed by secs. 8 to 21, 24, 25, 26, 62, 63 and 64 of the Act of 1905;[1] and, subject to the provisions of the Act, the practice of registration is regulated by the Trade Mark Rules, 1906. Of the sections mentioned, secs. 9, 10, and 62, relating to what may be registered;[2] sec. 11 and secs. 19 to 21, imposing certain restrictions on registration;[3] sec. 15, providing for disclaimers;[4] secs. 24 to 26, relating to associated trade marks;[5] sec. 63, relating to Sheffield marks;[6] and sec. 64, relating to cotton marks,[7] are dealt with in other chapters of this book. The present chapter deals with the application for registration and the procedure consequent on it, contained in secs. 12 to 14 and 16 to 18 and in the Rules. In the drafting of the Act of 1905, many provisions contained in the Acts of 1883 and 1888 were omitted, as being mere matters of procedure to be dealt with in the Rules.

Sec. 12. Application for Registration.

By sec. 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

[1] For the secs. of the repealed Acts which regulated registration, see the comparative tables showing the corresponding sections, below, p. 592.
[2] Chap. VIII., p. 127.
[3] Chap. X., p. 221.
[4] Chap. IX., p. 212.
[5] Chap. V., p. 107.
[6] Chap. VI., p. 112.
[7] Chap. VII., p. 121.

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.

1. Who may apply to Register a Trade Mark.

The section says "any person claiming to be the proprietor," but if it is shown that the claim is a wrongful or an erroneous one the mark should be refused registration, and, if registered, it can be removed under sec. 35, unless protected by sec. 41.[1]

Person includes any body of persons corporate or unincorporate,[2] and the Rules provide for the mode of execution of the application in the case of a firm or partnership, and in the case of a body corporate.[3]

The proprietor.

Proprietor means the person who is entitled to a mark in which trade mark rights have been acquired by user under the law apart from the Acts, either by himself or by his predecessor in business, the trade mark having been assigned to, or having devolved upon, him with the goodwill of the business in

[1] See Chap. XI., p. 276, Rectification of the Register.

[2] Sec. 19 of the Interpretation Act, 1889.

[3] Rule 17, and see Official Instructions, below, p. 706.

connection with which it is used,[1] or else the person who has invented[2] or selected, or caused to be invented or selected,[3] a mark which is new in respect of the class of goods for which registration is sought. The definition of a trade mark for the purpose of the Act of 1905 includes a mark proposed to be used, as well as a mark actually used.[4]

An importer.

An importer of goods produced abroad, whether by manufacture, or by a process of nature—as, for instance, mineral waters—is not the proprietor of the trade mark of the producer, even though he has an exclusive contract for importation of the goods into, or for dealing with them in, this country, and notwithstanding that the producer consents to his application to register.[5] "The registration by the importer was wrong," says Fry, L.J., who delivered the judgment of the Court of Appeal in the case in which this was decided. He added: "If the mark registered had been one which indicated the importer it might have been maintained;[6] but an importer has no right to appropriate to himself a mark which, as in this case, both by user and express statement on its face, asserts itself to be a mark of the producer or of the owner of the place of origin, because at the time of the registration the mark was an old one, and of course could not be registered as a new one; it was an old one of Kreuzberg's (the producer), and therefore could not be registered as an old one of the Apollinaris Company" (the importers).

It was argued on behalf of the company, in the case just referred to, that, being entitled by the terms of a contract with the producer to the whole produce of the spring from which the

[1] See Chap. II., p. 22. Where a person has become the absolute owner in equity of a business and a trade mark used in it, an application by him to register the trade mark will be entertained by the office, although he has not the legal title, but the application must be in the name of the real person applying, and not in the name of a predecessor no longer entitled to registration: *Heddle & Co.'s Application*, 20 R. P. C. 599 (1903), Byrne, J.

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

[3] *I.e.*, for himself. See *Roger's Tm.*, 12 R. P. C., at p. 156 (1895), North, J.

[4] Sec. 3.

[5] *Apollinaris Co.'s Tm.*, [1891] 2 Ch. pp. 226—230; 8 R. P. C. 137, C. A.; and *European Blair Cement Co.'s Tm.*, 13 R. P. C. 600; 75 L. T. (N. S.) 63 (1896). Cf. *Defries & Sons, Ltd.* v. *Electric and Ordnance Accessories Co., Ltd.*, 23 R. P. C. 341 (1906), Joyce, J., where the vendor of goods made to his order abroad was held entitled to a name associated with the goods (*Stewart Arc Lamps*).

[6] Cf. the judgment of Jessel, M.R., in *Hirsch* v. *Jones*, 3 C. D. 584; 45 L. J. Ch. 364 (1876), cited p. 54.

producer obtained the goods to which the mark was attached, the company were entitled to register the mark as their own; but the Court refused to determine this question, since the contract relied on was, in fact, subsequent in date to the registration of the mark by the company.

Where the mark belongs to the importer.

In cases where a mark is used by a sole importer there may be a question whether it is his mark, signifying that the goods which bear it have been selected or imported by him, or the mark of the producer, signifying, as in the common course, that the goods are his manufacture, and this question must be decided according to the manner in which the mark and goods are put before the public.[1]

So where a manufacturer abroad sold and sent goods bearing the words *Bull's-eye*, his trade-mark, to a person in England, the importation of such goods into this country, coupled with the circulation of certain pamphlets containing the words, was held to be such a use here of those words by the manufacturer as to prevent the importer setting up a claim to the exclusive use of them, although the words were only known to the public in connection with goods sold by the importer. And the registration of the words by the importer was ordered to be expunged.[2]

Registration by licensee under patent.

Where a person has sold goods under a licence from the owner of a patent giving to them a certain name, a question may arise whether the name is the name of the article or indicates the goods of the person dealing in them. Thus, in *Freeman* v. *Sharpe*,[3] the patented article had been sold by the licensees under the name *Capstan*, and they had registered that word as a trade mark by arrangement with the plaintiffs. On the termination of the licence the licensees made and sold a somewhat different article under the name *Capstan No.* 2, and the plaintiffs,

[1] See *Hirsch* v. *Jones*, p. 68, note (6), and the *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), and *Defries & Sons, Ltd.* v. *Electric and Ordnance Accessories Co., Ltd.*, supra, p. 68, note (5); and Chap. II., p. 54. *Goodfellow* v. *Prince*, 35 C. D. 9; 56 L. J. Ch. 545 (1887), C. A.; *Robinson* v. *Finlay*, 9 C. D. 487: 39 L. T. (N. S.) 308 (1877), C. A.; and *Jones' Tm.*, 53 L. T. 1 (1885), C. A., were cases of joint ownership of trade marks. In *Seelchaer* v. *Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645, Kekewich, J. (a passing-off case), the defendants had had by contract for many years the exclusive sale in the United Kingdom of *Hunyadi Janos* water, and on the determination of the contract they were restrained from using the word *Hunyadi* on other water without clearly distinguishing the same from *Hunyadi Janos* water, but it was held that a red mark which they had used on *Hunyadi*, and also on other waters, was their own trade mark.

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

[3] 16 R. P. C. 205 (1899), North, J. (*Capstan Closets*).

the owners of the patent, which was still unexpired, sought to restrain such use of the word *Capstan*, and to expunge the mark from the Register, on the ground that the word was the name of the article, and that the goodwill of the defendants in the article had determined. Both the action and the motion to rectify failed, the Court finding that the name indicated goods manufactured and sold by the defendants in the action.

Application through agent.

The application for registration may be made by or through an agent duly authorised to the satisfaction of the Registrar.[1] If the proprietor appoints an agent, he will be bound by his acts, so that where, under the Act of 1883, by the default of the agent, the registration was not completed within twelve months, it was deemed to have been abandoned.[2]

Registration in the agent's name.

If the mark is, as sometimes happens, by the agent's mistake or fraud, registered in the name of the agent instead of that of his principal, it may be removed and a new application made.[3] In some cases, where there has been no wrongful intention on the part of the agent, an assignment to the principal,[4] or to his successor in business,[5] has been permitted, or a rectification of the Register effected;[6] but the authorities are conflicting upon the question whether either of these courses ought to be allowed.[7] Where an agent acting for two separate principals has, by mistake, registered the trade mark of one in the name of the other, removal and a fresh application are necessary.[8]

2. The Registrar's Discretion.

The Registrar has a discretion under the Act to register or to refuse any trade mark which falls within the class of things which may be registered under the Act, and which is not debarred from registration by some provision of the Act. The following

[1] See above, p. 63.

[2] *Jackson & Co. v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1887), Stirling, J.; *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29, North, J. As to the practice under the present Act, see below, p. 80.

[3] *Marler's Tm.*, 44 L. T. 98, n. (1878), essel, M.R.

[4] *Farina's Tm.*, 44 L. T. 99, n. (1881), essel, M.R.

[5] *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 70 (1886), Chitty, J.; *Re Australian Wine Co.*, 61 L. T. 427, n. (1885), Chitty, J.; *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.

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

[7] See *Rivière's Tm.*, 55 L. J. Ch. 545 (1886), C. A., and note (8); and cf. *Grocott's Design*, 17 R. P. C. 139 (1900). See also Chap. XI., p. 301.

[8] *Kingsford & Son's Application*, 6 R. P. C. 413; 61 L. T. 426 (1889), Kay, J.

table shows the reasons for refusal which arise under the Act and Rules themselves:— Reasons for refusal of the application.

(1) The application is not made by or on behalf of any person (properly) claiming to be the proprietor of the mark.[1]
(2) It is not made in proper form.[2]
(3) It is deemed to be abandoned.[3]
(4) The mark tendered does not consist of or contain any of the essential particulars of a registrable trade mark.[4]
(5) The application is successfully opposed.[5] Besides any other ground for refusal, an opponent may show that the registration of the proposed mark would be unjust to him, *e.g.*, by giving to the applicant the exclusive right to use a mark which he is already lawfully using, though not as a trade mark,[6] or he may show that it is a common mark.[7]
(6) Where there are conflicting claims to registration, the Registrar may refuse to register upon any of them until the 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.[8]
(7) The mark tendered is identical with, or has a resemblance which is calculated to deceive to, another mark already on the Register for the same goods or description of goods.[9]
(8) It contains matter the use of which, by reason of its being calculated to deceive or otherwise, would be disentitled to protection in a Court of Justice.[10]
(9) Its use would be contrary to law or morality.[10]
(10) It comprises a scandalous design.[10]

[1] See. 12 (1); above, p. 66.

[2] See Procedure on Application to Register; below, p. 77. "Prescribed" means prescribed by the Act or the rules thereunder, sec. 3. See also *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386.

[3] See. 18, p. 80.

[4] See. 9, Chap. VIII., p. 129.

[5] See. 14, pp. 85, 86 *et seq.*

[6] See per Cotton, L.J., in *Hudson's Tm.*, 32 C. D. p. 320; 3 R. P. C. 155 (1886); *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J. And see Chap. X., p. 221.

[7] Chap. VIII., p. 177. Of course a common mark is not distinctive, and therefore falls under the fourth objection.

[8] Sec. 20, p. 223.

[9] Sec. 10, p. 222.

[10] Sec. 11, p. 266.

(11) It contains the name or a description of goods other than those in respect of which the application is made.[1]

(12) It contains one or more of the things which, according to the rules, cannot be registered as marks or parts of new marks.[2]

Nature of the Registrar's discretion.

The discretion to refuse to register which is vested in the Registrar is a judicial discretion, and is subject to the appeal referred to below. It is submitted that, in the exercise of it, regard ought not to be had to considerations other than those just enumerated above, or such further objections, if there are any, as would have been bars to the acquisition of trade mark rights at common law, or as are sanctioned by the terms of the Act, or are founded on general principles of law.[3] In some of the cases decided under the Act of 1875 or the Act of 1883 and cited in the next paragraphs, however, the Comptroller's discretion has been referred to in very general terms; but these references ought, probably, to be understood as directed to cases of suggested deceptive marks, such as those in which the several *dicta* were spoken.[4]

"The Comptroller," Kay, J., said, in *The Emollio* case,[5] "when he is asked to register a trade mark, is bound to consider whether, looking to all the circumstances of the case, he can exercise his discretion by permitting the trade mark to be registered." And in *The Australian Wine Importers'* case,[6] the same

[1] Rule 16, p. 658.

[2] These are (Rule 11) the words "patent," "patented," "by royal letters patent," "registered," "registered design," "copyright," "entered at Stationers' Hall," "to counterfeit this is forgery," or words to like effect; also representations of their Majesties, or of any member of the Royal Family. The Royal arms, the British Royal crowns, the British national flags, and certain other devices are by Rule 12 prohibited from registration. See Appendix, p. 657.

See also *Hubbuck* v. *Brown*, 17 R. P. C. 118 (1900), where Kekewich, J., whose decision was subsequently affirmed by the Court of Appeal (17 R. P. C. 638), said that the exclusive right to the royal arms could not be claimed by the plaintiffs.

[3] In *Players' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65. Cozens-Hardy, J., upheld the Comptroller's objection that the mark applied for was substantially the same as a previously registered mark of the applicants'. See now associated marks, p. 108. The use of the word "registered" before registration may be a ground for refusal, if not explained as a *bonâ fide* mistake or if no other satisfactory explanation is given: *Altmann's Application*, 21 R. P. C. 733 (1904), Kekewich, J.; *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), C. A.

[4] And for instance, *Denhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A.

[5] *Grossmith's Tm.*, 6 R. P. C. 180: 60 L. T. 612 (1889).

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

learned judge said: "Does it follow because (the opponent) could not get an injunction, that (the applicant) is entitled to put the trade mark on the register? In my opinion, it does not follow at all, and I have said so many times. In my opinion the Comptroller ought to exercise his discretion in a wise[1] and comprehensive way."

Eno v. Dunn.

The existence of a discretion to refuse registration was asserted in the most decisive manner by the majority of the Law Lords in the House of Lords in *The Fruit Salt* case.[2] There, Lord Herschell said: "The case was argued on behalf of the respondent as if he had an absolute right to have any trade mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act.[3] Those sections prohibit the registration of a trade mark in certain specified cases, but there is no duty cast upon the Comptroller of registering every other trade mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all other cases plainly conferred. Of course, this discretion must be reasonably and not capriciously exercised; but it is, in my opinion, a reasonable exercise of it to refuse registration when it is not clear that deception might not result from it." And Lord Watson said that in cases where it is doubtful whether a trade mark tendered for registration is calculated to deceive or not, the application ought to be disallowed. Lord Halsbury, who dissented from the conclusion arrived at in the case, treated the Comptroller's discretion as more closely limited. "While I agree," he said, "that no absolute right to the registration of a trade mark is given to an applicant for registration, the meaning and intent of the statute itself is that, unless for some of the reasons contemplated by the statute, there is an objection to the registration, the trade mark ought to be registered. Unless we are of opinion that there is something in the proposed trade mark which the statute renders an objection to its registration, we ought to grant the application" (to register). And this opinion accords with that expressed by Lord Blackburn in *The Orr-Ewing* case, soon after the passing of the Act of

The Orr-Ewing case.

[1] *Quære* wide.

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

[3] For these sections see Appendix, p. 631.

1875.[1] "I cannot construe this section,"[2] his Lordship said, "as meaning anything else than that, when the Court of Chancery is satisfied that the applicant is a person who is, for the time being, entitled to the exclusive use of a trade mark in accordance with law, and that the trade mark is one within (the definition section of the Act), the Court is, *ex debito justitiæ*, to rectify the register,[3] just as it would, before the Act of 1875, have been bound *ex debito justitiæ* on similar proof, to prevent anyone infringing the trade mark shown to be his property. The burden of proof lies upon the person making the application to amend the register: but if he does produce such proof as would, in the opinion of the Court, entitle him to an injunction, I do not think the words 'if satisfied of the justice of the case' can, or ought to be, construed as meaning to give the Court a discretion to consider whether the nature of the trade mark is such as to make it inconvenient that he should exercise the right of property which it is proved he actually has."

The opinion last cited was delivered in a case where the marks concerned were old marks, and the apparent conflict between it and the opinions of the majority of the Law Lords in *The Fruit Salt* case may probably be reconciled by treating the doctrine of a right *ex debito justitiæ* to register as applicable only to marks used as trade marks before August 13th, 1875. The Act of 1875 excepted from the prohibition of actions for the infringement of unregistered trade marks the cases of such old marks as should be refused registration under it.[4] The exception was, however, cited by Lord Blackburn in his opinion. He stated that it did not affect the conclusion he had arrived at.

In his dissenting judgment in *The Somatose* case,[5] Lindley, L.J., said: "The sections (*i.e.*, secs. 70, 72 and 73) and the discretion given by sec. 62 (4) of the Act of 1883 . . . . would clearly justify

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

[2] Sec. 5 of the Act of 1875, corresponding to sec. 35 of the present Act.

[3] Upon the refusal of the Registrar to register a mark under the 1875 Act, the procedure by way of appeal was to move to rectify.

[4] Sec. 1. Sec. 42 of the Act of 1905 contains a similar exception, as did sec. 77 of the Act of 1883.

[5] *Farbenfabriken Vormals Friedr. Bayer & Co.'s Tm.*, 11 R. P. C. p. 88; [1894] 1 Ch. 645. Kay and Smith, LJJ., did not discuss this point. In *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905), Warrington, J., referred to the passage quoted above.

the rejection of any trade mark, even if it contains one of the statutory requisites, if such mark be of an indecent or libellous character, or if it infringes the rights of some other person, or if it is identical with, or so similar to one already registered as to be calculated to deceive. But I can find no other restriction, and if a person seeks to register a mark which is open to none of these objections, and which does contain one of the essentials mentioned in sec. 10 of the Act of 1888, I am aware of no legal principle which would justify the Court in refusing to direct its registration."

In *The Solio* case, Kekewich, J.,[1] in upholding the refusal by the Comptroller to register the word *Solio*, gave considerable weight to the consideration that he would be overruling the discretion of the Comptroller, and reversing a practice of the office not to register in connection with photographic materials words indicating a connection with the sun; but in the Court of Appeal,[2] and also in the House of Lords,[3] where the registration was allowed, the question was treated as being purely whether the word fell within one of the essential particulars defined in the Act.[4]

In a recent case,[5] Fletcher Moulton, L.J., after referring to the rights of the registered proprietor of a trade mark to protect it against infringement and to object to the registration of conflicting marks, said: "There are two rights which, although they are not *ex debito justitiæ*, give to an applicant the rights which the Legislature means a trader to possess in defence of those things which he uses as marks of origin in a lawful trade."

Discretion to be judicially exercised.

In another case,[6] Farwell, L.J. (then Farwell, J.), said: "The Comptroller undoubtedly has a discretion—a discretion, of course, to be exercised judicially, like all other judicial discretions. There is an appeal to this Court, but the Court ought not to overrule the judicial exercise of the Comptroller's discretion unless it is clearly of opinion that the discretion was wrongly exercised." Still more recently, in an application under the Act of 1905, Kekewich, J., said in effect that although the discretion

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

[2] 14 R. P. C. 487; 76 L. T. (N. S.) 732.

[3] [1898] A. C. 571; 15 R. P. C. 476.

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

[5] *Lyle and Kinahan's Application*, 24 R. P. C. 249 (1907), at p. 261.

[6] *Booth Distillery Co.'s Applications*, 21 R. P. C. 18 (1904). See also *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905).

was open to review, it was exercised in a judicial manner, and, subject to the provisions of the Act, ought not to be readily upset.[1]

Consents.

Where the Registrar takes objection to a mark on the ground of its resemblance to a registered mark, the matter is not concluded by the consent of the owner of the latter mark to the registration. Such consent may be evidence as to the improbability of deception. It does not bind the Registrar.[2]

Acceptance subject to conditions.

It is now expressly enacted that the Registrar may accept a trade mark absolutely or subject to conditions, amendments, or modifications,[3] and a like power is conferred on the Board of Trade or the Court on appeal from the Registrar.[4] These provisions are new, but in a few cases under the old law registration was allowed subject to a condition which was noted on the Register.[5] But notes as to geographical limits of use were disapproved by the Court of Appeal.[2] In cases of honest concurrent user they are, however, expressly authorised by sec. 21 of the Act of 1905. The words of sub-sec. (2) are probably wide enough to cover amendments or modifications in the trade mark itself, and not merely in the form of application, which matter is expressly provided for in sub-sec. (6). In one reference to the Court under the Act of 1905 the Court has, in making an order under paragraph 5 of sec. 9, required an undertaking to be given to it.[6]

Registrar to hear applicant before refusing the application.

The Registrar is directed, before exercising his discretion adversely to an applicant for registration, if so required within one month from the date of his objection, to give the applicant an opportunity of being heard personally or by his agent, by sending the applicant ten days' notice of a time when he may be so heard, and the applicant is directed, within five days from the date when such notice would be delivered in the ordinary course of the post, to notify to the Registrar whether he intends to be so heard or not.[7]

The decision of the Registrar against an applicant for the registration of a mark is subject to appeal to the Board of Trade

[1] *Birmingham Small Arms Co.'s Application*, [1907] 2 Ch. 396; 24 R. P. C. 563.

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

[3] Sec. 12 (2), above, p. 66.

[4] Sec. 12 (4), above, p. 67.

[5] See above, p. 59. In *Verschure and Zoon's Application* (1905), 22 R. P. C. 568, registration of the word "Vezet" was allowed, subject to a condition that the applicants should not claim by virtue of the registration the right to restrain the use of the letters "V. Z."

[6] *In re Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436, Kekewich, J.

[7] Sec. 53, and Rules 83 to 86.

or to the Court.[1] If required by the applicant, the Registrar is to state in writing the grounds of his decision.[2] If an applicant contemplates appealing from the Registrar, he should be careful to bring all the materials on which he may wish to rely before the Registrar.[3] An appeal is given against a conditional acceptance as well as against an absolute refusal.[4] On an opposition, an appeal lies to the Court, or, with the consent of the parties, to the Board of Trade.[5]

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

The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of the Act, apply to either of the law officers for directions in the matter.[6] It has been decided by the Court of Appeal in a patent case[7] that in any such case the Comptroller may so apply, notwithstanding that the matter involves a question of construction of the Act, and the Court will not in its discretion grant a mandamus against the Comptroller where he has properly taken the direction of the law officer under the section.[8] But, of course, the direction of the law officer would not interfere with any right of appeal expressly conferred by the Act.

It was provided by sec. 82 (3) of the Act of 1883 that the Comptroller should act under the superintendence and direction of the Board of Trade, and this provision was continued by sec. 74 of the Act of 1905 with respect to registration of trade marks. It is now replaced by sec. 62 of the Patents and Designs Act, 1907.

3. Procedure on application to Register.

The procedure on an application to register varies according as the application is (1) an ordinary one, (2) a special application under paragraph 5 of sec. 9, or in lor (3) a standardisation mark under sec. 62, or (4) a Sheffield mark under sec. 63, or (5) a cotton mark under sec. 64, or (6) a series of trade marks. Applications for Sheffield marks and cotton marks, and for series of marks so far as they differ from ordinary applications, are

[1] Sec. 12 (3), below, p. 92. *Re Australian Wine Importers, Ltd.*, 41 C. D. p. 285; 6 R. P. C. p. 314.

[2] Sec. 12 (3). Rule 33. Form TM No. 4.

[3] See sec. 12 (5).

[4] Sec. 12 (3). Rule 32.

[5] Sec. 14 (5).

[6] Sec. 56, replacing sec. 95 of the Act of 1883. *Re Tm. Normal*, 35 C. D. p. 245; 4 R. P. C. 123, per Lindley, L.J.

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

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

considered in the chapters specially dealing with those subjects;[1] the other modes of application are here dealt with.

A. *Ordinary applications to Register.*

Ordinary applications.

The procedure is prescribed by Rules 17 to 34, 47 to 50, and 62 to 67; it is described in paragraphs 4 to 12 of the Official Instructions.[2]

Form of application.

A printed form of application, Form TM No. 2, must be obtained and filled up, and a representation of the proposed mark affixed to it, and four additional representations, each on Form TM No. 3, must also be sent in with it.[3] The application must be filled up and signed[4] in accordance with the rules and the directions given in the notes to the form. If the application is for an old mark, that is, one used before August 13th, 1875, it must contain a statement as to the time during which and the persons by whom it has been used.[5] If registration in more than one class is required, a separate application must be made for each class.[6]

Word in foreign language or characters.

When a trade mark contains a word or words in other than Roman characters a sufficient transliteration and translation to the satisfaction of the Registrar of each of such words must be given; and where a trade mark contains a word or words in a language other than English, the Registrar may require an exact translation thereof.[7]

Essential particulars and disclaimers.

The present rules and forms do not require the applicant to state in his application the essential particulars of the trade mark or to make any disclaimer; but the Registrar may call on

[1] Sheffield marks, Chap. VI., p. 112; Cotton marks, Chap. VII., p. 121. Series of marks, Chap. V., p. 110.

[2] Printed in the Appendix, p. 702.

[3] The Forms are set out in the 2nd Schedule to the Rules, below, p. 678. Stamped forms must be used; they are obtainable at certain post offices and at the Inland Revenue Office, in the Patent Office, Room 32; see Instructions, below, p. 705.

[4] Signature, Rule 17. As to applications by agents, see Rule 10, and above, p. 70.

[5] Rule 20. It was held under Rule 11 of 1890 that where the user claimed has been by a firm, it is not necessary to state the names of the persons who were from time to time members of the firm, nor to insert the words "and their predecessors in business for the time being": *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J. Stirling, J., had previously held (*Bryant & May's Tm.*, unreported, but cited 17 R. P. C. at p. 396) a statement of user by the applicants or their predecessors in title to be sufficient. An application by a limited company in the names of their predecessors, the late owners of the mark, was held not to be good: *Heddle & Co.'s Application*, 20 R. P. C. 599 (1903), Byrne, J.

[6] Rule 24.

[7] Rule 28.

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.[1]

The Registrar or the Board of Trade or the Court may require, as a condition of registration, any such disclaimer as they shall consider needful for the purpose of defining the rights of the applicant under the registration.[2]

What may be essential particulars of registered trade marks is considered in Chapter VIII.,[3] and additions and disclaimers are dealt with in Chapter IX.[4]

The address and description of the applicant must in every case be stated in full in the form,[5] and 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 or the opposition thereto.[6]

Procedure on receipt of application.

Upon receipt of an application for registration the Registrar causes a search to be made amongst the registered trade 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.[7] If the Registrar thinks there is no objection to the mark being registered, he may register it absolutely, or subject to conditions, amendments, or modifications,[8] which acceptance is to be communicated to the applicant in writing. On the other hand, if he objects to the registration, a statement in writing of his objections is sent to the applicant, and unless the applicant within one month applies for a hearing,[9] the application is deemed to be withdrawn.[10] Similarly, if conditions are attached to the acceptance, and the applicant objects to them, he must apply for a hearing within one month, otherwise his application is deemed to be withdrawn. If he does not object to them, he must so notify the Registrar in

[1] Rule 34; cf. sect. 15.
[2] Sec. 15, Chap. IX., below, p. 212.
[3] Page 127.
[4] Page 212.
[5] As to address, see Rule 8.
[6] Rule 9.
[7] Rule 29. Cf. sec. 19.
[8] Rule 30. As to conditions, see above, p. 76.
[9] As to hearings, see sec. 53 and Rules 83 to 86.
[10] Rule 31.

writing.[1] After a hearing by the Registrar, he communicates his decision to the applicant in writing, and if the applicant objects to it, he may require the Registrar to state in writing the grounds of his decision, and the materials used by him in arriving at the same.[2] The date of the sending by the Registrar of such statement is the date of the decision for the purpose of appeal.[3]

Withdrawal of acceptance.

An acceptance by the Registrar may, if given by error, or if the Board of Trade in special cases so directs, be withdrawn.[4] But the applicant has thereupon the same rights of being heard and of appealing as if the mark had been originally refused.[4] It may happen that in the course of an opposition new grounds for objection on the part of the Registrar may be disclosed, and in such cases the Board of Trade could, under its special power above referred to, direct that the mark should not be registered.

Abandonment of the application.

It is provided by sec. 18 that:—

> "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,[5] treat the application as abandoned, unless it is completed within the time specified in that behalf in such notice."

Sec. 63 of the Act of 1883, to which sec. 18 corresponds, was held not to operate so as to prevent a fresh application being made in a case where the merits of the abandoned application had never been gone into or considered.[6]

Advertisement.

The Registrar may accept the mark tendered, either absolutely or conditionally, or refuse it. When an application has been accepted, whether absolutely or subject to conditions, the Registrar is, as soon as may be after such acceptance, to cause it, as accepted, to be advertised in the official paper during such times and in such manner as he may direct.[7] The advertisement sets forth all the conditions subject to which the application has been accepted,[7] and comprises either a representation of the mark or a reference to the place where a specimen or representation is

[1] Rule 32.

Sec. 12, sub-sec. (3), and Rule 33. Form TM No. 4.

[3] Rule 33.

[4] Sec. 16 and Rule 63.

[5] Rule 62, and Form O, No. 1. Fourteen days is in general the length of notice.

[6] *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886); *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29: see also *Hayward's Tm.*, 54 L. J. Ch. 1003; 53 L. T. (N. S.) 487 (1885), Kay, J.

[7] Sec. 13 and Rules 47 to 49.

deposited for exhibition.[1] The requisite blocks must be furnished by the applicant.[2] It is open for any one who objects to the registration, within one month after the advertisement, to send in notice of opposition.[3] The Registrar may enlarge the time for notice of opposition.[4] If a modification of the trade mark is allowed in the course of an opposition the trade mark is to be re-advertised.[5]

If there is no opposition, or if the opposition is disallowed, and the Registrar is satisfied that the applicant is entitled to registration, the registration proceeds. This is provided by sec. 16, which is as follows:—

Date of registration.

"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."[6]

The applicant must, before registration, pay the prescribed fee.[7] A special power to stop a registration is conferred on the Board of Trade by this section.[8] The particulars to be entered on the Register have already been noticed.[9]

Death of the applicant before registration

If the applicant have died before the registration, the Registrar may register the name of the person owning the goodwill of his business, after the death and ownership have been proved to the satisfaction of the Registrar.[10]

Certificate of registration or of refusal to register an old mark.

Upon registration, the applicant becomes entitled to a certificate of registration without payment of a fee therefor.[11] Where the Registrar refuses an old mark, that is, a mark used as a trade mark before August 13th, 1875, he may, on request, grant a certificate that registration has been refused.[12]

[1] Sec. 13 and Rules 47 to 49.
[2] Rule 48.
[3] Sec. 14. See below, p. 85.
[4] Rule 99.
[5] Sec. 14 (9).
[6] As to date, see Chap. XII.; below, p. 321.
[7] Rule 64, and Form TM No. 11, p. 683, and List of fees, p. 673.
[8] See also Rule 63, and above, p. 80, Withdrawal of Acceptance.
[9] Above, pp. 57 and 59.
[10] Rule 66.
[11] Sec. 17 and Rule 67. Form of Certificate, Form O, No. 2, p. 683.
[12] Sec. 42. Form TM No. 32 Fee £1. See Table of Fees, p. 673

B. *Special Applications under Sec.* 9 (5).

If an application is made to register a distinctive name, signature, or word or words, other than such as fall within the descriptions in paragraphs (1), (2), (3), and (4) of sec. 9, an order of the Board of Trade or the Court must be obtained, that the mark is to be deemed a distinctive mark.[1] The four paragraphs referred to are as follows:—(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. In reference to all other names, signatures, or words, the following procedure is prescribed by Rules 35 to 41, and the ordinary procedure is varied to the extent required by them.[2] The application must be made on the Special Form TM No. 5, which includes a statement that the applicant desires an order of the Board of Trade or the Court directing registration.[3] Upon receipt of the application the Registrar causes 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,[4] and he notifies to the applicant the result of such search.[5] The applicant has one month from the receipt of such notification within which to 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, and does not obtain any extension of time under Rule 99, his application is deemed to be withdrawn.[6] If he desires to be heard by the Board of Trade, he must fill up and send with his case Form TM No. 10.[7] Thereupon the Registrar sends the case and a copy of all

[1] Sec. 9 (5). See also Chap. VIII., p. 127.

[2] In the nine months of the year 1906, during which the Act of 1905 was in force, 290 applications of this special nature were made; of these 183 were reported to the Board of Trade, and one applicant elected to be heard by the Court: Comptroller-General's Report for 1906. In the year 1907 there were 202 applications, of which 143 were so reported: Report for 1907.

[3] Appendix, p. 680.

[4] Rule 36.

[5] Rule 37.

[6] Rule 38.

[7] Appendix, p. 682. The fee on such request is £1; see List of fees, p. 673.

communications between himself and the applicant to the Board of Trade.[1] If the applicant desires to be heard, the Board fixes a hearing, and the Registrar may attend and be heard, and the Board makes an order determining whether, and subject to what conditions, amendments, or modifications,[2] if any, the application is to be accepted, or they may require the applicant to apply to the Court, and limit a time for that purpose.[3] If the applicant desires to obtain an order of the Court he must, within one month from sending to the Registrar his case as above stated, bring the matter before the Court by motion, and, if he does not do so, he is to be deemed to have withdrawn his application.[4] If the application is accepted either by the Board of Trade or the Court, it is to be advertised, and proceedings thereafter are to be had in respect of it as if it had been accepted by the Registrar in the ordinary course.[5] On an application under this paragraph for the registration of the word "Apollinaris," the Court, subject to an undertaking which it required of the applicants, made an order that that word was to be deemed a distinctive mark within the meaning of the section.[6]

C. *Standardisation Marks under Sec.* 62.

Section 62 is as follows:—

Standardisation, &c., trade marks.

"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."

[1] Rule 38.

[2] As to conditions, amendments and modifications, see p. 76.

[3] Rule 39. The Act gives the Board of Trade power to refer any appeal under the Act to the Court, sec. 59, but this hardly appears to be an appeal.

[4] Rule 40.

[5] See above, p. 78.

[6] *Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436, Kekewich, J.

An application under this section must be made in duplicate on Form TM No. 6,[1] and be accompanied by six copies of the mark,[2] and the procedure is prescribed by Rules 42 to 46. The Registrar reports on the application, and sends copies of his report to the Board of Trade and the applicants, and the applicants must within one month from the receipt of such report send the Board in duplicate a case setting out the grounds upon which they rely in support of their application, and if they fail to do so, their application is to be deemed to be abandoned.[3] The Board of Trade may call for such evidence as they think fit, and are, if necessary, to hear the applicants and the Registrar, and to make an order determining whether and subject to what conditions, amendments or modifications,[4] if any, the application may be permitted to proceed. If it be permitted to proceed, it is treated in all respects as an ordinary application, and the mark is advertised.[5]

Sixty-three applications were made under sec. 62 in the year 1906, but fifty of these were made by one association; eleven such applications were made in the year 1907.[6]

Amendments.

Amendment of application.

The Registrar or the Board of Trade or the Court may, at any time, whether before or after acceptance, correct any clerical error in, or in connection with, an application for registration of a trade mark, and may permit an applicant for registration of a trade mark to amend his application upon such terms as they may think fit.[7] And a more general power of amendment is provided by Rule 98, by which "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 the prescribed times.

It is further provided that the time prescribed by the Rules for doing any act or taking any proceeding thereunder may be enlarged by the Registrar, if he shall think fit, and upon such notice to other parties, and proceedings thereon, and upon such

[1] Appendix, p. 681.
[2] Rules 42 and 43.
[3] Rule 44.
[4] As to these words, see above, p. 76.
[5] Rule 45. For fees relating to such application, see List of fees, below, p. 673.
[6] Comptroller-General's Reports for 1906 and 1907.
[7] Sec. 12, sub-sec. (6). This is wider than sec. 91 (*a*) and (*d*) of the Act of 1883, which it replaces. Whilst an opposition is pending, the Registrar will not as a rule allow an amendment of an application.

terms as he may direct, and such enlargement may be granted though the time has expired for doing such act or taking such proceeding.[1]

4. Opposition to Registration.

When the mark has been accepted and advertised, any person —not merely any person who would be aggrieved by the registration[2]—may oppose the registration by showing that the mark is, or would, if registered, be, an infringement of his rights, or that on any other ground it ought not to be registered.[3]

Opposition to registration.

The procedure by which an opposition is to be conducted is regulated by sec. 14 of the Act of 1905, and by Rules 51 to 61.[4]

Section 14 is as follows:—

(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

[1] Rule 99, and as to opposition proceedings, see Rule 60. As to excluded days, see Rule 100.

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

[3] Below, pp. 88 and 91.

[4] These are summarised in par. 17 of the Instructions, Appendix, p. 711.

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.

Rules.

The more important Rules as to the procedure on opposition are as follows:—

Opposition.

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.

Notice of 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 Journals 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.

Counter-statement.

53. Within one month from the receipt of such duplicate the applicant shall send to the Registrar a counter-statement (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 counter-statements shall be accompanied by a duplicate in writing.

Evidence in support of opposition.

54. Upon receipt of such counter-statement 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 application.

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 reply by opponent.

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.

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.

Security for costs.

61. Where a party giving notice of opposition neither resides nor 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.

There are also Rules empowering the Registrar to give leave to either party to file further evidence,[1] providing for the furnishing of copies of exhibits or for inspection of the exhibits,[2] and empowering the Registrar, where he has granted an extension of time to one party, to grant an extension to the other party for any subsequent step.[3]

Who may oppose.

Any person, not merely any person who would be aggrieved by the registration,[4] may oppose the registration, and an opponent is not confined to objections based on interference with his rights, but can set up any proper ground of opposition,[5] *e.g.*, that the mark does not contain or consist of any of the essential particulars enumerated in sec. 9.

Statement of grounds of opposition.

The provision, confining an opponent to the grounds of opposition contained in his notice of opposition,[6] is now contained in the Act itself instead of in rules, as was the case under the repealed Acts. The tribunal hearing an appeal can, however, give leave to an opponent to take a further objection.[7] It is doubtful whether the Registrar can, whilst the opposition is before him, give such leave, under the general power of allowing amendment of documents, conferred by Rule 98, for the Rules are subject to the provisions of the Act,[8] and it is not clear that sub-sec. (8) allows such an amendment of grounds of opposition. Under the Acts of 1883 and 1888, it was open to the Registrar, on an appeal in an opposition, to take a new objection to the registration of the mark,[9] but under the Act of 1905 the leave of the Court is required.[10] A special power is conferred on the Board of Trade by sec. 16 to stop registration notwithstanding that the mark has been accepted, and any opposition has failed.[11]

[1] Rule 57.
[2] Rule 58.
[3] Rule 60. Rule 99 is the general rule as to enlargement of time.
[4] Cf. Rectification of the Register, sec. 35.
[5] Cf. Grounds of Opposition, below, p. 91.
[6] Sec. 14, sub-sec. (8).
[7] Sec. 14, sub-sec. (8).
[8] Sec. 60. It is not the general practice of the Registrar to allow an amendment of an application pending an opposition.
[9] See below, Appeal, p. 92.
[10] Sec. 14, sub-sec. (8).
[11] See above, p. 81, and Rule 63.

Summary of procedure on an opposed application.

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

(1) Application.[1]

[(2) Notice of objection of Registrar to entertain the application.[2]

(3) Application by applicant to the Registrar for a hearing, within one month of (2).[3]

(4) Hearing by Registrar.

(5) Communication of Registrar's decision to applicant.[4]

(6) Application by applicant to Registrar for statement of grounds of decision within one month of (5).[5]

(7) Notice of appeal to Board of Trade or the Court, one month from decision of Registrar.[6]]

(8) Advertisement of application.[7]

(9) Notice of opposition, one month from advertisement. Notice to be in duplicate, with grounds of opposition, and address for service, and to be signed by opponent or his agent.[8]

(10) Counter-statement (in support of the application), one month from receipt of (9) from Registrar. To be in duplicate with grounds of application and admission, if any, of facts.[9]

(11) Opponent's evidence, one month from receipt of counter-statement. To be by statutory declaration delivered at the Patent Office. Copies of the declarations to applicant.

(12) Applicant's evidence in answer, one month from receipt of (11). To be by statutory declarations and copies as (11).

(13) Opponent's evidence in reply, fourteen days from receipt of (12). Statutory declarations and copies as (11).

(14) Notice of appeal to the Court or, with the consent of the

[1] Page 77. Form TM No. 2, p. 678.

[2] Rule 31.

[3] Pages 76 and 79. No fee appears to be payable, except in cases of opposition.

[4] Rule 33.

[5] Rule 33, p. 80. Form TM No. 4.

[6] Page 92, Rules 121 and 122. The date of the sending by the Registrar of the statement of the grounds of his decision is the date of the decision for the purpose of appeal, Rule 23. If the applicant appeals to the Court he proceeds by notice of motion. Adapt form in Appendix, p. 721, Rule 122; if to the Board of Trade, Form TM No. 29, p. 695, must be used, and it must be accompanied as prescribed by Rule 123.

[7] Page 80.

[8] Form TM No. 7, p. 681.

[9] Form TM No. 8, p. 682.

parties, to the Board of Trade, one month from decision of Registrar.[1]

Forms of the several notices and other documents referred to in the above table are set out in the Appendix, pp. 716 to 722.

New power to award costs.

Both the Registrar and, on appeal, the Board of Trade, have now full power to award costs to either party to an opposition.[2] Under the repealed Acts there was no power to give an applicant the costs of an unsuccessful opposition, and the power to give costs to an opponent was confined to the case of an abandonment of the application by the applicant.[3]

Amendments and enlargement of times by the Registrar.

The Registrar's powers under sec. 12 (6) and Rules 98 and 99 to amend clerical errors in connection with any application for registration, and to allow the amendment of any document, drawing, or representation of a trade mark, for the amendment of which no special provision is made by the Acts, and to enlarge the times prescribed by the Rules for doing any act or taking any proceeding thereunder, have already been stated.[4]

Under the old Rule 54, it would seem that a notice of opposition might have been amended, even though the amendment raised an entirely new case of fraud against the applicant. So, in *Moët's Trade Mark*,[5] where the Registrar had refused to amend an opposition on the ground that he had no power, and notwithstanding that he had also expressed an opinion that, as it was directed to charge fraud against the applicant, it could not be made "without detriment to his interests," and that on the merits it ought not to be allowed, the Divisional Court directed a mandamus to the Comptroller to hear and determine the application to allow the amendment, and Mathew, J., said he thought it ought to be made. Under the Acts of 1883 and 1888 the time for giving notice of opposition was prescribed by the Acts themselves, and the Registrar (sitting for the Comptroller) held that he had no jurisdiction to allow an amendment of a notice of opposition after the expiration of three months from the date of the advertisement, being the extreme limit for opposition allowed under the Act of 1888, or after the case had been heard

[1] See above, p. 89, note (6).

[2] Sec. 14, sub-sec. (10).

[3] Sec. 69 of the Act of 1883, as amended by the Act of 1888. See below, Costs, p. 99.

[4] Page 84, above; cf. also Rule 97 (power to dispense with evidence), Appendix, p. 668.

[5] 7 R. P. C. 226 (1890), Mathew and Grantham, JJ.

and disposed of before the Comptroller. In the case in question,[1] the opponent in the course of an appeal to the Court asked for leave to amend his notice, but this, Stirling, J., held, he had no jurisdiction to grant, and the opponent then made a similar application to the Registrar, with the result already stated. The Registrar can now, under his general power of enlarging time conferred by Rule 99, enlarge the time for giving notice of opposition, but it would appear that sub-secs. (2) and (8) of sec. 14 of the Act of 1905 confine an opponent to the grounds of opposition stated in his notice of opposition, and that such grounds cannot be added to, except on an appeal and by leave of the tribunal hearing the appeal.[2]

Grounds of Opposition.

The reasons for refusing to register a mark which is propounded for registration are dealt with in detail elsewhere.[3] Those which are most commonly relied on by an opponent are the following :—

(i.) That the mark propounded is identical with a trade mark already on the Register with respect to the goods or the description of goods for which the mark propounded is sought to be registered or so nearly resembles such a mark as to be calculated to deceive.[4] In this case the register number of the mark already on the Register, and the number of the Journal in which it has been advertised, must be stated in the notice of opposition.[5]

(ii.) That the registration or use of the mark would interfere with the use by the opponent of some mark in which he has rights, or which he is actually lawfully using, whether as an unregistered trade mark,[6] or as an advertisement,[7] or as a mark common in the trade,[8] and that, consequently, the applicant's mark is not distinctive.

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

[1] *Robertson, Sanderson & Co.'s Tm.*, [1892] 2 Ch. 245 ; 9 R. P. C. 264.

[2] See above, p. 88.

[3] See above, p. 71, and the Chapter on Rectification of the Register, p. 276; Forms, Appendix, pp. 716 *et seq.*

[4] Sect. 19, p. 222.

[5] Rule 52, above, p. 86.

[6] Page 180.

[7] Page 181.

[8] Page 177.

of the applicant,[1] or that it has been acquired by the applicant in fraud of his rights.[2]

5. Appeal from the Registrar.

The tribunal of appeal.

An appeal from the refusal of the Registrar *proprio motu* to register a trade mark is by sec. 12 (3) given to the applicant, who has the option of appealing either to the Board of Trade or to the Court.[3] But in an opposition an appeal from the decision of the Registrar must be to the Court, unless both parties consent that it should be to the Board of Trade.[4] The Board of Trade may, however, refer an appeal to the Court.[5] It is apprehended, however, that it will not as a rule do so, except for special reasons,[6] or unless some general question under the Act comes up for decision. It is open to the Registrar, after a successful appeal from his refusal to accept a mark, to refuse registration on notice of opposition.[7]

The practice on appeal to the Board of Trade is governed by Rules 122 to 127 inclusive, which are as follows:—

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.[8]

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

[1] See. 20, p. 223, and see Proprietor, p. 67. The mark may be copyright. As to a copy of a foreign picture, see *Schauer* v. *Field*, [1893] 1 Ch. 35; 62 L. J. Ch. 72, C. A.

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

[3] A similar right of appeal is given in case of cotton marks, see sec. 64 (5). As to Sheffield marks, see sec. 63 (9).

[4] See. 14 (5).

[5] See. 59.

[6] See, for instance, *In re Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436.

[7] See *Orr-Ewing* v. *Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. 707 (1879).

[8] Appendix, p. 695.

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.

Directions by Board.

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.[1]

Hearing of appeal.

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.

No appeal unless notice duly given.

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.

The fee payable on appeal is £1.[2]

The form of notice of appeal, TM No. 29, must be filled up in accordance with the marginal notes.

Notice of and case on appeal.

The case on appeal is a summary statement, generally drafted in a somewhat argumentative form, of the questions raised and the facts upon which the appellant relies, and it may include the statement of the grounds of appeal, which must be sent with the notice.

[1] The directions may include a direction to the applicant to serve a person materially interested, and also directions allowing fresh evidence to be adduced before the Court, if the latter think fit: sec. 14 (7) and *Application of Extract of Meat (Baron Liebig) Photograph Brand, Ltd.*, 17 R. P. C. 161 (1900), Cozens-Hardy, J., where, and also in the Appendix, at pp. 717 and 721. the general form of the directions will be found set out.

[2] List of fees, Appendix, p. 673.

Forms of notice and case on appeal are given in the Appendix.[1]

The Registrar is, by sec. 12 (3) of the Act of 1905, if required, to state in writing the grounds of his decision not to accept a trade mark, and the materials used by him in arriving at his decision.[2] This provision applies where the mark has not yet been advertised. In cases of opposition also the Registrar states his reasons in writing, and the Rules seem to contemplate this, although it is not expressly so provided.

Appeal to the Court.

An appeal to the Court is by notice of motion, which must be given within one month of the decision appealed against or within such further time as the Registrar shall allow.[3]

The Court.

The Court is the High Court of Justice[4] in England,[5] but in practice all the appeals are heard in the Chancery Division.

No appeal except that given by the Act.

There is no appeal other than that given by the Act open to an unsuccessful applicant, for he cannot apply to the Court under sec. 35 as a person aggrieved by the omission of his name from the Register;[6] but the authority referred to[6] does not directly apply to the case of an unsuccessful opponent, although much of the reasoning of it does. It would, however, be anomalous that any other person aggrieved should be able to apply to remove a mark from the Register, but that one who had opposed the registration before the Registrar should be barred;[7] and sec. 54 expressly provides that in dealing with any question of rectification the Court may review any decision of the Registrar relating to the entry in question or the correction sought to be made. No doubt, if the opposition had come before the Court

[1] Page 719.

[2] See also Rule 33, and above, p. 80.

[3] Rule 121. "Prescribed," however, by sec. 3 means in relation to proceedings before the Court, prescribed by Rules of Court. No special Rules of Court have been made in reference to procedure under the Act. Formerly an appeal would be brought by summons or motion. See 2nd ed. of this work, p. 89.

[4] Sec. 3. As to cotton marks, the Lancashire Palatine Court has a concurrent jurisdiction. See sec. 71, and below, p. 126. An order of the House of Lords allowing an appeal from the Registrar should be remitted to the High Court for execution: *Re Orr-Ewing & Co.*, 28 W. R. 412 (1880), Hall, V.-C. The order is made an order of the High Court on motion of course, which may be *ex parte*: Seton, 6th ed., 882, and *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C. at p. 470 (1887), Chitty, J.

[5] Sec. 3. The provisions for Scotland, Ireland, and the Isle of Man do not seem to authorise an appeal to any of their Courts.

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

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

the matter would be *res judicata* between the registered owner and the opponent.[1]

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

The Registrar may, under sec. 20, in any case where each of several persons claims to be registered as proprietor of the same trade mark, and no such agreement is arrived at as the section authorises, refuse to register any of them until their rights have been determined by the Court. Under the former practice, unless the Court otherwise directed, the question was raised by a special case, which might be settled by the Comptroller in case of difference.[2] No special procedure is prescribed by the present Act or Rules, but sec. 20 is expressed differently from the former sec. 71, and it would seem that under it the application to the Court would be a motion or motions by one or more of the applicants asking that the Registrar should proceed with the application or respective applications.[3]

A motion by way of appeal should ask that the decision of the Registrar may be reversed and that he may be directed to proceed, or not to proceed, as the case may be, with the application in question.[4]

Notice of the motion must be served on the Registrar,[5] so that he may appear if he thinks fit, and in an appeal in an opposition the opponent, or the applicant, as the case may be, should be made a respondent. And if there has been no opposition, but the Registrar has refused to register because of the presence of marks similar to the mark in question on the Register, the Court generally requires notice of the appeal to be sent to the owners of such marks;[6] and where an appeal is referred by the Board of Trade to the Court, the directions given on such a reference generally direct service on or notice to such owners.[7] The party in whose favour an order is made must

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

[2] Rules of 1890, 44, 45.

[3] See, however, *In re Hudson's Application*, 24 R. P. C. 582 (1907), Joyce, J., and *Albert Baker & Co.'s Application*, 25 R. P. C. 513 (1908), Eve, J., oppositions.

[4] Cf. Appendix, p. 721, and for the practice under the repealed Acts Daniell's Chancery Practice, p. 1251, Chanc. Forms, p. 802, and see *Simpson, Davies & Sons' Tm.*, 15 C. D. 525 (1880).

[5] Rule 129.

[6] See *Kenrick and Jefferson's Tm.*, 7 R. P. C. 321 (1890), Chitty, J. The appeal may now be to the Court direct, but the practice is the same on this point.

[7] See *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288: and *König and Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 449; *Pomril, Ltd.'s Application*, 18 R. P. C. 181 (1901). The Board

forthwith leave an office copy of the order at the Trade Marks Branch of the Patent Office, and the Register may, if necessary, thereupon be rectified or altered by the Registrar.[1]

The Registrar may, if he thinks that an order should be made public, publish it in the Journal.[2]

Address for service where the applicant or opponent is abroad.

Scotch or Irish applicant or opponent.

Where the applicant or opponent does not reside or carry on business in the United Kingdom, he may be required to give an address for service;[3] but this does not provide for the case of a Scotch or Irish applicant or opponent. Where, therefore, a person who would otherwise be named as a respondent to the appeal is in Scotland or Ireland, and so cannot be served with the notice of motion or summons, the practice of sending him notice in writing of the day fixed for the hearing, and of omitting his name as respondent, has been introduced,[4] for this is all that "natural justice" requires.[5] And if the person to whom such notice has been sent does not choose to appear at the hearing, he is bound by the decision of the Court.[5]

Evidence upon the appeal.

The evidence before the Registrar or the Board of Trade is given by statutory declarations 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.[6] In such case the Board of Trade or the Registrar are in respect of requiring the attendance of witnesses and taking evidence on oath in the same position as an Official Referee.[7] The Registrar has in proceedings at the Office a wide power of dispensing with evidence.[8] The declarations may be used upon an appeal to the Court with all the incidents and consequences of

of Trade may on a reference by them direct service on a person materially interested, although the refusal to register is not based on any similarity to a mark owned by him: *Application of Extract of Meat (Baron Liebig) Photograph Brand, Ltd.*, 17 R. P. C. 161 (1900), Cozens-Hardy, J.

[1] Rule 129, p. 672. If required, Form TM No. 30 must also be left at the office.

[2] Rule 130, p. 672.

[3] Rule 9, p. 656.

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

[5] *King & Co.'s Tm.*, [1892] 2 Ch. 462: 9 R. P. C. 350, Kekewich, J., and C. A.

[6] Sec. 49. As to the manner of taking such declaration, see Rule 105.

[7] Sec. 49. As to the powers of an Official Referee, see Order XXXVI., r. 49, and the Arbitration Act, 1889; as to the meaning of "oath" and "affidavit," see Interpretation Act, 1889, sec. 3.

[8] Rule 97.

evidence by affidavit.[1] If the Board of Trade refer an appeal to the Court, they generally give the appellant liberty to adduce such further evidence as the Court may see fit to direct or permit;[2] and such evidence is usually given on affidavit.[3] An appeal from the refusal of the Registrar before advertisement to accept the mark is required to be heard on the materials stated by the Registrar to have been used by him in arriving at his decision,[4] and no new grounds of objection can be taken by the Registrar, except by leave of the appeal tribunal, and where further objections are admitted, the applicant may withdraw his application without payment of costs on giving the prescribed notice.[5] On an appeal in an opposition, any party may in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.[6] Except by Rule 125, empowering the Board of Trade to give directions as to evidence, the Rules do not appear to contain any directions as to the manner of adducing further evidence on appeal. Fresh grounds of opposition can only be taken by leave of the tribunal, and if any are allowed to be taken, the applicant has a like power of withdrawal as in the case of an appeal before advertisement.[7]

Modification of the application on the appeal.

Formerly the Court had no jurisdiction to amend the application[8] or notice of opposition on appeal.[9] Now, however, as already stated, the Board of Trade or the Court, as well as the Registrar, have power to permit at any time an applicant to amend his application.[10] And on an appeal from the Registrar before advertisement the Board of Trade or the Court may make

[1] Sec. 49. Formerly the declarations had to be verified by affidavit: *Farrow's Tm.*, 7 R. P. C. 260: 63 L. T. 233 (1890), Stirling, J.; and *Kingsford's Application*, 15 R. P. C. 197 (1898).

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

[3] In accordance with Order XXXVIII. r. 1 of the Supreme Court Rules. For an order made by the judge as to evidence, see *Roger's Tm.*, 12 R. P. C. at p. 153 (1895), North, J.

[4] An applicant may require a statement in writing of the grounds of the Registrar's decision and the materials used by the Registrar: above, p. 80.

[5] Sec. 12 (5) and Rule 128. Seven days after leave given is the prescribed time.

[6] Sec. 14 (7).

[7] Sec. 14 (8).

[8] *Players' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J. See, however, *Swift Specific Co.'s Tm.*, 6 R. P. C. 352 (1889), Stirling, J.; *Kenrick and Jefferson's Tm.*, 7 R. P. C. 321 (1890), Chitty, J.; and *König and Ehhardt's Application*, [1896] 2 Ch. 236; 13 R. P. C. 449, Stirling, J.

[9] *Robertson, Sanderson & Co.'s Tm.*, [1892] 2 Ch. 245; 9 R. P. C. 264, Stirling, J. See also above, note (7).

[10] Sec. 12 (6), above, pp. 67 and 84.

an order in favour of the applicant subject to conditions,[1] amendments, or modifications.[2] The word amendment seems to be appropriate to alterations in the application, for instance, striking out certain of the goods in respect of which the application is made, while the word "modifications" seems to refer more especially to alterations in the proposed mark itself.[3] On an appeal in an opposition the tribunal may impose conditions,[4] and 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 the mark, but the mark as so modified must be re-advertised.[5] Whether after an opposition has been entered the Registrar has power to permit a modification of the mark applied for seems to be at least doubtful.[6]

Disclaimers.

The present Rules and Forms do not require an applicant to state in his application the essential particulars of his mark, or to make any disclaimer. But the Registrar or the Board of Trade or the Court may require as a condition of entry on the Register a disclaimer of common or non-distinctive matter, or of parts not separately registered, or any other disclaimer needful for defining the rights of the applicant under the registration.[7] The Court cannot, of course, impose conditions as to disclaimers or otherwise, or require amendments or modifications, except as a term on which the registration of the mark can proceed, but if an applicant refuses to comply with the condition or accede to the requirement, his application would fail.

What objections the Court can consider.

Under the Act of 1883 it was held that on appeal the Court had jurisdiction to enter into and determine all questions arising on the objections, including, of course, in a case where the Comptroller had already registered the mark, the question whether the mark had been rightly admitted to the Register.[8]

[1] See the undertaking required by the Court in *In re Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436, and the condition imposed in *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905). And for other cases in which, under the repealed Acts, conditions were imposed, see above, p. 59, note (3).

[2] Sec. 12 (4), above, pp. 67 and 76.

[3] Cf. sec. 14 (9). Under the Acts of 1883 and 1888 the Court could not direct registration of part of a mark: *Meens' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J. (*Key Brand, Geneva*).

[4] Sec. 14 (6).

[5] Sec. 14 (9).

[6] It is not his practice to allow such a modification.

[7] Sec. 15 and Rule 34. The section and Rule are fully set out, and discussed below, Chap. IX., p. 212.

[8] In *Re Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1886), Kay, J., and C. A.; *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887), Kay, J.; and cf. *Paine* v. *Daniell & Sons' Breweries, Ltd.*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A.;

Now, however, on an appeal in a registration case, whether an opposition or before advertisement, the Registrar, as well as an opponent, is limited to the objections taken when the matter was before the Registrar, except by leave of the appeal tribunal.[1]

If an unsuccessful opponent appeals, and then, after the appeal is referred to the Court, is willing to withdraw his opposition, an order should be obtained dismissing the appeal and directing the registration to be proceeded with.[2]

6. Costs.

Costs before the Registrar.

In an opposition the Registrar has now power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid.[3] He formerly had only a limited power to give costs, that is to say, he could only give them to an opponent, and that only when the applicant abandoned his application.[4] In the absence of special circumstances, the costs generally follow the event.

Costs on appeal to the Court.

The Court has no jurisdiction to make the Registrar pay costs,[5] and the ordinary rule under the Acts of 1883 and 1888 was that even a successful appellant paid the costs of the Comptroller as well as his own. In *The Alpine* case[6] Mr. Justice Chitty said that the Comptroller's costs were deemed to be costs incidental to registration.

Subject as above stated, in all proceedings before the Court under the Act of 1905, the costs of the Registrar are in the discretion of the Court,[7] and the costs of other parties are also in

and *Talbot's Tm.*, 11 R. P. C. 77 (1894), Stirling, J., rectification cases.

[1] Sec. 12 (5), and sec. 14 (8).

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

[3] Sec. 14 (10).

[4] Sec. 69 (5) of the Act of 1883, as amended by the Act of 1888.

[5] Sec. 48. This does not alter the previous rule of the Court: *Rotherham's Tm.*, 14 C. D. 585; 49 L. J. Ch. 511 (1880), C. A., unsuccessful appeal by Registrar; *Leaf's Tm.*, 33 C. D. 477; 3 R. P. C. 289 (1886), and *Van Duzer's Tm.*, 3 R. P. C. 243, both Bacon, V.-C.; *Colman's Tm.*, [1894] 2 Ch. 115; 11 R. P. C. 129, Stirling, J., all successful appeals by applicant from Comptroller; and *Eastman, &c. Co.'s Application*, [1898] A. C. p. 585; 15 R. P. C. p. 487, applicant successful in House of Lords. See below, Test Case.

[6] 54 L. J. Ch. p. 730 (1885). The "Law Reports" do not contain this part of the judgment; see also *Farbenfabriken & Co.'s Tm.*, 11 R. P. C. p. 93; [1894] 1 Ch. 645, C. A.; cf. Chap. XI., p. 311.

[7] Sec. 48.

its discretion.[1] The provision as to the costs of the Registrar is new, but under the Acts of 1883 and 1888 in a few special cases, an applicant for registration who successfully appealed from the refusal of the Comptroller to register was not ordered to pay costs. Thus where the case was argued as a test case, no costs were given, although the application failed,[2] and in another case where the Comptroller took a new point in Court, after the objection upon which he had refused registration had been removed, and succeeded upon it, he did not press for costs.[3] Where, on the hearing of an appeal from the Registrar, he by leave of the tribunal takes any new ground of objection, the applicant may withdraw his application without payment of costs on giving notice as prescribed.[4]

Test case.

New objection at the hearing.

In a case in which applicants appealed from the Comptroller's refusal to register, and succeeded only in the House of Lords, the House made no order as to the costs of the appeal to them, but expressed an opinion that the costs in the Court of Appeal, which the appellants had been ordered to pay to the Comptroller, should be repaid to the applicants, but not the costs of the hearing before Kekewich, J.[5]

In the appeals from the Registrar, which have come before the Court under the Act of 1905, in which an applicant has successfully appealed against his refusal to register, the applicant has on appeal been ordered to pay the Registrar's costs.[6]

On a special application under paragraph 5 of sec. 9 to register a distinctive word, which was referred to the Court, the Registrar was held to be entitled to the costs.[7]

Costs on appeal to Court in an opposition.

If the opponent appeals, or appears as a respondent to the applicant's appeal, the costs of the application to the Court generally follow the event; but the Court has jurisdiction, which it frequently exercises, to refuse to make any order for

[1] Order 65, r. 1.

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

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

[4] Sec. 12 (5). The notice must be given within seven days after the leave has been given: Rule 128, p. 672.

[5] *Eastman, &c. Co.'s Application*, [1898] A. C. at p. 585; 15 R. P. C. p. 488.

[6] *In re Birmingham Small Arms Co.'s Application*, [1907] 2 Ch. 396; 24 R. P. C. 563; *Shamrock & Co.'s Application*, 24 R. P. C. 569 (1907), Neville, J.

[7] *Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436.

costs where it is dissatisfied with the conduct of the successful party. Thus, where the applicants based their case in part on an alleged exclusive right to the use of certain words in their label, and they had no such right;[1] and where the judge thought that both appellant and respondent had behaved improperly, no costs were given.[2] And where opponents appealed from the decision of the Comptroller allowing registration, and succeeded on one ground of objection but failed on other grounds which involved issues of fact, the appellants were ordered to pay the costs so far as they had been increased by these issues, the respondents paying the other costs, with the usual set-off.[3]

Jurisdiction on appeal as to costs before the Registrar.

It was held under the Act of 1883 that no costs of the proceedings before the Comptroller, except so far as these might be allowed by the taxing master as costs of or occasioned by the proceedings in Court, could be given;[4] and the same rule applied under the Act of 1875.[5] The Act of 1905 confers no express power on the Court over such costs. It would seem, however, that, now that the Registrar has power to award costs, the Court on appeal could deal with the costs before the Registrar as well as the costs of the appeal.[6]

Costs on appeal to the Board of Trade.

The Board of Trade, on appeal to it in proceedings under sec. 14, that is in an opposition, have power 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.[7] As between applicant and opponent, the Board of Trade will no doubt follow the same general rule as the Court, and give costs to the successful party. It is submitted that, on appeal, the Board of Trade can vary the order of the Registrar as to costs, and deal with the costs before him as well as upon appeal.[8]

Costs on withdrawal of application.

Where the tribunal hearing an appeal against a refusal to register, whether in an opposition or not, allows fresh grounds of objection to be taken, the applicant may on giving the

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

[2] *Fuente's Tm.*, [1891] 2 Ch. 166; 8 R. P. C. 214, Romer, J.

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

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

[5] *Brandreth's Tm.*, 9 C. D. 618; 47 L. J. Ch. 816 (1878), Jessel, M.R.

[6] See sec. 14 (5). See also sec. 14 (10), and below, as to the power of the Board of Trade over costs.

[7] Sec. 14 (10).

[8] Sec. 14 (5).

prescribed notice [1] withdraw his application without payment of costs, or in the case of an opposition without payment of costs of the opponent.[2]

Security for costs.

If a party giving notice of opposition, or of appeal in an opposition, 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.[3]

7. Renewal of Registration.

Registration is for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of the Act.[4] The subject is dealt with in Chap. XIV., under the heading of "Removal of Mark from the Register." [5]

[1] Notice must be given within seven days after leave to take fresh objections has been given: Rule 128.

[2] Secs. 12 (5) and 14 (8).

[3] Sec. 14 (11).

[4] Sec. 28.

[5] Page 372.

CHAPTER V.

CLASSIFICATION OF GOODS.

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It has already been shown that the use of the mark in connection with goods of the particular kind identified with it is of the essence of trade mark rights,[1] and this essential feature is retained by the Registration Acts. It is provided that—

> "A trade mark must be registered in respect of particular goods or classes of goods";[2]

and that—

> "A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill."[3]

And the express restrictions on the registration of identical marks and marks so nearly resembling registered trade marks as to be calculated to deceive, which are contained in sec. 19, apply only where the marks already registered are on the Register with respect to the same goods or description of goods as those for which the marks put forward for registration are sought to be registered.[4]

[1] Ante, p. 29; and see *Somerville* v. *Schembri*, 12 App. Ca. 453; 4 R. P. C. 179 (1887).

[2] Sec. 8 of the Act of 1905, replacing sec. 65 of the Act of 1883.

[3] Sec. 22 of the Act of 1905, replacing sec. 70 of the Act of 1883. This is subject to the proviso contained in sec. 22, and to the provisions of secs. 23 and 62. As to assignments, see Chap. XIII., p. 345.

[4] See below, p. 228.

Classes.

Accordingly, goods have been divided by the Trade Mark Rules into forty-nine classes, and a miscellaneous and residuum class,[1] and Rule 5 provides that if any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Registrar. For the convenience of applicants for registration an alphabetical guide to the classification of goods has also been drawn up and published,[2] and in case of uncertainty, upon application by letter to the Registrar, giving a full description of the goods and the purposes for which they are used, the Registrar will inform any intending applicant what class he should name in his application. Applications for the registration of the same mark in different classes are treated as separate and distinct applications.[3]

A trade mark may be registered for certain only of the goods comprised in a class, and it will then, of course, be protected as to those goods only.[4] Many of the classes comprise a number of very different kinds of goods; for example, class 6, "Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in class 7," comprises both engine-boilers and sewing machines. Registration in a class does not, however, confer on the registered proprietor any right to sue for infringement of the mark in regard to goods of kinds other than those for which he uses his mark. Thus, where the owner of a mark comprising the word *Neptune*, who had used it only for iron sheets, although class 5, for which it was registered, included also wire, brought an action against a person who had registered and used a mark comprising the same word for wire, the Court of Appeal refused to grant an injunction, and they ordered the Register to be rectified by restricting the registration of the plaintiff's mark to iron sheets only.[5] In this case (*Edwards* v. *Dennis*[5]) the plaintiff claimed the mark as assignee of the goodwill of a business which dealt only in the iron sheets,

Registration and protection for part of a class.

[1] See Classification of Goods, below, p. 697. The classes are the same as under the Rules of 1890, except for a slight alteration in Class 23, as to which see below, p. 121.

[2] It can be procured at the Sales Department of the Patent Office.

[3] Rule 24, p. 659.

[4] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

[5] *Edwards* v. *Dennis*, 30 C. D. 454: 55 L. J. Ch. 125, C. A. (1885). See also below, pp. 328, 385. For other cases in which orders have been made confining the goods to those in connection with which the registered trade mark has been used, or excluding particular goods for which it has not been used, see Chap. XI., Rectification of the Register, at p. 298.

and it was held that, as assignee, his trade mark rights under the Acts must, in any event, be restricted to the goods with which the business assigned to him was concerned;[1] but Cotton, L.J., stated that, in his opinion, it was not the intention of the Act (of 1875) that a man registering a trade mark for an entire class, and using it only for one article in that class, should be able to claim for himself the exclusive right to use the mark for every article in the class, and with this opinion the other Lords Justices agreed. This opinion was endorsed and followed by Chitty, J., when the question arose in an action brought by the original proprietors of a trade mark,[2] who endeavoured, but unsuccessfully, to secure exclusive rights for cigars in a trade mark which they had registered in the tobacco class, but which, as it comprised the word "mixture," was appropriate, and had at first been used, only for cut tobacco.[3]

Trade mark should not be registered for goods in which there is no intention to deal.

The question arose under the Act of 1883 whether registration could be properly made in respect of goods in which the applicant did not deal or intend to deal. In *Batt & Co.'s Trade Marks*[4] the respondent, who was a general exporter and dealer, had registered two trade marks in 1882 and 1889 respectively for all the goods comprised in class 42, and in 1897 an application was made to remove the marks from the Register on the ground that the respondent had never used them in connection with any goods in class 42, and had never had any *bonâ fide* intention of so using them. Romer, J., found these facts against the respondent and ordered the removal of the marks so far as regards class 42, and his decision was upheld in the Court of Appeal and the House of Lords. Lindley, M.R., delivering the judgment of the Court of Appeal, which was approved and affirmed in the House of Lords, held that the decision in *Edwards* v. *Dennis*[5] fairly governed the case in principle and stated the question of law as follows:—"Can a man properly register a trade mark for goods in which he does not deal or intend to deal—meaning by intending to deal, having at the time of registration some definite and present intention to deal in certain goods or descriptions of goods, and not a mere general

[1] Act of 1875, s. 2; Act of 1883, s. 70; Act of 1905, s. 22.

[2] *Hargreaves* v. *Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237.

[3] Cf. the present Rule 16, post, p. 658.

[4] [1898] 2 Ch. 432; 15 R. P. C. 262 and 534, Romer, J., and C. A.; [1899] A. C. 428; 16 R. P. C. 411 (*sub nom. Batt* v. *Dunnett*).

[5] See note (5), above, p. 104.

intention of extending his business at some future time to anything which he may think desirable? This question we answer in the negative." This case has been followed in several others, in which marks registered without any intention to use them, or without any intention to use them on some goods for which they were registered, have been removed from the Register as to the whole or part of the goods for which they were registered.[1]

Non-user of trade mark.

The matter is one now expressly provided for by sec. 37 of the Act of 1907, which enacts as follows:—

"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."

This section treats of a particular ground for rectification of the Register, and the procedure is under sec. 35, which deals generally with that matter.

The subject is dealt with in Chap. XI., but it may here be noticed that the application to take a trade mark off the Register, wholly or partially, under sec. 37 must be by a person aggrieved,[2] and that a discretion is given to the Court as to removal. The registered proprietor of a trade mark may himself apply under sec. 32 to the Registrar to have particular goods or classes of goods struck out from those for which the trade mark is registered, and this course may in some cases save a proprietor the costs of an application by another person to rectify the Register. It is provided by sec. 27 that where, under the provisions of the Act, user of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as

[1] See below, Chap. XI., Rectification, at p. 299; and cf. also *Hedley's Tms.*, 17 R. P. C. 719 (1900), where a mark, on which an applicant for rectification based his application, had been registered but not used, and any intention to use it had been given up, Cozens-Hardy. J., said it could probably be removed from the Register.

[2] See below, p. 293.

it shall think right, accept user of an associated registered trade mark,[1] or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user; and, where parts of a registered trade mark are separately registered by the same proprietor under sec. 25 as combined trade marks,[2] user of the whole trade mark is for the purposes of the Act to be deemed to be a user of such registered trade marks belonging to the same proprietor as it contains.

In practice, leave to register a mark is frequently given, and oppositions to registration are frequently withdrawn, or overruled, on the terms that the registration be restricted to part of a register class.[3] The restriction has in some cases been effected by the entry of a note of the agreement upon the Register, and in a case where, without any formal opposition, it had been agreed between the applicant and an objector, that the registration should be restricted to certain goods in the class for which it was effected, Pearson, J., on an *ex parte* application, directed the Comptroller to enter a note of the restriction on the Register.[4]

Associated Trade Marks.

Associated trade marks.

Provision was made in the Act of 1883 for the registration of a series of trade marks resembling each other in material particulars but differing in certain respects, as, for instance, statements of quality. Series of trade marks may be registered under the Act of 1905, but they are made part of new species of trade mark introduced by the Act, which are called associated trade marks; these are divided into combined trade marks, series of trade marks and associated trade marks not falling within either of these descriptions. An associated trade mark must be a registrable trade mark under the Act,[5] and it only differs from an ordinary trade mark in its association with other registered

[1] Associated Trade Marks, see below.

[2] Below, p. 109.

[3] See, for instance, *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M.R.; *Braby & Co.'s Applications*, 21 C. D. 222; 51 L. J. Ch. 637 (1882), North, J.; *Kenrick and Jefferson's Tm.*, 7 R. P. C. 321 (1890), Chitty, J.; and *König and Ebhardt's Tm.*, 13 R. P. C. 449 (1896), Stirling, J.

[4] *Keep's Tm.*, 26 C. D. 187; 54 L. J. Ch. 637 (1884); but, as to the particular restriction in this case, see *Dewhurst's Application*, [1896] 2 Ch. p. 143; 13 R. P. C. p. 97, C. A., where the Court distinguished between a condition of registration and a note of an agreement; see also Chap. XI., at p. 299, and Chap. X., at p. 229.

[5] See also sec. 27, below, p. 110.

trade marks of the same proprietor, and in the consequence of such association, namely, that it can only be assigned with such other trade marks.

Resembling marks belonging to the same proprietor.

It is enacted by sec. 24 of the Act of 1905 that "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."

The wording of this section should be compared with that of sec. 19,[1] which relates to identical or similar marks belonging to different proprietors. It had been held in a case under the Acts of 1883 and 1888, in which an applicant asked for registration of a trade mark only slightly differing from a trade mark of his own registered for the same goods, that the registration ought to be refused, as to accede to the application would uselessly encumber the Register.[2] The decision was an inconvenient one from the commercial aspect, because it is necessary for an English trader in some foreign countries in order to attain registration to show that the mark is registered in this country. Moreover, a trader may desire to vary his trade mark in some slight respect, and the policy of the trade mark legislation should be that in general marks actually used should be on the Register. Sec. 21 therefore appears to effect an improvement in the law. It has been construed in the *Birmingham Small Arms Co.'s Application*,[3] in which the applicants having already on the Register in one class the trade mark "B. S. A." applied to register it in another class for goods of quite a different description, and the Registrar, as a condition of registration, required the marks to be associated. The applicants appealed, and it was held on appeal, that the Registrar's discretion was not an absolute one, but one to be exercised subject to the provisions of the Act, including sec. 24, and that the goods were of different descriptions, and that sec. 24 had nothing to do with the registration of identical trade marks, but applied only to cases where registration was sought for a mark "so closely resembling a

[1] Below, p. 222.

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

[3] [1907] 2 Ch. 396; 24 R. P. C. 563, Kekewich, J.

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"; and the Registrar was directed to proceed with the registration without the condition as to association.

Section 24 does not deal with the case of concurrent applications by the same proprietor for marks slightly differing, that being a matter falling under sec. 26.

Combined trade marks.

The next kind of associated trade marks is that in which a whole mark is registered and also separate parts of it. These are called in the marginal note to sec. 25 combined trade marks. That section is as follows:—

"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."

Parts of a trade mark which are separately registered are, on an application to register the whole mark, excepted from the provisions of the Act as to disclaimer which are contained in sec. 15.[1] Sec. 25 applies to the converse case of the proprietor of a registered trade mark seeking to register part of it, and probably also to concurrent applications for registration of the whole and the parts. It would seem also that where a proprietor is seeking to register a mark which includes parts already registered, the Registrar could under his general discretion require the marks to be associated. The provision at the end of the section that user of the whole trade mark is to be deemed to be user also of the included marks was no doubt inserted in view of sec. 37,[2] under which a trade mark may be removed from the Register by reason of non-user. Sec. 27 contains a more general provision, but gives the Court a discretion.

[1] Disclaimers, Chap. IX.; below, p. 212.

[2] Above, p. 106.

Series of trade marks.

By sec. 26 it is provided that—

"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."

This section replaces sec. 66 of the Act of 1883, but with the addition of (*c*) and (*d*), and of the last sentence making a series of trade marks a particular case of associated marks. The addition of (*d*), colour, is due to the fact that colour may now enter into the consideration of the distinctiveness of a trade mark.[1] Paragraph (*c*) of this section should be compared with sec. 24, which appears to cover a case in which there are slight differences in distinctive matter. Sec. 24 does not, however, apply to concurrent applications, but probably these could be dealt with under the general discretion of the Registrar by his requiring the marks to be associated.

Application for a series of trade marks must be made in conformity with Rule 27.[2]

Section 27 provides as follows:—

Assignment of associated trade marks.

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

[1] See. 10, below, p. 209.

[2] Below, p. 659. And see Rule 49 as to advertisement. Fees for registration, List of fees, 5*a*, p. 673.

The proviso seems to have special reference to the provisions of sec. 37 [1] as to non-user, and possibly also to the rule that a trade mark can only be assigned with a goodwill in the goods for which it has been registered.[2]

Where a mark is registered as associated with any other mark or marks cross references are inserted by means of notes in the Register to the marks with which it is associated.[3]

[1] Above, p. 106.
[2] Sec. 22.
[3] Rule 65, p. 664. Fee one shilling for each note that a mark is associated with a newly registered mark; see List of fees, p. 674.

CHAPTER VI.

SHEFFIELD MARKS.

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Sheffield Marks and the Cutlers' Company.

THE care of the Register and the registration of marks to be used on metal goods registered under the present Act by a person carrying on business in Hallamshire, or within six miles thereof, is committed, by sec. 63 of the Act of 1905, as it was also by sec. 81[1] of the Act of 1883, to the Cutlers' Company.

The Cutlers' Company.

This company was incorporated by the Act 21 Jac. I. c. 31, and its members and proceedings are regulated by several Cutlers' Company Acts, referred to below. But long before the seventeenth century Hallamshire had been noted for its cutlery manufactures, and from time to time a jury of cutlers was empannelled with the other juries of the local Court Leet to assign marks to the different manufacturers, wherewith to distinguish their respective wares; and in the Court Rolls of the Manor of Sheffield of the 7th of Elizabeth, and, again, in the Rolls of 1590, presentments of the regulations governing persons engaged in the knife-making and certain other cutlery trades are recorded.[2] The seventh of these regulations provided that no person should strike any mark upon his wares but that which was assigned him in the Lord's Court under a penalty of ten shillings. The cutlers had also a charter granted by the lords of the manor.[3]

The incorporating Act, the Cutlers' Company Act, 1623,[4] laid down certain regulations for the control of persons engaged in

[1] See below, p. 117.

[2] Hunter's History of Sheffield, London, 1819, p. 118.

[3] M. M. A. Report, 1862. Evidence of Mr. Jackson, Q. 104.

[4] 21 Jac. I. c. 31, local.

the businesses of manufacturing knives, shears, scissors, or other cutlery wares, within the specified district, and incorporated the persons then so engaged, and it fixed the limits of the district concerned, as they have ever since remained, to be those of the lordship of Hallamshire and within six miles compass from it. The Act, in particular, provided that persons engaged in the businesses mentioned, in the said district, should strike such marks, and such marks only, as should be assigned to them by the company. These regulations were repealed by the Cutlers' Company Act of 1791,[1] and fresh regulations, chiefly relating to the admission of new freemen and to the taking of apprentices, were enacted. By sec. 17 of the Act last mentioned, members of the company, who alone were then permitted to manufacture the goods referred to,[2] were forbidden, under a penalty, to strike, engrave, or use any mark like, or counterfeiting, a mark assigned to any other person. The Cutlers' Company Act of 1801[3] empowered any freeman of the company to bequeath his mark, as his other personalty, by his will, his widow not to be thereby prevented from carrying on the trade, or selling the right to the mark, for her lifetime, to any other person entitled to carry on the trade. The Cutlers' Company Act of 1814[4] threw open the specified trades to all persons, and removed the existing restrictions as to taking apprentices. It provided, further (sec. 3), that all manufacturers, whether freemen or not, on application, should have marks assigned to them by the company, the marks not to be marks previously assigned, and at the time continuing to be the property of any persons other than the applicants, and not to consist of surnames; (sec. 4) that marks in common use should not be assigned; and (sec. 6) that an assigned mark might be bequeathed by will, and if it were not bequeathed, it should go to the widow and family of the proprietor on his death, but not so as to give power to more than one person in the family to use it at the same time. The last Cutlers' Company Act, that of 1860,[5] extended the provisions of the Acts to all persons within the district using or exercising the trades of manufacturers of steel, makers of saws and edged tools, and other articles of steel, or steel and iron combined, having a cutting edge, and it

[1] 31 Geo. III. c. 58, local.

[2] Knives, sickles, shears, scissors, razors, files, and forks, or any of them, sec. 3.

[3] 41 Geo. III. c. 97, local.

[4] 54 Geo. III. c. 119, local.

[5] 23 Vict. c. xliii.

enabled persons carrying on any of the trades within the Acts, and not being freemen of the company, to become freemen on payment of the proper fees, and to have marks assigned to them.

Corporate marks were assignable in gross.

It will be seen that, under these Acts, the old corporate marks were assignable personal property of the grantee; this was, at all events, the case where the marks were owned by non-freemen, and where they did not comprise any personal elements calculated to make their use by others than the original grantees misleading.[1] In this respect they differed from ordinary trade marks, which are, and always have been, assignable or capable of transmission only in connection with the business in which they are used.

Grant of a corporate mark.

The right to the mark originated in the grant by the company, and lasted for the lives of the grantee and his widow. The grant was made upon the application of the grantee after a search, carried out by the searchers of the company, to ascertain whether the mark applied for was the subject of a then existing grant. Marks, as they lapsed, were re-granted over and over again.[2]

Recent legislation and the Cutlers' Company.

The rights and privileges of the Cutlers' Company were expressly saved by sec. 25 of the Merchandise Marks Act, 1862. There is no similar provision in the Merchandise Marks Act of 1887, but, except in so far as that Act restricts the use of particular marks as being forged trade marks, or false trade descriptions, it does not in any way affect the rights or privileges of the company. The Act of 1875[3] empowered the owner of a Sheffield corporate mark to have it registered under that Act in the same manner and on the same terms as if it were not a Sheffield corporate mark. Under the Act of 1883 the old Register of corporate marks was closed on December 31st, 1888.[4]

Closing of the Register.

The Act of 1875.

The Act of 1875 left the Register of the Cutlers' Company, and the power of the Company to assign marks, untouched, except that it restricted the latter power in regard to marks identical with, or so nearly as to be calculated to deceive, resembling

[1] *Bury* v. *Bedford*, 32 L. J. Ch. 741; 33 L. J. Ch. 465; 4 De G. J. & S. 352 (1863), M.R. and L.J.J.

[2] See the evidence of Mr. Jackson, Qq. 113, 117, 142, and Mr. Hunter, Q. 1899; M. M. A. 1862.

[3] Sec. 9 (6), set out below.

[4] Sec. 81 (9).

marks registered under the Act in the manner mentioned below.[1] And it provided generally that:—

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

The Act provided[2] further, (1) for copies of all the Sheffield corporate marks in force being delivered to the Registrar; (2) for notices of new applications to the company for the assignment of corporate marks, and copies of the marks applied for, being delivered to the Registrar, and for notices of applications to the Registrar for registration under the Act of marks belonging to any goods or class of goods within the Cutlers' Company Acts,[3] and copies of the marks referred to, being delivered to the company;[4] and (3) for notices of assignment and registration.

Sub-sections (4), (5), and (6) of sec. 9 of the Act of 1875 were in the terms following:—

Mark resembling a corporate mark not to be registered.

"(4.) *The Registrar, under this Act without the special leave of the Court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with respect to which a Sheffield corporate mark shall have been assigned and actually used, and of which mark a copy, or description, or notice of the assigning whereof shall have been delivered or given to the Registrar as aforesaid, register a trade mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive.*[5]

Corporate mark resembling registered mark not to be assigned.

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

Corporate mark might be registered.

"(6.) *Any person to whom a Sheffield corporate mark legally*

[1] Sec. 9 (5).

[2] Sec. 9. Appendix, p. 648.

[3] See list below; p. 116.

[4] The company sometimes opposed the registration of marks which they deemed to resemble too closely corporate marks in use. See *Re Rosing*, 54 L. J. Ch. 975, n. (1878).

[5] Cf. s. 6 of the Act of 1875, sec. 72 of the Act of 1883, and sec. 19 of the Act of 1905.

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

The Act of 1883.

The Act of 1883, on the other hand, provided for the closing, within five years from the commencement of the Act,[1] of the Register of corporate marks, and for the commencement of a new Register of trade marks to be kept at Sheffield by the Cutlers' Company, to which the corporate marks might be transferred; and it directed that all corporate marks entered on the Register of corporate marks and not entered on the new Register before the closing of the former, should be deemed to have been abandoned.[2]

The Act of 1888.

Section 81, the part of the Act of 1883 relating to the Sheffield marks and containing the provisions just referred to, was amended by sec. 20 of the Act of 1888, the principal alteration being occasioned by the substitution of, and the extension thereby of the section to, "metal goods," meaning "all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal," in place of "cutlery, edge tools, raw steel, goods made of steel, or of steel and iron combined, whether with or without a cutting edge." The last-mentioned class of goods had been inserted in the original section in the place of the list taken by the Act of 1875 from the Cutlers' Company Act of 1860, namely, knives, sickles, shears, scissors, razors, files, forks, saws, edge tools, or other articles of steel, or of steel and iron combined, having a cutting edge.

The effect of sec. 81.

The section, as amended by sec. 20 of the Act of 1888, is set out in the Appendix.[3] The general effect of the section was to make the Sheffield Register a branch of the principal Register for trade marks used on metal goods and registered by persons carrying on business in Hallamshire or within six miles thereof, and to place the local Register under the charge of the Cutlers' Company. The duties of the company were, however, ministerial only as regards the registration of old corporate marks;[4] as

Duties of the Cutlers' Company with regard to registrations.

[1] January 1st, 1884, sec. 3.
[2] Sec. 81 (9).
[3] Page 634.
[4] *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344 (1889), C. A.

regards the registration of other marks, the Company were substituted for the Comptroller, subject to his veto upon any particular registration,[1] unless such veto was overruled on appeal by the Court, and subject, in cases where the Comptroller's veto was not exercised, to appeal from the Company to him and to a further appeal to the Court.[2]

The Act of 1905.

Section 81 of the Act of 1883 is now replaced by sec. 63 of the Act of 1905, which, however, differs only in a few respects from the repealed section. The differences consist mainly in the omission of some transitory[3] and obsolete provisions, or provisions which are now unnecessary having regard to the general provisions of the new Act.[4] The principal alteration is the substitution of an appeal from the company direct to the Court for an appeal to the Comptroller, and from him to the Court.[5] The Sheffield Register is continued and, save as otherwise provided, forms part of the Register.

The former proviso saving the life interest of a widow of a holder of a corporate mark[6] is omitted as being presumably obsolete. Certain provisions relating to penalties under the Cutlers' Company's Acts[7] are also omitted, sufficient protection being now given by the Merchandise Marks Act, 1887.

Section 63 of the Act of 1905 is as follows:—

Sheffield marks.

"With respect to the master, waraens, 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,[8] and, save as otherwise provided by this Act, such Register shall for all purposes form part of the Register:

[1] Sub-sec. (5).

[2] Sub-sec. (12).

[3] For instance, the transfer to the Sheffield Register of marks previously registered, part of sub-sec. (2), as amended by the Act of 1888, sec. 20, and sub-sec. (9) referred to on p. 116, closing the register of corporate marks.

[4] Sub-secs. (10) and (11) of sec. 81.

[5] Sub-sec. (9). Cf. with sub-sec. (12) of sec. 81 of the Act of 1883.

[6] Sub-sec. (7) of sec. 81 of the Act of 1883, as amended by the Act of 1888.

[7] Sub-sec. (13) of sec. 81 of the Act of 1883.

[8] April 1st, 1906.

(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,[1] 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,[2] but which have not been entered in such Register before the passing of this Act:[3]

(3) An application for registration of a trade mark used on metal goods[1] 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]

(4) Every application so made to the Cutlers' Company shall be notified to the Registrar in the prescribed manner,[5] and, unless the Registrar within the prescribed time[6] 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:[7]

(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:[8]

(6) Upon the registration of a trade mark in the Sheffield

[1] Metal goods are defined by sub-sec. (10), below.

[2] Commencement of the Act of 1883.

[3] As regards the registration of old corporate marks, the duties of the company are ministerial only: *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344 (1889), C. A. The prescribed form is Sheffield No. 1, below, p. 691. Fee £5.

[4] The effect of this sub-section and sub-sec. (7) is to constitute the Sheffield Register a branch register for metal goods. The application must be on Form TM No. 2, Appendix, p. 678, and addressed to the Law Clerk to the Cutlers' Company, The Cutlers' Hall, Sheffield; see Rules 107 to 112, p. 669; and Instructions (18), p. 711.

[5] A copy of the application is to be sent within seven days, with two representations of the mark for each class: Rule 108.

[6] The time is one month from receipt of notice: Rule 109.

[7] *I.e.*, as an ordinary application is proceeded with by the Registrar, sub-sec. (7), Rule 112. 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: Rule 110.

[8] The Court is defined by sec. 3. See also sub-sec. (9) and sec. 64, sub-sec. (5), which in the case of a cotton mark gives an appeal, alternatively to the Court or the Board of Trade at the option of the applicant.

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:[1]

(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,[2] he shall in the prescribed manner[3] notify the application and proceedings thereon to the Cutlers' Company:

(9) Any person aggrieved[4] by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner,[5] 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.[6]

[1] Cf. sec. 16.

[2] See sub-sec. (10).

[3] *I.e.*, by sending a copy of the official paper, the Trade Marks Journal, containing the application with a note distinguishing such application: Rule 111.

[4] Cf. sec. 35, p. 278.

[5] By motion, notice of motion to be given within one month from the date of the decision or within such further time as shall be allowed, Rule 121; see also sub-sec. (7).

[6] For the list of goods to which the Cutlers' Company's Acts and the Act of

(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.[1]

A complete collection of representations of pending applications in classes 5, 6, 7, 11, 12, 13, 14 and 22 is now kept for public inspection at the Cutlers' Hall, Sheffield. On an application in any of those classes being made at the Patent Office, a copy of the Journal containing the application is forwarded by the Registrar to the Cutlers' Company.[2] The rules relating to Sheffield marks are Nos. 107 to 112.[3] A request to enter a corporate mark of the Sheffield Register must be made on Form Sheffield No. 1.[4]

1875 applied, see p. 116; and for the list to which the unamended Act of 1883 applied, see the repealed sub-sec. (2), p. 634.

[1] The certificate is evidence: sec. 51; Rules 102 to 104, above, p. 62.

[2] Rule 111.

[3] Below, p. 669.

[4] Rule 107.

CHAPTER VII.

COTTON MARKS AND THE MANCHESTER BRANCH OFFICE

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The first Cotton Marks Rules.

By the Rules issued under the Act of 1875,[1] marks for cotton goods in Classes 23, 24 and 25[2] were specially treated. An office was set up at Manchester for the exhibition of all devices, marks, &c., used in the cotton trade, and in the Rules called *cotton marks*, and every person using any cotton mark was required to send to the office three representations of it. A committee of persons versed in the usages of the cotton trade was appointed to consider the cotton marks, of which representations were sent in to the Manchester office, and to divide them into two classes: (a) those which were, in the opinion of the committee, trade marks within the meaning of the Act; and (b) those which were not; and power was given to the Commissioners of Patents to add any cotton marks to either class.[3] It was provided that any proprietor of a cotton mark not specified in class (b) might apply to be registered as proprietor of the mark in the manner and subject to the conditions in and under which he might have applied to be registered in respect of any other trade mark, but that it should not be lawful to register any person as proprietor of any cotton mark in class (b) except in pursuance of an order of the Court.

[1] Now repealed: see Chitty's Statutes, Rules 57—63a.

[2] Class (23), cotton yarn and thread (under the present Rules this is replaced by (a) cotton yarn, and (b) sewing cotton); (24) cotton piece goods of all kinds; (25) cotton goods not included in Classes 23, 24, or 38. Class 38, articles of clothing. Under the Rules of 1890, Class 23 was divided as follows:—(a) cotton yarn and sewing cotton not on spools or reels, (b) sewing cotton on spools or reels.

[3] Rule 58 (a of March. 1883.

The Cotton Marks Committee.

The committee so appointed was held not to be a judicial tribunal, but merely a body appointed to consider and give an opinion on technical matters peculiarly within the knowledge of its members, and it was decided that its decisions could be reconsidered or disregarded by the Court, or by the Registrar by direction of the Court, notwithstanding that it had acted fairly and properly, and had not proceeded on any wrong principle in arriving at them.[1] And in a number of cases applications to the Court in respect of marks placed by the committee in class (b) were successful, and the marks were registered as trade marks.[2]

The Manchester Branch Office, under Act of 1883.

The special rules were repealed and the committee of experts dissolved;[3] but the Manchester Office was maintained and constituted a branch office of the Registry, and applications for the registration of marks in Classes 23, 24, and 25 were, under the Rules of 1890, addressed and sent to it.[4]

Special points of practice.

The system of deposit of cotton marks not registrable as trade marks, was also continued. This had the double advantage of acting as a warning to other traders of the marks being in use, and of enabling persons wishing to design new marks to see what marks were in actual use. Another practice, special to the Manchester Branch, was that of consulting the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce in questions of difficulty arising in applications to register.

Effect of the Act of 1905.

The Act of 1905 gives statutory recognition to the Manchester Branch office, the chief officer of it being the Keeper of Cotton Marks, who acts under the direction of the Registrar.[5] All applications for cotton marks, that is, for trade marks for

[1] *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. 707 (1879); H. L. reversing the judgment of the C. A., 8 C. D. 794; 47 L. J. Ch. 807 (1877).

[2] *Exp. Ede & Co.*, 28 W. R. 436 (1878), Jessel, M.R.; *Re Dugdale*, 49 L. J. Ch. 303; 28 W. R. 436 (1880), Hall, V.-C.; *Re Wood, Start and Sharp*, 50 L. J. Ch. 317; 44 L. T. (N. S.) 97 (1881), Hall, V.-C.; *Re Sykes*, 13 L. T. 626; 29 W. R. 235 (1880), Hall, V.-C.

[3] Lord Herschell's Committee refused to adopt a recommendation that honorary trade assessors be appointed to pass or reject cotton trade marks, on the grounds that their appointment would diminish the sense of responsibility of the office, and that it did not feel sure that the creation of such a tribunal, reserving power to override its decisions, would give general satisfaction. Report of 1888, p. x.

[4] Rule 8 of 1890.

[5] Sec. 64 (1). The address of the Keeper of Cotton Marks is, Manchester Branch of the Trade Marks Registry, 48, Royal Exchange, Manchester.

goods in Classes 23, 24 and 25,[1] except such as may be prescribed,[2] must be made to the Manchester Branch; and the Register for trade marks for all such goods is called the Manchester Register, and a duplicate is kept at the Manchester Branch.[3] When an application is made to the Manchester Branch, it is notified to the Registrar, and the Keeper of Cotton Marks reports to the Registrar on the application; and the Registrar may object to the application proceeding, subject to an appeal to the Court or the Board of Trade at the option of the applicant.[4] If the Registrar makes no objection, the application is advertised and proceeded with. Subject to the special Rules 113 to 117, the procedure is the same *mutatis mutandis* as that on an ordinary application.[5] Where a trade mark applied for is already in use, the length of time of user must be stated in the application.[6] The practices of deposit of marks and of consulting a committee of the Manchester Chamber of Commerce are sanctioned and continued by the Act.[7] The Act enacts that certain features that might, under sec. 9, be registrable or distinctive in respect of other goods shall not be registered or deemed distinctive in respect of certain goods within the cotton classes,[8] and this provision of the Act came into force immediately on the passing of the Act.[9] In particular no exclusive use of a word can be obtained by registration of a cotton mark, and no word or words can be registered alone for cotton piece goods or cotton yarn; and line headings, that is, the coloured strips at the end of a piece, cannot be registered alone and are not to be deemed distinctive.

Section 64 of the Act of 1905 is as follows:—

Manchester Branch.

"(1) The Manchester Branch of the Trade Marks Registry of the Patent Office (hereinafter 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

[1] See. 64 (2). See note (2), p. 121, as to the goods comprised in these classes.

[2] No goods have been prescribed as exceptions under the Rules of 1906.

[3] See. 64 (2) and (3).

[4] See. 64 (4) and (5), and Rules 113 to 116. The application must be on form Cotton No. 1, below, p. 602, and four additional representations must be sent on form Cotton No. 2.

[5] Rule 118.

[6] See. 64 (9).

[7] See. 64 (11) and (14).

[8] See sec. 10, which is set out fully below.

[9] August 11th, 1905. The Act generally came into operation on April 1st, 1906.

the direction of the Registrar. The present keeper of the Manchester Branch shall be the first Keeper of Cotton Marks.

Manchester Register.

"(2) As regards cotton goods [1] 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.

Applications for cotton marks.

"(3) All applications for registration of trade marks for such cotton goods in the said classes (hereinafter referred to as 'cotton marks') shall be made to the Manchester Branch.[2]

"(4) Every application so made to the Manchester Branch shall be notified to the Registrar in the prescribed manner[3] 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[4] 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]

"(5) If the Registrar gives notice of objection as aforesaid the application shall not be proceeded with, but any person aggrieved[6] may in the prescribed manner[7] appeal to the Court or the Board of Trade, at the option of the applicant.

Registration.

"(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.[8]

Rectification of the Register.

"(7) When any mark is removed from or any cancellation or correction made in the Manchester Register[9] notice thereof shall

[1] As to the goods included in Classes 23, 24, and 25, see note (2), p. 121.

[2] Form Cotton No. 1, Appendix, p. 692. The application is to be in duplicate, Rule 113.

[3] See Rule 115, p. 670. The search made by the Keeper of Cotton Marks includes the B list, see above, p. 121.

[4] One month after the hearing, Rule 116, p. 670.

[5] Rule 118, p. 670, and Chap. IV., Registration.

[6] Cf. sec. 35, below, p. 278.

[7] Rules 121 to 127, "The Court," see below, p. 126.

[8] Cf. sec. 16.

[9] See Chap. XI., Rectification of the Register, p. 276.

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.[1] Certificate.

"(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. Length of user.

"(10) As from the passing of this Act[2]— Words, line headings, &c.

(*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[3] 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[4] 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.[5] Inspection. 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,[6] 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.[7] Certificate of mark on deposit.

[1] Sec. 51, Rules 102, 103, and 104, and Form MB No. 2, p. 695.

[2] August 11th, 1905. The Act generally came into operation on April 1st, 1906.

[3] As to word marks generally, see p. 142.

[4] Inspection of the Register, sec. 7.

[5] See above, p. 121.

[6] 5*s*.

[7] This is a certificate of an application having been made, Form MB No. 1, p. 698. As to certificates, see sub-sec. (8) and sec. 51.

Rules.

"(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.[1]

Existing practice preserved.

"(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."[2]

The Rules, Nos. 113 to 118, relating to cotton marks, have already been noticed in the text or the notes. They will be found fully set out in the Appendix.[3]

The Palatine Court of Chancery.

"The Court" is in England the High Court of Justice,[4] but a co-ordinate jurisdiction with that of the High Court of Justice is vested in the Court of Chancery of the County Palatine of Lancashire in respect of any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester Office, subject to the ordinary right of appeal from decisions of that Court.[5]

The registration of oriental words as part of a mark, a matter which greatly concerns the cotton trade, will be dealt with later.[6]

[1] As to the power of the Board of Trade to make Rules, see sec. 60, and above, p. 58.

[2] See above, p. 122.

[3] Page 670.

[4] Sec. 3.

[5] Sec. 71.

[6] Rule 28 deals with marks containing words in characters other than Roman, or in a language other than English; see p. 659. The Office formerly refused to register words in oriental character, except "Chop" and "Hong" marks, *i.e.*, firm names in Chinese; see *Deuchurst's Application*, [1896] 2 Ch. p. 141; 13 R. P. C. p. 202.

CHAPTER VIII.

WHAT MARKS MAY BE REGISTERED AS TRADE MARKS.

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THE marks which may be registered as trade marks were determined, from the commencement of the Register until the end of 1883, by sec. 10 of the Act of 1875; from the last-mentioned date until the end of 1888, by sec. 64 of the Act of 1883, from the beginning of 1889 to April 1st, 1906,[1] by the amended sec. 64, enacted by sec. 10 of the Act of 1888, and since the last-mentioned date by sec. 9 of the Act of 1905.[2] Section 9 is as follows:—

Registrable trade marks.

"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:

[1] Except that certain changes of the law as to cotton marks took effect from August 11th, 1905.

[2] As to cotton marks, see also sec. 64 (10), above, p. 123.

"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."

Sec. 10 of Act of 1875.

Sec. 10 of the Act of 1875 (now repealed) was as follows:—

"*For the purposes of this Act:*

A trade mark consists of one or more of the following essentials; that is to say,

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

A written signature or copy of a written signature of an individual or firm; or

A distinctive device, mark, heading, label, or ticket.

And there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures; also

Any special and distinctive word or words or combination of figures or letters used as a trade mark before the passing of this Act[1] *may be registered as such under this Act.*"

Sec. 64.

Sec. 64 of the Act of 1883, as amended by the Act of 1888, was, so far as relates to what might be registered, as follows:—

"**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*

[1] August 13th, 1875.

individual or firm applying for registration thereof as a trade mark; or

(c) *A distinctive device, mark, brand, heading, label, ticket;*[1] *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. . . .*

(3.) *Provided as follows: . . .*

(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* 13*th day of August,* 1875, *may be registered as a trade mark under this part of this Act.*"

Comparing sec. 9 in a general way with the sections of the earlier Acts, it will be seen that names and signatures have been registrable under all the Acts; that, except as to old marks, words were not essential particulars under the Act of 1875, and that paragraphs (3) and (4) owe their inception to an alteration made by the Act of 1888, and that devices, labels and tickets, if distinctive, have been registrable under all the Acts, for "mark" in the Act of 1905 includes these by virtue of the definition clause, sec. 3.

New marks may be registered.

Before the Registration Acts it was necessary for the plaintiff in a trade mark action to plead that the mark in question had acquired a reputation and become known as his by user in connection with his goods; but the Court did not require him to prove that the user had extended over any long or defined period, and it was therefore practically open to a trader to obtain protection against infringers of a newly-devised mark which had hardly been used at all.[2] The Acts have provided an additional mode of acquiring trade mark rights, for it has been held that marks which have never been used may be registered as trade marks, and a right of property thereby acquired in them.[3] "In my opinion," Cotton, L.J., said, in *Hudson's* case, "the language (of the Act of 1875), though not appropriate, means this, that a man who designs one of those special things pointed out in sec. 10, is, as

[1] In the Act of 1883, there followed here, "or fancy word or words not in common use;" (d) and (e) were introduced by the Act of 1888.

[2] See above, Chap. II., p 35.

[3] *Hudson's Tm.*, 32 C. D. 311: 3 R. P. C. 155 (1886), C. A.: *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J.

designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled within the meaning of the Act to the exclusive use of that which in fact he has never in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it as that his user would be interfered with by the registration." The Act of 1905 expressly includes in the definition of a trade mark contained in sec. 3 a mark "proposed to be used."

Applicant must intend to use the mark.

But the applicant for the registration of a new and unused mark must intend to use it as a trade mark, for it is not permitted to place marks on the Register merely to prevent other traders using and appropriating them.

This principle was laid down by the Courts in decisions before the Act of 1905, and is now embodied in sec. 37. It is more fully discussed in a subsequent chapter.[1]

Section 9 of the Act of 1905.

This section governs all applications for registration, and all registrations made or taken to be made since the commencement of the Act, April 1st, 1906; but, as the question whether a mark on the Register was, when registered, properly qualified for registration or ought to be expunged under sec. 35, must, subject to sec. 36, be considered with reference to the law in force at the date when the registration complained of was made, or is taken to have been made,[2] it is necessary to consider the terms of the corresponding sections in the earlier Acts and to compare them with those of this section.

Sec. 36.

It is, however, provided by sec. 36 that no trade mark which was upon the Register at the commencement of the Act and which under the 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. A registrable trade mark is defined as a trade mark which is capable of registration under the provisions of the Act.[3] It has been decided by Neville, J., that the proper construction to be put on this section is, not that a trade mark registered under a

[1] Chap. XI., below, at p. 293.

[2] See *Ward, Sturt and Sharp's Tms.*, 50 L. J. Ch. 347; 44 L. T. 97 (1881), Hall, V.-C.; and *Re Borril Tm.* 13 R. P. C. 388 (1896); 2 Ch. 604, per Lindley, L.J.; also sec. 6; and cf. Chap. XI., below, p. 276.

[3] Sec. 3, above, p. 24.

former Act must be judged of as if the Act of 1905 had been in force at the date of such registration, but that it must be ascertained whether, under the facts existing when the decision is given, the mark is capable of registration under the Act of 1905, and he held that a word which was at the date of the decision the name of an article was not saved from removal by the section.[1] On appeal, Buckley, L.J., said that he thought one could read the section thus: "Take the facts of to-day and the law of to-day, and inquire whether if the mark were taken off it would on the facts of to-day and the law of to-day be entitled to go on again. If so, leave it alone." It did not mean, "Take the facts of 1884" (the date of registration of the mark in question), "assume the law of 1905 to have been the law in 1884, and see whether upon that assumption the registration could validly have been made in 1884."[1] Kennedy, L.J., agreed with this judgment. Lord Alverstone, L.C.J., thought that there was a good deal of difficulty as to the meaning of sec. 36, and found that, whichever construction was given to it, the appeal failed. Section 36 concludes with a proviso that nothing contained in it shall subject any person to any liability in respect of any act or thing done before the commencement of the Act to which he would not have been subject under the Acts then in force. There is no saving as regards acts of infringement done after the commencement of the Act and before the decision that the trade mark is a registrable trade mark under the Act.

What Act applied to pending registrations.

Both the Act of 1883[2] and the Act of 1888 contained saving clauses,[3] and where an application was made two days before the Act of 1883 came into operation, and the registration was opposed, and the matter came before the Court for decision, the Court of Appeal thought it "undoubtedly the better course" to treat the question as governed by the old Act of 1875.[4] The Act of 1905 contains no saving clause, but by the Interpretation Act, 1889, s. 38, where an Act repeals any other enactment, then,

[1] *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545; and on appeal, [1908] 1 Ch. 513; 25 R. P. C. 156. See also p. 164, note (3).

[2] Sec. 113: "this repeal of enactments shall not affect the past operation of any of those enactments, or any . . . right to use a trade mark granted or acquired, or application pending, . . . or right . . . acquired, . . . or anything duly done . . . under . . . any of those enactments before or at the commencement of this Act."

[3] Sec. 27: "nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act."

[4] *Hudson's Tm.*, 32 C. D. p. 317, Cotton, L.J.; 3 R. P. C. 115 (1886). In the particular case it made no

unless the contrary appears, the appeal shall not (*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.

Sec. 9 is purely restrictive.

Section 9 is purely restrictive, as were also the corresponding sections of the earlier Acts, which it has replaced. They were intended to limit and curtail the numerous forms of words and other things which, before the Acts, were appropriated as trade marks.[1] The intention of the Legislature was in the Act of 1905 to enlarge the classes of registrable marks.[2]

No mark can be put upon the Register unless it complies with the terms of sec. 9, but the presence in it of one or more of the specified particulars does not make the mark a good trade mark,[3] or, of necessity, entitle it to registration. Some restrictions on registration are imposed by the Act itself,[3] and the Registrar has, as is shown elsewhere,[4] discretion to allow or refuse registration where all the conditions of the Acts are complied with.[4] In the case of cotton marks some of the essential particulars enumerated in sec. 9, *e.g.* words, are excluded.[5]

Essential Particulars.

A registered trade mark must contain one or more of the essential particulars, or be an old mark.

No trade mark can be properly registered unless it contains one or more of the essential particulars enumerated in the Act under which the registration is made,[6] or unless it is within the proviso relating to old marks. This is clear from the Acts, but it is also supported by judicial authority. Thus, in *The Orr-Ewing* case, Lord Cairns said[7]: "I cannot think that the Vice-Chancellor Hall sufficiently appreciated the object and provisions of the Act of Parliament when he said that he considered that, in each case, a device or label, registration of which is applied for, must be looked at as a whole, and that, if it appears to be such as in the ordinary course of business would be distinguished from other devices or labels, it should be registered. To some extent,

difference. See also *Burgoyne's* case, 6 R. P. C. 227; 61 L. T. 39 (1889), and the *Apollinaris* case, [1891] 2 Ch. p. 201; 8 R. P. C. 137.

[1] Per Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 634; 4 R. P. C. 31 (1887).

[2] See *Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436, Kekewich, J.

[3] Above, p. 22; also secs. 11, 19 and 20. See Chap. X., below, p. 221.

[4] Chap. IV., p. 70; *Eno* v. *Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890); and see per Lindley, L.J., above, p. 74.

[5] Sec. 64 (10), and above, p. 123.

[6] Above, p. 133.

[7] *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. p. 484; 48 L. J. Ch. 710 (1879).

no doubt, this is true; but I apprehend the first duty cast upon the Court is to ascertain whether some one, or more than one, of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with the one, or more than one, essential particular or particulars which distinguish it." And in a later case, under the Act of 1883, Chitty, J., said[1]: "The argument is that, though neither of the particulars is within the 64th section, the mark must be looked at as a whole; and being looked at as a whole, it is brought within the sub-sec. (c) (as a device or label) because as a whole it is distinctive. This point was raised before Mr. Justice Pearson, in *Price's Patent Candle Co.'s* case,[2] and without success. It is quite true that the mark must be looked at as a whole, but we must find in the whole, one at least of the essential particulars; and not one of the essential particulars, in my opinion, can be found in this mark." So, in *The Birmingham Vinegar Brewery Co.'s Application*,[3] Kekewich, J., in considering a label, set aside the argument that, although there were none of the essential particulars in detail, yet the combination of many particulars which were not essential might make the whole label into an essential particular. In *Wright, Crossley & Co.'s Application*,[4] in which the applicants sought to register a label alleged to be distinctive, Byrne, J., after referring to the cases already quoted, and holding that the mark did contain an essential particular or particulars, inasmuch as it contained certain devices, said: "These devices, as and when used as part of the trade mark, with the rest of the label appear to me to make the whole label distinctive."[5]

These cases, so far as they decide that a trade mark must contain an essential particular, are still authorities applicable to the present Act. It should be borne in mind, however, that that Act contains no reference, as the Act of 1888 did, to additions or "added matter,"[6] and it seems to be the intention of the Act,

[1] *Bradley's Tm.*, 9 R. P. C. p. 207 (1892). The mark in question consisted of the words *Worth's Corsets* printed in ordinary type, between two co-axial ovals.

[2] 27 C. D. 681; 54 L. J. Ch. 210 (1884). A conventional label with the words *National Sperm* printed on it. As to labels, see further, pp. 192 to 197.

[3] 11 R. P. C. 195; 70 L. T. 646 (1894).

[4] [1900] 2 Ch. 218; 17 R. P. C. 386.

[5] But, although in *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 611, the Court of Appeal were considering a different question, namely, whether a word was part of a mark or an addition to it, they appear to have assumed that the label must be considered as a whole. See also *The Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109. See also below, "Label."

[6] Sec. 64 (2) and sec. 74 (2) of the Act of 1883, as amended.

that provided an essential particular is found in the mark, it should be registered as a whole, with such disclaimer only as may be necessary under sec. 15.

The sub-sections are alternative.

The five divisions into which essential particulars were by sec. 10 of the Act of 1888 divided, were held to be separate and distinct.[1] In the case of (d) and (e) a different conclusion was arrived at by the Court of Appeal in *The Somatose* case,[2] where it was held that a word could not be registered as an "invented word" unless it also was a word "having no reference to the character or quality of the goods," but this construction of the Act was disapproved of by the House of Lords in *The Eastman Photographic Materials Co., Ltd.'s Application*,[3] and the decision of the Court of Appeal was reversed. The divisions are likewise distinct under the Act of 1905. Therefore, although in construing one division the scope of another division may be material,[4] the fact that a thing is not an essential particular under one heading will not prevent its being a proper essential particular under another heading. It follows, too, from this construction that qualification under more than one heading is possible—for instance, a word might be an invented word within (3), and also be a word having no direct reference to the character or quality of the goods within (4).

Additions now abolished.

The former enactments requiring an applicant for registration to state in his application the essential particulars of the trade mark, and also to disclaim any right to the exclusive use of added matter and of any addition are omitted in the Act of 1905,[5] no mention of "added matter" or of "additions" being contained in the present Act. A wide power to require disclaimer is, however, conferred by sec. 15, where necessary, to define the rights of the proprietor of the trade mark.[6]

Name marks.

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

Names are highly valued as trade marks, or as essential particulars of trade marks, and they were often adopted and

[1] See Ld. Herschell's judgment in *Eastman & Co., Ltd.'s Application*, [1893] A. C. 571; 16 R. P. C. 476.

[2] *Farbenfabriken Vormals F. Bayer & Co.'s Tm.*, [1894] 1 Ch. 645; 11 R. P. C. 84.

[3] See note (1).

[4] See, for instance, *Holt's Tm.*, [1896] 1 Ch. 711, 717; 13 R. P. C. 16 and 118 (1896), North, J., and C. A.; and *Pirie v. Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, Vaughan Williams, J.

[5] See above, p. 135.

[6] See Chap. IX., p. 212.

protected as such before the Acts.[1] Since 1875 the corresponding part of the earlier Acts had been as follows:—(*a*) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive name.*[2]

It was pointed out that under the former wording the name of a body corporate might possibly not be included, the word "person" which would have included it not being used.[3] In the present Act the word "company" is introduced.

The name need not be that of the company, individual or firm applying for registration, or that of a predecessor in business.[4] But the name must be that of a real company, individual or firm as opposed to an imaginary company, individual or firm. Thus it was held in *Holt & Co.'s Trade Mark*,[5] by Lindley and Smith, L.JJ. (Kay, L.J., dissenting), that *Trilby*, being the name of an imaginary person taken from a novel, was not within clause (a) of sec. 64 (1) of the Act of 1883; and Lindley, L.J., said: "Clause (a) does not say that the name to be registered need be the name of a living person, nor the name of the applicant for registration. In this respect clause (a) differs from clause (b). The reference to a firm, however, points rather to real persons than to imaginary persons. In metaphorical language, an imaginary person may perhaps be called an individual, but such a use of the word is unusual, and to my mind rather fanciful. It is hardly to be supposed that the Legislature meant 'individual' to be taken in a fanciful or metaphorical sense, or meant it to denote an imaginary person who has not and never had any real existence." The question whether clause (a) was satisfied if it can be shown that the name has at some time been the name of a real person or firm did not arise; but there is nothing in the judgments of Lindley and Smith, L.JJ., to indicate that they considered that such a name would not fall within clause (a).[6]

Name of imaginary person.

[1] "The name of a firm is a very distinctive word indeed": per Jessel, M.R., in *Ex parte Stephens*, 3 C. D. p. 660; 46 L. J. Ch. p. 47 (1876).

[2] Sec. 10 of the Act of 1875. Sec. 64 of the Act of 1883. No change was made by the Act of 1888.

[3] *Colman's Application*, [1894] 2 Ch. 127; 11 R. P. C. at p. 134.

[4] Cf. para. (2), below, p. 140.

[5] 13 R. P. C. 16 and 118, C. A., [1896] 1 Ch. 711, reversing North, J. It was argued that if the word fell under clause (a)—with the condition of which it did not comply, as it was not printed in any distinctive manner—it could not be registered under clause (e). The majority of the C. A. approved the argument, but held that the word did not fall under clause (a). For these clauses, see above, p. 130.

[6] In *Banks and James' Tm.*, 12 R. P. C. 333 (1895), Chitty, J., held that *Shakspere* was not a "fancy word," one of his reasons being that there were many living persons of the name.

The alteration in the present Act from "a name" to "the name" makes it more clear that a real company, individual or firm is intended.

The practice of adopting trade names which are different from those of the traders or of the partners in the firm using them is very common—for instance, in the Scotch whiskey trade, in which it is a common practice to use a Scotch name. The practice is of itself perfectly lawful,[1] and such a name so adopted, and although so adopted for one branch only of a business, would no doubt be within the clause; and as this practice is allowed, there seems to be no reason why a trader should not adopt as his trade mark the name of a real[2] or imaginary individual. But the effect of the decision in *Holt's Trade Mark* as applied to the present Act is[3] that if the name adopted be that of a real person or firm, it comes under paragraph (1), and must be represented in a special or particular manner; whilst if it be that of an imaginary person, it can be registered in ordinary lettering under paragraph (4), provided that it has no direct reference to the character or quality of the goods,[4] or possibly under paragraph (5). Names falling within clause (1) are not within clause (4).[5]

It does not follow that every name of a company, individual or firm, represented as required by paragraph (1), which an applicant may select is entitled to registration, for, apart from the general restrictions expressly specified by the Act,[6] the Registrar, in the exercise of his discretion,[7] would, no doubt, reject any name which, contrary to the fact, tended to suggest that the goods on which it was used were the manufacture or merchandise of, or had some connection with, a particular company, person or firm, or were goods of a particular kind, especially if the name were not the proper name of the applicant or of his predecessors in trade.[8] And if the name indicated a particular

[1] See *Macmillan* v. *Ehrmann Bros., Ltd.*, 21 R. P. C. 647 (1904), C. A., where, however, Vaughan Williams, L.J., regretted the lawfulness of the practice.

[2] Cf. *A. W. Gamage, Ltd.* v. *H. E. Randall, Ltd.*, 16 R. P. C. 185 (1899) (a passing-off case in which the plaintiffs failed. *Shorland* for cycling shoes). Makers of tennis racquets sometimes name their racquets after well-known players.

[3] See note (5), p. 137.

[4] See infra, p. 165.

[5] The decision in *Holt's* case, supra, would seem to apply under the present Act.

[6] Secs. 11, 19 and 20; Chap. X., p. 221.

[7] See p. 70.

[8] Cf. *Thorneloe* v. *Hill*, [1894] 1 Ch. 569; 11 R. P. C. 61 (*John Forrest* — passing-off case).

living person, who did not assent to the use of his name, the Registrar might in his discretion reject it, even although no connection of the person with the particular goods would be suggested.[1]

Name must be mere name in nominative case.

The name must be the mere name in the nominative case. Thus, where *Pirie's Parchment Bank* was registered as a trade mark, and the two latter words were disclaimed, Lindley, L.J., held that *Pirie's* was not the name of a firm within the former sub-section.[2]

And as regards the registration of names in the possessive case, generally, Lord Herschell's Committee reported[3] that "complaints have also been made that where words have been refused as not being distinctive, they have afterwards been allowed where the applicant has applied for a mark consisting of the same word preceded by the applicant's name with an apostrophe. We think," they added, "that this course ought not to be pursued. Little or no mischief might result where the name of the applicant was an uncommon one; but where the name was a common one the result would be to deprive all persons bearing the same name of their right to use a common word in connection with their own name, and even if the name were an uncommon one it would be impossible to say that there were not other persons bearing it who might wish to use it in connection with the common word which it is sought to monopolise."

The report continues: "Evidence has been given that marks consisting of a combination of the applicant's name with the article he manufactures or sells are highly valued. There can be no doubt that if a manufacturer or vendor has obtained for his goods a reputation amongst the public, he could, by process of law, quite apart from the Trade Marks Act, prevent goods that

[1] By Rule 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. The rule also provides that the Registrar may require the consents of legal personal representatives in the case of persons recently dead. See also *Carroll's Application*, 16 R. P. C. 82 (1899), Kekewich, J. (*Princess Christian*). Portraits of well-known persons have, with their consent, been registered as trade marks.

[2] *Pirie* v. *Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17; cf. *Colman's Tm.*, [1894] 2 Ch. 115; 11 R. P. C. 129, where Stirling, J., held that *Colman's* occurring in a label need not be disclaimed under sec. 64 (3) (1) of the Act of 1883, as amended by the Act of 1888.

[3] Report of 1888, p. xii.

were not his from being offered to the public on the representation that they were so. But it would be quite a different thing to give, by virtue of registration under the Trade Marks Act, a right to prevent another manufacturer or merchant honestly describing his own goods by his own name."[1] The effect of the decision in *Piric* v. *Goodall*[2] will, no doubt, be to put a stop for the future to the registrations which the committee thought objectionable.

Special or particular manner.

The word "distinctive" has been dropped in the present Act. Every trade mark must be distinctive, that is, capable of distinguishing the goods from those of other persons. The word "special" has been, in conjunction with the word "distinctive," construed by the Court as regards marks registered as old marks.[3] There seems to be little difference in meaning between "special" and "particular." The intention of the requirement that the name should be represented in a special or particular manner is obviously to prevent a name from being so taken as a trade mark that any trader might unintentionally infringe it by an honest use of his own name.[4] This intention would be carried into effect by construing the words to mean "not ordinary, having regard to the practice in the trade concerned."

Ordinary type.

It was held under the old clause that a name printed in ordinary type,[5] or in type in ordinary use, as, for instance, capitals,[6] or common ornamental letters,[7] was not within the clause; and that the addition of marks which are common to the trade makes the words no better as a trade mark.[8] Similar decisions would no doubt be given under the Act of 1905.

Signatures.

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

[1] See *Hopkinson's Tm.*, [1892] 2 Ch. 116; 9 R. P. C. 102, Kekewich, J., where something like this seems to have been done by the registration of a name as an old mark.

[2] See note (2), ante, p. 139.

[3] See below, p. 174.

[4] See the extract quoted above from the report of Ld. Herschell's Committee. As to the right of a man to trade under his own name, see below, p. 532; but cf. *Hopkinson's Tm.*, note (1).

[5] *Carroll's Application*, 16 R. P. C. 82 (1899) (*Princess Christian* for needles).

[6] *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J. (*Gianaclis Cigarettes*).

[7] *Re Price's Patent Candle Co.*, 27 C. D. 681; 54 L. J. Ch. 210 (1884), Pearson, J.

[8] *Ibid.*, and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.; (*Worth's Corsets*) printed between two co-axial ovals.

The corresponding essential particular in the Act of 1883 was as follows :—

Signature of the applicant.

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

Under the Act of 1875 the latter words of the clause ran "of an individual or firm." The addition "applying for registration" was effected by the Act of 1883. A trader can now register the signature of his predecessor in business under this sub-section. Under the old clause (b) this could not have been done, but it is possible that a signature might have been registered under the old clause (a),[1] and a signature of a predecessor could probably have been registered as an old mark.[2] Of course, the signature of a predecessor in business, properly registered by him and assigned or transmitted as a trade mark, together with the goodwill of the business, is usually as available for use by the successors, and can be as readily protected, as if it had been originally registered by them.[3] The words "written signature of a firm" were construed by the Comptroller to mean a signature (actually used in the ordinary course of business) of the trading style under which the applicant had a *bonâ fide* right to trade, and which consisted of a *personal name* or of *personal names*, and not to include mere descriptive trading styles, such as *The Excellent Tea Co.* or *The London Stout Co.*[4] In a recent case under the Act of 1888, "Macfarlane & Co.," which had been registered as a signature, was ordered to be removed from the Register, it being admitted that it was an adopted trade name and not the signature of an existing firm.[5]

Requirements for a good trade mark.

Copies of written signatures were frequently protected as trade marks, or as material parts of trade marks, before the Acts.[6] As a man's signature has for several centuries been the mark in universal use to authenticate documents which are his, it might have been expected that it would have been used also to authenticate his goods, and that signatures would have occupied a more prominent place among trade marks than they do. There are, however, several objections to a signature as a trade mark. A

[1] This is discussed in the 2nd ed. of this work, p. 129.

[2] As to old marks, see below, p. 198.

[3] See Chap. XIII., p. 345, Assignment and Devolution of Trade Marks.

[4] Notice in the Trade Marks Journal, January 1st, 1896.

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

[6] As in *Farina* v. *Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 24 L. J. Ch. 632; 26 L. J. Ch. 11; and 4 K. & J. 650 (1855), Wood, V.-C., and Ld. Cranworth.

good trade mark must not only enable a customer to recognise the goods which bear it, when he sees them, as those of the manufacturer or trader with whom he wishes to deal, but must also enable him to describe and call for them. As regards the latter requirement, a signature is usually nothing more than a bare name mark, for the manner of writing it will rarely be such as to enable even a person who could read and recognise it at sight to recollect and describe it; and it is obvious that for customers—some foreigners, for instance—who are unable to read the signature, it, or indeed any name mark, fulfils neither of the requirements referred to. Another disadvantage of a signature as a trade mark is that the protection afforded is very narrow. Thus, a trade mark of which the signature of one of the complainers (it being a Scotch case), Daniel Crawford, was the essential particular was held not to be infringed by a facsimile of the signature of the respondent, Robert Crawford, and apparently the judgment would have been the same although the names had been identical. Lord Kyllachy, after pointing out that the case put forward was purely a trade mark case, said: "Now it is new to me that a man who has a registered trade mark or facsimile of his own signature can complain of another trader using as a trade mark a facsimile of his own merely because the two names happen to be the same;" and, without hearing evidence, he decided that the case was not sustainable.[1]

Word Marks.

Words as trade marks.

Words are highly valued as trade marks, since when well chosen they combine the necessary quality of distinctiveness with convenience for being remembered and referred to, which is only equalled by such simple devices as, from their resemblance to common objects or to familiar geometrical figures, at once suggest appropriate names; and, while in many of the classes all, or almost all, the suitable devices are either already appropriated or have ceased to be distinctive, the number of new words which may be invented is practically unlimited.

Word marks were common enough before the Registration

[1] *Crawford & Son* v. *Bernard & Co.*, 11 R. P. C. 580 (1894); and cf. *Barber* v. *Manico*, 10 R. P. C. 93 (1893), where Smith, L.J., sitting as a judge of first instance, held that the words *Edward Barber* were not an infringement of an old trade mark consisting of the words *Era James Barber, Sheffield.*

Acts, and provision has been made in all of these for the registration of any special and distinctive word or words used as trade marks before August 13th, 1875, the date on which the Act of 1875 came into operation, and also, under sections already considered, for the registration of the name of an individual or firm printed, &c., in some particular and distinctive manner, and of a written signature or copy of a written signature. Except such old marks, names, and signatures, no other word marks could be registered under the Act of 1875.[1] This was altered by the Act of 1883, which, under sec. 64 (1) (c), allowed the registration of "a fancy word or words not in common use." The expression "fancy word," however, gave rise to considerable differences of opinion as to its meaning, and after the report of Lord Herschell's Committee it was struck out of clause (c), and the two new clauses (d) and (e) were substituted for it.[2] These clauses allowed the registration of: (d) "an invented word or invented words"; and (e) a "word or words having no reference to the character or quality of the goods, and not being a geographical name."

The report of Lord Herschell's Committee on word marks.

The portion of the report above referred to, which relates to this subject, was as follows[3]:—"It will be convenient to consider first what words ought to be allowed as trade marks. There can be no objection to permitting the registration of an invented word not to be found in the vocabulary of our own or any other country. It seems, further, that existing words may with advantage be permitted as trade marks, subject to limitations which at once suggest themselves. It is manifest that no one ought to be granted the exclusive use of a word descriptive of the quality or character of any goods. Such words of description are the property of all mankind, and it would not be right to allow any individual to monopolise them and exclude others from their use. Again, geographical words, which can be regarded as descriptive of the place of manufacture or sale of the goods, are open to obvious objections. One manufacturer

Geographical names.

[1] *Ex parte Stephens*, 3 C. D. 659; 46 L. J. Ch. 46 (1876), Jessel, M.R. (*Acilyton*); *Rose* v. *Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C. (*Limetta*); see per Lindley, L.J., in *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887).

[2] Act of 1888, sec. 10.

[3] Report of 1888, p. xi. On a question of construction of the Act of 1888, it is permissible to refer to this report in order to ascertain the evils which the Act was directed to remedy, per Ld. Halsbury, L.C., in *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476. The passage given in the text was from the words "It is manifest," quoted by Ld. Halsbury.

or merchant cannot properly be allowed to prevent all his competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first person who had manufactured or sold the goods in the place the name of which he seeks to appropriate as a trade mark. But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to lead to difficulty and litigation.[1] We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale. We would add upon this point that we think that where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. The question has been raised whether a word having the same sound as one entered on the Register, though spelt differently and with a different meaning, should be registered. The question in such a case would seem to be whether the resemblance between the old mark and that applied for was such as to be calculated to deceive; if it were, it ought, of course, to be rejected."

Translated words.

Phonetic equivalents.

The old clauses (d) and (e) introduced by the Act of 1888 are now replaced by paragraphs (3) and (4) of sec. 9 of the Act of 1905, but paragraph (3) is exactly the same as clause (d), namely, "an invented word or invented words," and paragraph (4) differs only in slight respects from clause (e), the differences being in favour of applicants for registration. It is as follows:—"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*." The words italicised are new, but surnames were in practice refused registration.

Special restrictions as to the registration of words in the cotton classes are contained in sec. 64 (10) of the Act of 1905.[2]

A Fancy Word or Words not in common use.[3]

As already stated, the meaning of these expressions gave rise to considerable differences of opinion, and, since the marks

[1] See Chap. II., at p. 49.
[2] See above, p. 125.
[3] A fancy word was a good trade mark before the Acts. "The more ridiculous it is, the better it is"; Wood, V.-C., in *Young* v. *Macrae*, 9 Jur.

registered under the Act of 1883 are still governed by that Act,[1] subject to the provisions of sec. 36 of the present Act,[2] it is necessary to consider the cases. Before the date of the amending Act a definition of *fancy word* had been laid down by the Court of Appeal which seemed to be fairly clear and precise.

Fancy words.

In *Lloyd & Sons' Trade Mark*,[3] Chitty, J., in the year 1893, summed up the result of the decisions to that time in the following passage: "To be a fancy word, the word must be obviously meaningless as applied to the article in question. On that principle the Court has held that the term *Gem*,[4] with reference to a gun, is not a registrable fancy word; with reference to hair restorer, that the word *Melrose*[5] is not a fancy word; with reference to velveteen, that the word *Electric*[5] is not a fancy word; and with reference to lace, the opinion of Lord Justice Cotton appears to have been that the term *Alpine*[6] was not a fancy word. These are some of the numerous illustrations that may be given of what may be thought by some to be the severe and strict construction which the Courts put upon the 64th section. There is another case, which I may also usefully mention, which is the case of *Jubilee* with reference to note paper." The last-mentioned word was also held not to be a fancy word.[7] The severity of construction, of which Chitty, J., spoke, has, however, been somewhat relaxed by later decisions of the Court of Appeal, referred to below, which appear to have the effect of confining the rules laid down by the earlier decisions of the Court to words which were either ordinary English words, or very slight modifications of such words,[8] fancifully applied, or, perhaps it would be more correct to say, to words other than newly coined words.

Van Duzer's case.

The leading cases are the consolidated appeals of *Van Duzer's*

(N. S.) 322 (1862). The expression "fancy word" was well understood as being the antithesis of a descriptive word: see *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508, Ld. Hatherley at p. 514 (1872); *Hirst* v. *Denham*, 14 Eq. 542 (1872), Bacon, V.-C.; *Blair* v. *Stock*, 52 L. T. 123 (1885), Kay, J.; *Alpine Tm.*, 29 C. D. 877 (1885), Chitty, J.

[1] *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J. (*Satinine*); *Paine's Tm.*, 9 R. P. C. 134 (1892), Kekewich, J., and *Re Tm. Bovril*, [1896] 2 Ch. 600; 13 R. P. C. 382, Kekewich, J., and C. A.

[2] See above, p. 132.

[3] 10 R. P. C. 281 (1893), *Carnival* not a fancy word.

[4] *Re Arbenz's Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), Kay, J., and C. A.

[5] *Van Duzer's Tm.* and *Leaf's Tm.*, infra.

[6] 31 C. D. p. 639.

[7] *Towgood Bros.* v. *Piric & Sons*, 4 R. P. C. 67; 56 L. T. 394 (1887), Chitty, J.

[8] As *Reversi*, see below.

Trade Mark and *Leaf & Son's Trade Mark*,[1] the appeals in *Re Trade Mark Bovril*,[2] and in *Burroughs, Wellcome & Co.'s Trade Marks*,[3] all in the Court of Appeal. The first case arose out of an application to register the words *Melrose Favorite Hair Restorer*, which had been adopted by the applicants in 1880, and were identified by reputation with their goods, and with theirs alone. A label containing them had been already registered by the applicants. It was argued that, although *Melrose* happened to be the name of a place, it was registrable because of its secondary meaning, indicating the applicants' goods;[4] that it was sufficient if the words were not "*in common use*" in connection with the goods in question; and that an earlier decision of Chitty, J., in *The Alpine* case,[5] holding that a word was a *fancy word* if it were fancifully used, was right. The Court of Appeal did not assent to any of these arguments.

The fancy word must be obviously meaningless.

To be a *fancy word*, Cotton, L.J., held, a word must be one "which obviously cannot have reference to any description or designation of where the article is made, or of what character it is." So that it is not enough that it should be shown by evidence that it, in fact, has no such reference, and the incorrect or inappropriate user of a word which is descriptive does not make it a fancy word. Lindley, L.J., said: "To be a fancy word I think the word must either have, to ordinary English people, to whom this Act of Parliament is addressed, no meaning, like the word *Eureka* or the word *Acilyton*, or if it has any meaning at all, it must be obviously non-descriptive[6] when used as a trade mark"; and Lopes, L.J.,[7] laid down the following conditions as necessary in order that a word should come within the term:—It must be obviously meaningless as applied to the article in question; it must be fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as to be neither deceptive nor

[1] 34 C. D. 623; 4 R. P. C. 31 (1887), Cotton, Lindley and Lopes, L.JJ.

[2] [1896] 2 Ch. 600; 13 R. P. C. 382, Lindley, Lopes and Rigby, L.JJ.

[3] [1904] 1 Ch. 736; 21 R. P. C. 217.

[4] This was sufficient to make the words a trade mark under the law before the Acts. See Chap. II., pp. 37 *et seq.*

[5] 29 C. D. 877 (1885). The right of appeal in this case was lost by a slip as to time.

[6] 34 C. D. p. 642; "non-descriptive" was substituted for "meaningless" after a suggestion by Cotton, L.J., of "obviously not intended to be descriptive," p. 645. See also *Meaby & Co., Ltd.* v. *Triticine, Ltd.*, 15 R. P. C. 1 (1898), North, J.

[7] Page 644.

descriptive, nor calculated to suggest deception or description; and, further, it must have "an innate and inherent character of fancifulness, which must not depend on evidence, and cannot be supported by evidence, to show that, in fact, it is neither deceptive nor descriptive, or calculated to be deceptive or descriptive." It must speak for itself.

In *Leaf & Son's* case the Court, applying these criteria, held that *Electric* for velveteens was not a fancy word.

The definitions given in these judgments have been cited and were followed in many subsequent cases turning upon the meaning of the expression. Thus, in *Waterman* v. *Ayres*,[1] the Court of Appeal held, that *Reversi* was not a fancy word for a game. Ordinary Englishmen, Cotton, L.J., said, would consider it was in some way connected with reversing, and Fry, L.J., said that, by its likeness to *reverse*, it was calculated and intended to convey to the minds of persons who read it a notion of the character of the game, and it was, therefore, not a fancy word.[2]

Whilst, however, there has not been, and could not have been except in the House of Lords, any dissent expressed from the definitions laid down in *Van Duzer's* and *Leaf & Son's* cases,[3] a limitation appears to have been drawn in the application of those definitions. In *Densham's Trade Mark*,[4] the Court was asked to expunge from the Register the word *Mazawattee* which had been registered in 1887 for tea, and subsequently for other articles, on the ground that the word was not a fancy word not in common use. It appeared that the word had been obtained by joining the Hindustani word *Mazadhar*, meaning luscious, to the Cingalese word *Wattee*, meaning garden or growth, and dropping out the syllable "*dhar*." It was contended that the word was descriptive, but the Court of Appeal, affirming Romer, J., held that it was clearly not descriptive, and was a fancy word. Lopes, L.J., whilst adhering to the previous definition of a "fancy word," expressed the opinion that the cases had gone far enough.

[1] 39 C. D. 29; 5 R. P. C. 368 (1888).

[2] See also *Edge's Tm.*, 8 R. P. C. 207 (1891) (*Filtered Blue*); and *Hodgson* v. *Sinclair*, 9 R. P. C. 22; 8 T. L. R. 45 (1891), *Britannia*, for soap.

[3] See the judgment of North, J., in *Meaby & Co., Ltd.* v. *Triticine, Ltd.*, 15 R. P. C. 1 (1898).

[4] [1895] 2 Ch. 176; 12 R. P. C. 75 and 271, Romer, J., and C. A. (Lindley, Lopes and Kay, L.JJ.).

The Borril case.

In *The Borril* case,[1] which also came before the Courts on a motion to expunge, the word *Borril* had been on the Register for nine years in Class 42 for substances used as food. The word was new when registered, and had since been applied to meat extract and to other articles of food. Kekewich, J., refused the motion, and the applicants appealed. The decisions of the Court of Appeal in *Van Duzer's* and *Leaf's* cases were cited, and it was contended that *Borril* was not obviously non-descriptive. All the members of the Court (Lindley, Lopes and Rigby, L.JJ.) pointed out that in the cases relied on by the applicant, ordinary English words and not coined words were under consideration; they also all held that as a fact *Borril* was not descriptive. Lindley, L.J., after saying that it would be wrong to substitute for the words "fancy word" "a non-descriptive word," but that they must ask themselves fairly whether *Borril* was a non-descriptive word, said: "I think it is eminently and purely a question of fact. Now, I ask myself this: Supposing that a jury were asked whether, on November 2nd, 1886, *Borril* was a fancy word not in common use, and supposing they said, upon a direction from the judge, which I think it would be the duty of the judge to give, that, if they were of opinion that it really intelligibly described the thing sold, it would not do, could they, with that direction, screw themselves up to say that it was not a fancy word not in common use? I do not think they could. That really settles the matter." Lopes, L.J., also said: "I say to myself, What would an intelligent jury say if they were asked if *Borril* was a fancy word? If I had had to try the case, I should have told them that they must keep in their minds that this word was placed upon the Register in 1886, and that they must regard it as it stood at that time. I should have told them that to be a good fancy word it must be non-descriptive and meaningless as applied to the article to which it was intended to be applied; and if I had so told them, I do not hesitate to say that I am confident that they would have come to the conclusion that the word was not descriptive, and that it

[1] *Re Tm. Borril*, [1896] 2 Ch. 600; 13 R. P. C. 382, Kekewich, J., and Lindley, Lopes and Rigby, L.JJ. The word is an obvious derivation from *Bos* and *Virilis*. Bovine and virility are ordinary English words. The word "vril" is found in Lord Lytton's novel "The Coming Race." It is curious that the Court which rejected *Somatose* (see below, p. 167) should have accepted *Borril*.

was a good fancy word." It will be observed that, whilst the Court accepted the conditions previously laid down by it as applicable to an ordinary English word, it stated them somewhat less rigorously in the case of a newly coined word. However, in *Meaby & Co., Ltd.* v. *Triticine, Ltd.*,[1] North, J., held that the principle to be applied in the case of the word *Triticumina*, registered in Class 42, in respect of leaven and wheatmeal biscuits, &c., and derived from *triticum*,[2] was that laid down in *Van Duzer's* case, and that the word was not "obviously not intended to be descriptive," and he accordingly ordered it to be expunged. It is difficult to reconcile this decision with that in *The Bovril* case.

The Tabloid case.

The expression "fancy word" was again considered by the Court of Appeal in *The Tabloid* case,[3] in which the facts were that manufacturing chemists, having for some time sold compressed drugs under the word *Tablet*, in 1884 registered for substances used in pharmacy the word *Tabloid*, which they invented for the purpose, and from that date they had sold compressed drugs under that name. With some hesitation the Court held that at the date of registration the word was a fancy word not in common use. They held that the "*Bovril*" case showed that it was not necessary that the word should be absolutely unsuggestive, and that, applying the test laid down by Lindley, L.J., referred to above, the word *Tabloid* was not one "really intelligibly describing the thing sold." Cozens-Hardy, L.J., said that the swing of the judicial pendulum had been very great, and the extreme point of that swing was to be found, he thought, in that case.

The Cyclostyle case.

In a recent case[4] Neville, J., held that *Cyclostyle*, registered in 1884 in respect of stationery and apparatus for producing facsimile copies of writings and designs, was not at the date of registration a fancy word. The word had before registration been applied to a cog-wheel pen and the duplicating apparatus relating to it, and Neville, J., held that it was descriptive, first, because it was the name of a particular article, and secondly, because it gave, although in languages other than English, a combined word which did describe

[1] 15 R. P. C. 1 (1898).
[2] Wheat.
[3] *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217.
[4] *In re Gestetner's Tm*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 1

the article in question, and his decision was affirmed on appeal.[1]

A list of words which have been held not to be "fancy words not in common use" is given on a later page.[2]

The decisions are only restrictive.

The propositions laid down by the Court of Appeal in the cases cited do not amount to definitions from which tests to show affirmatively that any particular word is within the meaning of the Act can be drawn. They are negative propositions only. "To say that every word is a fancy word because it is unknown to an average Englishman, would be plainly to lay down a proposition which could not be for a moment maintained, (for) there are many good English words descriptive of articles which are unknown to an average Englishman, taking a rather high standard."[3]

Descriptive words.

A word descriptive of, or intelligibly suggesting a description of, the origin, qualities, or uses of the goods, is not a fancy word.[4] The word *Gem*, therefore, having come into use to indicate excellence in the article to which it is applied, is not a fancy word.[5] And on an application to register it as a trade mark for air-guns, it was a further fatal objection that it had, by user, become descriptive of a particular class and make of gun.[5]

Words in a foreign language.

The Acts are directed to ordinary Englishmen,[6] and the

[1] In the judgment as delivered, Neville, J., said that he did not think that "a word is not descriptive because from the description alone you could not possibly either make the article or form an absolute and definite conclusion as to what shape or character the article would take": 24 R. P. C. at pp. 548, 549. The passage is omitted in the revised judgment in the Law Reports, perhaps, as being not wholly consistent with the udgment in the *Tabloid* case.

[2] Page 156, below.

[3] Per Chitty, J., in *Davis* v. *Striboll*, 6 R. P. C. p. 241; 59 L. T. 854 (1888), *Bökol*, the name of a Norwegian beer, rejected as a trade mark for the beer.

[4] "Descriptive" does not necessarily mean accurately so, but descriptive for practical and popular purposes, per Rigby, L.J., in *Reddaway* v. *Banham*, [1895] 1 Q. B. 297; 12 R. P. C. at p. 91.

[5] *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887). So held by the C. A., reversing Kay, J., whose judgment was delivered before that of the C. A. in *Van Duzer's* case. In *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545, *Cyclostyle* was held to be the name of the article, and not a fancy word: affirmed on appeal, [1908] 1 Ch. 513; 25 R. P. C. 156. *Reversi*, *Satinine*, *Carnival*, *John Bull*, *Roadster*, and *Beatrice* are other instances, below, p. 156.

[6] See the judgments of Lindley, L.J., in *Van Duzer's* case, and Cotton, L.J., in *Waterman* v. *Ayres*, supra, and of Lindley, Lopes, and Rigby, L.JJ., in *Tm. Boeril*, supra, and of Kekewich, J., and Rigby, L.J., in *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621; *Lloyd & Sons' Tm.*, 10 R. P. C. 281 (1893) (*Carnival*); and *Buryoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39, *Oomoo*, cited below. Cf. the Report of Ll. Herschell's Committee, cited above, p. 143.

question whether the words put forward are obviously meaningless and non-descriptive in regard to the goods for which the mark is to be used, is to be tried, therefore, in the light of such information as ordinary Englishmen may be supposed to possess. It has, nevertheless, been held that *Monobrut*, which is a compound of *brut*, meaning "dry" as opposed to "sweet" in the French wine trade, and which in itself means "very dry," is descriptive, and therefore not a fancy word.[1] As already stated, *Triticumina*, for wheaten food, was held by North, J., to be "obviously descriptive" having regard to its derivation from *triticum*, wheat, and to its use in advertisements.[2]

Name of the goods in foreign language.

The name of the goods is not a good trade mark apart from any objection under the Acts,[3] and it cannot, of course, be registered under them.[4] So that the introducers of a kind of beer, which was common in Sweden and Norway, were not allowed to retain on the Register the names by which it was ordinarily known in those countries, and under which it had been sold in England.[5] "For the sake of caution limiting my proposition to the European languages," Chitty, J., said, "I am of opinion that, in reference to an article produced in a foreign country and imported into England where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy word within the meaning of the Act."

And it is clear that a word which, though not English, carries a well-understood descriptive meaning,[6] such as *Sanitas*[7] or *Britannia*,[8] is not a "fancy word."

[1] *Vignier's Tm.*, 6 R. P. C. 490; 61 L. T. 495 (1889), Kay, J. Cf. *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), where Kay, J., rejected the Chippeway Indian word *Kokoko* because it meant *Owl*, which was a common mark; but Romer, J., doubted whether he should have come to the conclusion that the word was descriptive, see *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. at p. 82; and *Davis & Co.* v. *Stribolt & Co.*, infra.

[2] *Meaby & Co., Ltd.* v. *Triticine, Ltd.*, 15 R. P. C. 1 (1898), North, J.

[3] See Chap. II., at pp. 35 *et seq.*, and the judgment of Chitty, J., in *Barlow* v. *Johnson*, 7 R. P. C. 395 (1890); also *Gesetzner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156.

[4] Per Fry, J., in *Waterman* v. *Ayres*, supra, p. 147, note (1).

[5] *Davis & Co.* v. *Stribolt & Co.*, 6 R. P. C. 207; 59 L. T. 854 (1888), Chitty, J. (*Bökol* and the Swedish form of that word).

[6] Ld. Herschell's Committee reported that, in their opinion, "where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language." See the whole passage cited above, p. 143.

[7] *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887), Kay, J.

[8] *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), Chitty, J.

This rule does not, however, extend to exclude words taken from a barbarous language. So that the word *Oomoo*, which was said to mean "choice" or "select" among some of the Aborigines of Australia, was held by Chitty, J., to be a fancy word notwithstanding. "If it does mean choice," the judge said, "or if it ever meant choice in the Aboriginal language of Australia, it does not mean choice to an ordinary Englishman, or to a sufficient number of Englishmen in this country, to enable me to say it has a meaning." [1]

Names of common marks.

The name suggested by a mark which is common to the trade is not a fancy word, and this rule was held to apply where the word was the name in the unwritten language of an uncivilised tribe, the Chippeway Indians, to whom the trade in the goods in question was not shown to have extended.[2] It is, however, difficult to reconcile this with the rule already referred to that the Acts are directed to ordinary Englishmen, or to reconcile with it the case last stated, which was decided a few months later.

Secondary distinctive meaning does not constitute a fancy word.

In *The Singer* cases, and other cases of word marks before the Acts, the contest was whether the name was that of the article merely, or whether it had acquired a secondary meaning identifying the article with the owners of the marks;[3] but under the Acts of 1883 and 1888 such secondary meaning, so far as regards the right to registration,[4] is immaterial in the case of marks not used as trade marks before August 13th, 1875. It cannot make a word a fancy word within the Act of 1883,[5] or an invented word within the Act of 1888 or 1905; it may have an important bearing, however, under paragraph (5) of sec. 9 of the Act of 1905.[6]

Geographical words.

In *Van Duzer's* case both Cotton and Lindley, L.JJ., refused to hold that no geographical name could possibly be a fancy word. And Lindley, L.J., said[7]: "If you pick out some name which no Englishman ever heard of, such as *Penj Deh*, to which

[1] *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39 (1889); but cf. the case next cited.

[2] *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), Kay, J., *Kokoko*, meaning owl; but see supra, p. 151, note (1).

[3] Chap. II., at p. 39.

[4] It may have an important bearing upon passing off cases, see *Reddaway* v. *Banham*, [1896] A. C. 199; 13 R. P. C. 218, and Chap. XVI., p. 508.

[5] *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887), C. A.; *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 169 (1887); and see below, p. 183.

[6] See below, p. 173.

[7] 34 C. D. p. 643.

our attention was called some years ago, I do not know that that would not do. It conveys no meaning to an Englishman, and such a geographical name, for all I know, may be a fair and proper fancy word." But, as was held in that case, a name which is known to be that of a place from which the goods might come is not registrable.[1] So, in *The Apollinaris* case, the Court decided that the names of the springs from which the mineral waters came, and which were not the property of, or wholly controlled by, the traders who sought to appropriate the names as trade marks, could not be registered.[2] The word *Britannia*[3] has also been held to be objectionable on the ground that it is a geographical word.

If a word which would not ordinarily be understood to be geographical is also the name of a place, it was not necessarily to be treated under the Act of 1888, as the name of a place for trade mark purposes. Apart from special circumstances, as, for instance, a connection between the goods and the place, the question is what meaning the word would bear ordinarily to ordinary people.[4] Thus the word *Magnolia* was not held to be a "geographical name," merely because there were several places of that name in the United States, from which country the goods came.[4] And in *Clement et Cie.'s Trade Mark*,[5] Kekewich, J., held *St. Raphael* not to be geographical, as it was not shown that the words were adopted with the intention of referring to any place of that name. Under the Act of 1905, the limitation given to "geographical name" in *The Magnolia* case is adopted; the words of the Act are "not being according to its ordinary signification a geographical name."[6] Although the primary signification be not geographical, the real or imputed connection of the article with the locality may make the name a

[1] See also *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J., *Brymbo*, for steel.

[2] [1891] 2 Ch. pp. 203, 221; 8 R. P. C. 137, C. A. "Apollinaris" has now been held to be a word "deemed to be a distinctive mark" under para. (5) of sec. 9 of the Act of 1905, [1907] 2 Ch. 178; 24 R. P. C. 436, Kekewich, J.

[3] *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), Chitty, J. Compare *Paine's Tm.*, 9 R. P. C. 130; 61 L. J. Ch. 365 (1892), Kekewich, J., in which *John Bull Brand* were held not to be "fancy words" because of their reference to England or the English. Kekewich, J., said that he was not sure that the words were not a geographical name.

[4] *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and Lindley, Lopes, and Rigby, L.JJ., and see "geographical name," below, p. 170.

[5] [1900] 1 Ch. 114; 16 R. P. C. 173; Court of Appeal, 16 R. P. C. 611. There was no decision on this point.

[6] See below, p. 170.

"geographical name" for the purpose of the Act of 1888.[1] It is submitted that the same considerations would be applicable in deciding whether such a word would be disqualified to be a "fancy word not in common use" by reason of being geographical.

It seems that the name of the factory from which the goods bearing the mark come is not a geographical word within the meaning intended.[2]

"Geographical words," which can be regarded as descriptive of the place of manufacture or sale of the goods," Lord Herschell's Committee reported,[3] "are open to obvious objections. One manufacturer or merchant cannot properly be allowed to prevent all competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first who had manufactured or sold goods in the place the name of which he seeks to appropriate as a trade mark.[4] But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to lead to difficulty and litigation. We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale."

Name of a person.

The name of a person,[5] even though the person be a mythical person,[6] is not a fancy word, and the name of an individual registrable under (a) could not be registered under sec. 64 (1) (c) of the Act of 1883 as a fancy word.[7]

[1] *Magnolia Metal Co.'s Tms.*, supra.

[2] *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.: and see *Hall* v. *Barrows*, 4 De G. J & S. 150: 32 L. J. Ch. 548; 33 L. J. Ch. 204 (1863), Romilly, M.R., and Westbury, L.C.

[3] The whole passage is cited above, p. 143.

[4] See Chap. II., at p. 50; and *Seixo* v. *Provezende*, and *Wotherspoon* v. *Currie* and other cases there cited.

[5] *Banks and James' Tm.*, 12 R. P. C. 333 (1895), *Shakspere*, Chitty, J.; and *Harris' Tm.*, 9 R. P. C. 492 (1892), Stirling, J., where *Beatrice*, for shoes, was held not to be non-descriptive; see, however, as to this case, *Holt's Tm.*, [1896] 1 Ch. 711: 13 R. P. C. 118. The early case in which *The Lawford* was allowed to be registered seems to be clearly in conflict with the later decisions; (1885), W. N. 124, Pearson, J.

[6] *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), *Britannia*, Chitty, J. The C. A., by consent, reversed the order to expunge this mark. And cf. *Paine's Tm.*, 9 R. P. C. 130, where Kekewich, J., held the words *John Bull* not to be fancy words.

[7] *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 16 and 118, North, J., and Lindley, Kay, and Smith, L.JJ.; the decision was on the Act of 1883, but the principle appears applicable also to the Acts of 1888 and 1905.

A combination of words, each of which is common to the trade, is not a "fancy word."[1] Combination of words.

Not in Common Use.

In order to come within sec. 64 (c) of the Act of 1883 the word or words not only must be a fancy word or fancy words, but must not be in common use. The time to be considered is the date of application.[2]

In *The Alpine* case[3] Chitty, J., took the view that the use referred to is to be understood to be use in the trade, and this view has been adopted also in a Scotch case, in which Lord Craighill said that the term "common use," as employed in the statute, does not necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. "What is enough, in my opinion," he added, "to establish common use, in the sense of the statute, is this: if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less directly with the use of the commodity to which the term has been applied."[4] But it is submitted that the condition suggested by the last phrase is not in accordance with the later decisions as to what are fancy words cited above,[5] and that the construction adopted by Kekewich, J., in the more recent case of *Paine's Trade Mark*,[6] gives the correct meaning of the Act. "I cannot think," the learned judge said, "it means simply the use applied to this trade only. It cannot mean, I think, that words are not in common use if they are not used in the trade. It must mean something wider and larger than that, and seeing that *John Bull* are two words, or a combination of words, which are in common use wherever the English language is known, I think that I must hold them to be in common use within the meaning of the Act." In a later case Chitty, J., held that *Shakspere* was a word in common use, as being the name of many living persons.[7] Common use, whether in the trade or popularly.

[1] *Pirie* v. *Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A.; *Pirie's Parchment Bank*; and see *Perry, Davis & Son* v. *Harbord*, 15 App. Ca. 316; 7 R. P. C. 336 (1890) (*Perry-Davis' Vegetable Pain Killer*).

[2] *Re Tm. Bovril*, [1896] 2 Ch. 600; 13 R. P. C. 382.

[3] 29 C. D. 877 (1885).

[4] *Stuart & Co.* v. *Scottish Val de Travers Paving Co.*, 13 Sess. Cas. 4 Ser. 1 (1885), *Granolithic* stone. The word was held to be in common use.

[5] Pages 144 *et seq.*

[6] 9 R. P. C. p. 133; 61 L. J. Ch. 365 (1892) (*John Bull* beer).

[7] *Banks and James' Tm.*, 12 R. P. C. 333 (1895).

The extent of user which amounts to "common use" has not been defined, but it was decided that the words *Tower Tea*, which were used by the plaintiff and the defendant in the case of the *Great Tower Street Tea Co.* v. *Smith*, and by three other persons in the tea trade, and of which the word *Tower* was used by several traders in other trades, were words in common use.[1] On the other hand, the mere use by a single person, other than the applicant for registration, at an exhibition in this country, of a word which is not known in the trade concerned, does not amount to common use within the clause.[2] The phrase may be compared with "common to the trade" in sec. 74 of the Act of 1883 and sec. 15 of the Act of 1905.[3]

"The" prefixed to word.

Words which are not entitled to registration as fancy words do not become so entitled by having the definite article prefixed to them.[4] This is clear from the definitions cited above. A different view was taken by the Comptroller[5] when first the Act of 1883 came into operation, and before the decision of *Van Duzer's* case.

Examples from decided cases.

The following words have been held not to be fancy words not in common use[6]: ALPINE embroidery, p. 155; APOLLINARIS water, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. pp. 202, 221; 8 R. P. C. 137; BEATRICE shoes, *Harris' Tm.*, 9 R. P. C. 492;[7] BEN LEDI whiskey, *Ainslie & Co.'s Tm.*, 4 R. P. C. 212; BÖKOL beer, p. 151; BRITANNIA soap, pp. 153 and 154; BRYMBO iron (Brymbo being a place in Wales), p. 153; CARNIVAL cigarettes, p. 145; COMPACTUM for umbrellas, *Davis' Tm.*, 14 R. P. C. 903; CYCLOSTYLE (for stationery and duplicating apparatus), *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156, *supra*, p. 149; ELECTRIC velveteen, p. 147; ELECTROID anti-fouling composition, *Hannay's Tm.*, 7 R. P. C. 46; EMOLLIO cream, *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612; EMOLLIORUM dubbing, *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12; FRIEDRICHSHALL

[1] *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J.

[2] *Burgoyne's Tm.*, 6 R. P. C. pp. 230, 232; 61 L. T. 39 (1889), Chitty, J. (*Oomoo*); and see *Ripley* v. *Bandey*, 14 R. P. C. 591 and 944 (1897).

[3] See Chap. IX., p. 212.

[4] *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. (*The Self-Washer*).

[5] See the *Alpine Tm.*, 29 C. D. 877 (1885).

[6] The pages referred to are those of this book.

[7] This was on the ground that a reference to the Princess would be imputed. See, however, *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118 (*Trilby* for gloves, blouses, &c.).

water, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. 186; 8 R. P. C. 137; Gem air-guns, p. 145; Granolithic stone, *Stuart* v. *Scottish Val de Travers Paving Co.*, 13 Sess. Cas., 4 Ser. 1; Hand Grenade Fire Extinguisher, *Harden Star, &c. Co.'s Tm.*, 3 R. P. C. 132; 55 L. J. Ch. 596; Herbalin (a medicine), *Humphries* v. *Taylor's Drug Co.*, 59 L. T. 820; Hunyadi Janos water, *Apollinaris Co.'s Tm.*, supra; John Bull and John Bull Brand beer, p. 155; Jubilee note paper, p. 145; Kokoko cotton goods, p. 151, note (1), and p. 152; Manor tin-plates, *Thompson's Tm.*, 6 R. P. C. 213; Melrose hair restorer, p. 146; Monobrut champagne, p. 151; Red, White and Blue coffee, *Hanson's Tm.*, 37 C. D. 112; 3 R. P. C. 130; Reversi (for a card game), p. 147; Roadster (for boots), *Thompson's Tm.*, 13 R. P. C. 35; Sanitas (for a disinfectant), *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166; Self-washer and The Self-washer soap, *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492; Shakspere (for cigarettes, &c.), *Banks and James' Tm.*, 12 R. P. C. 333; Tower tea, *Great Tower Tea Co.* v. *Smith*, 6 R. P. C. 165; Triticumina (for wheaten biscuits, &c.), *Meaby & Co., Ltd.* v. *Triticine, Ltd.*, 15 R. P. C. 1; Washerine soap, *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482; Zephyr Asiatic Walnut Pipe, *Friedlander's Tm.* (1885), W. N. 85.

The only reported instances of words decided to be within the clause are the words Alpine (for embroidery), p. 155, *Re Tm. Alpine*, 29 Ch. D. 877;[1] Bovril (for foods), p. 148, [1896] 2 Ch. 600; 13 R. P. C. 382; Mazawattee (for tea), p. 147, *Densham & Son's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271; Oomoo (for wine), *Burgoyne's Tm.*, 6 R. P. C. 227 (1889), supra, p. 152; Tabloid (for medicines and preparations of food), *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217; and The Lawford (for tennis racquets) (1885), W. N. 124 (Pearson, J.). The decision in *The Alpine* case was subsequently disapproved by the Court of Appeal,[2] and that in the last case is certainly not in accord with the interpretation subsequently put upon the clause under which the registration was allowed.[3] Great numbers of words have, however, been registered by the Comptroller as fancy words without objection.

[1] As to this decision see, however, *Van Duzer's Tm.*, and *Leaf's Tm.*, 34 C. D. 623; 4 R. P. C. 31.

[2] *Alpine Tm.*, 29 C. D. 877 (1885), Chitty, J.; see above, p. 146.

[3] See above, p. 155.

Invented words.

(3) "An invented word or invented words."

This paragraph is the same as clause (d), which was, with clause (e),[1] substituted for "fancy word or words not in common use" by sec. 10 of the Act of 1888, upon the recommendation of Lord Herschell's Committee which has been already quoted.[2] The leading authority on the present clause is *The Solio* case[3] in the House of Lords, in which several points were decided. Lord Halsbury, L.C., in his speech referred to the report of that Committee, and both he and Lord Herschell considered that the decisions on the expression "fancy word" had no bearing on the interpretation of the provisions substituted by the Act of 1888.[4] The House of Lords further overruled the decisions in several earlier cases, including that of the Court of Appeal[5] in *The Somatose* case, to the effect that clauses (d) and (e) of sec. 10 of the Act of 1888 must be read conjunctively, and not as alternatives. *The Solio* case came before the Courts on an appeal from the Comptroller's refusal to register the word *Solio* for photographic paper, the refusal being on the grounds (*inter alia*) that the mark did not consist of an essential particular, and that it had reference to the quality or character of the goods. Kekewich, J., and the Court of Appeal upheld the refusal to register,[6] on the ground that the word suggested the sun, and had reference to the character and quality of the goods, and that therefore (following the decision of the Court in *The Somatose* case) it was not registrable as an invented word. The Lord Chancellor did not deal with the point explicitly, but all the other members of the House who took part in the decision[7] said that clauses (d)

The Solio case.

[1] A word or words having no reference to the character or quality of the goods, and not being a geographical name.

[2] Above, p. 143.

[3] *Eastman Photographic Materials Co., Ltd.'s Application*, [1898] A. C. 571; 15 R. P. C. 476.

[4] This view had been previously expressed by Lindley, L.J., in *The Somatose* case, *Farbenfabriken Vormals Bayer & Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84.

[5] *Farbenfabriken, &c. Co.'s Tm.*, supra, note (4), Lindley, Kay, and Smith, L.JJ., all concurring on this point; the other cases overruled are *Meyerstein's Application*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J.; and *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12 (*Emolliolorum*), in which Stirling, J., followed the decision of Kay, J. In *Densham & Son's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 271, Lindley, Lopes, and Kay, L.JJ., took the same view, although, having regard to the facts, the point did not call for decision.

[6] 13 R. P. C. 707; (1896), W. N. 158, Kekewich, J.; and 14 R. P. C. 487; (1897), W. N. 48, Lindley, Lopes, and Rigby, L.JJ.

[7] Lds. Herschell, Macnaghten, Morris, and Shand.

and (e) must be treated as independent clauses, and there is no reason to suppose that the Lord Chancellor differed from their judgments. Lord Herschell said that he could not find any justification for qualifying the provision "(d) an invented word or words" by the condition that they should have no reference to the character or quality of the goods, and he went on to point out that under (e) any word in the English language might serve as a trade mark, and that different considerations therefore arose under clauses (d) and (e). "If, then, the use of every word in the language was to be permitted as a trade mark, it was surely essential to prevent its use as a trade mark where such use would deprive the rest of the community of the right which they possessed to employ that word for the purpose of describing the character or quality of goods. But with regard to words which are truly invented words—words newly coined—which have never heretofore been used, the case is, as it seems to me, altogether different; and the reasons which required the insertion of the condition are altogether wanting. If a man has rightly invented a word to serve as his trade mark, what harm is done, what wrong is inflicted if others be prevented from employing it, and its use is limited in relation to any class or classes of goods to the inventor? So far, then, from seeing no reason for a distinction between the particulars designated in (d) and (e), there seems to me abundant reason for not interpolating in (d) words which the Legislature has used only in relation to (e)."

(d) not qualified by (4).

Since *The Solio* case the law is therefore settled that an invented word is not debarred from registration as a trade mark by reason of its referring to the character or quality of the goods.[1] Lord Macnaghten said: "If it is an invented word—if it is 'new and freshly coined' (to adapt an old and familiar quotation)—it seems that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods. I do not think that it is necessary that it should be wholly meaningless." It was decided that the word *Solio* was an invented word, and accordingly capable of registration; and Lords Halsbury, Herschell and Macnaghten disapproved of the suggestion that

[1] *Kodak. Ltd.* v. *London Stereoscopic &c. Co., Ltd.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., at p. 350.

the word referred to the character or quality of the goods; in fact, one of the main reasons given by Lord Halsbury for his judgment was that the word did not indicate the character or quality of the goods.

Quantum of invention.

The determination of the standard of invention to be applied is both an important and difficult matter. It is clear from *The Solio* case that the mere fact that the word exists in a foreign language, whether modern or classical, is not sufficient to exclude a word, if it really is invented. Thus, neither the fact of the existence of an Italian word *solio* meaning throne, or of a Latin word in the ablative case with the same meaning, prevented *Solio*, which had, in fact, been invented for the purpose of a trade mark, from being entitled to registration.[1] On the other hand, the fact that the word is a foreign word does not make it an invented word in England.[2] It was said in the same case that words which are in sound ordinary English words, but are mis-spelt, are not eligible.[3] The following are passages from the judgments in *The Solio* case on this point. Lord Halsbury said: "I desire to give my opinion with reference to the particular word, and not to go behind it. I can quite understand suggesting other words—compound words, or foreign words—as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word *Cheapandgood*, or even without taking so gross an example, using a word so slightly differing from an ordinary and recognised word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. The line must be sometimes difficult to draw; but, to my mind, the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in substance there has

Foreign word not necessarily debarred.

[1] See also *Field, Ltd.* v. *Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1900), Buckley, J. (*Saronol*).

[2] See Ld. Herschell's judgment quoted below, p. 161.

[3] See especially Ld. Halsbury's judgment and that of Ld. Herschell. The point had been so decided by Kekewich, J., and the Court of Appeal in *Ripley's Application*, 15 R. P. C. 151 (1898) (*Pirle*). *Uneeda* has been held not to be an invented word, being a mere mis-spelling of "You need a": *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; [1902] 1 Ch. 783; 18 R. P. C. 170; 19 R. P. C. 281, Cozens-Hardy, J., and C. A. See also *Christy* v. *Tipper*, [1904] 1 Ch. 696; [1905] 1 Ch. 1; 21 R. P. C. 97, 755 (*Absorbine*), Joyce, J., and C. A.

been an infringement of the rule." Lord Herschell, referring to the observation of Kay, J., in *The Satinine* case,[1] that there was extremely little invention, said: "It may be that the word *Satinine*, which was there in question, was objectionable on other grounds, but if the word be an 'invented' one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases. It may, no doubt, sometimes be difficult to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form.[2] Again, I do not think that a foreign word is an invented word simply because it has not been current in our language. At the same time, I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest no meaning except to a few scholars, might not be regarded as an invented word. It is in this respect that I desire to qualify my assent to Lord Justice A. L. Smith's proposition that an invented word can never have a meaning." A passage from Lord Macnaghten's judgment is quoted above.[3] Lord Shand said: "I agree . . . . in thinking, especially after the decision to be given in this case, that the Comptroller-General will be fully warranted in taking care that there shall not be admitted, under the guise or cover of words called 'invented' by the applicant, words really in ordinary use, which might, in a disguised form, have reference to the character or quality of the goods. There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an 'invented' word, and a

[1] *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890).

[2] See *Uneeda* case, p. 160. note (3).

[3] Page 159.

word would not be 'invented' which, with some trifling addition or very trifling variation, still leaves the word one which is well known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word." In a subsequent case,[1] much reliance was placed on the last-quoted passage by the applicants, who were applying to expunge the registration of the word *Saronol*, which had in 1890 been registered for common and soft soaps. They contended that the French word *saron* was used in the soap trade in this country, and that *Saronol*, being merely the word *saron* with a termination, was not an invented word. Buckley, J., held the word to be an invented word, even although *saron* had been used as alleged, and said that he did not understand Lord Shand as meaning to express anything differing from the other Lords.

Variations of ordinary words.

Before the decision in *The Solio* case, registration of a word as an invented word was difficult to obtain, but it afterwards under the Act of 1888 became the practice at the Patent Office to accept for registration, as invented words, words which had very little invention indeed, but were merely ordinary English words having a slight variation in or a slight addition to them.[2] In such cases, however, the Comptroller required a disclaimer of the part formed by the common word, thus *Fireproofine* has been accepted with a disclaimer of "fireproof." It would seem that a disclaimer of the kind referred to does not help to qualify a word as an invented word,[3] although it may protect the public from what would otherwise be the consequence of registration. Thus an application to remove from the Register the word *absorbine*, which had been registered and used for an absorbent preparation, the exclusive use of "absorb" being disclaimed, was successful. The word was held to be a mere variation of the word absorb.[4]

The result of the cases is that a mere ordinary addition to, or misspelling or variation of, a word in use in the English language

[1] *Field, Ltd.* v. *Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1900).

[2] See an article entitled "Words as Trade Marks" in the Solicitors' Journal (1900), Vol. XLIV. 548, in which the following examples are given, namely, *Perfumette* for perfumes, *Enamcline* for blacking, &c., *Detergene* for goods in Class 47, *Glazo* for creams and polishes for leather, and *Fireproofine* for a fireproofing liquid.

[3] See the case next cited.

[4] *Christy* v. *Tipper*, [1904] 1 Ch. 696; [1905] 1 Ch. 1; 21 R. P. C. 97 and 755, Joyce, J., and C. A.; and cf. *Application of the Compagnie Industriele des Petroles*, [1907] 2 Ch. 435: 24 R. P. C. 585, Warrington, J., *Motorine* upheld under para. (4) of sec. 9.

does not make the word so formed an invented word, but the question in each case is one of fact.

Before the Act of 1905, letters not being essential particulars, the Comptroller objected to register names of letters;[1] however, since the definition of "mark" in sec. 3 includes "letter," it is assumed that there would not be the same objection under the present Act, provided, of course, that the mark was distinctive.

Inventor.

Questions have arisen with respect to the meaning of the expression "invented word," first, as to the person inventing the word, and, secondly, as to point of time to be regarded.

In *Holt's Trade Mark*,[2] Kay, L.J., expressed an opinion that, if the person who is seeking to register a word as an invented word has not been the inventor, or first user, he is not entitled to register it.[3] The Lord Justice was, however, dealing with a case in which there had been entirely independent prior use of the word. In the *Linotype Co.'s Application*,[4] Cozens-Hardy, J., held that it was not necessary that the applicant for registration should be the inventor of the word applied for. In that case the word, namely "Tachytype," had been invented by an American Company to distinguish their goods and had been used as part of the name of the Company, which had assigned such rights as it had in the United Kingdom in connection with the mark or name to the applicants. As to the point of time to be regarded, it was held in the case last cited that it was not necessary that there should have been no prior publication of the word in the United Kingdom before the application to register. Further, Swinfen Eady, J., decided in *The Kodak* case[5] that "if a word is 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 "Kodak" had been registered for photographic cameras in 1888, and had been used from that date for cameras and films,

Date of invention.

[1] *Vezt*, the Dutch equivalent of the letters V, Z, was allowed to be registered under special circumstances, and subject to a condition: *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905), Warrington, J.

[2] [1896] 1 Ch. 711; 13 R. P. C. 118 (*Trilby*, the heroine of Du Maurier's book of that name).

[3] See also the judgment of Smith, L.J., but Lindley, L.J. (and perhaps Smith, L.J.), decided the point on the ground that the word had become a well-known word.

[4] [1900] 2 Ch. 238; 17 R. P. C. 380.

[5] *Kodak, Ltd.* v. *London Stereoscopic, &c. Co., Ltd.*, 20 R. P. C. 337 (1903). Cf. the judgment of Lopes, L. J., in *The Borril* case, above, p. 148.

but it was not registered for films until 1891. It was held that the registration for films was good. In this case the goods, namely cameras and films, were of the same general description, namely, photographic, and the word had been applied to both substantially about the same time. In a later case[1] Warrington, J., held that in order that a word may be an "invented word," it must be coined for the first time for the purpose of being applied to the goods in question, or in other words, for the purpose of its use as a trade mark in this country; and he expressed the view, without deciding the point, that the word must be newly coined substantially at the date of the application to register it. It is submitted, however, that it is sufficient if the word was an "invented word" when first used as a trade mark for the goods, and has not by reason of other user of it, lost that character.[2] If, on an application to expunge a word mark, sec. 36 of the Act of 1905, which provides a saving for a trade mark registrable under that Act, is relied on, the proprietor of the mark must show that it is then registrable, and therefore, although the word may have been an "invented word" when first used for the goods, if it has become the name of the article, the section does not assist to save the mark from removal.[3]

A word already in existence cannot properly be said to be an "invented word," merely because the person claiming to have invented it was not aware of its existence.[4]

The following words have been held to be invented words within the meaning of the Act:—KODAK, *Kodak, Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337 (1903); KYNITE, *Kynoch & Co.'s Tm.*, 14 R. P. C. 905 (1897); MAZAWATTEE, p. 147, *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271; NEOSTYLE, *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 329 (1903);[5] SAVONOL, p. 162, *J. C. & J. Field, Ltd.* v. *Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1900); SOLIO, pp. 158, 159, *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476: TACHYTYPE, p. 163, *The Linotype Co.'s Application*, [1900] 2 Ch. 238; 17

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

[2] See the judgments of North, J., and the Court of Appeal in *Holt's Tm.*, [1896] 1 Ch. 711: 13 R. P. C. 118; and the *Tachytype* and *Kodak* cases cited above, p. 163.

[3] *Gesteuer's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545; [1908] 1 Ch. 513; 25 R. P. C. 156, Neville, J., and C. A. But see the judgment of Parker, J., in the *Diabolo* case, cited p. 165.

[4] Per Chitty, J., in *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166; 11 R. P. C. 517 (*Eboline*).

[5] The mark was, on appeal, removed from the Register on other grounds, 20 R. P. C. 803.

R. P. C. 380; VEZET, *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905).

The following words have been held not to be invented words within the meaning of the Act:—ABSORBINE, *Christy* v. *Tipper*, [1904] 1 Ch. 696; [1905] 1 Ch. 1; 21 R. P. C. 97 and 755; APOLLINARIS,* *Apollinaris Co.'s Tms.*, [1891]2 Ch. 186; 8 R. P. C. 137;[1] BIOSCOPE, *Warwick Trading Co.* v. *Urban*, 21 R. P. C. 240 (1904);[2] CYCLOSTYLE, *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545;[3] DIABOLO, *Philippart* v. *Whiteley, Ltd.*, 25 R. P. C. 565, (1908); EBOLINE,* *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166; 11 R. P. C. 517;[4] ELECTROZONE,* *British Electrozone Co.'s Application*, 13 R. P. C. 447 (1896);[5] EMOLLIOLORUM,* *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12;[6] FORMALIN, *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486 (1900);[7] HÆMATOGEN. *Hommel* v. *Gebrüder Bauer & Co.*, 21 R. P. C. 576; 22 R. P. C. 43 (1904);[8] PANORAM, *Kodak, Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337 (1903); PIRLE,* *Ripley & Sons' Application*, 15 R. P. C. 151 (1898);[9] SATININE,* *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890);[10] SOMATOSE,* *Farbenfabriken, &c. Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84;[11] TRILBY,* *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118;[12] UNEEDA, *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; 18 R. P. C. 170.[13] The cases in which an asterisk is placed against the word, were decided before the decision in *The Solio* case in the House of Lords.

(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."

Words having no direct reference to character or quality of the goods.

[1] *Friedrichshall* and *Hunyadi* were admittedly on the same footing as *Apollinaris*.

[2] It was held to be a known English word at the date of application for registration.

[3] It was held to be the name of a patented article at the crucial date.

[4] *Eboli* was shown to be the name of an Italian town of 11,000 inhabitants, and the application was for silk goods.

[5] The word was admittedly well known in the United States.

[6] The word was, in fact, registered under the Act of 1883.

[7] The word was held to be the name of the article.

[8] On the particular facts.

[9] This case was decided on the ground of the word being a mere mis-spelling of "pearl," which could not itself be registered. Kekewich, J., did not decide whether it was an invented word or not, and the decision of the Court of Appeal does not absolutely cover the point.

[10] See, however, Ld. Herschell's judgment in *The Solio* case.

[11] Ld. Herschell, in *The Solio* case, said that he thought it an excellent illustration of an invented word.

[12] That is to say, not at the date of registration.

[13] Held to be a mere mis-spelling of "You need a."

Act of 1888.

Clause (e) of sec. 64 (1) of the Act of 1883, as that section was amended by the Act of 1888, was as follows:—"A word or words having no reference to the character or quality of the goods, and not being a geographical name." The object of this clause was to permit ordinary English words to be registered subject to the maintenance of the right of the public to employ them in their ordinary meaning.[1] The decisions on the clause, however, and especially those prior to *The Solio* case,[2] tended to prevent the registration of words having a merely indirect reference to the character or quality of the goods; the framers of the Act of 1905 therefore introduced the word "direct" to qualify "reference" with the object of extending the class of registrable words,[3] or at all events of making the object of the Legislature more clear. Only two decisions on paragraph (4) of the Act of 1905 have been given by the Court. In the case of the word "motorine" registered in 1901 for lubricating oil with a disclaimer of the exclusive use of the word "motor," Warrington, J., applying sec. 36 of the Act of 1905, and therefore testing the word by the requirements of that Act, held that it had no direct reference to the character or quality of the goods.[4] Secondly, in *The Diabolo* case, Parker, J., held that, whether that word was tested by the Act of 1888, under which it was registered, or by the Act of 1905, it ought to be removed from the Register.[5]

Iteration made by Act of 1905.

As the decisions under the Act of 1888 may be important in applications to remove marks registered under that Act, and as, moreover, they have a bearing on the construction of paragraph (4), they are shortly stated here.

Test applied under Act of 1888.

The question under clause (e) was not whether the word which it was sought to place or retain on the Register had in fact any reference to the character or quality of the goods, but whether it had such a reference in appearance. For if it had, it must be either descriptive or deceptive, and in either case it was not entitled to be on the Register.[6] Under the Act of 1905 a deceptive mark is equally debarred from registration.[7] A

[1] See the judgment of Ld. Herschell in *The Solio* case, *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476, quoted supra, p. 161.

[2] See note (1).

[3] Kekewich, J., said in *Re Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436, that the Act of 1905 is an amending Act intended to bring within the area of registration many trade marks which could not otherwise be registered.

[4] *Compagnie Industrielle des Pétroles, Application*, [1907] 2 Ch. 435; 24 R. P. C. 585.

[5] *Philippart* v. *Whiteley, Ltd.*, 25 R. P. C. 565 (1908).

[6] *Edge's Tm.*, 8 R. P. C. 207 (1891) (*Filtered Blue*), Stirling, J.

[7] Sec. 11.

large number of the decisions on clause (e) have been in relation to words which, under the decision in *The Solio* case,[1] could be registered as invented words independently of the question whether or not they have a reference to the character or quality of the goods; and such decisions have now to some extent lost their importance. But in *The Solio* case,[2] Lords Halsbury, Herschell, and Macnaghten, differing from the view adopted by the Court of Appeal[3] that *Solio* would suggest the sun, and had therefore some reference to the character or quality of the goods for which it was used, namely, photographic paper, held that it had no such reference; and, in substance, the House of Lords overruled the earlier decision in *The Somatose* case,[4] of the Court of Appeal[5] that, having regard to the Greek word σωμα, meaning *body*, *Somatose* was not a word having no reference to the character or quality of the goods, which included preparations made from meat. On the other hand, the Court of Appeal had held that *Mazawattee*, which was compounded of the Cingalese word for *garden* and part of a Hindustani word meaning *luscious*, had no reference to the character or quality of the goods, which included tea.[6] Although clause (e) made it a condition of registration that the word should have no reference to the character or quality of the goods, this meant that in the general understanding of ordinary English people it must bear no such reference.[7] And the fact that an ingenious mind, knowing the class of goods to which the word is applied, can find some reference through etymology or otherwise to the character or quality of the goods is not fatal to registration.[8] Thus, the suggestion that *Trilby*, the name of the heroine in Du Maurier's book of the same name, when used as a mark for gloves, blouses, &c., would be taken to have a reference to such articles as were fit for such a person as the book describes, was said by Lindley, L.J., to be too fanciful and far-fetched.[9] Another example is the word *Kynite*, which

[1] See clause (d), p. 158.

[2] *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476.

[3] 14 R. P. C. 487, affirming Kekewich, J., 13 R. P. C. 707.

[4] *Farbenfabriken Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84.

[5] Smith and Kay, L.JJ., Lindley, L.J., dissenting.

[6] *Deasham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271.

[7] See the judgment of Rigby, L.J., in *Eastman Photographic Materials Co.'s Application*, 14 R. P. C. 407, and of Kekewich, J., in *The Linotype Co.'s Application*, 14 R. P. C. 900 (1897) (*Typograph*).

[8] See the judgment of L.J. Herschell in *The Solio* case, supra, p. 161.

[9] *Holt & Co.'s Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118; and see *Ellis & Co.'s Tms.*, 21 R. P. C. 617 (1904) (*Quaker*).

has been held not to contain, by reason of the resemblance of the first syllable to the root of the word *kinetic*, a reference to the character of the goods in question, namely, explosives.[1] If a word, not originally importing a reference such as the clause contemplates, comes to be known as the name of the article, it does not, by that fact, come to have a reference to the character or quality of the goods within the meaning of the section;[2] thus, although *Magnolia* had come to be known as the name of an alloy, it was held not to refer to the character or quality of the goods. But, of course, a word which is descriptive of the goods, when tendered for registration, is not entitled to registration.[3] And the business of the proposed user of the word may be regarded as well as the goods; thus, Kekewich, J., held that *Typograph*, a dictionary word meaning a type-making and type-setting machine, would, if registered by the Linotype Company for metals used in manufacture, have reference to the character or quality of the goods.[4] Words that would be understood to be commendatory were held not to satisfy the condition imposed by clause (e),[5] and a word that is a mere misspelling of a word that is not capable of registration is not admissible.[6]

Decisions under Act of 1888.

The following words were held not to be within clause (e), on the ground that they could not be said to have no reference to the character or quality of the goods:—APOLLINARIS,* for natural mineral waters, *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137;[7] BIOSCOPE, for cinematograph apparatus, *Warwick Trading Co.* v. *Urban*, 21 R. P. C. 240 (1904);[8] CENTURY, for machinery, *Printing Machinery Co.'s Application*, 23 R. P. C. 38 (1906);

[1] *Kynoch's Tm.*, 14 R. P. C. 905 (1897), Kekewich, J.

[2] *Magnolia Metal Co.'s Tms.*, [1897] 3 Ch. 371; 14 R. P. C. 621, Lindley, Lopes, and Rigby, L.JJ., differing from Kekewich, J., on this point.

[3] Thus, *Filtered Blue* for laundry blue is inadmissible: *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J.

[4] *Linotype Co.'s Application*, 14 R. P. C. 900 (1897).

[5] See the observations of Rigby, L.J., in *Ripley & Son's Application*, 15 R. P. C. 151 (*Pirle*); *Harrisons and Crosfield's Application*, 18 R. P. C. 34 (1901), Byrne, J. (*Nectar*); *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; [1902] 1 Ch. 783; 18 R. P. C. 170; 19 R. P. C. 281, Cozens-Hardy, J., and C. A. (*Uneeda*); and *Printing Machinery Co.'s Application*, 23 R. P. C. 38 (1906), Farwell, J. (*Century*).

[6] See the *Pirle* and *Uneeda* cases cited in the last note, and the judgments in *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476, also *The Absorbine* case above, p. 162.

[7] The mark was intended to be used for water from the *Apollinaris* spring. *Friedrichshall* and *Hunyadi Janos* were admittedly on the same footing. *Apollinaris* has now been declared to be a distinctive mark under para. (5 of sec. 9; *In re Apollinaris Tm.*, [1907] 2 Ch. 178: 24 R. P. C. 436.

[8] On the facts as to previous user.

EDGE'S FILTERED BLUE,* for laundry blue, *Edge's Tm.*, 8 R. P. C. 207 (1891);[1] EMOLLIOLORUM,* for harness, &c., *Talbot's Tm.*, 11 R. P. C. 77 (1894); HÆMATOGEN, for a medicine, *Hommel* v. *Gebrüder Bauer & Co.*, 21 R. P. C. 576 (1904); JOHN BULL,* for fermented liquors and spirits, *Paine's Tm.*, 9 R. P. C. 130 (1892);[2] NECTAR,* for tea, coffee and cocoa, *Harrisons and Crosfield's Application*, 18 R. P. C. 34 (1901); PANORAM, for a panoramic camera, *Kodak, Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337 (1903); PIRLE,* for cloth, &c., *Ripley's Application*, 15 R. P. C. 151 (1898);[3] SATININE,* for starch and soap, *Meyerstein's Application*, 43 C. D. 604; 7 R. P. C. 114 (1890): SOMATOSE,* for a pharmaceutical product principally consisting of ingredients of meat, *Farbenfabriken Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84; TYPOGRAPH,* for metals and certain machinery, *Linotype Co.'s Application*, 14 R. P. C. 900 (1897); U'NEEDA, for biscuits and other goods in Class 42, *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; 18 R. P. C. 170: [1902] 1 Ch. 783; 19 R. P. C. 281. The cases in which an asterisk is placed against the word, were decided before the decision of *The Solio* case in the House of Lords.

The following words have been held to have no reference to the character or quality of the goods:—BROWNIE, BULLSEYE, and KODAK, for films, *Kodak, Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337 (1903);[4] KYNITE, for explosives, *Kynoch's Tm.*, 14 R. P. C. 905 (1897); MAGNOLIA, for a metal alloy known by that name, *Magnolia Metal Co.'s Tms.*, [1897] 3 Ch. 371; 14 R. P. C. 621; MAZAWATTEE, for tea, *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75, 271; QUAKER, for fermented liquors, *Ellis & Co.'s Tms.*, 21 R. P. C. 617 (1904);[5] SOLIO, for photographic paper, *Eastman, &c. Co.'s Tm.*, [1898] A. C. 571; 15 R. P. C. 476;[6] TRILBY, for gloves, blouses, &c., *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118; VEZET, *Verschure and Zoon's*

[1] This mark was registered under particular types of camera.

the Act of 1883; the argument, as in *Talbot's Tm.*, infra, must therefore have been that, as it was good under the Act of 1888, it ought not to be expunged.

[2] The mark was actually registered under the Act of 1883, but see note (1).

[3] As being equivalent to pearl.

[4] It was suggested that the names were descriptive of films suitable for

[5] It was suggested that the name suggested goods suitable for Quakers, a suggestion that Farwell, J., described as fantastic.

[6] Per Ld. Halsbury, L.C., and Lds. Herschell and Macnaghten, although this was not the ground of the decision, which was that the word was an invented word within (d).

Application, 22 R. P. C. 568 (1905).[1] In addition to these decisions, in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), it was objected that the words *El Destino* on a label for cigars indicated, by the fact that the words were Spanish or Mexican, the character or quality of the goods, but this objection failed both at the trial and in the Court of Appeal. Also, Chitty, J., in *Burgoyne's Tm.*, 6 R. P. C. 227 (1889), came to the conclusion that, if the Act of 1888 applied, which he held was not the case, the word *Oomoo* would have been capable of registration under it, and presumably, therefore, he considered that it had no reference to the character or quality of the goods.

The only decisions of the Court on para. (4) of the Act of 1905 are those referred to on p. 166.

Not being a geographical name.

It is a further condition that the word should not, according to its ordinary signification, be a geographical name. The qualification "according to its ordinary signification" was added in the Act of 1905, and gives express effect to the decision in *The Magnolia* case referred to below. The report of Lord Herschell's Committee was to the effect that the registration of geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale,[2] but the Act contains no such limitation of the prohibition. The words "geographical name" are not equivalent to the "name of any place," and a word does not become a geographical name simply because some place of the earth's surface has been called by it. In *The Magnolia* case,[3] it appeared that in the United States, whence the metal had been imported, there were several places known by the name "Magnolia," but it did not appear that the goods had any connection with any of those places. Rigby, L.J., said: "It is, no doubt, shown by the evidence, that there are places in the United States called by the name 'Magnolia,' and if 'geographical name' in sec. 64, sub-sec. (e), were equivalent to the name of any place, 'Magnolia,' as the name of places mentioned in the evidence, would fall within the exception. But in our judgment, the phrase 'geographical name' in sec. 64, sub-sec. (e), ought not, in general, to receive so wide an interpretation. It must, we

Magnolia case.

[1] The objection to the word was that it was equivalent to the letters "V, Z," in the Dutch language.

[2] Quoted above, p. 143.

[3] *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and Lindley, Lopes and Rigby, L.JJ.

think, in the absence of special circumstances, be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word 'Monkey' is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. If, indeed, in its primary and obvious meaning, the word has reference to a locality, as the word *Melrose* in *Van Duzer's* case, or the word *Eboli* in *Sir Titus Salt & Co.'s* case (from which Mr. Justice Chitty declined to distinguish the derivative *Eboline*), it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word *Apollinaris*, given to the water from a spring known as the Apollinaris Spring. So, if 'Magnolia' had been the name of a place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the article manufactured in the place having the name."[1] It would seem that under the Act of 1905 the ordinary signification of a word must be considered apart from its application to the particular goods, but it may be that, where the ordinary signification depends on the context, the application to the particular goods is material.

The prohibition of the registration of a geographical name is not confined to the noun substantive, but extends to the adjectival form.[2] The mere fact that part of a word is a foreign word, and might therefore have some reference to the country where the word is known, does not make the word a geographical name.[3]

The decisions on the unamended Act of 1883 arising on the

[1] See also *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114: 16 R. P. C. 173, 611, Kekewich, J. (*St. Raphael*). On the appeal, it was not necessary, in the view the Court took, to decide the point whether the words were geographical.

[2] *In re Sir Titus Salt's Application*, [1894] 3 Ch. 166; 11 R. P. C. 517, Chitty, J. (*Eboline*).

[3] *Re Densham & Son's Tm.*, [1895] 2 Ch. 176: 12 R. P. C. 75 and 271 (*Mazawattee*).

question whether a geographical word could be registered as a "fancy word not in common use," will be found collected above.[1]

The following words have been held to be geographical names under the Act of 1888:—APOLLINARIS, *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137;[2] EBOLINE, *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166; 11 R. P. C. 517.[3] The following words have, on the other hand, been held not to be geographical names: MAGNOLIA, p. 170, supra; MAZAWATTEE, *Densham's Tm.*, p. 147, supra.[4] Also in *Pinto* v. *Badman*, 8 R. P. C. 181, the words EL DESTINO on a label were objected to on the ground of being geographical, but this objection was overruled.

Not being a surname.

A new statutory condition is introduced by the Act of 1905 that the word should not, according to its ordinary signification, be a surname, but in practice the Comptroller refused under the Act of 1888 to register surnames.[5]

Other Distinctive Words.

In addition to the classes of names, signatures and words, which may under paragraphs (1), (2), (3) and (4) of sec. 9 be essential particulars, the Act of 1905 allows registration of any distinctive name, signature, word or words not falling within such paragraphs, but an order of the Board of Trade or the Court declaring that the name, signature, word or words is or are to be deemed distinctive is necessary.[6] "Distinctive" is defined to mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. The rules made under the Act provide a special mode of application for registration of such marks.[7] Numerous words have now been registered by order of the Board of Trade under this paragraph,[8] but only in one case has the Court been asked to make an order, namely, in an application to register "Apollinaris."[9] An application was originally made to the Board of Trade, but the Board, under the power conferred on it by Rule 39, required the applicants to apply to the Court, one of the reasons for this course being that the word

[1] Ante, p. 152.

[2] See also *In re Apollinaris Tm.*, [1907] 2 Ch. 178; 24 R. P. C. 436.

[3] See p. 171, note (2).

[4] See above, p. 171, note (3).

[5] See official notice, 2nd ed. of this work, p. 731.

[6] See. 9 (5), coupled with the definition of "mark" in sec. 3.

[7] See Chap. IV., Registration of Trade Marks, above, at p. 82.

[8] Instances are given below, Appendix XXIII.

[9] *In re Apollinaris Tm.*, [1907] 2 Ch. 178; 24 R. P. C. 436.

had been removed from the Register under the repealed Acts.[1] The applicants, relying on the provision of the section that, in the case of a trade mark in actual use, the tribunal may take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods in respect to which it is proposed to be registered, adduced evidence to show that the mark was in fact distinctive. Kekewich, J., held that the applicants had established this fact, and made a declaration that the word ought to be deemed to be a distinctive mark within sec. 9. As the mark had, however, only been used in connection with the water from the particular spring, the applicants were required to give an undertaking not to use the mark except in respect of the water from their property at Neuenahr or in the neighbourhood thereof. It was suggested that the word only distinguished the water from the particular spring from other mineral waters, but Kekewich, J., held that it distinguished the goods of the proprietor of the trade mark from those of other persons, and that, that being so, it did not matter that it also distinguished the goods irrespective of the proprietor. As a general proposition, this might be open to criticism, but in the case before the Court, which was one of a monopoly in a particular product, so long as the mark was applied only to the water from the spring and belonged to the proprietors of the spring, no conflict could take place.

Paragraph (5) is more fully considered below in relation to distinctive marks generally.

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.

The policy of the Act is that *de facto* trade marks shall be registrable; paragraphs (1), (2), (3) and (4) are therefore supplemented by this general provision. By sec. 3 "mark" shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof. Practically all permanent symbols are covered by these words, but if there be any not expressly mentioned, it may nevertheless come within the meaning of "mark," for the word "include," and not the

[1] See above, pp. 153, 168.

word "mean," is used. It is not a fatal objection that the mark is capable of registration as a design.[1]

The corresponding clause of the Act of 1883 was as follows:—

(c) *A distinctive device, mark, brand, heading, label or ticket.*[2]

It will be observed that distinctive letters and numerals, and distinctive combinations of which they form part, are as well as distinctive names, signatures and words, added to the things which under the previous Acts could constitute essential particulars.

Sec. 9 contains the following definition of the term "distinctive":—

> "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."[3]

This definition merely expresses what was law before the Registration Acts, that, in order to be a trade mark, a symbol must be capable of distinguishing the goods upon which it is placed from similar goods, so as to identify them with the business of the proprietor of the mark.[4]

"Distinctive."

The word "distinctive" standing alone in clause (c) of the Act of 1883, and coupled with *special* in relation to old marks,[5] has been construed in a number of cases. In *Leonard and Ellis'* case, Fry, L.J., expressed an opinion that the words *special and distinctive* of sub-sec. (3) (ii.) of sec. 64 "import the specialising of the make and manufacture of a particular maker from all other manufacturers, and distinguishing the manufacture of one person from the manufacture of all others."[6] In *Wood v. Butler*,[7] Lindley, L.J., said that distinctive trade mark "must mean some mark which distinguishes the goods to which

[1] *United States Playing Card Co.'s Application*, [1908] 1 Ch. 197, Swinfen Eady, J.

[2] Sec. 64 (1) (c). "Distinctive" governed each of the words which followed it, *Waterman* v. *Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888), C. A.; *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J.; *Piric* v. *Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, C. A.

[3] See the judgment of Kekewich, J., in *The Apollinaris* case, referred to above, p. 173.

[4] See Chap. II., p. 22; *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. 707 (1879), and *Hopkinson's Tm.*, [1892] 2 Ch. p. 121; 9 R. P. C. 102, Kekewich, J.

[5] Below, p. 198. Cf. the meaning of distinctive in sec. 74 of the Act of 1883, *Faulder's Tm.*, 18 R. P. C. 535 (1901), C. A.

[6] 26 C. D. p. 304; 53 L. J. Ch. 612 (1884), C. A., *Valvoline* for valve oil.

[7] 32 C. D. 247; 3 R. P. C. 81 (1886), *Elon* for cigarettes, claimed as an old mark; followed in *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish graphite* pencils), a passing-off case; see the decision of C. A., 18 R. P. C. 27.

it is attached as those made or sold by the person who uses the mark"; and Fry, L.J., repeated his definition from the earlier case. The whole Court held that it was *not* sufficient for the mark to be distinctive as regards the trade; it must be distinctive in the eyes of the ultimate customers, the consumers. "It ought," said Lopes, L.J., "to be a special and distinctive mark, not only recognisable by the trade, but also recognisable by the consumer, as connecting the article with the manufacturer." So that, as the proprietor of the mark had put upon the boxes in which his goods were enclosed words suggesting that they were made, not by him, but by a foreigner, although the suggestion was, as the trade knew, false, he had by his own act prevented the mark from being distinctive.

Lord Halsbury, in *Perry-Davis & Son* v. *Harbord*,[1] defined the word in similar language to that of Fry, L.J., quoted above; distinctive, he said, "means distinguishing a particular person's goods from somebody else's,—not a quality attributed to the particular article, but distinctive in that respect that it means that it is a manufacture of his distinguished from somebody else's." And he held that the word *Pain-killer*, as applied to a patent medicine, was neither special nor distinctive.[2]

"The essence of a trade mark," said Kay, J., in *Richards* v. *Butcher*, "is that it is some distinctive thing which points out that the goods are the goods of A. B."[3]

And in *Hopkinson's Trade Marks*[4] Kekewich, J., said: "In order to protect a trade mark before the Act, you were obliged . . . . to prove by evidence, and satisfy the Court, that the words used as a trade mark were known in the market, and—I think it is Lord Westbury's phrase[5]—gave a vendible character to the articles to which they were attached, made these articles

[1] 15 App. Ca. p. 320; 7 R. P. C. 336 (1890). *Pain-killer* claimed as an old mark for medicine.

[2] So also did Ld. Morris, in the House of Lords, and Fry and Lopes, L.JJ., in the Court of Appeal.

[3] [1891] 2 Ch. p. 536; 8 R. P. C. 249, Kay, J., and C. A. *Monopole* for wines. In each of the three cases last referred to, the marks were claimed as special and distinctive words used as trade marks before August 13th, 1875. They were all rejected.

[4] [1892] 2 Ch. p. 121; 9 R. P. C. 102. *J. & J. Hopkinson* for pianos, claimed and allowed as an old mark. In *Dewar & Son, Ltd.* v. *J. H. Dewar*, 17 R. P. C. 341 (1900), Lord Kyllachy said he was not satisfied that the words *Dewar's Whisky* were, assuming use prior to 1875, "special and distinctive."

[5] *The Leather Cloth Co.* v. *The American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), cited above, p. 52.

recognised as coming from a particular manufactory, and so gave them a character different from every other article in the trade. Therefore it seems to me that the Legislature here[1] did no more than adopt the language of the cases."

Farwell, J., has differentiated the cases of old and new marks thus: "In the case of an old trade mark the word 'distinctive' means that it does in fact distinguish the goods of the plaintiff as his manufacture or selection from the goods of all other persons. That of course is a question of historical fact which can be determined by circumstances which have gone before. In the case of a new mark, of course, that cannot be so, but it means that the mark must be capable of distinguishing the goods of the plaintiff as his manufacture, or selection, from the goods of all other persons.[2]

James' Tm. In *The Dome Black Lead* case[3] Lopes, L.J., put a somewhat different interpretation on the word *distinctive*. It means, he said, "that it must be a mark or device of such a kind as, in case of infringement, it shall be clear what it is that is being infringed, and that the mark is something distinct from all other marks used in the same class of goods." And the Court of Appeal there held that, upon the evidence, a sketch of a short cylinder terminated by a hemisphere was a distinctive design for black-lead, which was in fact made up for sale in pieces of the shape shown by the sketch. There is, however, no disagreement between the two interpretations, and on consideration it will be seen that the first assumes the second, for no mark can distinguish the goods which bear it from all similar goods, or can create a species within the genus, unless it has itself some recognisable and characteristic peculiarity to separate it from other marks which may be found upon some or all of them. Moreover, a mark which satisfies the second test, and possesses such a peculiarity as is referred to, if this is recognised with sufficient readiness as a peculiarity, must of necessity, when it becomes known, distinguish the goods which bear it in the manner required by the test suggested by the *dicta* first cited. In the case of new marks which have, and can have, acquired no connection by reputation with their owner, all that can be

[1] *I.e.*, by the use of the phrase "special and distinctive" in the old mark clauses of the Acts.

[2] *Louise & Co., Ltd. v. Gainsborough*, 20 R. P. C. 61 (1903).

[3] *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

demanded of the mark is that it shall be capable of distinguishing the goods to which it is applied in the required manner, and this accords with the old law.[1]

Effect of user to be considered.

Section 9 provides that, in determining whether a trade mark is so adapted—*i.e.*, to distinguish the goods of the proprietor of the trade mark from those of other persons—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. This is an important enactment operating in favour of owners of trade marks which have been used but not registered. There are many such marks which were not registrable under the previous Acts, and as to which it could not, apart from distinctiveness gained by use, be said that they were distinctive, that is to say inherently distinctive. The present Act allows them to be registered if in fact they operate to distinguish the owner's goods.

Meaning of "distinctive."

In order to be distinctive, then, a mark must be different from other marks used upon or in connection with the same goods, and the difference must be such as, in the case of a mark already used and known, to distinguish the goods which bear it as the goods of its proprietor; or, in the case of a new mark, to be capable of so distinguishing, and to be likely when used and known, to so distinguish, the goods. Three questions arise upon this:—(1) What are the other marks from which a mark under consideration is to differ? (2) What kind and degree of difference will suffice? and (3) What is the function of evidence in the determination of the inquiry? The second and third questions may be more conveniently considered in connection with the restriction put by sec. 19 upon the registration of marks which too nearly resemble previously registered marks.[2]

Questions to be considered.

1. What Marks are to be distinguished.

Common marks.

In many trades there are a great number of common marks, which have been generally adopted for ornament or some similar purpose, or which—having been in the first instance appropriated as trade marks—by abandonment,[3] by wide-spread piracy,[4] or, in

[1] See Chap. II., p. 35.

[2] Chap. X., at p. 234. As to question (2), see also below, p. 183.

[3] See below, p. 370.

[4] See *Ford* v. *Foster*, 7 Ch. 611; 27 L. T. (N. S.) 219 (1872), C. A. See p. 38, above; also *Ripley* v. *Bandey*, 14 R. P. C. 591 and 944 (1897), Kekewich, J., and C. A.; and Chap. XIV., p. 362.

the case of word marks, by becoming the names,[1] and therefore descriptive, of the goods, have become *publici juris*. And a mark, to be distinctive, must be distinguishable from all of these.

The Orr-Ewing case.

Thus the committee of experts appointed under the Act of 1875,[2] to classify the marks tendered for registration in respect of cotton goods, rejected some marks bearing arrangements of elephants, lions, and crowns, on the ground that such devices or symbols in themselves, and by reason of the extensive use by the trade of lions and demi-lions, and crowns and elephants, were not private property, and did not possess a distinctive character; and on the appeal from the Registrar's refusal to register, evidence was given that among the marks rejected by the committee were 31 crowns used by 18 different firms, 52 elephants used by 30 different firms, and 137 lions and demi-lions used by 64 different firms.[3] In the same case it was shown that triangular tickets in green and gold were in common use in the cotton trade.

In the early years of the existence of the Register, a number of common marks were accepted and placed upon it in ignorance of their true character. The committee of experts, to which reference has been made, was instituted to assist the Registrar, and, after 1884, the Comptroller, in determining what marks were common in the cotton class, and it was the practice of these officers in other cases to consult the representatives of the trade concerned on the subject.[4]

What marks are common.

It is clear that such marks as those above referred to, which are in common use in the trade, must be standards of comparison by which the distinctiveness of a new mark may be tested;[5] and some assistance in determining when a mark is to be taken to

[1] See Chap. II., p. 37.

[2] See Chap. VII., p. 121.

[3] *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. p. 485; 48 L. J. Ch. 707 (1879); and see *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878); and *Hyde & Co.'s Tm.*, 7 C. D. 724; 54 L. J. Ch. 395, n. (1878), both Jessel, M.R.

[4] Per Jessel, M.R., in *Kuhn's* case, supra. See also sec. 64 (14) of the Act of 1905.

[5] See *Bryant and May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.; the cases cited in note (3); *Anderson's Tm.*, 26 C. D. 409; 53 L. J. Ch. 664, Chitty, J.; affirmed on appeal, 54 L. J. Ch. 1084 (1884); *Thewlis and Blakey's Tm.*, 10 R. P. C. 360 (1893), North J., *Ancross* rejected because anchors were common in the trade; and *Hudson's Application*, 24 R. P. C. 582 (1907), Joyce, J., "*The Thunderer*" for whistles; *Anglo-Swiss Condensed Milk Co.* v. *Pearks, Gunston and Tee, Ltd.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A., "*Milkmaid*" for butter.

be in common use may be obtained from decisions on the repealed Acts. Thus, sec. 64 (1) (c) of the Act of 1883, repealed by the Act of 1888, allowed "fancy words not in common use" to be registered, and on this it was held, that use by several firms in the trade in question, and by others in different trades, was comm ı use.[1] In *The Washerine* case[2] Chitty, J., held, that marks might be *common to the trade* within sec. 74 of the Act of 1883, though not publicly used by more than three persons, as required by sub-sec. (3), and that the words did not mean "in common use in the trade," but "open to the trade," and this interpretation was adopted by Kekewich, J., in *The Apollinaris* case.[3] Chitty, J., gave as an example the case of a mark widely used and then abandoned by all but two or three persons in the trade. In *The Apollinaris* case the word in question was the name of a mineral water which might have been sold by the proprietors to other traders than the claimants of the mark, although they were, for the time, the sole importers of it. And in *The Herbalin* case[4] the word had been extensively used before registration both by the plaintiff and by the defendant. The cases cited in this paragraph were all cases of descriptive words.

In *The Stone Ales* case[5] Lindley, L.J., expressed an opinion that a mark used by one person in the trade only could not be common to the trade.

A mark may be distinctive although there are in use in the trade a number of marks embodying somewhat the same idea. Thus in a case in which the use of a star was held to be *publici juris*

[1] *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. p. 172; 5 T. L. R. p. 232, North, J. (1889), *Tower Tea*; and see above, p. 155. Cf. also sec. 74 of the Act of 1883, and the decisions on "distinctive" and "common to the trade" in that section. Distinctive there meant *prima facie* distinctive: *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson* v. *Miller*, 13 R. P. C. 35 (1895), Stirling, J. (*Roadster*); *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37, 535, Kekewich, J., and C. A. (*Silverpan*).

[2] *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889).

[3] [1891] 2 Ch. p. 209; 8 R. P. C. 137.

[4] *Humphries* v. *Taylor Drug Co.*, 59 L. T. 820; 5 T. L. R. 41, Kekewich, J. (1888)

[5] *Thompson* v. *Montgomery*, 41 C. D. p. 49; 6 R. P. C. 404 (1889). In *Ripley* v. *Bandey*, 14 R. P. C. 591 (1897) (*Oval Blue*), the defendants were proceeded against for selling blue in an oval shape similar to that employed by the plaintiff, from which his goods had acquired the name *Oval Blue*. Kekewich, J., held that the name had not fallen into common use, although the oval shape had been used by three other persons, but he also held that the plaintiff failed owing to his neglect to enforce his rights against the other users—a result tantamount to holding the shape to be common. On an appeal the case was settled: 14 R. P. C. 914.

in the tobacco trade, the registration of a particular form of star was upheld,[1] and in another case it was held that, although a diamond was present as part of a complex figure in many marks used in the trade, a simple diamond was a good trade mark.[2] Where a mark has been long registered the *onus* of proving that it was common when registered is not discharged by proving occasional and slight user by other persons.[3]

If a trade mark contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade, or the Court, may require, as a condition of the mark being upon the Register, that the proprietor shall disclaim any right to the exclusive use of all or any portion of such matter or make such disclaimer as they shall think needful for the purpose of defining his rights under such registration.[4]

The question how far marks which are or have been used by one or more persons in the trade, but which are not commonly used, or common to the trade in the sense just suggested, and which are not trade marks, ought to be regarded—in judging whether a mark tendered for registration is distinctive—has been the subject of some decisions.

Other trade marks, registered or unregistered.

Where any marks already in use are trade marks, whether registered or unregistered, it is clear that they are obstacles to the registration of any mark which so closely resembles them as to be calculated to deceive, unless the applicant has an independent trade mark right in the mark he puts forward.[5] This is expressly enacted by sec. 19, in regard to registered trade marks;[6] and it follows, in the case of unregistered trade marks, from the prohibition placed by sec. 11 upon the registration of any matter, the use of which, by reason of its being calculated to deceive or otherwise, would be deemed disentitled to protection in a Court of Justice.[7] Apart from these sections, however, the marks in use in the trade at the date of registration may have to be regarded in considering whether a particular mark is distinctive.

[1] *Dexter's Tm.* and *Wills' Tms.*, [1893] 2 Ch. 262; 10 R. P. C. 269.

[2] *Bass, Ratcliff and Gretton, Ltd.'s Tm.*, [1902] 2 Ch. 579; 19 R. P. C. 129, 529, C. A. See also *Star Cycle Co., Ltd.* v. *Frankenburgs*, 24 R. P. C. 46, 405 (1907), a passing-off case.

[3] *Boord & Son* v. *Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland. And see the judgment of Moulton, L.J., in *Star Cycle Co.* v. *Frankenburgs*, supra.

[4] Sec. 15.

[5] Cf. Chap. XV., pp. 411 *et seq.*, Infringement, and see sec. 21 as to concurrent user.

[6] Chap. X., p. 221.

[7] Page 266.

In *Bass'* case the Court was considering whether Bass' diamond which had been registered as an old mark was distinctive when registered, and it was objected that a diamond was in common use in the trade. Vaughan Williams, L.J., in giving judgment, said, after stating that the question was whether Messrs. Bass' mark of the simple diamond was distinctive: "In order to judge whether it is distinctive, you must look at the other trade marks which, it is alleged, were in use at that time. I do not know that they need be actual marks. Probably they could not very easily be trade marks if they were very similar and used by several persons—three or four or whatever the number might be—because they might indicate apparently any one of those four manufacturers of beer; but you have to compare the simple diamond trade mark as used by Messrs. Bass before they registered with the marks which were in use at that time."[1] A mark which is calculated to deceive the public by leading them to believe that it is the trade mark of some person other than its proprietor, or that the goods sold under it are the goods of another person, cannot generally be distinctive in accordance with the explanations of the term given in the judgments cited above.[2] In the very extraordinary circumstances of the case of *Mouson* v. *Boehm*,[3] it was held that a trade mark which had been registered at a time when a similar and previously acquired unregistered trade mark for the same goods was in existence might be allowed to remain on the Register, on the ground that the later mark had been registered in good faith and in ignorance of the earlier unregistered mark, and had remained unchallenged on the Register for two years, during which time it had been extensively used in its proprietor's business; but the case was treated as exceptional, and the earlier trade mark was admitted upon the Register also.[4]

Abandoned trade mark.

But an abandoned unregistered trade mark is, as such, no obstacle to the registration of a similar mark,[5] that is, unless it has become a common mark in the trade.

Marks used in advertisements.

Besides common marks and trade marks, there are, however,

[1] *Bass, Ratcliff and Gretton, Ltd.'s Tms.*, 19 R. P. C. 529 (1902).

[2] See below, Deceptive Marks, pp. 266 *et seq.*

[3] 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J. The facts are stated below, p. 411. Cf. *Verity's Tm.*, 19 R. P. C. 58.

[4] See sec. 21 as to concurrent user, below, p. 264.

[5] See *Mouson* v. *Boehm*, cited supra, note (3), and *Paine & Co.* v. *Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A. (*John Bull beer*).

other marks used by traders in their businesses; for instance, marks employed in advertisements, or in the "get up" of his goods by a single trader. Are these to be taken as standards in estimating the distinctiveness of a new mark? This, it is submitted, depends upon the extent to which they are known and used. Thus in *Louise* v. *Gainsborough*[1] it was held that the celebrated "Duchess of Devonshire" picture was not rightly registered as a trade mark for hats, &c., because it had at the date of registration been in common use in the trade in almost every way except by impression on the goods. And it would be a great hardship to compel a rival trader to omit a material part of a well-known advertisement of his trade, because someone had registered it as a trade mark. If a mark is well known in connection with a particular trader, though not used as a trade mark by him, its use upon the goods of another would be likely to identify them with him rather than with the latter, and it would not, therefore, be distinctive in regard to such goods, in the sense explained. So Kekewich, J., refused to direct the registration, as a trade mark for wire-bound indiarubber hose, of a device consisting of a sketch of an elaborate knot of the hose, on the ground that it too closely resembled a picture of similar hose printed by the opponents in their price lists, notwithstanding that the device in question had been employed as an advertisement by the applicants in their own price lists, and was registered as their copyright design.[2] The matter is, however, different where no deception can result. Thus the mere user in a different locality of a mark on a price list was held not to invalidate the subsequent registration of the mark by another trader.[3] It would be very onerous on a trader to expect him to discriminate all the marks used by his fellow traders, otherwise than as recognised trade marks, in connection with their businesses, on peril of having his trade mark removed from the Register.

[1] 20 R. P. C. 61 (1903). Farwell, J., held that it had been used in a way which would be an infringement; as to this, see below, p. 395. See also *Anglo-Swiss Condensed Milk Co.* v. *Pearks, Gunston and Tee, Ltd.*, 21 R. P. C. 261, C. A. (1904), where some of the users were merely as ornamentations.

[2] *Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893).

[3] *Verity's Tm.*, 19 R. P. C. 58, Buckley, J. (1902). The trade mark had at the date of the application to rectify been on the Register for thirteen years.

2. What Degree of Distinctiveness is required.

What degree of distinctiveness is required.

The question, what degree of difference from other marks will entitle a mark to be registered, is considered in the chapter dealing with restrictions on registration, and, in particular, with sec. 19.[1] In addition to what is there said, it may be pointed out that, although a mark offered for registration may be fairly distinguishable from each of several others, yet the existence of these, if they are in use, opposes a cumulative weight of objection to any new mark which has an apparent resemblance to a number of them.[2]

Secondary distinctive meaning.

A secondary meaning acquired by user in connection with the applicant's goods, which would have sufficed to create trade mark rights in an apparently descriptive mark before the Acts,[3] did not enable such a mark to be registered under the repealed Registration Acts, unless it was used as a trade mark before August 13th, 1875. In *The Stone Ales* case[4] the mark *Stone Ale* was removed from the Register on the ground that there was no evidence of its separate user as a trade mark before the date mentioned, although its secondary meaning was not only fully established, but was the basis of the injunction granted against the defendant in the case. Now, however, it is possible to register a word which has acquired a secondary meaning as indicating the goods of the applicant only if it can be shown that it is distinctive in actual use.[5]

Colour.

If a trade mark is limited in whole or in part to one or more specified colours, in such case the fact that it is so limited is, under the Act of 1905,[6] to be taken into consideration by any tribunal having to decide on the distinctive character of the mark. This provision is a new one, and reverses the practice under the previous Acts.[7] Apart from any such limitation, a trade mark is to be deemed registered for all colours.[6]

Descriptive Marks.

Descriptive marks.

According to the construction placed upon the Acts, a descriptive mark cannot be distinctive. So that any mark which describes the goods, their quality, or the purpose to which they

[1] Page 234.

[2] Cf. below, pp. 248, 249.

[3] Chap II., at p. 37.

[4] *Thompson* v. *Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal on this point to the House of Lords. As to old marks, see below, p. 201.

[5] Sec. 9 (5).

[6] Sec. 10.

[7] *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., red, white

are to be applied, is not registrable, and this rule has been applied far more strictly than that which rejected mere descriptive words as trade marks before the Acts.[1] The subject is discussed under the head of Word Marks, above.[2]

Device.

Devices as trade marks.

Devices have been registrable under all the Acts. They are the oldest, and, in many ways, they form the most valuable, kind of trade marks. Before the description of shops and factories by street and number became the common and convenient method of identification, every trader had his characteristic "sign," and it was an obvious and natural step to transfer the sign from the shop to goods which it was desired to show had come out of it. And this was done in very early days. Fragments of classic pottery bear the potter's mark of their maker, and, to come to later times, the early editions of the Aldine Classics bear the device of a dolphin wound round an anchor.[3] A good trade mark which has a device as its central feature has this peculiar advantage, that its use is not restricted to customers who speak any one language. It is not, of course, necessarily equally useful or distinctive everywhere. For instance, pictures of a stag and a buffalo, though perfectly different to people who are acquainted with the forms of both animals, might well be indistinguishable by the inhabitants of some of the Pacific islands where no quadruped is known which is larger than a pig, and who would have no name for either. The chief objection to a device trade mark is the difficulty of choosing one which shall be sufficiently simple and striking to fix itself in the customer's memory, and shall readily suggest a name or description by which it can be referred to, and yet, at the same time, be distinguishable from the other marks in use for the same goods or description of goods.

Word or letter is not a device.

It was decided under the Act of 1875, which did not, except in the case of old marks, provide for the registration of words, that a collection of English letters,[4] or a single letter,[5] could not, but

and blue in three parallel stripes. See as to old marks, *Bass, Ratcliff and Gretton's Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 529, where the Court reserved the question whether colour could enter into the distinctiveness of old marks. And see below, pp. 209, 210.

[1] Chap. II., at p. 37.

[2] Pages 142 *et seq.* As to descriptive devices, see p. 187.

[3] Salaman on Trade Marks, p. 1.

[4] *Ex parte Stephens*, 3 C. D. 659; 46 L.J.Ch. 46 (1876), Jessel, M.R. (*Aeilyton*).

[5] *Mitchell's Tm.*, 7 C. D. 36; 46 L. J. Ch. 876 (1877), Hall, V.-C., application to register A., as an old mark for pens, refused.

that a word printed in Oriental characters might, be registered as a device.[1] Under the Act of 1905, letters and numerals are included in the term "mark,"[2] and can be registered, if distinctive.[3]

Portrait of inventor.

The portrait of a person, for instance the portrait of the manufacturer of the goods in question, may be a distinctive device, and as such capable of registration.[4] But a particular portrait may be common to the trade, for instance if it is that of the inventor of a process of manufacture which is open to the public, and if goods made according to the process are known and described by reference to the inventor. Thus in *Anderson's* case[5] a device consisting of a portrait of Baron Liebig, with the words *Brand* above and *Baron Liebig* below it, was rejected as a trade mark for Liebig's extract of meat, on the ground that the words *Baron Liebig* were open to the trade,[6] and that the portrait of the inventor of the goods was descriptive of the goods. In this case, Chitty, J., found[7] that it was a common practice for those engaged in trade to place a photograph of the inventor on the particular article in order to show that he was the inventor, or to show in the particular case that the article was made according to his invention. But it would appear that, having regard to *Rowland* v. *Michell*,[8] if such a practice is relied on to show that a portrait is not distinctive, it must be proved to exist in the particular trade. Registration of a portrait as a trade mark would only confer on the proprietor the right to stop the use of another portrait as being an infringement, if there was not a substantial difference between the two portraits.[9] Portraits of living persons or of persons recently dead cannot be registered

[1] *Rotherham's Tm.*, 11 C. D. 250; 14 C. D. 585; 49 L. J. Ch. 511 (1878), Bacon V.-C., and C. A. (*Tod* in Arabic). Cf. *Gout* v. *Aleploglu*, 6 Beav. 69, n. (1833) (*Pessendede* (*i.e.*) *warranted* in Turkish).

[2] Sect. 3.

[3] Sec. 9 (5). The Comptroller, under the repealed Acts, refused to register words in sound merely equivalent to the names of letters, but the reason for this, namely, that letters could not be registered, is now gone. Under special circumstances the Court allowed the registration of "Vezet" in *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905).

[4] *Rowland* v. *Michell*, [1897] 1 Ch. 71; 13 R. P. C. 457; 14 R. P. C. 37, Romer, J., and C. A.

[5] 26 C. D. 409; 53 L. J. Ch. 664, Chitty, J., and on appeal, 54 L. J. Ch. 1084 (1885); see *Liebig, &c. Co.* v. *Anderson*, 55 L. T. 206, Chitty, J.

[6] So held in *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. (N. S.) 298 (1867).

[7] Basing his finding on the judgment of the Court of Appeal, and particularly of Cotton, L.J., in an action of *Liebig's Extract of Meat Co., Ltd.* v. *Anderson*, 55 L. T. 206.

[8] See judgment of Lindley, L.J., [1897] 1 Ch. 74; 14 R. P. C. 44.

[9] See note (4), ante.

without the consent of such persons or their legal representatives, as the case may be, if the Registrar require such consents.[1]

Part of mark common to the trade.

Under the Act of 1905, the system of the Act of 1888, by which an applicant had to disclaim the exclusive use of matter added to an essential particular,[2] is discontinued. But matter common to the trade is liable to be required to be disclaimed,[3] as it was under the earlier Acts.[3] In *Baker* v. *Rawson*,[4] where a lighthouse, surrounded by two concentric circles, with initials and a date between them, had been registered in 1877 as a new mark, although the circles were in fact common to the trade, an application was made to remove the mark from the Register. North, J., held that the circles ought not to have been registered, but as the whole mark had been used for a number of years, instead of ordering its removal, he directed a note, stating that the circles were common to the trade, to be put upon the Register. It will be noticed that the mark had been registered under the Act of 1875, which contained no provision for disclaimer at all, but registration with disclaimer had been approved under it.[5]

Combination device.

A combination of devices which are common to the trade may form a new and distinctive device.[6] The test by which any such combination must be tried is, it is submitted, correctly stated in the following passage from the report of Lord Herschell's Committee.[7] The Committee say: "In this connection we may refer to a point which has been the subject of considerable controversy, namely, how far registered or common marks when combined together are to be regarded as a new mark. We think that the juxtaposition of two or more such marks is not, if there be nothing more than this, a combination constituting a new mark. An important test appears to be whether the existing marks are so combined as to suggest a new idea. For instance,

[1] Rule 15 below, p. 657. See also *Carroll's Application*, 16 R. P. C. 82 (1899), Kekewich, J. (*Princess Christian*).

[2] Secs. 64 (2) and 74 of the Act of 1883, as amended by the Act of 1888.

[3] Sec. 15. See Chap. IX., p. 212.

[4] 45 C. D. p. 533; 8 R. P. C. 89 (1890); see also *Kuhn's Tm.*, 53 L. J. Ch. 238, n. (1878), Jessel, M.R., where registration with a disclaimer was approved under the Act of 1875. See now sec. 15, Chap. IX., p. 212.

[5] By Jessel, M.R., in *Kuhn's Tm.*, 53 L. J. Ch. 238, n. (1878).

[6] The mark must be looked on as a whole; see Chap. X., at p. 240, and below, p. 192, "Label," and, for an instance, where a number of common and some distinctive elements combined together did not form, as wholes, distinctive combinations: see *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; and Ld. Cairns' judgment, p. 484 (quoted above, p. 134); 48 L. J. Ch. 707, 708 (1879); and see the order made, 4 App. Ca. p. 503.

[7] Report of 1888, p. ix. The passage follows that upon the "idea of a trade mark," cited at p. 237.

assuming a cat and a fiddle to be each an old mark, we do not think that the mere representation of a cat and a fiddle together would be a new mark, but the representation of a cat playing upon a fiddle, the idea conveyed by which would be neither the cat nor the fiddle, but a cat playing upon a fiddle, would be a good combination, and might properly be registered. We think that this view differs somewhat from that which has been at times, at all events, entertained by the Board of Trade, but it appears to us to be the sound one."

A combination of devices or labels may be registered as a single trade mark, even although the intention is to use them so that they cannot all be seen at once, where for instance some of the marks are intended to be placed outside and some inside a package of goods.[1]

Devices descriptive of the goods.

It has been held, in the case of word marks, that descriptiveness is inconsistent with distinctiveness, and it would seem to follow generally, that marks which are descriptive of the goods to which they are to be applied are not within the Acts. In the opinion of Lord Herschell's Committee,[2] such marks are not legitimate, and after the Committee's report the Comptroller refused to accept them. This opinion is in accordance with the judgment of Pearson, J., in *James'* case,[3] holding that a representation of the goods on which the mark was to be used was not a good mark. In that case the mark in question was a sketch of a cylinder with a dome top, which had been registered in 1861 as a design, and as a trade mark in 1877. It was used as a trade mark for black-lead, which was generally, but not exclusively, sold in blocks of the shape shown by the sketch, and upon which the words "registered shape" were stamped. The Court of Appeal reversed the decision of Pearson, J., but Cotton and Lindley, L.JJ., apparently differed from the learned judge in their view of the facts only. They held that the mark was not a mere representation of the goods, and they laid stress on the circumstance that it might be used, and it had occasionally

James' case.

[1] *Crompton & Co.'s Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265. The mark consisted of three labels, and the essential particulars were stated to be the combination of devices. It was held also that it was not necessary that the devices should be verbally described or specified.

[2] Report of 1888, p. xii.

[3] 31 C. D. 340; 55 L. J. Ch. 915 (1885). It also accords with a number of American decisions: see Sebastian, 4th ed., p. 36. The Court of Appeal, however, thought that little assistance was to be obtained from the American cases; 33 C. D. 392; 3 R. P. C. 340.

been used, on blocks of shapes other than that shown by the sketch.[1] Lindley, L.J., said: "I cannot see why, according to English law, a fish may not be a distinctive mark for a fishing-line, though I can understand that a picture of a fish may not be a distinctive mark of that particular kind of fish. Why a pig should not be, according to English law, a distinctive mark for lard, or something made out of a pig, I do not know. Supposing you tanned a pigskin into leather, I do not know why a pig should not be a good trade mark for tanned pig's hide." Lopes, L.J., took the same view of the facts; but in the course of his judgment he asked: "Why is it (the mark) the less a distinctive device or mark because it represents the thing upon which it appears?" The suggestion of this question is not only at variance with the opinion cited above, but also with the statement of Lindley, L.J., that a fish would not be a good trade mark for fish of the same kind.[2]

Devices comprising pictures of the goods.

But although descriptive devices, including mere representations of the goods upon which the mark is to be used, are objectionable, there seems to be no reason why pictures of the goods, worked up into a characteristic and uncommon design, should be refused. Thus a drawing of a mere ordinary coil of wire for wire, of a barrel for beer, a cricket-bat for cricketing materials, would be bad as trade marks; but not a drawing of the wire woven up into a knot of new and striking design, or of several barrels or bats arranged in a particular and original manner.[3]

Device representing name of goods.

In a case in which the word *Magnolia* had been registered as a trade mark, and also a representation of a magnolia flower as another trade mark, and the word at the time of its registration was the name of the alloy in respect of which it was registered,

[1] 33 C. D. 392; 3 R. P. C. 340. The appeal was heard *ex parte*, the respondents not appearing.

[2] See *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893), Kekewich, J.; and cf. *Ripley* v. *Bandey*, 14 R. P. C. 591 and 944 (1897), Kekewich, J., and C. A., where Kekewich, J., held the plaintiff to have established that *Owl Blue* meant his laundry blue, which was of an oval shape, but held that, owing to laches, he could not complain of the use of the oval shape by other traders. In the Court of Appeal the case was settled. An interlocutory injunction was granted by Buckley, J., to restrain a defendant from selling cigars made in the plaintiff's distinctive shape without clearly distinguishing, *Elliott & Co., Ltd.* v. *Hodgson*, 19 R. P. C. 513 (1902); *query*, however, whether the decision went too far.

[3] The question was discussed, but not decided, in *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893). The Registrar refuses to accept for registration as trade marks, pictorial representations of goods to which the marks are to be applied.

and that registration was therefore bad, it was held that nevertheless the registration of the flower was good.[1]

It is somewhat difficult to define what degree of descriptiveness will make a mark objectionable, but the test is, it is submitted, to be found in the rule that, assuming the mark to be distinctive having regard to the marks already in use in the trade as already defined, it must not be such as to restrict the liberty of any trader to use any drawing, picture, or device, which he may fairly require to enable him to describe his goods to any class of his customers in the ordinary manner.

The rules prohibit the registration of certain devices of a national character as trade marks or prominent parts of new trade marks,[2] and as regards certain other devices, *e.g.*, the arms of a foreign State or of a city, the Registrar may require justification or consent.[3]

Brand.

This word was introduced by the Act of 1883, in consequence of the ruling of Jessel, M.R., that cigar marks burnt into the ends of the boxes could not be registered under the Act of 1875, and in order to allow such marks to be registered;[4] but it has not been restricted in practice to marks burnt into the goods or their envelope. Thus, a number of word marks were at one time accepted and registered in the tin-plate trade as brands, which would not have been accepted under any of the other heads,[5] because the words were geographical words.

Brand.

Lord Herschell's Committee said, in their report[6]: "Some controversy has arisen with reference to the meaning of the word *brand* as distinguished from the other words employed. There can be no doubt that the term derives its origin from the practice of producing some mark by means of burning, but it appears now to be in use in certain trades for the purpose of describing trade marks no longer produced in this way, and differing in no respect from the labels and tickets mentioned in the section; nevertheless, a distinction has been made in the practice of the Office, and trade marks have been allowed registration in certain trades as brands when they would not have

[1] *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265, 621, Kekewich, J., and C. A.

[2] See Rules 11 and 12 below, p. 657.

[3] Rules 13 and 14, below, p. 657.

[4] See the evidence of the Comptroller before Ld. Herschell's Committee, Q. 2993. The Comptroller stated that he did not see any reason for keeping up the distinction between brand and design or mark. Q. 3295.

[5] *Ibid.*, Q. 3294.

[6] Report of 1888, p. xi.

been accepted in other classes as labels or tickets. We see no reason for this distinction. It does not appear to us to receive support from the language of the Act, and we think that, in future, brands should be dealt with in precisely the same way as labels or tickets."

Pirie v. *Goodall.*

This opinion corresponds with that expressed in the judgments delivered in *Pirie* v. *Goodall.*[1] There the plaintiffs had, in 1885, registered the words *Pirie's Parchment Bank* for paper, disclaiming the exclusive use of both *parchment* and *bank*, which were words in common use in the trade. The defendants in an action for infringement moved to remove the mark from the Register, and the plaintiffs tried to support it (*inter alia*) as a brand. Vaughan Williams, J., held, that the word *brand* must be limited in some way; it could not include all words, whether, for instance, they were *fancy words*[2] or not. "I think," he said, "that before you can register anything as a brand, there must be evidence that, in point of fact, it is as a brand, and as a brand only, that it is used." The use of the words as a watermark on paper was not, the learned judge thought, user as a brand; but, he added, "I see no reason why a brand should not be woven into the goods just as much as stamped on to them or burnt into them." He ordered the trade mark in question to be removed from the Register. This decision was affirmed on appeal, and Lindley, L.J., who delivered the judgment of the Court, said he did not see why *mark*[3] did not include *brand*, and he held that word marks[4] could only be registered when they came within those parts of the section (64) which expressly relate to words, and consequently that they could not be registered as *brands*.[5]

In *Paine's* case,[6] the words *John Bull Brand*, registered in 1885 as a trade mark for beer, were ordered to be removed. An attempt was made to support the mark as a brand, but Kekewich, J., pointed out that the mark claimed was the three words, not the first two, and that the addition of the last word did not make the whole a brand. Some question was raised in the cases

[1] [1892] 1 Ch. 35; 9 R. P. C. 17.

[2] The mark had been registered under the Act of 1883.

[3] "Mark" was mentioned in sec. 64 (1) (c) of the Act of 1883.

[4] That is, marks consisting of a word or words, not headings, labels, or tickets, which comprise words.

[5] Cf. Ld. Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. p. 295; and the judgments in *Holt's Tm.*, 13 R. P. C. 16 and 118; [1896] 1 Ch. 711, C. A., as to words that are also names.

[6] W. N. (1892), p. 56; and 9 R. P. C. 130, Kekewich, J. The action in which the question arose is further reported: *Paine & Co.* v. *Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

cited above as to whether a brand mark must not be registered as a brand, but there is no machinery for such registration, as no distinction is made between the different heads referred to in the section upon the Register. In a later case, in which the device of a milkmaid was held to be common for butter, the addition in the plaintiffs' mark of the words "Milkmaid Brand" *did not* enable them to retain their mark.[1]

The term *brand* was sometimes applied, before the Acts, to trade marks branded on metal goods, or on wine casks, or corks,[2] and its use to denote a class of some kinds of goods, as cigars, for instance, is very common; but these uses seem to have nothing to do with its meaning in the Act.

Heading.

The meaning of this term is not at all clear. The word is ordinarily used of a sentence or words placed at the top of a document either as a title or to describe the matter contained in it; and it has been held that the words *Family Salve*, printed thus, *Reinhardt's Celebrated Family Salve*, at the top of a wrapper used for patent medicine bottles, formed a distinctive heading.[3] But it was held also, under the Act of 1875, which did not provide for the registration of words, that the single word *Valvoline* did not form a heading, on the ground that word marks were specially provided for in the Act.[4] If the first decision can be relied on, and if it indicates the whole significance of the word in the section, the operation of the section under this head is very limited, for documents attached to the goods or their envelope can themselves be registered as labels.

Line heading for cotton goods.

In the cotton trades a line heading means the pattern or marking woven at the end of a piece of cloth;[5] and in *The Great Tower Street Tea Co.* v. *Smith*,[6] North, J., said that this was what he understood by *heading* as used in this section. These

[1] *Anglo-Swiss Condensed Milk Co.* v. *Parks, Gunston and Tee, Ltd.*, 20 R. P. C. 509: 21 R. P. C. 261 (1904), Joyce, J., and C. A.

[2] Sebastian, 4th ed. p. 33; *Millington* v. *Fox*, 3 My. & Cr. 338 (1838); *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1865).

[3] *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. The mark had been registered in 1876 as an old mark. It would, under the later decisions, have been refused as descriptive, and also because it was not the whole mark used before the Act.

[4] *Leonard & Ellis's Tm.*, 26 C. D. p. 295 (1884), C. A.; see the judgment of Selborne, L.C.

[5] *Harter* v. *Souvazoglu* (1875), W. N. 11, 101; *Carver* v. *Bowker*, Seb. Dig. p. 350 (1877); *Robinson* v. *Finlay*, 9 C. D. 487 (1877).

[6] 6 R. P. C. p. 168 (1889).

line headings are of great importance in the Manchester trade, but were not registrable under the Acts of 1875, 1883 or 1888, since they are essentially colour marks. Under the Act of 1905 colour may be taken into consideration as affecting distinctiveness, and line headings can be registered as part of a combination,[1] but no line heading can be registered alone in respect of cotton piece goods, and even if registered as part of a mark a line heading is not to be deemed distinctive, and the registration confers no exclusive right to the use of it.[2]

Label.

A label consists of a number of words, or of a word or words combined with a device or devices, or of a device or devices alone, printed on paper or other substance, in order to be stuck upon or attached to the goods or their envelope.

A single word or several words, not registrable alone, and not forming any sentence, will not become registrable by being printed on a plain piece of paper. Thus North, J., said[3]: "The plaintiffs would not be in any better position at all if they had put the words *Tower Tea* upon a piece of paper, otherwise blank, and fixed it on to their packages, than if they had, as they have done, impressed the words *Tower Tea* upon the packages themselves." And it would make no difference that the paper was surrounded by a conventional border, or was occupied by other indistinctive matter, not altogether forming a distinctive combination. Romer, L.J., in his judgment in *Re Clement et Cie.'s Trade Mark*,[4] in which the Court of Appeal decided that certain words formed part of a label and not additions to it, said: "I desire to add that our judgment must not be understood as sanctioning the registration of words which in themselves would not constitute a proper trade mark, merely because some flourishes were colourably placed round them with the view of making out a distinctive or compound label, when, in fact, what was really intended to be registered was the words alone." In that case it

[1] See above, p. 125.

[2] Sec. 64 (10) (b) and (c).

[3] *The Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. p. 170 (1889). Cf. Ld. Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884). So a black label, bearing the descriptive word *Monobrut* in its centre, was removed from the Register in *Vignier's Tm.*, 6 R. P. C. 490; 61 L. T. 495 (1889), Kay, J.

[4] [1900] 1 Ch. 114; 16 R. P. C. 173, 611.

was held that a description of the qualities of the article, and directions for use, although in form contained in a label, were an addition to a proper label, and this decision has been followed by Farwell, J., in a subsequent case.[1] The name of a firm printed in common letters on an ordinary label does not make a distinctive label.[2]

Phrases and proverbs.

Lord Herschell's Committee reported[3] that "it is said that there is often a desire to register short phrases, such as proverbs, &c., and that owing to the difficulty of finding new marks, it is expedient that they should be allowed. We see," they added, "no objection to this, provided they be in no way descriptive of the character or quality of the goods, or of their place of origin, sale, or manufacture." Probably such phrases may be registrable under the present Act as "words having no direct reference to the character or quality of the goods";[4] and, even if they have such reference,[5] they could be registered as distinctive marks, if by use they have in fact become distinctive of the goods.

Ordinary arrangement of common parts.

An ordinary arrangement of parts which are in common use, each part remaining as a separate feature in the combination, does not form a distinctive label.[6] So a label for match-boxes, bearing representations of a prize medal, with the words *Bryant & May's Royal Wax Vestas* printed in ordinary type, medals being common marks in the trade, was held not to be distinctive;[7] and so also was a label bearing two co-axial ovals, with the words *Worth's Corsets* in ordinary type, and four dots arranged as a star at each end printed between them, ovals being common marks in the trade.[8] In the last case, Chitty, J., held that the

[1] *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902).

[2] *Price's Patent Candle Co.*, 27 C. D. p. 686 (1884), Pearson, J.; and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J., *Worth's Corsets*, between co-axial ovals. In *The Birmingham Vinegar Co.'s Tm.*, 11 R. P. C. 195; 70 L. T. 646 (1894), Kekewich, J., a label comprising a large H, some common words, and a small device, was held not to be, as a whole, a distinctive label.

[3] Report of 1888, p. xii.

[4] Sec. 9 (4).

[5] Under the Act of 1888, *Uneeda* was held equivalent to "you need it," and not registrable: *National Biscuit Co.'s Application*, [1902] 1 Ch. 783; 18 R. P. C. 170; 19 R. P. C. 281, Cozens-Hardy, J., and C. A.

[6] Cf. "combination of devices," above, p. 186, and the passage from the report there cited; also *Jamieson* v. *Jamieson*, 15 R. P. C. 169 (1898), Byrne, J., and C. A., a passing-off case, in which the Court of Appeal reversed the judgment of Byrne, J., for the plaintiff, on the ground that the similarity of the get-up of the defendant's goods to that of the plaintiff's was solely due to features common to the trade.

[7] *Bryant & May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.

[8] *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.

addition of the trade name of the owner of the mark made it neither better nor worse, and he approved and followed *Price's* case.[1]

The Act permits the registration of a distinctive label, and it is, therefore, a sufficient qualification for a mark that it is such a label, but some difficulty arises when the question what is sufficient to render a label distinctive is considered. Ought the label to be looked at as a whole, or should it be analysed, in order to ascertain whether it contains one or more features which are in themselves distinctive? And, further, what must be the nature of such features? The decisions which have already been cited[2] are to the effect that the label must be examined, and that to qualify for registration some separately distinctive feature must be found in it. Some of the decisions[3] seem to go further, however, and to lay down the rule that such a distinctive feature must itself be an "essential particular" (other than a label) within the meaning of the Act. It is submitted, however, that this is not the true view and is contrary to the general rule of construction of the Act of 1888 laid down by the House of Lords in *The Solio* case,[4] and that it is sufficient if there be found some distinctive feature or features in the label, which operate to make it, as a whole, distinctive. The Court of Appeal has not been called on to give a direct decision on the point, but it has on several occasions determined that a label must be looked at as a whole.[5]

Additions under the Acts of 1883 and 1888.

A good many of the difficulties which arose in connection with the registration of labels under the Acts of 1883 and 1888 were due to the provisions of those Acts with respect to additions to

[1] 27 C. D. 681; cited p. 193.

[2] *Orr-Ewing* v. *Registrar of Tms.*, 4 App. Ca. 479; *Price's Patent Candle Co.'s* case, 27 C. D. 681; *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195; *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386. See the quotations given above, pp. 134, 135.

[3] See the cases in note (2), other than *Price's* case. Chitty, J., in *Bradley's Tm.*, note p. 193 (2), expressly distinguished the case of a combination distinctive as a whole.

[4] *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476; see supra, p. 135.

[5] *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137; *Pinto* v. *Badman*, 8 R. P. C. 181; and *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 612; of these, two were decisions on disclaimers and the third—*Pinto* v. *Badman*—on novelty. The passage cited from the judgment of Ld. Cairns in *The Orr-Ewing* case, supra, p. 134, must, however, be borne in mind. The actual decision was that the Registrar should proceed with the application to register the distinctive device on the labels, with the name and address of the appellant's firm, it being found that the marks contained devices which were *primâ facie* distinctive. The case was under the Act of 1875.

essential particulars and disclaimers.[1] Section 64 of the Act of 1883 contained provisions for enabling certain matter to be added to essential particulars, and the Act of 1888 required such matter to be disclaimed. Section 74 of the Act of 1883 enabled certain marks common to the trade to be registered as an addition to a trade mark, but disclaimer of the addition was required by the section, as it originally stood, and as amended by the Act of 1888.

Additions abolished by Act of 1905.

Under the Act of 1905, the whole system of additions has been swept away. A trade mark must, as before, contain or consist of an essential particular, but it is registered as a whole, and an applicant has no longer to point out in his application for registration what the essential particular is. The applicant may, however, be required to make such disclaimer as may be necessary to define his rights under the registration.[2] The position is thus much simplified by the Act of 1905. Nevertheless, it is necessary, on account of previous registrations, to consider the law under the Acts of 1883 and 1888.

Disclaimer in regard to labels under previous Acts

No disclaimer of any part of a distinctive label was required by the Acts of 1883 and 1888, for the whole label is an essential particular.[3] Under sec. 64 (2), as amended by the Act of 1888, certain additions to the essential particulars in a mark might be registered, subject to a disclaimer of the exclusive use of the added matter; but, since a distinctive label is itself an essential particular, that sub-section did not apply to anything forming part of the label.[4] Moreover, common words, that is, words

[1] *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 611, and *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109, may be instanced out of the many cases cited above.

[2] Sec. 15. The section is set out fully below, p. 212.

[3] *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137; *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109; *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611; and see *Pinto* v. *Badman*, 8 R. P. C. 181.

[4] It is submitted that this statement of the law is in accordance with and follows from the decision of the Court of Appeal in *Clement et Cie.'s Tm.*, supra, note (3). In that case the label was registered under the Act of 1883, but the amendment of sec. 64 by the Act of 1888 does not appear to affect the decision so far as it has a bearing on that section. See also *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902), Farwell, J., where the "additional matter" was outside the real label. But in *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 193; 70 L. T. 646 (1895), Kekewich, J., affirmed the Comptroller's decision requiring an applicant to state that, not his label, but a device contained in it, was the essential particular of the mark, and to disclaim the exclusive use of the other matter. And in *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J., held that there ought to have been in the application a statement of the essential particular and a disclaimer of

which any one is at liberty to use, appearing in a label, did not need to be disclaimed under sec. 74 of the Act of 1883, for that section applied only to additions to the trade mark, and the whole label is itself the trade mark.[1] So, in *The Apollinaris* case, it was held, by the Court of Appeal, that the name *Friedrichshall* occurring on a label need not be disclaimed,[2] and this was followed by Chitty, J., in the case of *The Smokeless Powder Co.'s* trade marks, where he refused to order the words *Smokeless Powder* to be disclaimed on the application of rival makers of similar powder.[3] A dictum of Cotton, L.J., in an earlier case,[4] decided under the Act of 1875, that such words ought to be disclaimed, was cited in the last-mentioned case; but Chitty, J., declined to follow it. The decision of Stirling, J., in *Edge's* case,[5] that the words *Filtered Blue*, which he held to be bad as a separate trade mark, must be disclaimed when registered on a label, is also in conflict with the rule stated above. None of the above-mentioned cases were, however, cited in *Edge's* case, and it was not cited in *The Smokeless Powder* case. *Burland* v. *Broxburn Oil Co.*,[6] where the point does not appear to have been argued, and *Thompson* v. *Miller*,[7] are also in conflict with the rule. The point came before the Court of Appeal again in *Clement et Cie.'s Trade Mark*,[8] where the Court refused to order a disclaimer of the words *St. Raphael*, on the ground that the words formed part of and were not an addition to the mark.[9] A distinctive label may accordingly be properly registered, although it contains words or names to the exclusive use of which no claim could be maintained.[10]

added matter. He did not decide what form the statement and disclaimer should have taken.

[1] *Pinto* v. *Badman*, 8 R. P. C. pp. 188, 191 (1891), and *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611. As to the registration under the Acts of 1883 and 1888 of common marks as added matter or additions, see above, Chap. IX., p. 212.

[2] [1891] 2 Ch. p. 233; 8 R. P. C. 137; see also *Atkins' Tm.*, 3 R. P. C. 164 (1886), Bacon, V.-C., C. A.; and *Paine & Co.* v. *Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

[3] [1892] 1 Ch. 590; 9 R. P. C. 109. See also *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535. Kekewich, J., and C. A. (*Silverpan*).

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

[5] 8 R. P. C. 207 (1891).

[6] 6 R. P. C. 482; 41 Ch. D. 542 (1899), Chitty, J. (*Washerine*).

[7] 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*).

[8] Ubi supra, note (1).

[9] Cf. also *Wright, Crossley & Co.'s Application*, p. 194, note (2), above.

[10] *Hudson's Tm.*, *Atkins' Tm.*, and *Paine & Co.* v. *Daniells & Sons' Breweries*, supra. See also *Application of Albert Baker & Co.* (1898), *Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

Similar common words in another registered label is no objection to registration.

The presence of common words in a registered label does not prevent any trader registering a different label with the same or similar words. Thus *Valvoleum* printed across a label with a particular device was allowed, although *Valvoline* was already registered upon a label with a different device,[1] Jessel, M.R., holding that each word was merely equivalent to *valve oil*.

Blanks in registered labels.

It is a common practice to register labels with blank spaces which in use are filled up by matter which is either not capable of registration, or which for some other reason it is not convenient to register, because, for example, it is changed from time to time.[2] The practice is unobjectionable, and the use of the added matter, which forms, of course, no part of the trade mark protected by registration, does not interfere with the protection of the label as registered.[2] But in considering whether a mark is a proper mark to register, regard must be had to the appearance it will present in actual use.[3]

Colour.

Section 10 of the Act of 1905 provides that a trade mark may be limited in whole or in part to 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. This provision is of considerable importance in its effect on the registration of labels.

Ticket.

The only difference between a label and a ticket seems to be that a label is attached by sticking it on to the goods or their envelope, and a ticket by tying.[4]

Name, Signature, Word.

These have been considered above under paragraphs (1), (2), (3) and (4).

[1] *Re Horsburgh & Co.'s Application*, 53 L. J. Ch. 237 (1878); see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29; North, J. (*unco' guid whisky*).

[2] *Hammond* v. *Malcolm Brunker & Co.*, 9 R. P. C. 301 (1892); *Melachrino & Co.* v. *Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), both Chitty, J.; and see Chap. X., at p. 246. A possible difficulty might arise if the whole mark, as filled up, were described upon the goods as a "registered trade mark." See "misrepresentation" below, pp. 437 *et seq.* See Rule 15 as to variations of name or description of goods.

[3] *Christiansen's Tm.*, 3 R. P. C. 54; 2 T. L. R. 31 (1886), C. A., the *Tandstikker Match* case, and *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A. And see Chap. X., at p. 244.

[4] The words are used alternatively in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479; and *Great Tower Tea Co.* v. *Smith*, 6 R. P. C. 165.

Letter.

Under the previous Acts a single letter was not an essential particular ;[1] and a combination of English letters was held not to constitute a device,[2] except in the case of an old mark.[3] Letters could only be registered as additions under sec. 64 (2), or as part of a distinctive label or ticket.

Numeral.

"Numeral" is substituted for the word "figure" which was used in the Act of 1883 with the meaning of numeral.[4] A "numeral," however, did not constitute an essential particular under that Act, and, except in the case of an old mark,[3] could only be registered as an addition under sec. 64 (2), or as part of a distinctive label or ticket.

Old Marks.

Old marks.

Section 9 contains the following proviso :—

"Provided always that any special or distinctive word or words, letter, numeral,[4] or combination of letters or numerals, used as a trade mark by the applicant or his predecessors in business before the 13th day of August, 1875,[5] 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."

All the Registration Acts have contained provisions enabling certain classes of old marks, that is marks used before the commencement of the Act of 1875, to be registered, notwithstanding that they do not conform to the standard required of new marks by containing an essential particular. By sec. 10 of the Act of 1875 "any special and distinctive word or words, or combination of figures or letters, used as a trade mark before

Special and distinctive.

[1] *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C.

[2] *Ex parte Stephens*, 3 C. D. 659 ; 46 L. J. Ch. 46 (1876), Jessel, M.R.

[3] See below, p. 199.

[4] *Figure* was the term used in the previous Acts, but it was held to mean *numeral*, per Jessel, M.R., in *Ex parte Stephens*, 3 C. D. 659 (1876) : *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218 ; 17 R. P. C. 386.

[5] Date of commencement of the Act of 1875.

the passing of this Act may be registered as such under this Act."[1] With a slight alteration the same provision was retained in the Acts of 1883[1] and 1888.[2] It was decided that, under the sub-section as it originally stood, a single letter, although an old mark, could not be registered,[3] and to meet this the words "figure, letter" were added by the Act of 1883 before the words "or combination of figures or letters."

It has been said that it was the intention of the Act to allow to be registered anything which was protected as a trade mark under the old law, and could not be registered under the other clauses of the section.[4] But it was decided under the Act of 1888 that the proviso did not extend to all old marks, and that an old mark, consisting of, or even containing, a device, did not come within the proviso, and was not entitled to registration unless it consisted of or contained one of the essential particulars enumerated, and that it was, in that case, subject to the requirements of sub-sec. (2) of sec. 64 as to disclaimer of added matter.[5] And, similarly, it would seem that any old mark registered under the Act of 1875 or 1883, if not within the corresponding proviso, must conform to the general requirements of the Act under which it was registered. This decision is contrary to the previous practice of the Patent Office, which had treated all old marks as having a right to registration, and as free from the requirements of sub-sec. (2), and, as pointed out by Byrne, J., in his judgment, some of the results to which the language of the clause leads are anomalous.

It is difficult to understand why a change was made in the Act of 1905 from "special and distinctive" to "special or distinctive," for every proper trade mark must be distinctive; but the practical effect is that an old mark may be registered, if distinctive, although it may not be "special." The word "special" might therefore have been dropped altogether. It was said by Kekewich, J., in *Re Hopkinson's Trade Marks*[6], that the require-

[1] Sec. 64 (3).

[2] Sec. 10.

[3] *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C., *A.*, for steel pens.

[4] *Barrows' Tm.*, 5 C. D. 353 (1877), per Malins, V.-C.; *Bodega Co.* v. *Owens*, 6 R. P. C. 241, Chatterton, V.-C. (1888), in Ireland.

[5] *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J., who also held that sec. 74 did not apply in that case, if the mark could be registered under sec. 64 (3) (ii). It is settled that if the application is to register as an old mark, the words must have been used alone, see below, p. 205.

[6] *Re Hopkinson's Tm.*, [1892] 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.; see as to this, ante, p. 174.

ment that the mark should be "special and distinctive" only embodied the old law.[1] *Special* means of such a character that the mark "separates the article to which it is applied from all others of the same class or character; something which points out the article as standing alone, which makes the man who sees or reads the word understand that the article has a special standing, a special existence, and is not one of the general class, for instance, of pianos, but belongs to a class of a particular character."[1] *Distinctive* means that the mark is a distinctive thing which points out that the goods are the goods of A. B.[2] Thus, in *The Eton Cigarette* case, Fry, L.J., said: "It appears to me, that to satisfy the requirement of (this) definition the word or words must be distinctive in this sense, that they distinguish the manufacture of the person who has registered the trade mark from the manufacture of all other persons."[3]

Deceptive mark not distinctive.

Where, therefore, a cigarette manufacturer had registered the word *Eton* as an old mark, but had sold the cigarettes in boxes bearing the words *St. Petersburg—P. Marrogordato & Co.*, as well as *Eton*, thereby suggesting to purchasers that the goods were not of his manufacture, but were made in Russia, although the mark was known in the trade as, in fact, indicating his manufacture, it was held that he was not entitled to have it registered, and it was accordingly ordered to be removed.[3]

Descriptive words.

It follows that words which were merely descriptive of the goods to which they are applied cannot be registered as old trade marks under the clause, for, in fact, they could not be trade marks at all.[4] So, where fusees were manufactured under a patent which expired in 1881, and were called *braided fixed stars* (*fixed stars* being a common name for fusees, and *braided* descriptive of the process by which the particular goods were manufactured), and the words were registered as an old mark in 1877, they were ordered to be removed from the Register, on this as well as on other grounds,[5] and in a case in which it was found

[1] See above, pp. 174 *et seq.*

[2] *Richards* v. *Butcher*, [1891] 2 Ch. p. 536; 8 R. P. C. 249, Kay, J.; and per Halsbury, L.C., in *Perry, Davis & Son* v. *Harbord*, 15 App. Ca. p. 320; 7 R. P. C. 336 (1890). See also the definition of distinctive contained in sec. 9, considered above, p. 174.

[3] *Wood* v. *Lambert*, 32 C. D. p. 262; 3 R. P. C. 81 (1886); followed as to the effect of the plaintiff himself putting the name of a third person on the goods by Cozens-Hardy, J., in *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), a passing-off case, affirmed on other grounds by C. A., 18 R. P. C. 27.

[4] See Chap. II., at pp. 37 *et seq.*

[5] *Palmer's Tm.*, 24 C. D. 504 (1882); C. A.; and see *Chesebrough Manufacturing Co.'s Tms.*, [1902] 2 Ch. 1; 19

as a fact that "Swanbill" was descriptive of a corset with a busk of a particular shape, it was held not to be a special and distinctive word.[1]

Word with a secondary distinctive meaning.

Before the Acts words which were *primâ facie* descriptive might be acquired as trade marks, if, by use as such, in connection with the goods of a particular trader, they, in fact, acquired a secondary distinctive meaning distinguishing the goods as his;[2] and such words may still be so acquired as a "common law trade mark" apart from registration.[3] And it is submitted that wherever such words had been used and acquired as trade marks before August 13th, 1875, they are "special or distinctive," and therefore capable of registration within the clause. It was directly decided by Kekewich, J., in a case under the Act of 1875, that such secondary distinctive meaning made a word "special and distinctive"; and *à fortiori* such a word would be qualified under the present Act as "special or distinctive." In the case referred to[4] Kekewich, J., held the words *J. & J. Hopkinson*, printed in ordinary type, to be "special and distinctive," and to be properly registered as an old mark. "In order to protect a trade mark before the Act," he said, "you were obliged to prove by evidence and satisfy the Court that the words used as a trade mark were known in the market, and, to use Lord Westbury's expression in *Leather Cloth Co.* v. *American Leather Cloth Co.*,[5] gave a 'vendible' character to the articles to which they were attached, made those articles recognised as coming from a particular manufactory, and so gave them a character different from that of every other article in the trade. Therefore, it seems to me, that the Legislature in the Act of 1875 did no more than adopt the language of the cases, by reducing them into a compressed form, and say really that what the Court would have held to be a trade mark independently of the Act should now be capable of registration as a trade mark under the Act, provided only that the mark had been used as a trade mark

R. P. C. 191; 19 R. P. C. 342 (1902), where Buckley, J., ordered the removal from the Register of the word *Vaseline*, registered in 1877, on the ground that it was then descriptive of the goods, but on further evidence the Court of Appeal held that the word had been used not to indicate the article, but an article manufactured by a particular manufacturer. See also the cases cited below.

[1] *Bourne's Tms.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

[2] See Chap. II., at p. 37.

[3] *Reddaway* v. *Banham*, [1896] A. C. 199; 13 R. P. C. 218 (*Camel Hair Belting*). See below, p. 508.

[4] *Hopkinson's Tms.*, [1892] 2 Ch. 116; 9 R. P. C. 102.

[5] Above, p. 52.

before the passing of the Act." And this accords with the opinions expressed by several other judges.[1] *The Monopole* case was discussed[2] on the assumption that the word, though in itself descriptive, could be registered if it were shown to have been used before the Act of 1875 as a trade mark; and in *The Stone Ales* case[3] the only ground upon which the Court of Appeal proceeded in removing the mark *Stone Ale* was the want of proof of such user.

On the other hand, in *Perry, Davis & Son* v. *Harbord*,[4] the question was treated as an open one by two of the Lords Justices, for Fry, L.J., said: "It is not necessary now to inquire whether the words must be special and distinctive from their own proper nature and internal force *ex ri terminorum*, or whether they may acquire a distinctive character by user as applied to the goods"; and Lopes, L.J., made use of similar language, and added: "Speaking for myself, I should be inclined to think (the word tendered for registration as an old mark) must be inherently special and distinctive."[5] And on the further appeal, Halsbury, L.C., and Lord Morris held that the words in question in the case, *Pain Killer* for a medicine, were not special and distinctive; the Lord Chancellor, on the ground that they were descriptive of a quality attributed to the goods to which they were applied.[6] This decision is not in conflict with the conclusion stated above, for there was no finding or evidence that the medicine of the plaintiffs was distinguished from the same medicine made by others by use of the words *Pain Killer*; on the contrary, it appeared that there was no competition in its manufacture. It

[1] Malins, V.-C., in *Barrow's Tm.*, 5 C. D. 353 (1877); and Porter, M.R., in *Watt* v. *O'Hanlon*, 4 R. P. C. p. 15 (1887); and Chatterton, V.-C., in *Bodega Co.* v. *Owens*, 6 R. P. C. 241 (1888), both Irish cases. In *Leonard & Ellis' Tm.*, 26 C. D. p. 295 (1884), Ld. Selborne said: "As to the word *Valoline*, I for my part am not disposed to doubt that, if that word had been used in the United Kingdom as a trade mark before the passing of the Act, it might have been registered under the Act." See also p. 203, note (1).

[2] Fry, L.J., expressly reserved this question. *Richards* v. *Butcher*, [1891] 2 Ch. p. 547: 8 R. P. C. 249, Kay, J., and C. A.

[3] Page 204, note (2).

[4] 5 R. P. C. 333, Kay, J., and C. A. (1888); and 15 App. Cas. 316; 7 R. P. C. 336, H. L.

[5] The question was also referred to by Kay, J., in *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889) (*Emollio Cream*). Cf. *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131 (1898), where Romer, J., held that *Wright, Crossley & Co.*, which had been registered as an old mark, was not on the face of it an illegal or improper mark. In the Court of Appeal this point was not decided; 15 R. P. C. 377.

[6] Cf. *The Nourishing Stout* case, *Baggett* v. *Findlater*, L. R. 17 Eq. 29 (1873). Malins, V.-C.

is submitted that the proper construction was that adopted by Kekewich, J., and, as already pointed out, under the present Act all that is required is to show that a word used before August 13th, 1875, was and is distinctive within the meaning of sec. 9.

A geographical word may be registered if it was used as a trade mark and had acquired a secondary distinctive meaning before August 13th, 1875.[1]

In order that a word should be registered as a special and [or] distinctive word, it must be such at the date of registration.[2]

Examples of old word marks.

The following words have been held not to be special and distinctive words: EMOLLIO cold cream, *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889); BAFFLE safes, *Talbot* v. *Webley*, 3 R. P. C. 276 (1886); PERRY-DAVIS' VEGETABLE PAIN KILLER, *Perry, Davis* v. *Harbord*, 15 App. Cas. 316; 7 R. P. C. 336 (1890); SWANBILL, for corsets, *Bourne Tms.*, [1903] 1 Ch. 211; 20 R. P. C. 105.[3]

And the following have been admitted to registration as such: FRIGIDOMO, for a hot-house plant wrap, *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323 (1889); FAMILY SALVE, *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 (1880); EXCELSIOR SPRING MATTRESS, *Chorlton and Dugdale's Tm.*, 53 L. T. 337 (1885); J. & J. HOPKINSON (for pianos), *Hopkinson's Tm.*, [1892] 2 Ch. 116; 9 R. P. C. 102; VASELINE, *Chesebrough Manufacturing Co.'s Tms.*, [1902] 2 Ch. 1; 18 R. P. C. 191; 19 R. P. C. 342.

Used as a Trade Mark.

Used as a trade mark.

What is use as a trade mark has already been considered in Chapter II. The following paraphrase by Lord Esher[4] of the judgment of the Court of Appeal in *Palmer's* case[5] sums up the rules there stated: "Let us see what was used in the trade, and let us see whether any article was ever in the market made by

[1] See the judgments of Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 635; 4 R. P. C. 31 (1887); and of Kay, J., in *Compagnia General de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887) (*Cavité*).

[2] *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Bourne's Tms.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

[3] In *Dewar & Sons, Ltd.* v. *J. H. Dewar*, 17 R. P. C. 341 (1900), a Scotch case, Ld. Kyllachy said that he was not satisfied that the words *Dewar's Whisky* were sufficiently "special and distinctive," but did not decide the point. And in *Day* v. *Riley*, 17 R. P. C. 517, the question was discussed, but not decided, whether the words "Day & Son's Black Drink" were special and distinctive. Cf. *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (1854) (*Taylor's Persian Thread* in a label).

[4] *Spencer's Tm.*, 3 R. P. C. p. 74; 54 L. T. 659 (1886).

[5] 24 C. D. 504 (1883) (*Braided Fixed Stars*).

these people with these words only on them. If we find these words on goods in the market, which are said to be distinguishing marks on the goods, and on the same goods other marks, and never on any goods these words alone, then the conclusion of fact is that what was used upon the goods to distinguish them was all that was on the goods; and we are not going to inquire whether part of what was put on all the goods to distinguish them was at one end of the goods or at the other end of the goods, or whether they were an inch or half an inch apart, or even whether part was at the top and lapping over the side, or whether part was on one side and part on the other. If you find that they are on goods for the purpose of distinguishing the goods, that makes the user one user." [1]

In accordance with these principles, it has been held that words used only as a description of the goods,[2] for instance, in ordering them from the applicant, are not used as trade marks, and that a device employed as a pattern or design mark[3] is not so used either.

Use on bottles or boxes only.

So also it has been considered that the use of words upon rough packing-cases containing bottles of wine,[4] or sauce,[5] or medicine for animals,[6] or upon the side of a wine cork where they cannot be seen,[7] is not a use of them as a trade mark, since it does not "sell the goods,"[8] although in some cases, for example, where the goods are cigars, soap, or the better classes of candles, the trade mark may be, and almost invariably is, put not upon the goods themselves, but on the boxes which contain them.[9] But in such cases the boxes go into market and are bought with their contents by the purchasers, to whose attention the marks are directed.

[1] Cf. *Crompton's Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265, where three labels were held to be rightly registered as one trade mark.

[2] *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J. (*Coker Canvas*); *Talbot* v. *Webley*, 3 R. P. C. 276 (1886). Bacon, V.-C. (*Baffle Safes*); *Montgomery* v. *Thompson*, 41 C. D. 35; 6 R. P. C. 404 (1889), C. A. (*Stone Ale*); *Powell's Tm.*, [1893] 2 Ch. 388; 10 R. P. C. 63, 195 (*Yorkshire Relish*), Chitty, J., and C. A., aff. by H. L., [1894] A. C. 8; 11 R. P. C. 4.

[3] *Harrison's Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J. (*Albion*).

[4] *Richards* v. *Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A.

[5] *Powell's Tm.*, supra, note (2).

[6] *Day* v. *Riley*, 17 R. P. C. 517 (1900). Buckley, J.; and see *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), below, p. 207, note (1).

[7] *Kinahan's Tm.*, 10 R. P. C. 393 (1893), above, p. 31.

[8] Chap. II., at p. 30, and see *Louise* v. *Gainsborough*, 20 R. P. C. 61, at p. 64, where it appears that the plaintiffs relied on the use of the Duchess of Devonshire's picture on labels affixed to the boxes in which the hats were delivered. Farwell, J., doubted if that was sufficient.

[9] *Powell's Tm.*, supra, note (2).

Where the applicant has another trade mark.

The use by the applicant of a trade mark other than and distinct from the marks which he is seeking to place or maintain on the Register as an old mark is a circumstance to be considered in determining whether he used the mark in question as a trade mark, but it is not conclusive that he did not, for traders often have numerous trade marks and they not infrequently use two or more of them on the same goods at once.[1]

Old mark must have been used as registered, and alone.

And, as stated in the passage quoted above,[2] the mark sought to be registered must have been used, in the form in which it is offered for registration,[3] and as a separate mark complete in itself,[4] as a trade mark before August 13th, 1875.[5] So that words taken out of a label which was an old trade mark,[6] and words which had been used as a trade mark when combined with a device,[7] or with the name of the proprietor,[8] or with other words,[9] and which were not shown to have been separately used as trade marks, apart from the other matter, have been refused registration or removed from the Register.

Use must continue until application to register.

The Act of 1905 requires that the use of the trade mark should continue down to the application to register. Under the previous Acts the owner of an old trade mark was entitled to register unless it had been abandoned; mere discontinuance of user, not coupled with an intention to abandon, and not such that an

[1] *Powell's Tm.*, [1893] 2 Ch. pp. 394, 406, 411; 10 R. P. C. 63 and 195; [1894] A. C. 8; 11 R. P. C. 4, Chitty, J., C. A. and H. L. (*Yorkshire Relish*); *Richards* v. *Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A. (*Monopole*); *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523; 35 L. J. Ch. 53 (1865).

[2] Pages 203 and 204.

[3] *Meens' Application*, [1891] 1 Ch. 41: 8 R. P. C. 25, Chitty, J. (*Key Brand Geneva*); *Fuente's Tm.*, [1891] 2 Ch. 163; 8 R. P. C. 214, Romer, J., both combination marks. See, however, below, p. 316.

[4] *Spencer's Tm.*, 3 R. P. C. 73; 54 L. T. 659 (1886), Chitty, J., and C. A., and the cases next cited.

[5] Small user is, of course, sufficient, *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

[6] *Palmer's Tm.*, 24 C. D. 504 (1883), C. A. (*Braided Fixed Stars*); and see *The Stone Ale* and *Yorkshire Relish* cases, supra, p. 204, note (2).

[7] *Spencer's Tm.*, supra, *Diamond Cast Steel* combined with a cutler's mark; *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), Pearson, J., and C. A. (*Valvoline*).

[8] *Richards* v. *Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 37, 249 (1891), Kay, J., and C. A., *Monopole*, with *Heidsieck & Co.* See also *Heddle & Co.'s Application*, 20 R. P. C. 599 (1903), Byrne, J., device with name of proprietor.

[9] *Perry, Davis* v. *Harbord*, 15 App. Cas. 316; 5 R. P. C. 333; 7 R. P. C. 336 (1888), Kay, J., C. A. and H. L. (*Perry-Davis' Vegetable Pain Killer*); and *John Dewar & Sons, Ltd.* v. *J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session, where *Dewar's Whisky* had been registered, but it was held that the name under which the whisky had been sold was *Dewar's Perth Whisky* or *John Dewar's Perth Whisky*.

intention to abandon would be inferred, was no disqualification.[1] It will probably be held under the Act of 1905 that the use since August 13th, 1875, must be substantially continual, and that, in deciding whether this condition has been complied with, the circumstances of the trade must be considered.[2]

Slight variations permitted.

The continued use need not be of the trade mark exactly in its original form, but may be, as sec. 9 provides, with additions or alterations not substantially affecting the identity of the trade mark.[3] The Act does not expressly provide that the mark may be registered otherwise than in its original form, but the intention of the proviso appears to be to treat the original mark and the mark as used with additions or alterations not substantially affecting its identity as one and the same. The present Rules provide that an application for an old mark must contain a statement of the time during which and by whom it has been used in respect of the goods mentioned in the application; and the Registrar may require a statutory declaration verifying such user with exhibits showing the mark as used.[4]

Use for the same goods.

The mark must have been used as a trade mark for the class of goods in respect of which it is to be registered,[5] for it is only in respect of them that it is an old mark; and if registration is applied for in other classes the application, so far as regards such other classes, must be treated on the footing that the mark was not used before August 13th, 1875.[6] But use on goods essentially the same as those in the class to which the application relates, although they pass under a different name owing to slight variations in size or shape, is sufficient to qualify a mark as an old mark. Thus a mark used on hatchets and augers has been admitted as an old mark for axes and gimlets.[7]

Use in the United Kingdom.

The use must have been use as a trade mark in the United

[1] *Mouson* v. *Boehm*, 26 C. D. 398 (1884), Chitty, J.; *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

[2] *Mouson* v. *Boehm*, 26 C. D. 398. Cf. sec. 37.

[3] Cf. secs. 14 (9), 26, 27 and 34.

[4] Rule 20, below, p. 658.

[5] Chap. V., p. 103.

[6] *Jelley, Son & Jones' Application*, 51 L. J. Ch. 639, n.; 46 L. T. 381, n. (1878), Jessel, M.R.; and see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A., cited pp. 197 and 202, note (1); *Harrison* v. *Woodroffe*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J., and *Batt's Tm.*, (1889) A. C. 428; 16 R. P. C. 411.

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

Kingdom,[1] and mere importation into a British port for the purpose of re-shipment and transportation is not sufficient.[1]

Fraudulent user.

User which was commenced and continued in fraud of the rights of the owner of another trade mark cannot qualify a mark for registration.[2] The registration of the mark in such case would, besides, almost necessarily be within the prohibition of sec. 11 or sec. 19, as calculated to deceive.

Effect of infringements.

The owner of an old trade mark does not lose his title to register merely because other traders have infringed his right,[3] unless the infringements have been so extensive as to make the mark common[4] or non-distinctive.[5]

Slight evidence of user sufficient.

Slight evidence of user as an old mark will be accepted, it is said, even the production of a single label,[6] at any rate after the mark has been registered and used for a long time. Moreover, the onus of proving that a mark registered as an old trade mark was not used before August 13th, 1875, is on the person applying to remove the mark from the Register, at all events where the mark has been long registered.[7] And where a mark

[1] *Mees' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J.: *Monck's Application*, 50 L. T. 12 (1884), Chitty, J. In *Jackson & Co.* v. *Napper*, 35 C. D. p. 177; 4 R. P. C. 45 (1886), Stirling, J., said: "You must make out user *in England*": but the learned judge probably used the name of the only part of the United Kingdom in which user had been suggested, without intending to exclude user in Scotland or Ireland. The question whether foreign user was sufficient was raised as early as *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A. In *The European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), Stirling, J., a foreigner sold to an importer and sent the goods into this country in cases bearing the word *Bull's-eye* and his trade name, and also used the word in pamphlets sent with the goods; the importer himself sold the goods apart from the cases, and to the public the word had become known only in connection with goods sold by the importer. It was held that there had been such use of the word in connection with the goods in this country as would have entitled the foreigner to oppose the registration of the word by the importer, and the registration which had been effected in the name of the latter was expunged. The case does not decide that there was user of the word *as a trade mark*. See also *Neostyle Manufacturing Co., Ltd.'s Tm.*, 20 R. P. C. 329 and 803 (1903), C. A., where a person who had manufactured goods in this country and exported them marked with the word "Neostyle" was held to be a "person aggrieved" by the registration of the word by another person. As to user on cases, see p. 204.

[2] *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J. (*Hoop L Iron*); *Monck's Application*, note (1).

[3] See *Heaton's Tm.*, supra.

[4] Chap. XIV., p. 362.

[5] Above, p. 201.

[6] *Chorlton and Dugdale's Tm.*, 53 L. T. 337 (1888), Pearson, J.; *Palmer's Tm.*, 21 C. D. 47; 24 C. D. 504 (1882), Chitty, J., and C. A. The usual evidence is the production of old prints and dies or blocks for printing.

[7] *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.; *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342, C. A.

has stood upon the Register unchallenged for years, and important witnesses have died who might have given evidence of qualifying user before 1875, the Court accepts evidence of non-user, put forward by any one who seeks to procure the removal of the mark from the Register, with considerable hesitation.[1]

Where, on a motion to expunge, the owner of the mark does not appear to defend it, the onus is still on the applicant to prove non-user, and he may be in some difficulty in making out such a case.[2] But the onus of proving non-user before 1875, although on the person attacking the validity of the mark, may be shifted. Thus, in a Scotch case in which the owners of the mark led in the proof, but called no evidence to show such user and the mark had not been registered till 1891, and the evidence showed that during the period which it covered, commencing at some date subsequent to 1875, and down to the date of the proceedings a different trade mark had been used,[3] it was held that the onus was shifted on to the owners, and that, as they had not discharged it, the presumption was that there had been no user prior to August 13th, 1875.[4]

Standardisation Trade Marks.

By sec. 62 of the Act of 1905—

Standardisation, &c., trade marks.

"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

[1] *Edgington's Tm.*, p. 207, note (7).

[2] In *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J., where the applicants were successful, they showed that they had on first hearing of the mark some years before cautioned a person who represented the registered proprietor against using the mark, and heard no more of it for ten years afterwards.

[3] *Dewar's Perth Whisky*, the registered trade mark being *Dewar's Whisky*.

[4] *John Dewar & Sons, Ltd.* v. *J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session.

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."

A trade mark applied for under this section must be a registrable trade mark, and comply with sec. 9. The effect of the section is simply to allow associations and traders to register trade marks to be applied to goods certified by them, although they have no such trade connection with such goods as would, apart from this section, entitle them to register the marks in respect of such goods. The definition in the Act of a trade mark includes a mark used or proposed to be used to indicate that the goods are those of the proprietor of the trade mark by virtue of "certification,"[1] and therefore covers the case dealt with by this section.

The general rule of sec. 22 that a trade mark is assignable only in connection with the goodwill of the business in the goods is, of course, inapplicable to marks registered under sec. 62. The permission of the Board of Trade is required to an assignment or transmission in order to prevent a standardisation mark being passed on to somebody in whose hands it would have a meaning different from that it had come to import. The procedure on application to register is dealt with above, p. 83.

Colour.

By Sec. 10—

Trade marks by be limited to specified colours.

"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."

Under the Act of 1875, colours could not be registered.[2] Sec. 67 of the Act of 1883 was as follows:—"A trade mark may be registered in any colour or colours,[3] and such registration shall (subject to the provisions of this Act) confer on the

[1] See the definition, above, p. 24.

[2] *Robinson's Tm.*, 29 W. R. 31 (1880), Jessel, M.R. The decision in this case that a gold coin could not too nearly resemble a silver coin is inconsistent with the later authorities.

[3] The words "or colours" were added by the Act of 1888, s. 11.

registered owner the exclusive right to use the same in that or any other colour or colours.[1] This provision was, however, of little use to owners of trade marks, for it was held that a trade mark propounded for registration in colours must be distinctive independently of the colours. Thus an oblong label divided into three sections, which were respectively printed in red, white, and blue, was held not to be distinctive within the meaning of the Act.[2] Colour, said Kay, J., is treated as an accident, and if the mark were registered the applicant might use it in any colours he chose. "You may register a mark, which is otherwise distinctive, in colour, and that gives you the right to use it in any colour you like; but you cannot register a mark of which the only distinction is the use of a colour, because, practically, under the terms of the Act, that would give you a monopoly of all the colours of the rainbow." The only exception to this rule was possibly in the case of an old mark.[3]

Registration in colours.

The alteration in the law in this respect made by the Act of 1905 is a very useful one, for many marks depend for their distinctiveness on their colouring, and in such cases advantage will no doubt be taken of the terms of sec. 10 to limit them to specified colours. It must be remembered, however, that the fact that the registration of a trade mark was so limited would have to be taken into account in considering a question of infringement. It is therefore not advisable in registering a trade mark to limit it as regards colour, except so far as is necessary in order to assist distinctiveness.

Where a mark is registered without limitation of colour, the Registrar may 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.[4]

The question of colour in connection with line headings for cotton piece goods is referred to in the earlier part of the chapter.[5]

Bearing of colour upon the resemblance of marks.

The colours in which a mark is actually used, or is likely to be used, have often a material bearing upon questions of alleged

[1] See note (3) previous page.

[2] *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J. But the same mark, registered without colours, *i.e.*, as a label with three parallel stripes and the words *red, white and blue*, had been protected from infringement by the use of a similar coloured label comprising the same words: *Hanson* v. *British Tea, &c. Association* (1884), Bacon, V.-C., and C. A.; Sebastian, 4th ed. p. 338.

[3] *Bass, Ratcliffe and Gretton's Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 129 and 529.

[4] Rule 103, below, p. 669.

[5] Above, p. 191.

resemblance calculated to deceive, or of infringement;[1] for instance, a design similar in outline to that of the device in another mark, but filled up in a totally different manner, may have the distinctive filling up obscured by the use of a deep colour in printing.[2] Again, registration of a mark which contained Oriental words meaning *The Golden Fan Brand*, was refused on account of the presence on the Register of a fan mark, which in use was in gold colour,[3] and the refusal was upheld by the Court of Appeal. The fact that a registered owner whose mark is registered without limitation of colour, may use it in any colour must also be taken into consideration. Thus the words *red star brand* were directed to be removed from the Register on the ground that they constituted a mark having such resemblance to a star device mark, which might be coloured red in actual use, as to be calculated to deceive.[4]

Trade marks for the same description of goods, which while resembling each other in the material particulars thereof differ in colour amongst other things, may be registered in a series.[5]

In some cases under the earlier Acts marks have been allowed to be entered or retained on the Register upon the proprietors undertaking to use them in particular colours only, a note of the undertaking being placed on the Register.[6] But some disapproval of notes on the Register limiting a registration was expressed in a subsequent case under the Act of 1898.[7] Under the present Act, however, a limitation of colour is expressly recognised, in addition to which the Registrar and the Court have full powers to impose conditions on applicants.[8]

[1] *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. See also *Lever Bros., Ltd.* v. *Bedingfield*, 15 R. P. C. 453; affirmed as to infringement, 16 R. P. C. 3 (1898), Kekewich, J., and C. A.

[2] *Worthington's Tm.*, 14 C. D. 8 (1880), C. A.; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J., *Turney & Sons' Tm.*, note (1).

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

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

[5] Sec. 26.

[6] *Re Jeffrey & Co.*, May 18th, 1888, Stirling, J., registration allowed with note binding applicants not to use mark in black, or any colour so dark as to resemble black; *Re Johnson, Philpott & Co.*, Feb. 21st, 1888, North, J., Register rectified by consent, by adding note that the proprietor was only to use his mark in blue and white. Both cases are cited Sebastian, 4th ed. p. 338.

[7] *Dewhurst's Application*, above note (3).

[8] Secs. 12 (2), (6) and 14 (5), (6).

CHAPTER IX.

DISCLAIMERS.

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Sec. 15 of the Act of 1905. Disclaimers.

Sec. 15 of the Act of 1905 enacts as follows:—

"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."

Mark may contain non-distinctive matter.

It is provided by sec. 9 of the Act that a registrable trade mark must contain or consist of at least one of the essential particulars enumerated in that section; and it is clear from that section, as well as from sec. 15, that a trade mark may include matter besides its essential particular or particulars, as, for

instance, the name and address of the proprietor of the mark, statements of quality or price, place of manufacture, or descriptive or ornamental matter. In the Act of 1883 certain additions to essential particulars were expressly authorised,[1] and there was also authorised the addition to a trade mark of any distinctive word, or combination of words, although the same was common to the trade,[2] that is to say, open to the trade,[3] in the particular goods. Under the Act of 1883, as amended by the Act of 1888, an applicant had to specify in his application the essential particular or particulars of his trade mark and expressly disclaim the right to the exclusive use of such additional matter or additions, except so far as they consisted of his own name, or the foreign equivalent thereof, or his place of business.[4] Registration of old marks with additions, but subject to disclaimer, was also allowed by these Acts.[5] The system of additions and disclaimers complicated the working of the Acts, and the result of the provisions as to disclaimer was in some cases that an applicant was required as a condition of registration of his mark to disclaim matter, which did not constitute an essential particular within the meaning of the Acts, but did form perhaps an important feature of his mark contributing to the distinctiveness of the whole. This result entailed in many cases a hardship on the owner of a trade mark, particularly as it was held that a plaintiff in a passing-off action could not rely in that action on matter which he had so disclaimed,[6] and some traders considered it preferable not to apply to register their trade marks, or even to submit to a trade mark being removed from the Register, rather than to make the disclaimer imposed on them by the Acts. Thus, in *Faulder's Trade Mark*,[7] the owners of a trade mark registered in respect of preserves elected to have their trade mark, which included the word "Silverpan," expunged from the Register rather than have a disclaimer of that word entered on the Register; and subsequently in an action for passing-off brought

Added matter in Acts of 1883 and 1888.

[1] Sec. 64 (2). The Act is fully set out below, pp. 626 to 645.

[2] Sec. 74 (1) (b).

[3] *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J.

[4] Act of 1883, secs. 64 and 74; Act of 1888, secs. 10 and 16.

[5] Act of 1883, sec. 74; Act of 1888, sec. 16.

[6] *Rosenthal* v. *Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. The Court of Session in Scotland refused, however, to follow that decision, *Bayer* v. *Baird*, 15 R. P. C. 615 (1898).

[7] [1902] 1 Ch. 125; 18 R. P. C. 37 and 535, C. A.

by the owners of the mark the word "Silverpan" was held to be a fancy word identified with the plaintiffs' firm, and an injunction was granted against the defendants restraining the use of a circular in which the words "Silver Pan" were prominent. The system of additions with disclaimers above referred to has been swept away by the Act of 1905,[1] and the scheme of that Act is that, provided that a mark is qualified for registration by the possession of one or more essential particulars, it should be registered as a whole, subject only in exceptional cases, where necessary for the protection of public or private rights, to a disclaimer having the effect of defining the rights of the owner of the mark. In a recent case[2] Eve, J., said that the object of the Legislature was to relieve traders from the necessity of disclaiming, and that the condition was one for the imposition of which some good reason ought to be established rather than one which ought to be imposed, unless some good reason to the contrary was made out; and he held that an unsuccessful claim to a monopoly of the letters A.B.C. was not a ground necessarily for requiring a disclaimer of them. The alteration of the law is especially important where registration abroad is desired, since some countries do not register a foreign owner of a trade mark unless it is registered in his own country.

Scheme of the Act of 1905 as to disclaimers.

In what cases disclaimers may be required.

A disclaimer under sec. 15 of the Act may be required in either of the following cases: (1) If the mark contains parts not separately registered by the proprietor as trade marks; (2) If it contains matter common to the trade or otherwise of a non-distinctive character.

Parts not separately registered.

(1) A combination trade mark or a label may, and often does, contain a mark which may be separately registered, as, for instance, a distinctive device; and it is expressly provided by sec. 25 that, 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 (*sic*). Each such separate trade mark must satisfy all the

[1] It will be found fully discussed in the 2nd edition of this work, Chap. IX., p. 197, but, as it is practically obsolete, the full discussion is omitted in this edition; and as to additions or added matter, see *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 535, C. A.; and *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902), Farwell, J. As to the particularity formerly required in a statement of essential particulars, see *Crompton's Tm.*, [1902] 1 Ch. 758: 19 R. P. C. 265.

[2] *Application of Albert Baker & Co. (1898) Ltd.*, [1908] 2 Ch. 86; 25 R P.C. 513 (*A.B.C.*).

conditions and have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms part are to be entered on the Register as associated marks, with the result that they are not separately assignable. A disclaimer may be required of parts of a mark not so separately registered subject to this, that the parts required to be disclaimed must be parts to the exclusive use of which the tribunal holds the proprietor not to be entitled, or the disclaimer must be necessary for the purpose of defining the rights of the proprietor of the mark under the registration; and these particular words of the section seem to apply to a case in which a mark contains matter, not common to the trade or otherwise of a non-distinctive character, but of which the owner of the mark cannot claim a right of exclusive use by reason, for instance, of another trader having the right to use the same.

Matter common to the trade.

(2) Matter common to the trade or otherwise of a non-distinctive character. The expression "common to the trade" occurred in sec. 74 of the Act of 1883, which allowed the registration as an addition to a trade mark of certain distinctive matter, although the same was common to the trade in the goods with respect to which the application was made, but a disclaimer of the exclusive use of such matter was required.[1] Matter which is really distinctive cannot at the same time be "common to the trade," so that the word distinctive in this section was held to mean *primâ facie* distinctive,[2] and the section was held to apply to additions which would be distinctive if they were not common to the trade. The expression "common to the trade" is capable of two meanings, namely, in common use in the trade,[3] or open to the trade to use. Sub-sec. (3) of sec. 74 (which enacted that any device, &c., which was, before August 13th, 1875, publicly used by more than three persons

The three mark rule.

[1] The section is fully set out below, pp. 631, 632. It was held under the Act of 1875 that registration of a distinctive label conferred no exclusive right to words common to the trade, *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886); and as to infringement of a label containing such matter, see *Hennessy* v. *Dompé*, 19 R. P. C. 333; 20 R. P. C. 175 (1903); and *Hennessy & Co.* v. *Keating*, 24 R. P. C. 485; 25 R. P. C. 125 and 361 (1908), H. L.

[2] *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*); *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535, Kekewich, J., and C. A. (*Silverpan*).

[3] "Nothing, I apprehend, can be common to the trade, which is only used by one person in the trade." Per Lindley, L.J., in *Thompson* v. *Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889).

on the same or a similar description of goods, should, for the purposes of that section, be deemed common to the trade in such goods) provided a test of what was common in the trade. It was in fact a statutory recognition of a rule, known as the three mark rule, originally introduced by the Commissioners of Patents under the Act of 1875, and recognised by the Courts before the Act of 1883 was passed.[1] It applied whether the marks used by the three persons were precisely, or only substantially, similar, and whether they had been used as trade marks or otherwise, provided that they had been used on the same or a similar description of goods,[1] but use abroad did not fall within the rule.[2] The Act of 1905 contains no similar provision, but the same test of what is common in the trade would no doubt be applied. But as regards additions to new marks, the words "common to the trade" in the earlier part of sec. 74 were held not to be confined to such matter, but to mean "open to the trade to use."[3] This would, of course, apply to all merely descriptive matter, but, as pointed out above, the section dealt with matter *primâ facie* distinctive, and the expression "common to the trade" was said in one case[4] to be applicable in the sense of "open to the trade to use" to a word once largely used in the trade, but which had subsequently fallen out of use by all but one or two persons, or to a word descriptive of the goods, if *primâ facie* distinctive.[5] In the Act of 1905 the expression is probably wide enough to include, not only matter in common use in the trade, but matter *primâ facie* distinctive, which for some reason, as, for instance, that suggested in *The Washerine* case, is open to the trade to use.[6] Matter which is merely descriptive is clearly covered by the words "or otherwise of a non-distinctive

[1] See *Jelley's Application*, 51 L. J. Ch. 639, n. (1878); *The Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394, n. (1877), both Jessel, M.R.: *Wragg's Tms.*, 29 C. D. 551 (1885), Pearson, J.; *Beabow v. Low*, 44 L. T. 875 (1881), Bacon, V.-C.; and the judgment of Chitty, J., in *Burland v. Broxburn Oil Co.*, 42 C. D. 274: 6 R. P. C. 482 (1889); also *Baker v. Rawson*, 45 C. D. 429; 8 R. P. C. 89 (1891), North, J.

[2] See *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.

[3] *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Boulder*). See also *In re Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535, Kekewich, J., and C. A. (*Silverpen*).

[4] *The Washerine* case, note (3).

[5] *Humphries v. Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*) and the *Washerine* and *Boulder* cases, note (3).

[6] In *Application of Albert Baker & Co.* (1898), *Ltd.*, [1908] 2 Ch. 80; 25 R. P. C. 513, Eve, J., seems to have so construed the section.

character" in sec. 15. Such matter, however, will not as a general rule be required to be disclaimed. The rights of other traders will generally be sufficiently protected by sec. 44, which provides that no registration under the 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.[1] Apart from this special enactment, the registration of a label distinctive as a whole does not give to the proprietor the right to the exclusive use of merely descriptive matter contained in it; at least this was so held under the Act of 1875 by the Court of Appeal,[2] and the principle of the decision seems to be still applicable.

Label distinctive as a whole.

It was settled under the Acts of 1883 and 1888 that words common to the trade or common matter contained in a distinctive label need not be disclaimed,[3] for a distinctive label is itself an essential particular, and consists of the combination of all the parts.[4] A distinction must be made between such a label and a mere word or device coupled with mere flourishes or a conventional border.[5] Under sec. 15 of the Act of 1905 there seems to be power to require a disclaimer of part of a distinctive label.

In any case coming within the terms of the first part of the section a disclaimer may be required of the right to the exclusive use (1) of any part or parts of such trade mark to the exclusive use of which the tribunal holds the proprietor not to be entitled, or (2) of all or any portion of matter, common to the trade or otherwise of a non-distinctive character, to the exclusive use of which the tribunal hold the proprietor not to be entitled.[6] The

[1] Cf. sec. 64 (3) (ii.) and sec. 74 (2) of the Act of 1883, as amended by that of 1888, below, pp. 629, 632.

[2] *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886). See also cases referred to above, p. 215, note (1)

[3] *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.; and *Application of Albert Baker & Co.* (1898), *Ltd.*, 25 R. P. C. 513 (1908), Eve, J. A contrary opinion seems to have been expressed in the earlier case of *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886). The *Washerine* and *Roadster* cases, p. 216, note (3), were not, perhaps, cases of labels distinctive as a whole.

[4] Per Esher, M.R., in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891).

[5] *Clement et Cie.'s Tm.*, p. 216, note (7); and in *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902), Farwell, J., a part of the label separated from the distinctive part by a border, and containing the name of the article and directions for use, &c., was held to be "added matter."

[6] The words "to the exclusive use," etc., seem to apply both to (1) and (2). See the section set out above, p. 212.

words marked (1) seem to refer especially to the words in the earlier part of the section relating to parts of the mark not separately registered, and the words marked (2) to common or non-distinctive matter; but it may be that the construction ought not to be strictly *reddendo singula singulis*. Lest the parts of the section already quoted do not meet the case, the tribunal is under it given an express power to require such other disclaimer as it may consider needful for the purpose of defining the rights of the proprietor under such registration; but the case must fall within the opening words of the section, otherwise no disclaimer can be required under it. By Rule 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. It will be noticed that the wording of this Rule does not follow that of sec. 15.

Time at which disclaimer may be required.

It was held, both under the Act of 1883 and that of 1888, that a disclaimer required by the Acts must be made on application for registration, and that therefore the Court on an appeal from the Comptroller could not allow an amendment of the application by disclaimer,[1] and, although the Court in a few cases did make an order for disclaimer on a motion for rectification,[2] the power of the Court so to do was questioned by the Court of Appeal.[3] It is quite clear that under sec. 15 of the Act of 1905 a disclaimer may be required by the Registrar on an application to register, or by the Board of Trade or the Court on an appeal from the Registrar in an application to register, or on such an application as a condition of registration of a standardisation mark under sec. 62, or by the Court on an application to rectify the Register under sec. 35. Full powers of allowing amendment of applications to register are conferred on the Registrar, the Board of Trade and the Court, by sec. 12 (6). In an application for rectification the proprietor could elect to have his trade

[1] *Goodall's Tm.*, 42 C. D. 566 (1889), North, J.; *Mews' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.; *Players' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J. A disclaimer was allowed in *König and Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 149.

[2] *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.; *Coe's Tm.*, 8 R. P. C. 207 (1891), Stirling, J.; *Barland v. Brunswick Pencil Co.*, 42 C. D. 274; 6 R. P. C. 182, Chitty, J.; *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J.

[3] *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 535.

mark expunged from the Register, rather than have a disclaimer entered on the Register. This appears clear from the terms of the section itself, and a trade mark can always be cancelled on the application of the proprietor.[1]

Disclaimer at the instance of the proprietor.

The Registrar may, on the request of the registered proprietor of a trade mark or of some person entitled by law to act in his name, enter on the Register a disclaimer or memorandum relating to it which does not in any way extend the rights given by the existing registration of such trade mark.[2] A right of appeal to the Board of Trade is given.

Effect of registration with disclaimer.

The effect of a disclaimer is that the proprietor of the registered trade mark cannot claim any trade mark rights under the Acts, in respect of the parts of the mark to which the disclaimer relates,[3] so that, for instance, no action for infringement lies in respect of the use or imitation of the disclaimed particulars. But sec. 15 expressly provides that no disclaimer 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. This proviso gets rid of the decision of North, J., who, in a passing-off case,[4] refused an interlocutory injunction on the ground that the plaintiff was relying on certain lett . the exclusive use of which he had disclaimed. The Scotch Court of Session, however, declined to follow North, J., on the point, and held that such a disclaimer did not affect the registered proprietor's common law rights.[5] In addition to the proviso to sec. 15, the Act contains an express reservation of all rights of action in passing-off cases.[6] The mere presence in a second mark tendered for registration of disclaimed words does not make it resemble an earlier registered mark, in which the same words had been disclaimed, within the

[1] Sec. 32. See also *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 535.

[2] Sec. 32. See also below, p. 313.

[3] *Pirie* v. *Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A., *Pirie's Parchment Bank*, the plaintiffs disclaimed *parchment* and *bank*, but sought to set up some right to the combination: as to this see *Hubbuck* v. *Brown*, 17 R. P. C. 633 (1900), C. A.; also *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

[4] *Rosenthal* v. *Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. See also *Packham* v. *Sturgess*, 15 R. P. C. 669 (1898), North, J.

[5] *Bayer* v. *Baird*, 15 R. P. C. 615 (1898) (*C. B. Corsets*). Cf. also *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*), with *Burland* v. *Broxburn Oil Co.*, 6 R. P. C. 482, Chitty, J. (*Washerine*); and see also *Packham* v. *Sturgess*, 15 R. P. C. 669 (1898), North, J., and C. A. (*Sparkling Lime Wine*).

[6] Sec. 45.

meaning of sec. 19.[1] But in comparing two marks which are alleged to resemble each other too closely, some account must be taken of elements common to the trade which are included in both,[2] and on this ground the registration of a trade mark, with the common words or other particulars which are actually used in it, may secure it a more efficient protection under sec. 19 against the subsequent registration of similar marks in the same class than would be obtained by the registration of its distinctive elements only. If the places occupied by matter which would have to be disclaimed are left blank upon the Register, the proprietor forfeits none of his exclusive rights to the use of the registered and distinctive parts of the mark by filling up the blanks, in actual use, in any manner he pleases,[3] and, for the purposes of sec. 19, marks should be compared with the blanks filled in as actually used.[4]

Registration with blanks.

Traders prefer to register their marks as they are actually used, both because it saves the expense and trouble of preparing special prints for registration only, and for convenience of reference. Moreover, in some foreign countries registration is only permitted in the case of trade marks owned by foreigners in the exact form in which the marks are registered in the country of origin.

[1] *Loftus' Tm.*, [1894] 1 Ch. 193 : 11 R. P. C. 29, North, J. (*l'nen' Guid* in each of two quite distinct labels) ; and the cases in note (3), p. 219.

[2] See Chap. X., p. 241.

[3] *Melachrino & Co.* v. *The Melachrino Egyptian, &c. Co.*, 4 R. P. C. 215 (1887) : *Hammond* v. *Brander*, 9 R. P. C. 301 (1892). both Chitty, J. : and see Chap. XV., at p. 250.

[4] *Christiansen's Tm.*, 3 R. P. C. 54 (1886) ; *Lyle & Kinahan's Application*, 24 R. P. C. 249 (1907). C. A.

CHAPTER X.

RESTRICTIONS ON REGISTRATION.

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The Registrar's discretion is not limited by the express restrictions.

NOTHING can be entered upon the Register which is not authorised by the sections set out and commented on in Chapter VIII.,[1] and, as stated in that chapter, the Registrar has a discretion, subject to appeal, to refuse to register marks which he thinks ought not to be accepted, although they comply with the provisions of the enabling sections. This discretion is, as has been shown, general, and it extends beyond the letter of the restrictions imposed by other sections of the Acts which are the subject of the present chapter.[2]

The most important sections to be considered in this chapter are secs. 11, 19, 20, and 21.

I. Identical or Resembling Marks.

Identical or resembling marks.

Sec. 19 is as follows:—

"Except by order of the Court or in the case of trade marks in use before the the thirteenth day of August, one thousand eight

[1] Page 129, secs. 9 and 62, see "reasons for refusal," p. 71.

[2] Certain restrictions on registration are imposed by Rules 11 to 16 inclusive; see below, p. 657.

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."

And sec. 20 provides:—

Rival claims to identical marks.

"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 descriptions 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."

The corresponding provisions of the Act of 1883, as amended by the Act of 1888, were as follows:—

Sec. 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.*

"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.*

"(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.*"

It will be noticed that sec. 20 extends to marks nearly identical, whereas sec. 71 of the former Act was confined to cases in which there were conflicting claims to registration to the same trade mark. The provisions of the two sub-sections of sec. 72 of the former Act are now condensed into a single provision, which is substantially the same as before; in adopting the expression "so nearly resembling" instead of "having such resemblance," the Legislature has, however, reverted to the language of the Act of 1883 before amendment. The former expression suggests a closer resemblance than the latter one does.[1]

Old marks.

The special exception made in sec. 19 in the case of a trade

[1] See the Report of Ld. Herschell's Committee, quoted below, p. 237.

mark in use before August 13th, 1875, the commencement of the first Registration Act,[1] enables the Registrar to accept such a trade mark, although it is identical with one already on the Register for the same goods or description of goods. Under the repealed Acts, an order of the Court was required by sec. 72. Before the introduction of registration, when trade mark rights could, except in a few special trades and in particular places,[2] be acquired only by user, the duplication of marks for use in connection with the same description of goods, by use in different districts, was very common, and many duplicate old marks have been admitted on to the Register. A limit was put to the number of such duplicates which would be accepted by the adoption of the three mark rule which has been already referred to.[3] According to the rule, three, but not more than three, identical or substantially identical[4] old marks may be registered for use upon the same, or substantially the same, class or description of goods, provided that the marks have been honestly and lawfully acquired and used. So that a mark which was originally unlawfully copied from another could not claim registration along with the other under cover of the rule.[5] If more than three such marks had been so acquired and used before August 13th, 1875, they were all treated as common to the trade;[6] but the use of a mark abroad did not fall within the rule.[7] Leave to register a second old mark is granted as of course, if an independent and honestly acquired title to the mark as a trade mark is shown. In *Jelley's* case,[8] Jessel, M.R., said: "I have often had the case of a man in one town not knowing that another man in another town has the same mark, and he has got his trade mark registered. The second applicant must prove his title, that is all. The leave of the Court mentioned in sec. 6[9] is not a capricious leave. The rule of the Court which I have just stated is always followed, and it merely means that the second man must show his title. You cannot deprive him of his trade mark. Look at the monstrous injustice that would be done if a man who had a trade mark for,

The three mark rule.

Application of the rule.

[1] Trade Marks Registration Act, 1875, printed below, p. 647.

[2] *E.g.*, the cutlery trade in Sheffield.

[3] Chapter IX., p. 215: Act of 1883, s. 74 (3).

[4] *White Rose Tm.*, 30 C. D. 505 (1885), Kay, J.

[5] *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M.R.

[6] See *Burland* v. *Broxburn Oil Co.*, 42 C. D. at p. 280; 6 R. P. C. 482 (1889), Chitty, J.

[7] *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.; and see *Jackson & Co.* v. *Napper*, 35 C. D. at p. 178; 4 R. P. C. 45 (1886), Stirling, J.

[8] 51 L. J. Ch. 639, n. (1878).

[9] *I.c.*, of the Act of 1875.

perhaps, forty years, should lose it, because another man who had it for four years had happened to register it first." It was held that registration of an old mark might be allowed, although a similar mark had been on the Register for more than five years.[1]

The rule has never been applied to new marks, that is to say, to marks first used or invented since August 13th, 1875.[2] Title to a trade mark can still, however, be acquired by use, although registration is a condition precedent to any action by the proprietor in respect of its infringement,[3] and it is possible for two traders to acquire similar trade marks independently by user in separate districts. The Court has, however, now a discretion to allow registration of similar marks in a case of honest concurrent user.[4]

Sec. 20. Duplicate claims.

Section 20 empowers the Registrar, if there are rival claimants to registration of identical or of nearly identical trade marks in respect of the same goods or description of goods, to refuse registration, until their rights have been determined by the Court or settled by approved agreement. It corresponds to sec. 71 of the Act of 1883. Both sections are set out in extenso at the commencement of this chapter. Section 20 deals with cases in which there are two or more applications pending, sec. 19 with those in which one of the rival owners or claimants is already on the Register. The search to be made by the Registrar on receiving an application to register includes pending applications.[5] Two methods of settling the conflicting claims are permitted under the section, one by submitting the question of such claims for determination by the Court, the other by agreement. No special procedure under this section is laid down by the rules.[6] In the first case that was submitted to the Court under the section, the application was by one of the claimants that the registration might proceed notwithstanding the other application; this was in accordance with the usual directions given by the Court under the earlier Acts and the rules thereunder.[7] In

[1] *Jackson & Co.* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45; *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1888), both Stirling, J.

[2] *Jackson & Co.* v. *Napper*, 35 C. D. p. 162; 4 R. P. C. 45 (1886), Stirling, J.: *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.; and see *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

[3] Sec. 42.

[4] Below, p. 264.

[5] Rule 20, below, p. 659.

[6] Rule 121 provides that appeals to the Court shall be by motion, but the application to the Court under sec. 20 may not be an appeal.

[7] *Simpson, Davis & Son's Tm.*, 15 C. D. 525 (1880), Jessel, M.R. Rule 44 of 1890 provided, however, that the claims should be submitted to the Court by a special case, unless the Court otherwise ordered.

the case referred to Joyce, J., entertained the motion in the absence of objection, but without laying down a general rule that the procedure adopted was right.[1] In a subsequent case in which each of the rival claimants entered an opposition to the application of the other, and the Registrar declined to proceed with either application until the rights of the claimants had been determined by the Court, the matter came before the Court on motions by the several claimants that the Registrar might be ordered to proceed with their respective applications.[2]

Registration by agreement of identical or nearly identical marks is now authorised, with the limitation that the approval of the Registrar, or (on appeal) of the Board of Trade, is required. Probably no agreement will be approved where the applicants have no existing rights in the marks arising from user or otherwise; the language of the section seems to imply that the applicants have some claims to the respective trade marks other than merely being applicants for registration. The Court has under sec. 21 power to permit duplicate registrations in the case of honest concurrent user,[3] and probably what may be done by the Court under that section may be done by agreement under sec. 20.

Public interests to be considered.

In deciding cases under secs. 19 and 20 the Court will consider public interests as well as the rights of the applicants *inter se*, and, unless the former are protected, will not give effect to an agreement for concurrent registrations of identical new marks, at all events in the absence of special circumstances.[4] In *Ehrmann's Trade Marks*[5] the applicants had formerly been partners, and certain registered marks had been used by the firm. The partnership was dissolved by an agreement that one partner should carry on business under one trade name which had been used by the firm, and the others under another trade name which had also been used by the firm, and each party was to be entitled to use the firm's marks with certain alterations to be made by them respectively, and applications were to be made by each party for registration of such marks; the agreement also provided for the cancellation of the former registrations if that should be necessary for the fresh registrations. On the

[1] *Hudson's Application*, 24 R. P. C. 582 (1907). On the hearing of the motion the mark was held to be *publici juris*.

[2] *Application of Albert Baker & Co.* (1898), *Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

[3] See below, p. 264.

[4] See below, Concurrent User, p. 264.

[5] [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

applications for registration being made, the Comptroller required the respective applicants to submit their rights to the Court, whereupon the applicants appealed. On the appeals being referred to and coming before the Court, the Comptroller raised objections to registration—first, on the ground of the existing registrations, but, having regard to the view which the Court took, this was not finally dealt with; and, secondly, on the ground that identical new marks ought not to be registered in the names of different persons; whilst the applicants relied on the special circumstances as giving them a right to the registrations. Stirling, J., held that in such a case the Court should consider the protection of the public, and ought to be satisfied that there was no reasonable probability of harm resulting, and he dismissed the appeals.[1]

The words "except by order of the Court" refer presumably to cases in which, either on concurrent applications under sec. 20, or under the powers conferred by sec. 21, the Court shall have made an order permitting identical or resembling trade marks to be registered by different proprietors for the same goods or description of goods.[2]

Sec. 19 is not limited by the register classes.

The operation of sec. 19 is not limited by the classes into which goods are divided for the purposes of registration.[3] Thus, in *The Australian Wine Importer's* case, which was decided under the Act of 1883, the question arose whether an application to register a label containing a device and the words *Golden Fleece* for wine could be opposed on the ground of the prior registration of what were held to be similar labels for spirits, both wine and spirits being in the same register class (42), and Kay, J., held that, whether sec. 72 of the Act of 1883 applied or not, the use of the mark tendered, having regard to the presence on the Register of the other marks, would be calculated to deceive within the meaning of the next section, and that it ought not to be registered. The Court of Appeal affirmed the decision, and Lindley, L.J., said[4]: "For the purpose of deciding whether two sets of goods are of the same description, we must not, it appears

[1] See now sec. 23 as to apportionment of the trade marks of a firm on dissolution, below, p. 352.

[2] See below, pp. 264 to 266.

[3] In the Act of 1875 the words "goods or classes of goods" were used instead of "goods or description of goods" used in the Acts of 1883 and 1905.

[4] 41 C. D. p. 291; 6 R. P. C. 311 (1889).

to me, lay too much stress on the classification in the schedule to the rules. You find there goods of the same description in different classes, and goods of different descriptions in the same class. For example, if you turn to classes 26—29, you will find that flax and hemp are in one class, and jute in another, though all of them are fibrous, and more or less of the same description for trade purposes. Then, if you turn to class 22, you will find bicycles and railway carriages in the same class. Now, for trade purposes, can you have any goods more different than bicycles and railway carriages? Of course, they are utterly different things, and yet they are put by the framers of these Rules into the same class, so that we cannot be guided by their classification in construing the words 'same goods or description of goods,' which are the words used in sect. 72." And the judges were all inclined to think that wines and spirits were of the same description of goods, although they did not decide the point. And North, J., in a subsequent case, expressed the opinion that beer and rum are the same description of goods within the meaning of the section.[1] In a later case[2] Romer, J., found as a fact that there was an intimate connection between the bicycle and camera trades, and he ordered a trade mark, which had been registered in class 22 for bicycles, to be expunged on the application of a company which had used the mark for bicycle cameras and had registered marks containing the word in question in classes other than class 22.[3] On the other hand, in *Braby & Co.'s Applications*, North, J., allowed a new mark to be registered for galvanised iron sheets, although a similar mark was already registered and used for bar iron and

The same goods or description of goods.

[1] *Turney & Sons' Tm.*, 11 R. P. C. 37; 10 Times L. R. 175 (1893), North, J.

[2] *Eastman, &c. Co., Ltd.* v. *John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898) (*Kodak*). As to this case see also below, p. 269; and see *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890), where the registration of "Dunn's Fruit Salt Trade Mark Baking Powder" was refused for baking powder in class 42 by reason of a prior use of the words "fruit salt" for a medicinal drink; and *Eno* v. *Dunn*, 10 R. P. C. 261 (1893).

[3] In *Finlay* v. *Shamrock Co.*, 22 R. P. C. 301 (1905), Porter, M.R., Ireland, an infringement case, the defendants' washing powder, which contained no soap, and the plaintiff's washing powder, sold as an extract of soap, were held to be the same description of goods. In *Compagnie Industrielle des Petroles' Application*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J., expressed the opinion that lubricating oil suitable for motor and petrol spirit were goods of the same description within the meaning of sec. 19. A difference in the nature of the goods is often an important element in passing-off cases; see below, p. 524.

wire, which goods were within the same register class as the iron sheets.[1] The true test would seem to be supplied by the question —Are the two sets of goods so commonly dealt in by the same trader that his customers, knowing his mark in connection with one set and seeing it upon the other, would be likely to suppose that it was used upon them also to indicate that they were his goods?[2] It has already been stated that the proprietor of a mark used for only part of a register class, even though it be registered for the whole, and *à fortiori* if the registration as well as the user is limited within the class, cannot by virtue of his registration prevent the use of the mark by other traders upon other descriptions of goods, although they may be included in the same register class.[3] But the fact that an opponent of an application for registration could not get an injunction to restrain the use which the registration sought is intended to cover, is by no means conclusive upon the question of the right to registration.[4]

Use or registration for part of a register class.

A second mark has often been admitted to registration by agreement with the proprietor of a mark already registered, who might otherwise have opposed it, on the terms that it shall be limited to part only of the register class. The limitation was effected by placing a note on the Register.[5] And in the same way marks have been allowed to be registered on the terms of being used in a particular manner, so as not to be confused with

Registration of a second mark by agreement.

[1] 21 C. D. 223 (1882); and see *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M.R.; see also *Edwards* v. *Dennis*, 30 Ch. 454, where a mark which had been used only for sheet iron was held not to be infringed by use of a somewhat similar mark for wire; and cf. *König and Ebhardt's Tm.*, 13 R. P. C. 449; [1896] 2 Ch. 236, where Stirling, J., allowed registration of a mark in class 39 on the application being confined to account books, ruled paper, and other paper for use in books. In *Suter, Hartmann & Rahtjen's Composition Co.'s Tm.*, 19 R. P. C. 42 (1902), Byrne, J., expressed the opinion that glue and gelatine were not the same description of goods as anti-corrosion and anti-fouling compositions, all being within Class I. In *Leiner's Application*, 20 R. P. C. 253 (1903), Byrne, J., registration for gelatine was allowed notwithstanding the use of an unregistered mark for tapioca and sago (Class 42). In *Lake and Elliott's Application*, 20 R. P. C. 605 (1903), Kekewich, J., the application was to register "Millenium" for carriages; the opponents who were flour millers had registered the same word for "food," and had sold flour and bread under the name "Millenium" out of carts bearing prominently that name and alleged that some confusion would be caused, but their opposition failed.

[2] See per Kay, J., 41 C. D. at p. 281, in the *Australian Wine Importers'* case.

[3] See p. 104, sec. 8; and see *Hargreaves* v. *Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

[4] See *The Australian Wine Importers'* case, supra, and p. 227, above.

[5] See *Re Rabone Bros. & Co.*, Seb. Dig. p. 395 (1879), Jessel, M.R.

a mark already registered,[1] or for use in a particular district.[2] And the Comptroller has in some cases been directed to put a note, in accordance with the agreement, upon the Register.[2] These last-mentioned cases, however, were decided under an old rule; and the Court of Appeal, in a case under the Act of 1888, disapproved of placing any territorial limitations on the Register on the grounds both of the want of jurisdiction to do so, and of the inexpediency of such a course having regard to the duty of protecting the public.[3] Under the Act of 1905, however, the Registrar, the Board of Trade, and the Court have power in an application to register to allow registration subject to conditions,[4] and sec. 24 expressly authorises, in cases which fall within it, conditions and limitations, if any, as to mode or place of user or otherwise.[5] But inasmuch as the tribunals have regard to the interests of the public as well as of opponents, they will probably, except perhaps in cases under sec. 21, be chary of allowing registration with a territorial limitation.

Where identical or similar marks are registered for different goods in the same register class, it is an infringement for the proprietor of either to use his mark upon the goods for which the other is registered.[6]

The provisions of sec. 19 embody the old rule, that a mark which from its resemblance to an existing trade mark is calculated to deceive cannot be protected as a trade mark, for its use is an infringement of the other mark, which would be restrained by the Court.[7] But the restriction extends beyond the rule, and it does not follow, because an opponent could not obtain an injunction against the use by the applicant

Sec. 19 extends beyond infringing marks.

[1] *Whiteley's Tm.*, 43 L. T. 627, n. (1879), Jessel, M.R.; *Sykes & Co.'s Tms.*, ibid., p. 626 (1880), Hall, V.-C. For restrictions as to colour, see Chap. VIII., at p. 209.

[2] *Keep's Tm.*, 26 C. D. 187 (1884), Pearson, J.; *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1884), Chitty, J.; *Whiteley's Tm.*, 43 L. T. 627 (1879), Jessel, M.R.

[3] *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 289 (Lindley, Lopes, and Kay, L.JJ.); and cf. *Ehrmann's Tms.*, supra, p. 226; and *Hall and Woodhouse's Application*, 19 R. P. C. 58 (1902), Buckley, J., where the registration of a second mark was refused, although both marks were local and their districts wide apart.

[4] Sec. 12 (2) and (4); sec. 14 (4) and (6). See also the similar power given by sec. 23 on an apportionment of trade marks where the goodwill of a business has become divided.

[5] See Concurrent User, below, p. 264.

[6] *Upper Assam Tea Co.* v. *Herbert*, 7 R. P. C. 183 (1890), C. A.

[7] *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L.C.; and see *Cope* v. *Evans*, L. R. 18 Eq. 158 (1874), Hall, V.-C., and the cases there cited. Deceptive trade marks are not protected, see Chap. XV., at p. 426.

of the mark which he tenders for registration, that it is not calculated to deceive within this sub-section. Thus, in *Speer's* case,[1] Kay, J., said: "I could quite conceive a case in which the similarity would not be such as would induce the Court, on that fact alone, to grant an injunction, but in which the Comptroller would still be entirely within his duty in saying that these marks are so nearly resembling one another, at any rate, that I will not, by allowing the registration, encourage the use of a mark which may lead to litigation hereafter. It seems to me that is a matter which the Comptroller ought to consider." And this is fully in accord with the judgments of the law lords in *The Fruit Salt* case;[2] and the distinction has often been noticed.

The law under the corresponding section of the Act of 1883 was summed up by Parker, J.,[3] in a case involving the comparison of two words, as follows: "You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods—then you may refuse the registration, or rather you must refuse the registration in that case."

Consents of proprietors.

The restrictions on registration of deceptive marks are not only for the protection of owners of marks on the Register, but also of the public, and therefore, notwithstanding the consents of owners who might oppose the registration, a mark may be refused on the ground of the likelihood of confusion with their marks, and the consents are only some evidence as to the probability of deception.[4]

[1] 4 R. P. C. at p. 524; 55 L. T. 880 (1887); and see *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.

[2] *Eno* v. *Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890). See also *Société, &c. de l'Étoile's Tm.*, below, page 232, note (4).

[3] *Picnotist Co., Ltd.'s Application*, 23 R. P. C. 774, at p. 777 (1906).

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

The words "belonging to a different proprietor" in sec. 19 limit the operation of the section by excluding from it a case in which an applicant has already on the Register for the same goods or description of goods a trade mark similar to the one which he is applying to register. In one case under the Act of 1888 an objection by the Registrar founded on such a similarity was upheld by the Court.[1] In such a case the Registrar may under the Act of 1905 require the marks to be registered as associated trade marks.[2]

Expired trade marks.

Under sec. 31 a trade mark which has been removed from the Register for non-payment of renewal fees is for the purpose of sec. 19 deemed to be a registered trade mark during one year next after the removal, unless it is shown to the satisfaction of the Registrar that there has been no *bonâ fide* user of it during the two years immediately preceding such removal.

Marks used in different Markets.

Limitation to particular market.

The question has been raised whether a mark which is sufficiently distinguishable from an opponent's mark everywhere except in a particular country or market, but has there such resemblance to it as to be calculated to deceive, on account of the local circumstances of the trade, for instance, because goods bearing the latter mark have locally acquired a particular name,[3] falls within the section, and ought, therefore, to be refused registration.[4] The question has not been directly decided,[5] but it is submitted that the objection would be sufficient to justify the rejection of the mark, unless the justice of the case could be met by a limitation as to area placed on the Register.[6] The

also *König & Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 449, Stirling, J. And as to compromise on an application to expunge, see below, p. 288.

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

[2] Secs. 24 and 25. See above, p. 107.

[3] See p. 250, below.

[4] In *Société Anonyme des Verreries de l'Étoile*, [1894] 1 Ch. 61; 10 R. P. C. 436, the trades of the applicants for rectification and of the respondents were in fact competing in the colonies, and Stirling, J., held that the use of the applicants' mark on goods shipped in English ports for the colonies was use in England, where the respondents' main trade was. Aff. by C. A., [1894] 2 Ch. 26; 11 R. P. C. 142.

[5] In *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A., Lindley, Lopes, and Kay, L.JJ., similar questions were discussed, and it was pointed out by Kay, L.J., that there might be deception in Burma, but the Court thought that there might be deception outside Burma, and proceeded on that ground.

[6] See the case last cited.

authorities cited below[1] show that probability of deception in England only is not all that is to be considered in cases of infringement; and it cannot be supposed that a mark would be admitted on to the Register if it were shown that the proprietor would forthwith, upon the application of the opponent, be restrained from using it. It is true that, where old marks have been in use simultaneously for years in different markets, the injunctions granted in infringement cases have occasionally been locally limited,[2] and such limitations have the support of a dictum of Cotton, L.J., in *Johnston* v. *Orr-Ewing*;[3] but in that case, on appeal, Lord Selborne expressed a doubt whether the rightful and *bonâ fide* trade mark of the trader using it could be excluded by injunction from particular markets (though unimpeachable everywhere else), merely because in those markets it might be liable to be called by a name which the mark of another had already acquired there.[4] And it seems clear that the principle upon which the limitation of the injunctions in the cases referred to was based cannot avail to enable a new mark to be registered, which is deceptive in any market, by reason of the existence of a mark with which it might there be confused. Moreover, as regards registered marks, registration confers in the absence of an express limitation rights unlimited as to locality; and, although the owner of a previously registered mark may not yet have extended his trade to the particular market in question, it is open to him to do so.[5] Thus, in *The John Bull Beer* cases, where the two marks concerned were used by the plaintiffs and the defendants respectively in different districts of England, the more lately adopted mark was refused registration, and subsequently an injunction was granted to restrain the use of it.[6] So, too, in *The Jackson Co.'s* case,[7] registration of a word was refused

[1] Page 235.

[2] *Carver* v. *Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C.; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J., a passing-off case. See below, p. 549.

[3] 13 C. D. p. 464.

[4] 7 App. Ca. p. 227. To that proposition, he said, he could not assent. See also the observations of Ld. Alverstone in *Lyle and Kinahan's Application*, 24 R. P. C. 249 (1907) at p. 259.

[5] See *Denhurst's Application*, p. 232 note (5).

[6] *Paine & Co.* v. *Daniells & Son's Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217. In *Grant* v. *Lecill*, 18 R. P. C. 361 (1901), Porter, M.R., Ireland (*Globe Furnishing Company*), the defendants contended that an injunction should not be granted on the ground that the plaintiffs did not largely trade in Ireland, but this defence failed.

[7] 6 R. P. C. 80; 60 L. T. 93 (1888), Kay, J. (*Kokoko*).

because it was the name of a common mark in the cotton trade among the Chippeway Indians, to whom the English cotton trade had not then extended. In *Deakhurst's Application*,[1] the Court of Appeal refused registration of a mark, having as an essential particular the words *The Golden Fan Brand* in the Burmese language and characters, on the ground of the presence on the Register, in respect of the same goods, of a fan which in fact, as used, was coloured gold. In this case the owner of the latter mark had consented to the registration, and the applicants were willing to submit to a condition that the mark should only be put on goods exported to Burma, and they adduced evidence that part of the mark was already known there as *The Golden Fan Trade Mark*. The broad ground on which the Court acted was that a second mark should not be placed on the Register containing a mere verbal description of an existing mark, because of the danger of purchasers being deceived.[2]

In the case of honest concurrent user or other special circumstances which in the opinion of the Court make it proper so to do, the Court may under sec. 21 permit registration of the same trade mark or nearly identical trade marks under conditions which may include a limitation as to place of user[3]; but, except in cases falling within this section or sec. 20, registration of a new mark with such a limitation will probably not be allowed, at all events where it is opposed by the owner of a trade mark registered for the same goods or description of goods.

Deceptive Resemblance.

Calculated to deceive.

"Calculated to deceive" may mean either "intended to deceive" or "likely to deceive," and the prohibition applies where the case falls within either meaning,[4] although the latter, which is, of course, the more inclusive meaning, is sufficient to dispose of most, if not all, of the questions that arise under the section. The words are not equivalent to "capable of being used to deceive,"[5] for it must be assumed, until the contrary is shown, that the applicant will make an honest use of his mark.[4] A

[1] [1896] 2 Ch. 137; 13 R. P. C. 288.

[2] The decision expressly left it open for the Comptroller, if he thought fit to do so, to allow the words to be registered as additional words subject to a disclaimer. In the application the words had been claimed as an essential particular.

[3] Sec. 21, below, p. 264.

[4] *Kuhnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*); and see the next case.

[5] *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

trade mark is calculated, by its resemblance to another already on the Register, to deceive, if in the course of its legitimate use in the trade it is likely to do so.

Two important questions are suggested by the section: A. Who are the persons whom the resemblance must be calculated to deceive? and, B. What rules of comparison are to be adopted in judging whether such resemblance exists?

A. What Persons are to be considered.

Whom the mark must be calculated to deceive.

In accordance with the cases decided in suits and actions for the infringement of trade marks before the Registration Acts, it is held that the persons to be considered in estimating whether the resemblance between the marks in question is calculated to deceive are all of those who are likely to become purchasers of the goods upon which the marks are used. So that, if such persons, using ordinary care[1] and inteliigence, are likely to be deceived, then the Registrar ought not to accept the mark.

The ultimate purchasers.

It is clearly not enough for the applicant to show that retail dealers buying his goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade mark to deceive their customers, the ultimate purchasers.[2] In fact, dealers who buy from the manufacturers in order to sell by retail are generally aware of attempted infringements, and are parties to the fraud.[3]

Foreigners.

Nor is the inquiry to be confined to England, or to persons acquainted with the English language, in cases where the goods

[1] *Christiansen's Tm.*, 3 R. P. C. 54 (1886). See per Esher, M.R., p. 62, quoted below, p. 240.

[2] *Wilkinson* v. *Griffith*, 8 R. P. C. at p. 374 (1891), Romer, J. See the judgment of Mellish, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. 616 (1872); and the judgment of Ld. Selborne in *The Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. 15 (1882); and *Powell* v. *Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54; 12 R. P. C. 496; 13 R. P. C. 235; and in the House of Lords, [1897] A. C. 710; 14 R. P. C. 720; especially the judgment of Kay, L.J., 13 R. P. C. 250; and *Hubbuck* v. *Brown*, 17 R. P. C. 645 (1900), C. A.

[3] *Anglo-Swiss, &c. Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.; *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A. "In my opinion the whole gist of the complaint against the defendants is, 'You have sold a weapon calculated to be used fraudulently by the middlemen'" (Cotton, L.J.). If ultimate purchasers do not know who is the manufacturer of the goods which they have been accustomed to purchase, that circumstance might contribute to make the mark of a rival trader deceptive. Cf. *Powell* v. *Birmingham Vinegar Brewery Co.*, supra, note (2); especially Ld. Watson's judgment, 14 R. P. C. at p. 730.

Persons of ordinary ability and carefulness.

in question have a foreign market.[1] It must not be assumed that a very careful or intelligent examination of the mark will be made,[2] and if it were shown that the class of persons who bought the goods were illiterate, that would be a material fact in cases where printing entered into the marks;[3] but, on the other hand, it can hardly be a bar to the admission of a mark that unusually stupid people,[4] "fools or idiots,"[5] may be deceived.[6] And if the goods are expensive and not of a kind usually selected without deliberation, and the customers generally educated persons, these are all matters to be considered.[7] If some parts of the mark are common, one must consider whether people who know the distinguishing characteristics of the opponent's mark would be deceived.[8] The cases cited are nearly

[1] *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson* v. *Griffith*, supra.

[2] "Unwary purchasers": *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508 (1872), Ld. Chelmsford; *The Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. 15 (1882). Ld. Selborne. "Ordinary purchasers purchasing with ordinary caution": *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L.C. "Ordinary or unwary purchasers": *Powell* v. *Birmingham Vinegar Brewery Co.*, 13 R. P. C. at p. 258, Lindley, L.J.; not "persons of an ideal character who either are particularly innocent or too easily deceived": *Payton* v. *Snelling*, 17 R. P. C. at p. 57, Romer, L.J., whose judgment was approved by the H. of L., 17 R. P. C. 628; and see the judgments of Kekewich, J., in *Marshall* v. *Sidebotham*, 18 R. P. C. 43 (1901), and *Alaska Packers' Association* v. *Crooks*, 18 R. P. C. 129 (1901). "The unwary customer is extremely difficult to find": see the last case.

[3] See *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492. The proposition is not contrary to the following passages from the judgments in *Singer Manufacturing Co.* v. *Loog* where the fact of illiteracy of the customers was not established. "Whatever be the class of persons who buy these things (sewing machines), we must at all events assume that they are persons capable of reading and writing, or of reading, at all events": per James, L.J., 18 C. D. p. 413. "The possibility of such a mistake is not a cause of action (for passing-off). The same thing might happen if the defendant issued circulars that his were *not* Singer sewing machines. For however large he printed the *not*, some one might not see it": per Ld. Bramwell, 8 App. Ca. p. 42. In one case in which the goods (lemonade powders) were largely bought by children, and it was suggested that they would be more easily deceived than adults, Byrne, J., expressed the opinion that, having regard to the nature of the goods, which they would be likely to purchase for themselves, they would be less likely to be deceived than grown-up people: *Clark* v. *Sharp*, 15 R. P. C. at p. 149 (the case was settled on appeal, 15 R. P. C. 268 (1898)).

[4] *Payton & Co., Ltd.* v. *Titus Ward & Co., Ltd.*, 17 R. P. C. at p. 67, Romer, L.J. (1900).

[5] Jessel, M.R., 2 C. D. at p. 447.

[6] See note (3), ante.

[7] *Pianotist Co.'s Application*, 24 R. P. C. 774 (1907). Parker, J. (*Neola, Pianola*).

[8] See the judgments of Romer, L.J., in *Payton & Co., Ltd.* v. *Snelling & Co., Ltd.*, 17 R. P. C. at p. 57; and *Same* v. *Titus Ward & Co., Ltd.*, 17 R. P. C. at p. 67 (1900) (passing-off cases); the former judgment being approved by the H. of L. on appeal, 17 R. P. C. 628; also *Alaska Packers' Association* v. *Crooks*, and *Marshall* v. *Sidebotham*, note (2), above.

all cases of infringement or passing off, and, as already said, a weaker case than would entitle a plaintiff to succeed in an action for infringement will enable an opponent to successfully object to the registration of a new mark.

B. Rules of Comparison.

What amount of resemblance is calculated to deceive.

It is impossible to discover from the decided cases any criterion as to the amount of resemblance which will suffice to cause the rejection of a mark more definite than that expressed in the section itself, and probably no test could usefully be stated ;[1] but a perusal of the more recent cases under the Act of 1888 shows that the Comptroller and the Court applied the restriction much more strictly against new marks than formerly, and, as already shown, it is settled that the onus of proving that there is no reasonable probability of deception is cast on the applicant.[2] In comparing the marks, the Registrar must, as appears from the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's. The report of Lord Herschell's Committee on this point admirably states what are conceived to be the critical tests, and it shows also what the amendment of the Act of 1883[3] by the Act of 1888 was intended to effect ; but it must be borne in mind that the Legislature has in the Act of 1905 reverted in this respect to the language of the Act of 1883. It will be useful to set out the whole passage.

1. The "Idea of the Mark" is to be regarded.

Lord Herschell's Committee on the principle of comparison.

"We have given very careful consideration to the evidence which has been laid before us by those interested in the trade of Lancashire. The number of marks registered in classes 23, 24, and 25, which are commonly described as the Cotton Classes, is very large; and the administration of the Act in relation to these classes is of great importance to the trade. There can be no doubt that the working of the Trade Marks Act has not given

[1] "What degree of resemblance is necessary (to constitute an infringement) is, from the nature of things, a matter incapable of definition *à priori*" : per Cranworth, L.C., in *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866).

[2] *Eno* v. *Dunn*, 15 App. Ca. 252 ; 7 R. P. C. 311 (1890). See also *Capsuloid Co., Ltd.'s Application*, 23 R. P. C. 782 (1906), Swinfen Eady, J.

[3] Substituting "having such resemblance" for "so nearly resembling."

satisfaction in Lancashire. Even if at times there may have been a disposition to expect too much, we think there have been substantial grounds for the dissatisfaction which has prevailed. The great bulk of the goods manufactured in Lancashire, in respect of which trade marks are used, is exported to other countries, and there can be no doubt that these marks fulfil important functions in the trade between Lancashire and India and other countries. One chief complaint has been that the usages of the trade and the character of the markets where the marks are intended to serve their purpose have not been sufficiently kept in view by the Patent Office. By sec. 72, sub-sec. (2), the Comptroller is directed not to register, with respect to the same description of goods, a trade mark so nearly resembling a trade mark already on the Register with respect to such description of goods as to be calculated to deceive. It is on the question whether marks do so nearly resemble one another as to be calculated to deceive, and what extent of resemblance to an old mark ought to cause the rejection of an application, that the chief difference has arisen between the trade and those to whom the administration of the Act has been entrusted. The tendency of the Office has been to construe the words of the Act more favourably towards applicants for new marks than the trade have thought right. We think the difference has arisen in part from the wording of the Act. The Comptroller has felt unable to say that two marks 'so nearly' resemble each other as to be calculated to deceive. He has thus not considered himself at liberty to take into consideration to the extent he otherwise might, the character of the market in which the mark is to serve its purpose.

The idea of each mark to be considered.

Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football.[1] It would be too much

[1] Cf. *Barker's Tm.*, 53 L. T. 23 (1885), Kay, J. (*Huntsman*, or *Sportsman's* cherry brandy).

to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

"In order to avoid misapprehension in the future, we recommend, even though it may not be absolutely necessary, a slight amendment of the Act, substituting for the words 'so nearly resembling' the words 'having such resemblance to'; and further, we would suggest that when the question arises whether a mark applied for bears such resemblance to one on the Register as to be calculated to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different; whilst, on the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same."

The principle is adopted by the Court.

It is conceived that the principles which should guide the Registrar, and the Court or Board of Trade on appeal from him, and also on applications under sec. 35 to remove a trade mark from the Register as too closely resembling another registered mark, are here stated in accordance with the leading cases on the subject.

The Two Elephant case.

Thus, in *Johnston* v. *Orr-Ewing*,[1] where both the plaintiffs' and the defendants' marks consisted of tickets bearing pictures of two elephants with a banner between them, the figures being differently arranged, Lord Selborne said:[2] "Although the mere appearance of these two tickets could not lead anyone to mistake one of them for the other, it might easily happen that they might both be taken by natives of Aden or of India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods. To such persons, or at least to many of them, even if they took notice of the differences between the two labels, it might probably appear that they were only differences of ornamentation, posture, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged.

[1] 7 App. Ca. 219 (1882).

[2] At page 225. See also *Baschiera's Tm.*, 33 Sol. J. 469; 5 T. L. R. 480 (1889), Chitty, J., where the ground of ejection was that "the dominating portion of each mark was a lion, and the goods were designated by the prevailing feature according to the custom of the trade."

Such variations might not unreasonably be supposed to have been made by the owners of the plaintiff's trade mark themselves for reasons of their own."

The Taendstikker case.

And in *The Taendstikker* case,[1] where the Court of Appeal, reversing the decision of Chitty, J., held that a label for match-boxes so nearly resembled an older label registered for the same goods as to be calculated to deceive, the judgment of the Court proceeded on the ground that the net impression produced by both labels was the same. The appellant's label as registered consisted of a black oblong, bearing the word *taendstikker* printed at the bottom, and the word *nitedals* at the top, and a small geometrical device having two overlapping medals on each side of it in the middle. The respondents' label as registered showed the same elements, with the word *medals* instead of *nitedals*, two blank spaces having the same outline as the medals, and a cross instead of the device, the blanks and cross corresponding in size and shape with the medals and device. It was shown that in practice the respondents printed representations of medals over the blanks.

Lord Esher's judgment.

The marks to be compared as wholes.

"The trade mark," said Lord Esher, "is the whole thing—the whole picture on each. You have, therefore, to consider the whole. Mr. Justice Chitty has looked at the distinguishing features. He, I think, only looked at it to see whether, with that distinction, the whole was like or unlike. That is what he did, but the argument raised by Mr. Romer, and which was not only shadowed but plainly put forward by his skilful cross-examination, was this: the moment there is any distinction in any part, the things are at once unlike. That is his point. Therefore he cross-examined the people thus:—The lamps[2] or the medals are alike, and they are common?—Yes. The two things in the middle are unlike?—Yes. The word at the bottom is common to the trade, and it is the same in both?—Yes; but it is common to the trade. Therefore, he says, everything but the words *medals* and *nitedals* is common, and those two are different, and therefore the whole is different. It seems to me he has fallen into this fallacy—he takes each thing by itself,

There may be general resemblance with many differences in details.

and says either it is common or it is the same, and leaves out altogether the mode in which the things are put together in the two pictures."

[1] *Christiansen's Tm.*, 3 R. P. C. 54 (1886).

[2] *I.c.*, the blank spaces.

And Lindley, L.J., said: "The difference here, looking at the boxes, is simply this, that the word *medals* is used instead of the word *nitedals*, all the rest being, according to the evidence, common. Now I do not think that is a dissimilarity which is sufficient in this case, because although I rather agree with the view taken by Chitty, J., that the leading feature is the name at the top or bottom of the label, one must not be misled by that. The question is, notwithstanding that, what is the effect of the use or introduction of that distinguishing character on the whole? When you look at the wholes, then it appears to me, I confess, that the dissimilarity is not enough to make the wholes dissimilar."[1]

Included common marks are not to be disregarded.

So that, where common marks are included in the trade marks to be compared, or in one of them, it appears, from the judgments just quoted,[2] that the proper course is to look at the marks as wholes, and not to disregard the parts which are common, although Cairns, L.C., in *The Orr-Ewing* case, expressed a different opinion.[3]

Parts of the contrasted marks common to the trade not to be disregarded.

Farrow's case[4] is a good illustration of Lord Esher's rule.[5] There both the applicant and the opponent were mustard merchants, and both used square boxes covered with yellow labels printed in black and red, for these boxes were common to the trade. The applicant placed upon his labels a picture of a charging buffalo, and the opponent a picture of a bull's head; both pictures were contained within silver rings, and these rings were also common to the trade. Stirling, J., said that the buffalo and the bull's head, as printed in the *Trade Marks Journal*, were very different, but when they were placed upon

[1] "Though no one particular mark was exactly imitated, the combination was very similar and likely to deceive": Hatherley, L.C., in *Abbott* v. *The Bakers', &c. Association*, W. N. (1872), 31. Cf. with *The Tandstikker* case that of *Lever* v. *Bedingfield*, 15 R. P. C. 453; and 16 R. P. C. 3 (1899), Kekewich, J., and C. A., in which it was held that there was no infringement of the mark as a whole, although some features had been taken from the plaintiffs' label.

[2] *Christiansen's Tm.*, 3 R. P. C. 54 (1886), above, p. 240; and see *Baker* v. *Lawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

[3] 4 App. Ca. 479 (1879).

[4] *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

[5] Page 240, above. In *Hennessy & Co.* v. *Dompé*, 19 R. P. C. 333; 20 R. P. C. 175 (1903), where some features of the marks were common to the trade, but one of them in its particular form had apparently been copied from the plaintiff's label in composing the defendant's, Kekewich, J., held that there was no infringement, but on appeal the defendant consented to an injunction. See also *Hennessy & Co.* v. *Keating*, 24 R. P. C. 485; 25 R. P. C. 125 and 361 (1908), H. L.

the coloured labels, the applicant's label too closely resembled that of the opponent to be admitted to the Register.

But if the only resemblances between the two marks are in parts which are common, so that the owner of the one has taken nothing which is peculiar to the other, then there is at all events no infringement,[1] at any rate unless the plaintiff had a distinctive arrangement of the common elements. Thus, in *Payton & Co., Ltd.* v. *Snelling, Lampard & Co., Ltd.*, a passing-off case, Lindley, M.R., said[2] the plaintiffs "must make out that the defendants' goods are calculated to be mistaken for the plaintiffs', and where, as in this case, the goods of the plaintiff and the goods of the defendant unquestionably resemble each other, but where the features in which they resemble each other are common to the trade, what has the plaintiff to make out? He must make out, not that the defendant's are like his by reason of those features which are common to them and other people, but he must make out that the defendant's are like his by reason of something peculiar to him and by reason of the defendant having adopted some mark, or device, or label, or something of that kind, which distinguishes the plaintiff's from other goods which have, like his, the features common to the trade. Unless the plaintiff can bring his case up to that, he fails." And in *Payton & Co., Ltd.* v. *Titus Ward & Co., Ltd.*, the same learned judge said[3]: "When what is called the plaintiffs' get-up consists of two totally different things combined, namely, a get-up common to the trade, and a distinctive feature affixed, or added to the common features, then what you have to consider is not whether the defendants' get-up is like the plaintiffs' as regards the common features, but whether that which specially distinguishes the plaintiffs' has been taken by the defendants. A defendant may take it more or less. It is very seldom that he copies it. Of course he does not do that, but if he so nearly takes it that when you look at it as a whole you can say that the defendant's goods are calculated to be taken

[1] *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1898), C. A., Lindley, M.R., Rigby and Vaughan Williams, L.JJ., reversing Byrne, J.: *Payton & Co., Ltd.* v. *Snelling, Lampard & Co., Ltd.*, 17 R. P. C. 48 (affirmed by H. of L. 17 R. P. C. 628); *Payton & Co., Ltd.* v. *Titus Ward & Co., Ltd.*, 17 R. P. C. 58, both C. A. (1900), Lindley, M.R., Sir F. Jeune and Romer, L.J., all passing-off cases; *Marshall* v. *Sidebotham*, and *Alaska Packers' Association* v. *Crooks*, above, p. 236 note (2) (trade mark and passing-off). See also *Hubbuck & Son, Ltd.* v. *Brown*, 17 R. P. C. 148 and 638 (1900); and *Wolff* v. *Nopitsch*, 17 R. P. C. 321 and 18 R. P. C. 27 (1901).

[2] 17 R. P. C. 52.

[3] 17 R. P. C. 63.

for the plaintiff's goods when properly looked at—if you can say that—then the plaintiff is entitled to succeed." In the former case, Romer, L.J., pointed out that where a person used certain leading features, which are common, another person commencing to use the same leading features ought to be careful that his goods can, by their own distinguishing features, be distinguished. If this is not done the later comer would certainly not be entitled to register his mark.

The fact that there has been actual copying of part of the plaintiff's mark is a matter to be considered, but it may not constitute infringement,[1] nor would it necessarily make the new mark deceptive.

Ear as well as eye to be considered.

The resemblance between two marks must be considered with reference to the ear as well as to the eye. Thus, if a star be registered, the word *star* for the same goods would be calculated to deceive, and further, since the registered proprietor of the device of a star could, under sec. 67 of the Act of 1883, use it in any colour, the words *Red Star* were held to be as objectionable as the word *star* by itself.[2] So, also, the words *The Golden Fan Brand* were refused registration as an essential particular of a mark, on account of the presence on the Register of a fan which was in fact coloured gold in use;[3] and a mark containing prominently the representation of half an apple on account of the words *Apple Brand* in two registered marks.[4]

A good illustration of the principle that the idea of the marks must be considered is afforded by *Currie & Co.'s Application*.[5] There the registered mark included the words *The Cock o' the North*, with the picture of a cock in a defiant attitude, and the applicants' mark also included a somewhat similar cock, both marks being for Scotch whisky. They contained other prominent features which were different in the two marks, but Kekewich, J., held that the Comptroller was justified in refusing registration of the applicants' mark, as it included in a central position the thing which caught the eye in the registered mark.

[1] *Lever v. Bedingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A., Lindley, M.R., Chitty and Vaughan Williams, L.JJ.

[2] *Société Anonyme des Verreries de l'Etoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436, Stirling, J.; [1894] 2 Ch. 26; 11 R. P. C. 142, Lindley, Kay and Smith, L.JJ. (*Red Star Brand*).

[3] *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, Lindley, Lopes and Kay, L.JJ.

[4] *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J.

[5] 13 R. P. C. 681 (1896), Kekewich, J. (*Cock o' the North* label).

The *Cat and Barrel* cases[1] are also good illustrations of the same principle. In these cases it was found that the plaintiffs' trade mark had come to be known as the "Cat and Barrel Brand," and the marks held to be infringements included combinations of a cat and barrel differing to a considerable extent from that which appeared in the plaintiffs' mark.[1]

2. The Marks are to be compared as fairly used in Practice.

Marks not to be merely compared side by side on a view;

It is also clear that the Registrar ought not merely to look at the marks as they stand side by side, for, from the nature of the case, they will not be so put before any customer whom it is sought to deceive by means of either of them. He can only contrast the mark upon the goods offered to him with his recollection of the mark used upon those he is seeking to buy, and allowance must be made for this in estimating the probability of deception. Any other rule would be of no practical use.[2] Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.[3]

but as seen and remembered in actual use.

In comparing the marks, therefore, regard must be had not only to their form as they appear on the Register,[4] but also to the appearance they would present in actual use when fairly and honestly used; to the nature of the goods upon which they are to be employed; to the character and size of the marks themselves, and to the probability of their becoming partially or wholly blurred or modified as ordinarily stamped or printed, or by ordinary wear and tear.[5]

[1] *Boord & Son* v. *Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J.; *Same* v. *Thom and Cameron, Ltd.*, 24 R. P. C 697 (1907), Inner House, Scotland.

[2] *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L C.; *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J., and Ld. Alverstone, M.R., in *Hubbuck* v. *Brown*, 17 R. P. C. at p. 645.

[3] *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882), Ld. Selborne, ante, p. 239.

[4] Jessel, M.R., held, in several cases, that the Register only should be looked at: *Re Jelley*, 51 L. J. Ch. (N. S.) 639, n. (1878): *Robinson's Tm.*, 29 W. R. 31 (1880); *Mitchell* v. *Henry*, 15 C. D. 181 (1880); but in the latter case the C. A. dissented from his opinion and overruled his decision: *Christiansen's Tm.*, 3 R. P. C. 54 (1886), Chitty, J.; *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.

[5] *Rosing's Application*, 54 L. J. Ch. 975, n. (1878), C. A.; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1885), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138 (1889), C. A. In *Hubbuck* v. *Brown*, 17 R. P. C. 148 and 638, the plaintiffs relied to some extent on the effect of stencilling, and see the judgment of Collins, L.J.

For instance, a mark which is used for hardware goods, and is stamped upon them with a die, is not likely to appear so definitely or to be so readily distinguishable from a similar mark as one which is engraved or printed upon a paper label, and so attached to the goods.[1] In the former case, too, the mark will necessarily be used in a small size only.[1] As regards size, however, even under circumstances in which, from the nature of the goods, large sizes showing the design distinctly can be, and generally are used—since it is open to a registered proprietor to use his mark in any size—size would not seem to be a material element in the comparison.[2] It must not be assumed against the applicant or registered proprietor that he is going to use his mark unfairly, in the sense that he is going to use something different,[3] by leaving out or obliterating any parts of the mark, for instance, so as to make it more like that of the opponent,[4] for the Court presumes that a trade mark will be used fairly and without fraud.[5] But the Registrar must consider any alterations which the applicant lawfully might make, without altering the essential features of his mark or losing the protection which would be conferred by registration.[6] Thus he may, unless he has under the Act of 1905 registered with a limitation as to colour,[7] use the mark in any colour, and in *Worthington's* case[8] a triangular frame with the picture of a church inside was rejected on the ground that it would, if the whole were coloured red, too nearly resemble Bass' well-known solid red triangle. And if it is shown that the applicant does actually use, or intend to use, his mark so altered as more nearly to resemble that of the opponent, as, for example, in *The Tandstikker* case,[9] by filling

Size of mark.

Alteration of mark as used from mark as registered to be considered.

[1] See the two cases cited in the previous note before *Hubbuck* v. *Brown*, in which, however, the opposition failed; and see *Re Jelley*, 51 L. J. (N. S.) Ch. 639, n. (1878), Jessel, M.R.

[2] *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J.

[3] *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.

[4] *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

[5] *Lambert's Tm.*, 6 R. P. C. 344; 61 L. T. 138 (1889), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Kuhnow's Tm.*, 10 R. P. C. 401 (1893). North, J. (*Carlsbad Salts*).

[6] *I.c.*, making his mark so different as to be practically an unregistered mark.

[7] See. 10.

[8] 14 C. D. 8 (1879), Jessel, M.R., and C. A.; and see *Hanson's Tm.*, 37 C. D. 112 (1887), Kay, J.; see "colour," p. 210.

[9] *Christiansen's Tm.*, cited above, p. 240. Also *Lyle and Kinahan's Application*, 24 R. P. C. 37, 249 (1907), C. A. In this case, however, the applicants established a long concurrent user of the name which it was proposed to insert in the blank, that name being the basis of the opponent's objection.

up blanks left in the mark as registered, the mark so altered will, as against the applicant, be treated as the mark to be considered.[1] On the other hand, such alteration of the opponent's mark, being something other than the ordinary effects of its lawful user in the registered form, is immaterial as against the applicant,[2] for no one can extend the protection given to his registered mark by departing from the registered form. The fact that the objector uses his mark in a form different from that in which it appears on the Register is, however, no answer to an objection if the mark in question so nearly resembles the objector's mark, as it there appears, as to be calculated to deceive,[3] for such use is legal, although, so far as the mark used is substantially different from the mark registered, it is not protected. Even if the user were illegal, it could hardly act as an estoppel;[4] and if the opponent were using his mark improperly, for instance, in aid of a fraudulent or illegal trade, or if his mark as used by him were calculated to deceive,[5] the applicant's proper course would be to remove the mark out of the way by an application to rectify the Register under sec. 35, if that remedy be not under the circumstances of the case barred for him by sec. 41.

Variation in the use of the opponent's mark.

Alteration of the opponent's registered mark in use cannot increase the objection.

Differences in the nature or origin of the goods to which the trade marks are to be applied, though the goods are of the same description, are elements to be taken into consideration.[6]

3. The Essential Particulars are to be specially attended to.

Regard must be specially directed to the essential particulars of the marks to be compared. In *Murphy's Trade Mark*[7] it was pointed out that the remaining matter in any of them might, subsequently to registration, be changed on an application under sec. 92 of the Act of 1883.[8] On this ground Stirling, J., refused

[1] See note (9), p. 245.

[2] *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

[3] *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301 (1892), Chitty, J.; *Rowland* v. *Michell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; all cases of infringement.

[4] See *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

[5] See *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.

[6] *Leiner's Application*, 20 R. P. C. 253 (1903), Byrne, J.; *Pianolist Co.'s Application*, 23 R. P. C. 774 (1906), Parker, J.; and the passing-off cases cited below, p. 247, note (1).

[7] 7 R. P. C. 163 (1890).

[8] See below, Chap. XI. at p. 316.

to allow a mark consisting of a lion carrying a sheaf, together with other matter, to be registered, there being already on the Register another mark comprising a lion bearing a crown, because the lions were the sole essential particulars of both, although each mark had additional matter, and the general appearances of the two were different. The applicants in this case offered an undertaking that they would use their mark only in the form tendered for registration, but this was not deemed sufficient by the proprietors of the opposing mark, and, as the mark was a new one, the judge refused to accept the offer as an answer to the difficulty raised by the resemblance of the essential particulars.[1] The section of the Act of 1883 referred to above is now replaced by sec. 34 of the Act of 1905, which permits alterations not substantially affecting the identity of the trade mark, but this does not affect the reasons for the decision in *Murphy's* case, for changes in non-essential particulars will be more easily obtainable than changes in essential particulars.

Undertaking not to vary registered mark in use.

4. All the Circumstances of the Trade to be considered.

Further, the Court must have regard to all the circumstances of the trade in which the marks in question are employed, or are to be employed, and in particular to the nature of the market, whether a home or a foreign one; to the number of other trade marks similar to the contrasted marks already circulating in connection with the same description of goods[2]; to the common marks which are or may be combined with the contrasted marks or either of them; and, generally, to the customs and usages of the trade.

Marks deceptive in particular markets.

It is obvious that marks which are readily distinguishable by Englishmen, or persons who can read English, may so resemble each other as to be calculated to deceive foreigners whose language is not only different from English, but written in different

[1] And cf. *Jamieson* v. *Jamieson*, 15 R. P. C. 169 (1898); *Clark* v. *Sharp*, 15 R. P. C. 141 (1898); *Payton & Co., Ltd.* v. *Snelling, Lampard & Co., Ltd.*, 16 R. P. C. 283; 17 R. P. C. 48 and 628; and *Same* v. *Titus Ward & Co., Ltd.*, 16 R. P. C. 424; 17 R. P. C. 58 (1900); all passing-off cases, in which a prominent and distinctive feature of the plaintiffs' get-up had not been taken; also *Marshall* v. *Sidebotham*, 18 R. P. C. 43 (1901). trade mark and passing off.

[2] Cf. the provision of sec. 43 that in an action for infringement the Court shall admit evidences of the usages of the trade in respect to the get-up of the goods and of any trade marks legitimately used in connection with such goods by other persons. See Chap. XV., Infringement, p. 377.

characters and in a different manner.[1] For them, if they are ignorant of English, the words upon a mark are only subordinate devices not readily distinguishable from other words occupying corresponding positions in any contrasted mark, and being of about the same length. But if the possible confusion between the marks in a particular market would arise entirely from a device, the use of which is open to the applicant for registration, *e.g.*, the Royal Arms, the opponent would fail.[2]

The fact that a mark only becomes deceptive owing to the presence in it of words in a foreign language and only when the meaning of those words is understood, will not help the applicant, and the mark will be refused registration if the translation of the words in English would be deceptive, even although the language used is an Oriental one.[3]

Numerous marks of the same kind on the Register.

In cases where there are a large number of marks similar to the mark propounded on the Register, the Court may think that, though the applicant's mark might be fairly distinguishable from the opponent's if there were no other, and perhaps also from each of the others taken alone, yet the extension of the number of such marks may lead to deception.[4] Thus in *Hargreaves* case,[5] there being four anchor marks already on the Register in the same class, Hall, V.-C., refused to allow another anchor mark to be added to them, notwithstanding that the new mark was sought to be registered for bacon and hams, while those already registered were used for different articles of food, such as biscuits, potted meat, &c., and that it was said to be distinguishable from them all. But the extent of the class is a

[1] *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J.

[2] *Hubbuck* v. *Brown*, 17 R. P. C. 156, Kekewich, J., an infringement and passing-off case, in which the plaintiffs alleged that their goods were known in Spanish-speaking markets as *Dos Leones*, by reason of their use of the Royal Arms. In the Court of Appeal, 17 R. P. C. 638, the decision was affirmed, it being held that there had not been a deliberate copying of the plaintiffs' particular form of the Royal Arms. The particular case could not now occur with a new mark, see Rule 12.

[3] *Denhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288.

[4] Cf. the provision of sec. 43 that in trying a question of infringement the Court shall admit evidence of any trade marks legitimately used in connection with the goods by other persons, below, p. 247, note (2).

[5] 11 C. D. 669 (1879); *Thorlis and Blakey's Tm.*, and *Hughes and Young's Tm.*, 10 R. P. C. 369 (1893), North, J.; and see *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. 479 (1879). Cf. *Bass, Ratcliff and Gretton's, Ltd.'s Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 129, 529, where a simple diamond was held to be distinctive notwithstanding the existence of many complex marks including diamonds.

matter to be considered.[1] The registration of other marks belonging to the applicant himself would not generally be material to defeat his application, since a trader often desires to register slightly differing marks to distinguish goods which are of different qualities or prices;[2] but a condition may be required that the trade marks be entered on the Register as associated trade marks.[3] Of course, the objection referred to in the present paragraph is much more material in the case of a new trade mark than in that of an old one.[4]

Similar marks belonging to the applicant.

In some cases, on the other hand, the existence of a number of marks, either as common marks or as trade marks, may operate to render a finer distinction allowable than would otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter. Thus, in *König and Ebhardt's Trade Mark*[5] the mark applied for included a crown, and the evidence showed that there were twenty-seven marks registered in the same class which consisted of, or included a crown or coronet, but the registration was allowed with a limitation of the goods for which it was registered[6] and a disclaimer of the crown. And in *Mitchell* v. *Henry*,[7] an action for infringement, the reasoning which led Jessel, M.R., to dismiss an application by the plaintiffs for an interlocutory injunction, was summed up by Cotton, L.J., as follows: "What is claimed by the plaintiffs is a double thread on a white selvage; if that is distinctive, then what the defendants are using, namely a triple thread upon a white selvage, must be a distinctive trade mark, and therefore I cannot restrain the defendants."[7]

The distinction between the marks may be of a well-known kind.

The case just referred to forcibly illustrates the difficulties which led Lord Herschell's Committee to recommend that the line headings woven at the ends of lengths of piece goods should not be admitted as trade marks upon the Register.[8] As they are

Line headings.

[1] *König and Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 449.

[2] "Series," sec. 26, Chap. V., at p. 110; and per Cotton, L.J., in *Mitchell* v. *Henry*, 15 C. D. at p. 193 (1880).

[3] Sec. 24, above, p. 108.

[4] See Ld. Blackburn's judgment in *The Orr-Ewing* case, 4 App. Ca. 499 (1879); and that of Stirling, J., in *Murphy's Tm.*, 7 R. P. C. p. 166 (1890).

[5] *König and Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 449. Cf. also *The Star Tobacco* case, on p. 255.

[6] See also the judgment of North, J., in *Baker* v. *Rawson*, 8 R. P. C. at p. 107 (1891).

[7] 15 C. D. at p. 194 (1880). The application of this reasoning to the particular case was disapproved by the C. A.

[8] Report of 1888, p. ix.

all constructed by weaving coloured threads into a narrow strip at the end of the piece, the range of possible variation is very closely limited, while the number of existing headings is extremely great, so that it was considered practically impossible to maintain effective distinctions between them, or to sufficiently identify and describe them on the Register. It is now by the Act of 1905 expressly enacted that a line heading shall not be deemed distinctive or registered alone.[1]

Marks common to the trade may be material in estimating resemblance.

The bearing of marks common to the trade upon the distinctiveness of a mark propounded for registration has been already discussed;[2] but besides affecting the right to registration in that way, the nature and number of the common marks with which it will be associated or contrasted may cause the mark propounded to be more or to be less distinguishable from a particular mark than if they did not exist. It is clear, therefore, that the Registrar must have regard to the marks common to the trade in applying sec. 19.[3]

5. Where the Opponent's Goods are known by a Name suggested by the Mark.

Where the goods of a particular trader have become known by a name derived from his trade mark, any other mark which would be likely to suggest the use of the same name for the goods on which it is used, so resembles the former as to be calculated to deceive.

Seixo v. *Provezende.*

Thus, where the trade mark of the plaintiff was a crown and the word *Seixo*, and his goods had in consequence come to be known in the market as *Crown-Seixo* wine, the defendants were restrained from using marks which led their wine to be described by the same name,[4] although evidence was given that *Seixo* was a common word in Portuguese. "The plaintiff," said Lord Cranworth, "had adopted a device or trade mark which had caused his wines to obtain celebrity under a name descriptive of that trade mark. The defendants have adopted a trade mark which could not fail to lead purchasers to attribute to the wines so marked the same name as that under which the plaintiff's wines were known, and so to believe that in purchasing them they would be purchasing the wines of the plaintiff. Against the use

[1] Sec. 64 (10). See Chap. VII, at p. 125.

[2] Page 177, above.

[3] Per Cotton, L.J., in *Mitchell* v. *Henry*, 15 C. D. 193 (1880), decided under the Act of 1875.

[4] *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866).

of such a trade mark the plaintiff has, I think, a right to have the injunction of this Court." So where a trade mark consisting of the full-length figure of a milkmaid carrying two pails, one on her head and one in her right hand, with the words *milkmaid brand* above it, was registered for condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee, and the goods upon which it was used were known as the *milkmaid* or *dairy-maid* brand, and subsequently another trade mark consisting of a half-length figure of a woman carrying a pail under her right arm, with the words *dairy-maid* at the side of the figure, was registered for butterine and other fatty substances used as food or as ingredients in food, an order was made to rectify the Register by confining the second registration to goods other than those included in the first, and to restrain the use of the second mark upon any of the goods for which the first was registered.[1] *The Dairy-maid Milk* case.

The objection is equally strong if the word suggested by the new trade mark, although not the same as a word suggested by the older mark, yet so nearly resembles it, as to be calculated to deceive.[2]

The cases just cited are cases where the name applied to the opponent's or plaintiff's goods was taken from the device used as a trade mark. The rule applies also to cases where the name is

[1] *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J. But cf. *Stone* v. *Pearks, Gaunton and Tee, Ltd.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A.; *Orr-Ewing* v. *Johnston*, 13 C. D. 434; 7 App. Ca. 219 (1879), Fry, J., C. A., and H. L. (*Two Elephant Yarn*); *Speer's Tm.*, 4 R. P. C. 521: 55 L. T. 880 (1887), Kay, J. (*Dog, Tower, and Harp Linen*); *Read* v. *Richardson*, 45 L. T. 54 (1881), C. A. (*Dog Head Beer*); *Baschieri's Tm.*, 33 S. J. 469; 5 T. L. R. 489 (1889), Chitty, J. (*Lion Matches*); *Société Anonyme des Verreries de l'Étoile*, 10 R. P. C. 436; [1894] 1 Ch. 61; 11 R. P. C. 142; [1894] 2 Ch. 26, Stirling, J., and C. A. (*Red Star Glass*); *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J. (*Red Medal Polish*); *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A. (*Golden Fan Cotton*); *Currie & Co.'s Application*, 13 R. P. C. 681 (1896), Kekewich, J. (*Cock o' the North Whisky*), and the *Cut and Dried* cases, cited above, p. 244, are to the same effect. In *Corrie Bros.* v. *Herbert*, 14 R. P. C. 436 (1897), Court of Session, such a case was set up by the plaintiffs, but failed (*El Musjid*), as also did the plaintiffs in *Lever Bros., Ltd.* v. *Bedingfield*, 16 R. P. C. 3 (1899), where the plaintiffs had a small picture of a laundry-maid on the label, and the defendant had the words *Red Maid*, and the plaintiffs relied (*inter alia*) on that. See also the *Ship Brand* case, *Price's Patent Candle Co.* v. *Jeyes' Sanitary Compound Co.*, 19 R. P. C. 17 (1902), compromised on the plaintiffs' appeal. Cf. also *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand* cider).

[2] *E.g.*, *Ancross* for umbrellas in a new mark, was rejected because there were several old anchor marks: *Thewlis and Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J.

taken from some word or words appearing upon the mark. *The Osman Towel* case[1] is an illustration of this;[2] *The Milkmaid* case;[3] *The Lion Soap* case;[4] and *Currie & Co.'s Application*,[3] already cited, and *Meeus' Application*,[5] are instances belonging to both classes.

The cases referred to above include instances both of the applicant's (or defendant's) mark containing[6] and of its suggesting[7] a word contained in or suggested by the opponent's or plaintiff's mark.

The name given by the public to the goods may be different from that which is given to them by the owner of the goods, but if it is proved that the plaintiff's goods, and his alone, are known by the name given by the public, the Court will protect it.[8]

Answers to objections founded upon names derived from marks.

Where the alleged resemblance is put upon the probability of the application of the same name to the goods of both the applicant and the opponent, it is often contended in reply, (a) that the name is in fact the name or description of the goods themselves; (b) that it is suggested by words, or devices, comprised in the marks, which are common to the trade, or is itself a word or the name of a mark which is common to the trade; or (c) that the proprietor of the opposing mark is seeking to secure a monopoly in the word under cover of his mark.

(a) Where the name is descriptive of the goods.

(a) The first objection is really included in the second, but may conveniently be stated separately. It is a question of fact whether the name concerned is the name of the goods or of some

[1] *Barlow* v. *Johnson*, 7 R. P. C. 395, W. N. (1890), 110, C. A.

[2] So also are *Hodgson and Simpson* v. *Kynoch, Ltd.*, 15 R. P. C. 465 (1898), Romer, J. (*Lion Soap*), a trade mark and passing-off case, the plaintiff failing as to the former: *Cochrane* v. *McNish*, [1896] A. C. 225; 13 R. P. C. 100, P. C. (*Club Soda*), infringement and passing-off; *Powell* v. *Birmingham Vinegar Brewery Co.*, [1897] A. C. 710; 14 R. P. C. 720, passing-off. See also *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand*).

[3] Supra, p. 251, note (1).

[4] See note (2).

[5] [1891] 1 Ch. 41; 8 R. P. C. 25 (1890), Chitty, J. (*Key Brand Geneva*).

[6] *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*; *La Société Anonyme des Verreries de l'Étoile*; *Deuchurst's Application*; *Cochrane* v. *McNish*; *Saxlehner* v. *Apollinaris Co.*; *Barlow* v. *Johnson*; *Meeus' Application*; *Powell* v. *Birmingham Vinegar Brewery Co.*; all supra.

[7] *Orr-Ewing* v. *Johnston*; *Speer's Tm.*; *Read* v. *Richardson*; *Wilkinson* v. *Griffith*; *Currie's Application*; *Application of Pomril, Ltd.*; above, p. 251, note (1).

[8] *Orr-Ewing* v. *Johnston*, 7 App. Ca. 219 (*Two Elephant Yarn*) was of this nature, as well as others of the cases cited above. And see *Fels* v. *Christopher Thomas & Brothers, Ltd.*, 21 R. P. C. 85 (1904), C. A. (*Naptha Soap*), in which, however, the plaintiffs failed to establish a secondary meaning.

quality[1] attributed to them, having no reference to the traders by whom they are made or dealt in, or whether it conveys a representation that the goods are made or dealt in by the proprietors of the opposing mark. The question has already been discussed.[2] All the authorities relevant to it before 1890 were discussed and commented on in *The Osman Towel* case[3] by Chitty, J., and the Court of Appeal. As has been shown elsewhere,[4] where a name was first given by a trader to goods in the manufacture or sale of which he had a monopoly, whether as of right under a patent,[5] or in fact because he was the first inventor or introducer of the goods,[6] the Court will more readily infer that the name is the name of the goods merely, and that it connotes no connection between them and the trader, and the probability that this is the case is nearly, although not quite, as strong where, in similar circumstances, the public themselves have taken the name from the trader's marks and applied it to the goods. Of course, it is much more difficult to make out that the name has no such connotation if it is not the only name applied to the goods in the market.

Where the opponent has had a monopoly in the goods.

If the fact is made out that the name suggested by the marks is merely descriptive, and there is no other resemblance which is calculated to deceive, the second mark is not disentitled to registration. Thus, in *Horsburgh & Co.'s Application*, Messrs. Leonard and Ellis, in 1873 had adopted, and subsequently registered, a trade mark comprising the word *valvoline*; four years later the

[1] *E.g.*, excellence: *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1886), C. A. (*Gem Air-guns*); or size: *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton cigarettes*).

[2] Chap. II., at p. 37; see per Ld. Selborne, in *Singer* v. *Wilson*, 3 App. Ca. p. 376 (1878).

[3] *Barlow* v. *Johnson*, 7 R. P. C. 395; W. N. (1890), 110.

[4] Chap. II., at pp. 43 *et seq.*

[5] *Wheeler & Wilson Co.* v. *Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C.; *Linoleum Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J.; and *Palmer's Tm.*, 24 C. D. 504 (1882). Chitty, J., and C. A.; *Slazenger* v. *Feltham*, 6 R. P. C. 531; 5 T. L. R. 365 (1889), C. A. (*Demon Racquets*) (a case of an invalid patent); *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and C. A. (*Magnolia Metal*); *Meaby & Co., Ltd* v. *Triticine, Ltd.*, 15 R. P. C. 1 (1897), North, J. (*Triticumina biscuits*); *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486; (1900), Farwell, J. (*Formalin*); *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156.

[6] *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A. (*Valvoline*), ; *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A. (*Gem Air-guns*); *Waterman* v. *Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888), C. A. (*Reversi*); *Chesebrough Co.'s Tm.*, [1902] 2 Ch. 1; 18 R. P. C. 191; 19 R. P. C. 342 (*Vaseline*), Buckley, J., and C. A., where, however, Vaseline was held to be a good trade mark.

applicants sought to register a different mark comprising the word *valvoleum*. The words were held to be substantially the same, and each of them to be descriptive of the valve oil in connection with which both marks were to be used, and Jessel, M.R., allowed the second mark to be registered.[1]

Section 44 of the Act of 1905 enacts that no registration under the Act shall interfere (*inter alia*) with the use by any person of any *bonâ fide* description of the character or quality of his goods.

(b) Where the name is suggested by matter in the mark common to the trade.

(b) Where the name is suggested by words or devices which are common to the trade and which occur in the trade mark offered for registration, the words or devices may be required to be disclaimed,[2] and, if they form part of the opponent's mark, cannot be, by themselves, relied on to support the opposition;[3] and, if not disclaimed by him, a disclaimer of them may possibly be obtained by an application to rectify the register.[4] The rule may also be applicable if a word or device was at the date of registration saved from disclaimer only by being part of an essential particular, as, for instance, occurring in a distinctive label.[5] In one case, where there was no disclaimer on the Register, and no application to rectify, North, J., notwithstanding evidence that part of the opponent's registered mark was common to the trade, held that it was used distinctively.[6] The presence of the common elements in both marks may be an element in creating a general resemblance between them looked at as wholes.[7]

The opponent cannot rely on disclaimed matter or words in his mark.

[1] 53 L. J. Ch. 237, n. (1878). The opponents had also registered *Valvoline* alone as a trade mark. It was subsequently removed from the Register; *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.: *Blair* v. *Stock*, 52 L. T. 123 (*Strathmore Blend Whisky*); *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29, North, J. (*Unco' Guid Whisky.*)

[2] See. 15, Chap. IX., p. 212; formerly the disclaimer had to be in the application to register, *Mews' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J. (*Key Brand Geneva*). Cf. *Players' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J.

[3] *Loftus' Tm.*, above, note 1. An injunction cannot be obtained in respect of disclaimed matter, except in a passing-off action (sec. 45); *Pirie* v. *Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, C. A. (*parchment bank paper*); *Rosenthal* v. *Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. Corsets*); *Watt* v. *O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M.R., an Irish case (*Old Innishowen*); *Hubbuck* v. *Brown*, 17 R. P. C. 148 and 638 (1900), Kekewich, J., and C. A. See, however, p. 218, above.

[4] Secs. 35 and 15. The disclaimer sections of the Act of 1883 were sec. 64 (2) and sec. 74 (2). These were amended by secs. 10 and 16 of the Act of 1888.

[5] *Semble*, per Romer, L.J., during the argument in *Clement et Cie.'s Tm.*, 16 R. P. C. 611 (1899).

[6] *Goodall's Tm.*, 42 C. D. 560 (1889), North, J. (*parchment bank paper*).

[7] See p. 250.

Where the name is common to the trade.

The Star Tobacco Mark case[1] is an authority to show that the suggestion both by the mark of the applicant and by that of the opponent of a word which is common to the trade, because it is a name or description for the goods in connection with which both marks are used, is not a sufficient reason for refusing the application to register. There the opponents had registered as an old mark a characteristic eight-pointed star, and also, as a new mark, a label with the star, another device and the word *star*, and they asserted that their goods were frequently sold and ordered as star goods. The applicant's mark consisted of a sea-picture within a ring, having a small six-pointed star in the clouds at the top, and a conspicuously drawn anchor in the lower part of the picture, and the words *star of hope*. The judge found that the device of a star, although not the particular star of the opponents' old mark, was common to the trade, and he allowed the registration. "I think," he said, "that the use of the word *star* and the use of the figure of a star are matters *publici juris*, and have been *publici juris* at all material times, except so far as some particular trader may have appropriated a particular phrase in which *star* is used in some special manner, or may have appropriated a particular design in which the figure of a star has assumed a special form, or has been so combined with other matters as to produce a specific thing different from what may be called the ordinary image of a star."[2]

In *Hubbuck* v. *Brown*[3] the plaintiffs sought to establish that in certain foreign countries their goods had acquired the name *Dos Leones*, and that the defendant's mark would deceive, but they were in the difficulty that their goods had acquired the name from the presence of the Royal Arms in their mark, and that they could not restrain the use of such Arms by the defendant without setting up a monopoly in them to which they were not entitled.[4]

(c) Where the name is said to give a practical monopoly.

(c) The third ground of reply has also been dealt with in several cases, and it is settled that a trader will not be allowed to acquire or use a mark which will probably lead to his goods being

[1] *Re Dexter's Application, Re Wills' Tm.*, [1893] 2 Ch. 262; 10 R. P. C. 269, Wright, J.

[2] As to such exceptions, see above, p. 179.

[3] 17 R. P. C. 148 (1899), Kekewich, J. (*Dos Leones*); affirmed by C. A., 17 R. P. C. 638.

[4] Cf. also *Phillips* v. *Ogden*, 12 R. P. C. 325 (1895), Wills, J., a passing-off case, in which both plaintiffs and defendants had the right to use *Guinea Gold* for cigarettes, and otherwise the boxes were sufficiently distinguished.

mistaken for those of another, even though this may make it difficult for him to truly describe the place of origin of his goods, or to present them to purchasers in the form in which they expect to receive goods of the class.[1] Thus, in *Wilkinson* v. *Griffith*,[2] an infringement case, Romer, J., in restraining the defendants from using their label, relied upon evidence that the plaintiff's goods were known as red stamp polish from the figures upon his labels, although it was urged on the defendants' behalf that the plaintiff's claim practically involved a claim to a monopoly in red labelled goods. The judge, however, expressly stated that the plaintiff was not entitled to any such monopoly. "I by no means hold, nor do I think, the evidence as a whole can fairly be said to establish," he said, "that any red mark on a label of the defendant would render that label deceptive. I can imagine many red marks, or even red medals, being so used as to prevent deception." But it is for the applicant for registration of the mark which is alleged to be deceptive to make it clear that such is not the case.

The Red Medal Polish case.

Evidence.[3]

Evidence material to the question of resemblance.

It follows that upon any question with respect to the registration of a mark which arises under sec. 19 it is material for the tribunal to be furnished with evidence of the matters of fact involved in the propositions stated above wherever it is alleged that they tend to increase or diminish the resemblance referred to in the sub-section.

Expert evidence as to probability of deception.

Besides this evidence, the evidence of persons who are well acquainted with the trade concerned was formerly constantly tendered by the parties to show that in the opinion of such persons, as experts, the alleged resemblance between the contrasted marks was, or was not, calculated to deceive, and it was formerly constantly admitted, although judges often expressed much impatience of evidence of this class,[4] and certainly it frequently presents in an eminent degree the characteristic vices of expert testimony. It

[1] *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508 (1872) (*Glenfield Starch*); *Montgomery* v. *Thompson*, [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ales*). It is to be noted, however, that these were both cases of attempted frauds. *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882), H. L. (*Two Elephant Yarns*). See also the last paragraph.

[2] 8 R. P. C. 370 (1891), Romer, J. (*Red Stamp Polish*).

[3] As to the evidence upon applications to register generally, see Chap. IV., at pp. 96 and 97.

[4] *Re Jelley*, 51 L. J. Ch. 639, n., Jessel, M. R. (1878); *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

consists in general of opinions formed after the dispute has arisen; not upon any judicial balance of the opposing contentions, but upon a scrutiny of the subject directed to discover what can be said in favour of one side only. And where the question is as to the degree of a resemblance between two words or designs, or as to whether a difference in particular parts of two contrasted labels is substantial or immaterial, reasons can rarely be found by the witnesses to recommend an opinion to anyone who has not conceived it for himself without their assistance. Since the decision of the House of Lords in *North Cheshire Brewery Co.* v. *Manchester Brewery Co.*[1] judges have in many cases refused to allow to be put to a witness, or have disapproved the question whether the public would be or would be likely to be deceived.[2] In that case Lord Halsbury, L.C., said: "Is this name so nearly resembling the name of another firm as to be likely to deceive? That is a question upon which evidence, of course, might be given as to whether or not there was another brewery either in the one place or in the other, or whether there were several breweries nearly resembling it in name; what the state of the trade was, and whether there was any trade name. All those are matters which are proper to be dealt with upon evidence; but upon the one question which your Lordships have to decide, whether the one name is so nearly resembling another as to be calculated to deceive, I am of opinion that no witness would be entitled to say that, and for this reason: that that is the very question which your Lordships have to try." And in *Payton & Co., Ltd.* v. *Snelling, Lampard & Co., Ltd.*,[3] Lord Macnaghten, commenting on the evidence and on questions having been put to witnesses whether a person going into a shop as a customer would be deceived, said: "But that is not a matter for the witness; it is a matter for the judge. The judge, looking at the exhibits before him, and also paying the attention to the evidence adduced, must not surrender his own independent judgment to any witness whatever." The question of evidence as to probability of deception

[1] [1899] A. C. 83 (a trade name case).

[2] *Alaska Packers' Association* v. *Crooks & Co.*, 18 R. P. C. 129 (1900), Kekewich, J.; *Hennessy* v. *Dompé*, 19 R. P. C. 333, at p. 339, Kekewich, J. (1902); *Lambert and Butler* v. *Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.; *Bourne* v. *Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.; *Fairbank Co.* v. *Cocoa Butter Manufacturing Co.*, 21 R. P. C. 23, at p. 26 (1904), Swinfen Eady, J. See also *Hennessy* v. *Keating*, 21 R. P. C. 485, 25 R. P. C. 125, 361 (1907), Porter, M.R., and C.A., Ireland, and H.L.

[3] 17 R. P. C. 628 (alleged passing-off by get-up); the passage referred to is at p. 635.

in such cases subsequently came before the Court of Appeal in *London General Omnibus Co.* v. *Lavell*.[1] In that case Farwell, J., who tried the case, had after a view of the rival omnibuses arrived at the conclusion that there was a resemblance intentionally designed and that the ordinary user of omnibuses would very probably be deceived, but no evidence was given of actual deception, and only the secretary of the company and a painter of their omnibuses were called as to the probability of deception. In allowing the defendant's appeal, the Court pointed out that there were considerable differences in the two omnibuses, and that, with the exception of one alteration made about five years before the trial, the defendant's omnibus had been running without alteration for ten years, and it held that the evidence for the plaintiffs was insufficient to prove probability of deception. In commenting on the lack of evidence, the members of the Court referred to the Court being required to make an assumption as to the habits of people travelling in omnibuses and of such matters, of the absence of evidence by persons in the habit of using omnibuses, and by officers of the company in the habit of checking the user of omnibuses and seeing passengers as they got in and out, and hearing complaints of deception. This decision has been the subject of considerable discussion in some subsequent cases,[2] but it is to be noticed that none of the members of the Court of Appeal intimated that a witness could be asked directly whether the defendant's omnibus would be calculated to deceive, and, as already stated, such a question, at all events if objected to, has in recent cases been disallowed. Expert evidence as to the circumstances usually attending the sale of the goods in the particular trade, and as to the ordinary class of customers served, their intelligence and education, what they particularly look for in purchasing the plaintiff's goods, and, if the goods are sold abroad, their knowledge of the meaning of English words in the marks, and such like matters, is no doubt admissible.[3] The judge must in the end act upon his own view on a comparison

[1] [1901] 1 Ch. 135; 18 R. P. C. 74.

[2] Particularly in *Bourne* v. *Swan and Edgar. Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105. Farwell, J., in this case refers to the omnibus case as having been treated as a common law action of deceit. This is no doubt the phrase used in the Court of Appeal, but it is the name generally applied to an action brought by the person deceived himself, in which sense, of course, it could not have been used. It is difficult to see in what respects the action differed from an ordinary action for passing-off.

[3] See *Hubbuck* v. *Brown*, 17 R. P. C. 148 (1900), Kekewich, J., as an instance of a case in which some evidence of this nature was given.

of the marks, having regard to the matters of fact referred to above. To quote a recent authority, in *Schweppes, Ltd.* v. *Gibbens*[1] Warrington, J., whose judgment was approved by the majority of the Court of Appeal and by the House of Lords, said: "It seems to me that each of these cases must be looked at by itself, and the judge looking at the label, or the get-up, or the device, whatever it may be that is complained of, with such assistance as to the practice of the trade as he can get from witnesses, must decide for himself whether the article complained of is calculated to deceive or not."

Direct evidence of probability of deception.

Evidence of ordinary members of the public who are not acquainted with the usages of the trade involved, or even of experts, that they think they would or would not be deceived by the resemblance of one mark to another, is of little assistance in the determination of questions of alleged deceptive similarity.[2]

Evidence of actual deception.

If one or more cases of actual deception are made out to the satisfaction of the Court, this will, of course, afford very strong evidence that the resemblance of the marks in question is so close as to be calculated to deceive. But the absence of evidence of actual deception is a circumstance which varies greatly in weight according to the nature of the case. It is conceived that it can never be conclusive by itself;[3] but where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material,[4] unless the absence of such evidence is

[1] 22 R. P. C. 113, 601 (1905). The passage quoted above is also quoted in *Hennessy* v. *Keating*, cited p. 257, note (2), in which the same result appears to have been arrived at, at all events in the House of Lords. The question is to be decided partly by the judge's eyesight, and partly by his view of the evidence: *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J. See, however, *Mitchell* v. *Henry*, 15 C. D. at p. 195 (1880); and *Christiansen's Tm.*, 3 R. P. C. 54 (1885), Chitty, J., and C. A.

[2] See *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*), and note (2), p. 257, supra. In *Turton* v. *Turton*, Fry, L.J., compared this evidence to the oaths of compurgators in a mediæval trial: 45 C. D. at p. 149.

[3] *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; *Compania General de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), Kay, J.; *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Paine & Co.* v. *Daniell & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, C. A.

[4] *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Rodgers* v. *Rodgers*, 31 L. T. 285 (1874), Mellish, L.J.; *Estcourt* v. *The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276 (1875), C. A.; *Lambert's Tm.*, 5 R. P. C. 556; 61 L. T. 138 (1888), North, J.; and *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. at p. 107 (1889), North, J.; *Talbot's Tm.*, 11 R. P. C. 77 (1894); *Phillips* v. *Ogden*, 12 R. P. C. 325 (1895), Wills, J.; but see *Liebig's Extract of Meat Co.* v. *Chemists' Co-operative Society*, 13 R. P. C. 635, 736 (1896), Kekewich, J., and C. A.

satisfactorily explained by the difficulty of procuring witnesses from a distant foreign market,[1] or otherwise. On the other hand, if one or both of the marks is new or nearly new, there can have been no opportunity, or little opportunity, for deception to occur.

On an appeal from the Registrar by an applicant for registration, the onus is on the appellant to show affirmatively that his trade mark is not calculated to deceive.[2]

Examples and illustrations.

The cases following, of marks held to have, or not to have, such resemblance to each other as to be calculated to deceive, illustrate the principles referred to above. Many of them have been cited already.

Contrasted Devices.

A pointer eating out of a pot, too near for registration to a similar dog standing by a pail with STANCH beneath it; *Jelley's Application*, 51 L. J. Ch. 639, n. A twisted curved horn, with a twig bearing two roses, too near a similar untwisted horn with a cord having two loops in the same place as the roses in the twig; *Rosing's Application*, 54 L. J. Ch. 975, n. A triangular frame with words upon it and a church inside, too near Bass's solid triangle; *Worthington's Tm.*, 14 C. D. 8; so also a white diamond within a red diamond; *Turney & Sons' Tm.*, 11 R. P. C. 37. A half-length figure of a milkmaid, with the word *Dairy-maid*, too near a full-length figure of a milkmaid carrying two pails; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28. A woman's head wearing a helmet with ATHENA beneath, not too near a man's head with WAY beneath; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102. A tower in an oval border, with a dog and harp, too near a tower, dog, and harp without any border; *Speer's Tm.*, 4 R. P. C. 521. An oval label containing interlaced triangular frames with a stag's head within them, too near an oval label with three superimposed solid triangles, although the lettering on the marks was conspicuously different; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247. A sheep suspended by its middle, with the words GOLDEN FLEECE, too near a somewhat different sheep with the same words; *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6

[1] *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J. In *Cowie Bros.* v. *Herbert*, 14 R. P. C. 436 (1897), the Scotch Court of Session commented on the absence of such evidence.

[2] *Eno* v. *Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1889); *Capsuloid Co., Ltd.'s Application*, 23 R. P. C. 782 (1906), Swinfen Eady, J.

R. P. C. 311. A pig in outline, and H. B. & Co., not too near shaded pointer dog, and STANCH; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669. A tobacco pipe and dart, not too near a tobacco pipe alone; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138. A charging buffalo, too near a bull's head, both being placed in silver rings on similar yellow wrappers; *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233. A mark having as its sole essential particular a lion bearing a sheaf, too near a mark having as an essential particular a lion with a crown; *Murphy's Tm.*, 7 R. P. C. 163. An elephant in a border with lettering round it, an infringement of a somewhat different elephant alone; *Upper Assam Tea Co.* v. *Herbert & Co.*, 7 R. P. C. 183. A label bearing a winged cross surrounded by two circles in its upper third, not an infringement of a similar label, being a lighthouse similarly surrounded and placed; *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89. A label with two red medals and a balloon, an infringement of a similar label with two red medals only, both labels being used for polish known in India, from the latter label, as red medal polish; *Wilkinson* v. *Griffith*, 8 R. P. C. 370. A label with a cock in the centre, the groundwork being a piece of plaid with the words *Prince Charlie, King o' the Hieland Hearts*, in the upper part, too near a label bearing in the upper part the words *The Cock o' the North* with a cock in a central position over a coat of arms, with a Highlander on one side and a horse on the other; *Curric's Application*, 13 R. P. C. 681. A label bearing a representation of the Royal Exchange, Glasgow, and the words *Royal Exchange Whisky* below, refused registration because it would give the right to restrain a label bearing the same representation with the words *Bodega Special Whisky* below; *Rogers' Tm.*, 12 R. P. C. 149. C. B. & Co. and also C. B. D. held to infringe marks, one consisting of the device of a corset and the letters C. B. within a star, and the other of C. B. corsets; *Bayer* v. *Connell Bros.*, 16 R. P. C. 157.[1] The device of a red deer's head, not an infringement of a trade mark consisting of a moose head; *Alaska Packers' Association* v. *Crooks & Co.*, 16 R. P. C. 503, and 18 R. P. C. 129. The device of the cut side of half an apple cut vertically, with the word *Pomril* across it, too near a mark containing a representation of an apple and the words "apple brand," both marks being for

[1] In Ireland before Porter, M.R. See also *Bayer* v. *Baird*, 15 R. P. C. 615 (1897), Sc. Ct. of Session.

cider; *Pomril Ltd.'s Application*, 18 R. P. C. 181. J. B. D. in an oval ring, an infringement of G. B. D. in an oval ring; *Maréchal and Ruchon* v. *M'Colgan*, 18 R. P. C. 262 (Ireland). A show-card with a device having some of the features and lines of a diamond and the word "famous" on it, not an infringement of a plain diamond; *Bass, Ratcliff and Gretton, Ltd.* v. *Davenport & Sons' Brewery, Ltd.*, 19 R. P. C. 129 and 529. A sphinx in combination with Egyptian scenery not an infringement of a sphinx in a different position; *Lambert and Butler* v. *Goodbody*, 19 R. P. C. 377. A rampant cat on a horizontal barrel, known as the "Cat Brand" or "Cat and Barrel Brand," held to be infringed by a cat's head and fore-quarters out of the top of a barrel on end, with the words CAT BRAND; *Boord & Son* v. *Huddart*, 21 R. P. C. 149. The same trade mark held to be infringed by a cat sitting on the top of a barrel placed on end; *Boord & Son* v. *Thom & Cameron, Ltd.*, 24 R. P. C. 697. A label of which a signature was claimed as the essential feature held not to be infringed by a label similar in structure, but having the defendant's name prominently upon it; *Dawson* v. *Stewart*, 22 R. P. C. 250. An ace of spades with the word *Hub* on it held to be an infringement of an ace of clubs with the word *Club* on it; *Munday* v. *Carey*, 22 R. P. C. 273. A shamrock with a stalk twisted so as to form "& Co.," not too near a compound mark of a crown and a shamrock in a different position with the letters M. V. on it; *Shamrock & Co.'s Application*, 24 R. P. C. 569. A diamond divided into two triangles, and bearing upon it a device and monogram, refused registration on the ground, *inter alia*, of similarity to other diamond marks; *La Union Agricola's Trade Marks*, 25 R. P. C. 295.

Contrasted Words.

WHITE ROSE, too near ROSALINE; *White Rose Tm.*, 30 C. D. 505. CONDI-SANITAS and SANITANT, infringements of SANITAS; *Sanitas Co.* v. *Condy*, 4 R. P. C. 195 and 530; 56 L. T. 621. BOYD'S UNRIVALLED HARNESS COMPOSITION, in a label with the Arms of the City of Dublin, not an infringement of PROPERT'S IMPROVED HARNESS COMPOSITION in a label, with a fox's head, the labels being similarly got up; *Beddow* v. *Boyd*, 4 R. P. C. 310. APOLLINIS, an infringement of APOLLINARIS; *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478. STEINBERG, an infringement of STEINWAY, the words being used with devices showing a general

similarity; *Steinway* v. *Henshaw*, 5 R. P. C. 77. EMOLLIO, too near EMOLLINE; *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612. EMOLLIOLORUM, not too near MOLLISCORIUM; *Talbot's Tm.*, 11 R. P. C. 77. SWIFT'S SPECIFIC occurring in a trade mark, not calculated to deceive merely because the words were descriptive of the opponent's drug; *Swift Specific Co.'s Tm.*, 6 R. P. C. 352. OOMOO, not too near EMU; *Burgoyne's Tm.*, 6 R. P. C. 229; 61 L. T. 39. KOKOKO, too near the common word COCO; *Jackson & Co.'s Tm.*, 6 R. P. C. 80. DEMOTIC, an infringement of DEMON; *Slazenger* v. *Feltham*, 6 R. P. C. 531. DUNN'S FRUIT SALT BAKING POWDER, too near ENO'S FRUIT SALT; *Eno* v. *Dunn*, 41 C. D. 439; 15 A. C. 252; 7 R. P. C. 311; subsequently held to be an infringement, 10 R. P. C. 261. EL DEVINO, an infringement of EL DESTINO; *Pinto* v. *Trott*, 8 R. P. C. 173. Label with EL DESTINACION, an infringement of a similar label with EL DESTINO; *Pinto* v. *Badman*, 8 R. P. C. 181. Label with LONDON PICKLES, an infringement of a similar label with LONDON PICKLE Co.; *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301. STAFFORD, an infringement of TRAFFORD; FORT of FORTRESS; NEW MISTRESS, but not NEW MATRON, NEW MASTER, or MASTER, of MISTRESS; but SOUTH AFRICAN not an infringement of a mark consisting of a negro's head and the word AFRICAN; *Smith and Wellstood* v. *Carron Co.*, 13 R. P. C. 108. VINCALIS, not too near WINCARNIS, the goods being different in appearance and use; *Coleman & Co., Ltd.* v. *Brown & Co.*, 16 R. P. C. 619 (passing-off). TRITICUMINA, not infringed by TRITICINE; *Meaby & Co, Ltd.* v. *Triticine, Ltd.*, 15 R. P. C. 1. Signature ROBERT CRAWFORD, not infringement of signature DANIEL CRAWFORD; *Crawford* v. *Bernard & Co.*, 11 R. P. C. 580. MARGARITA, an infringement of LA FLOR DE MARGARETTA; *Benedictus* v. *Sulliran, Powell & Co.*, 12 R. P.C. 25. SAVOLINE, an infringement of SAVONOL; *Field, Ltd.* v. *Wagel Syndicate, Ltd.*, 17 R. P. C. 266. IVORY, for soap, not necessarily calculated to cause the goods to be confused with IVY soap; *Goodwin* v. *Ivory Soap Co.*, 18 R. P. C. 389.[1] NIGHT CAP, not too near RED CAP or MOTHER RED CAP; *Hedley's Tms.*, 17 R. P. C. 719. VALTINE, too near VALENTINE; *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ltd.*, 17 R. P. C. 673, passing-off (and see 18 R. P. C.

[1] The action was dismissed on another ground, and the appeal would apparently have failed also on that ground, namely, that the defendants had acquired a right to use the word Ivory. The only point of similarity lay in the names.

175). S. GRIFFITHS, three stars and I. X. L., not infringed by E. GRIFFITHS and three stars, the stars being common marks of quality; *Marshall* v. *Sidebotham*, 18 R. P. C. 43. On an application for an interlocutory injunction, ST. IVES cheese held too similar to ST. IVEL, registered for cheese; *Aplin and Barrett* v. *Richards*, 20 R. P. C. 799. NEOSTYLE, not too near CYCLOSTYLE; *Neostyle Manufacturing Co.'s Tm.*, 20 R. P.C. 329 and 803. SECURINE, an infringement of SECCOTINE; *McCaw, Stevenson and Orr, Ltd.* v. *Nickols & Co.*, 21 R. P. C. 15. COCOSOLINE, not an infringement of COTTOLENE; *Fairbank Co.* v. *Cocos Butter Manufacturing Co.*, 21 R. P. C. 23. Mark including the words JOCK SCOTT, too near SCOTCH JOCK; *Booth Distillery Co.'s Application*, 21 R. P. C. 18. TABLONES, too near TABLOIDS; *Capsuloid Co., Ltd.'s Application*, 23 R. P. C. 782. NEOLA, not too near PIANOLA; *Pianotist Co., Ltd.'s Application*, 23 R. P. C. 774. LANCO, not too near LANCASHIRE; *Reddaway & Co., Ltd.* v. *Irwell and Eastern Rubber Co., Ltd.*, 23 R. P. C. 621; 24 R. P.C. 203, alleged passing-off, the goods being somewhat different. B. A. S., too near B. S. A.; *Birmingham Small Arms Co., Ltd.* v. *Webb & Co.*, 24 R. P. C. 27, passing-off. MIDLAND STAR, not too near STAR; *Star Cycle Co., Ltd.* v. *Frankenburgs*, 24 R. P. C. 46 and 405, alleged passing-off, there being several names in use in the trade which included the word star.

Concurrent User.

Concurrent user.

By sec. 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."

Prior to the Act of 1905 the Court had held itself bound by the terms of the Acts to refuse registrations of two identical or similar marks for the same goods.[1] This was an undoubted

[1] *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665; *Hall and Woodhouse, Ltd.'s Application*, 19 R. P. C. 58 (1902). An old mark has sometimes been registered notwithstanding the presence on the Register of a similar new mark: *Mouson* v. *Boehm*, 26 C. D. 398 (1884); *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45 (1887).

hardship in the cases, which sometimes occurred, of a trader having built up a trade under a trade mark in ignorance of a similar registered trade mark of another person, the businesses of the traders under the marks being confined to different localities so as not to have clashed. Section 21 provides a remedy for such a state of things by conferring on the Court in cases of honest concurrent user or of other special circumstances power to permit registration, either of the unregistered trade mark, or, if neither is registered, of both trade marks, subject to such, if any, conditions and limitations as it may think fit.[1] Where neither of the marks has been registered, the owners can also, if they settle their claims by agreement to the approval of the Registrar or the Board of Trade, obtain registration under sec. 20;[2] at least this appears to be the effect of secs. 20 and 21 taken together, but it may be held that the Court only can allow concurrent registration in cases which fall within the terms of sec. 21, although this would give a narrow interpretation to sec. 20. Restrictions as to mode or place of user[3] are expressly authorised, and limitations as to colour[4] or as to the goods on which the marks are to be used are amongst those which the Court can impose. No doubt in exercising its discretion under the section the Court will have regard to the interests of the public as well as those of the owners of the trade marks. Moreover, if the trade mark is one which ought not, under sec. 11, to be registered by reason of its being deceptive or otherwise, sec. 21 ought not to be applied in favour of it.[5]

Concurrent rights in registered mark.

Three other provisions of the Act may here be noticed, namely, that relating to apportionment of trade marks where a goodwill becomes divided on dissolution of partnership or otherwise;[6] the proviso to sec. 39, which provides 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 marks shall (except so far as their respective rights shall have been defined by the Court) be

[1] In *Boord & Son* v. *Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland, the Court held that where in an action for infringement concurrent user is alleged, the defendant ought to ask to be put on the Register. It is doubtful whether the Court can do this, however, without an application to register the mark in the usual way.

[2] Above, p. 225.

[3] As to the view taken by the Courts in respect of limitations of locality under the previous Acts, see above, p. 76.

[4] Sec. 10. See Chap. VIII., above, at p. 211.

[5] *Compagnie Industrielle des Petrole's Application*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J.

[6] Assignment and transmission of trade marks, Chap. XIII., below, p. 345.

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; and the following proviso to sec. 41 (which makes registration conclusive after a period of years):—

"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."

II. Deceptive or Scandalous Marks.

Sec. 11.

Deceptive or scandalous marks.

It is provided by sec. 11 that—

"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,[1] be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

With certain alterations to be noticed, this section embodies the provisions of secs. 73 and 86 of the Act of 1883.[2] The latter section related to trade marks the use of which was contrary to law or morality. Section 73 of the Act of 1883 affected only words, whilst in the present section the more general term "matter" is used. The words "as a trade mark or part of a trade mark" are substituted for the words "as part of or in combination with a trade mark"; this is in harmony with the remainder of the present Act, which omits all provisions for registering additions to trade marks. Sec. 73 was apparently in one case applied to a trade mark consisting only of a single word.[3] The word "exclusive" which qualified "use," both in the Act of 1875 and

[1] See p. 274, below.

[2] See below, pp. 274 and 275. The corresponding provision of the Act of 1875 was sec. 6.

[3] *Eastman Photographic Materials Co.* v. *John Griffith's Cycle Corporation*, 15 R. P. C. 105 (1898), Romer, J.

in the Act of 1883, was removed, upon the suggestion of Lord Herschell's Committee, by the Act of 1888.[1] The Committee say: "Words might be offered for registration in conjunction with a trade mark for which the applicant did not claim, and of which he would not be entitled to claim the exclusive use, but the use of which might nevertheless be calculated to deceive, and so be disentitled to the protection of a court of justice."

"Exclusive use."

The provisions as to deceptive marks were, no doubt, intended to embody the old rule of the Court of Chancery, which refused protection to the owner of a deceptive trade mark;[2] and it was held, by Jessel, M.R., that their operation was confined to cases where the marks were in themselves inherently deceptive;[3] but the Courts have held that the restriction is of wider scope than the old rule, or than this construction would suggest.[4] The leading case in point is *Eno* v. *Dunn*,[5] in which the House of Lords (Lord Halsbury and Lord Morris dissenting) overruled the judgment of the Court of Appeal (Lindley and Fry, L.JJ., Cotton, L.J., dissenting), and restored that of Kay, J. The question in that case was whether the words *Fruit Salt* occurring in a mark consisting of the words *Dunn's Fruit Salt Trade Mark Baking Powder*, and in a mark consisting of a distinctive label, quite different in character from the device used by the opponent, Eno, and bearing the words *Dunn's Fruit Salt Baking Powder*, were calculated to deceive, having regard to the well-known use of the words as the name of Eno's Fruit Salt. Eno, in the first instance, based his opposition to Dunn's application to register his marks partially upon his title as the owner of the mark *Fruit Salt*, registered as "a proprietary medicine for human use," and also as a "dry preparation for making a non-intoxicating beverage"; but finding that he could not prove user of that mark before 1875, and that the words were consequently not capable of registration under the Acts then in force, he was driven to consent to its removal from the Register, and to rely wholly upon the alleged deceptiveness of the marks propounded by Dunn.

The section extends beyond the old rule of estoppel by misrepresentation.

The Fruit Salt case.

[1] Sec. 15.

[2] See Chap. XV., at p. 246; and L.d. Macnaghten's judgment in *Eno* v. *Dunn*, infra.

[3] *Horsburgh's Application*, 53 L. J. Ch. 237, n.; 50 L. T. 23, n. (1878) (*Valvoleum*).

[4] See the judgment of Cotton, L.J., in which the majority of the law lords concurred, in *Eno* v. *Dunn*, 41 C. D. p. 448.

[5] 15 App. Ca. 252; 7 R. P. C. 311; *Dunn's Tm.* (1889). Subsequently an injunction was granted to restrain Dunn & Co. from using the words *Fruit Salt*: *Eno* v. *Dunn*, 10 R. P. C. 261 (1893), Kekewich, J.

The marks were normally used for different goods. Dunn's preparation was a baking powder, and Eno's an aperient effervescing powder; but evidence was given that, in a very few instances, Eno's salt had been used as a baking powder, although it was shown to be very unsuitable for the purpose. The majority of the law lords held that Dunn's marks were deceptive, and the application to register was dismissed. Lord Herschell and Lord Macnaghten based their judgments upon the discretion conferred on the Comptroller—apart from the sections considered in this chapter—to refuse marks from which it is not clear that deception might not result. Lord Herschell said: "I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived. The case was argued on behalf of the respondent, as if he had an absolute right to have any trade mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. I do not so read the statute. Those sections prohibit the registration of a trade mark in certain specified cases; but there is no duty cast upon the Comptroller of registering every other trade mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases fairly conferred." And Lord Macnaghten said of the marks: "They are calculated, and I think designed, to create a confusion in the minds of those persons to whom Mr. Dunn's advertisements are addressed, and to lead the ordinary run of such persons to suppose that his baking powder is in some way or other connected with Mr. Eno's preparation"; and he held, therefore, that the marks ought to be rejected, for the "Comptroller ought to reject words which involve a misleading allusion or suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood."

Doubtful new marks to be rejected.

Lord Herschell's judgment.

Lord Macnaghten's judgment.

Lord Watson's judgment.

Lord Watson, on the other hand, treated the case as one falling within the 73rd section. "These prohibitory clauses," he said, referring to secs. 73 and 72 (2), "cast upon the applicant the duty of satisfying the Comptroller, or the Court, that the trade mark which he proposes to register does not come within their scope. In an inquiry like the present, (the applicant) does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There, the onus of showing that his trade mark was

calculated to mislead rests, not on him, but upon the party alleging infringement; here, he is *in petitorio*, and must justify the registration of his trade mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed." And upon the question of fact he said: "There would be a supposed connection in the minds of many persons, who would naturally assume that the baking powder had been manufactured with the appellant's fruit salt, and purchase it in that belief; so that a batch of badly made baking powder might seriously injure the credit of the effervescing powder."[1]

The following cases deserve special notice. In *Denhurst's Application*[2] the words *The Golden Fan Brand* in Burmese characters were refused registration as an essential particular of a mark, there being on the Register for the same goods a fan which in use was coloured gold; and Kay, L.J., expressly based his judgment on sec. 73 of the Act of 1883, holding that the words would, in Burma, be calculated to deceive, in the event of the owner of the registered fan trading there. In *Eastman Photographic Materials Co.* v. *John Griffith's Cycle Corporation*,[3] the last-named company had registered *Kodak* as a trade mark for cycles, and the plaintiffs, who moved to remove the mark from the Register, had identified that name with themselves and their goods, and in particular with bicycle cameras, and the name was comprised in several of their trade marks, but none of them was registered in class 22, which includes bicycles. Romer, J., held that the defendants intended, by the use of the name, to cause the public to think that they were connected with the plaintiff company, or that their goods were those of the plaintiff company, and, following *Eno* v. *Dunn*, he ordered the mark to be removed, as, when registered, being likely to deceive. It is not clear, however, whether the decision was one on sec. 73 or on the general discretion of the Comptroller to refuse a deceptive mark apart from any particular section of the Act.

In a recent case the proprietors of a trade mark consisting of the word *Motorine*, and registered for lubricating oils, opposed an application for registration of the word *Motricine* as a trade mark for petrol spirit, and the opposition was partly based on

[1] See above, p. 70, "the Registrar's discretion."

[2] [1896] 2 Ch. 137; 13 R. P. C. 288. See supra, p. 234.

[3] 15 R. P. C. 105 (1898), Romer, J.

sec. 11, and the danger to the public by explosion, in case the petrol spirit were by reason of similarity of the name taken for the lubricating oil, was relied on. Warrington, J., decided that there was a possibility of confusion, and that serious consequences might ensue to the public, and he upheld the decision of the Registrar, who had refused registration.[1]

Mark containing name of the opponent's goods not necessarily deceptive.

A mark is not calculated to deceive merely because it contains an ordinary description of an article of commerce which is occasionally used to describe a rival trader's goods.[2] To hold otherwise would certainly be, as Fry, L.J., said in *The Fruit Salt* case, to allow the objector "to enclose and appropriate as private property certain little strips of the great open common of the English language."[3] Thus, where *The Smokeless Powder Co., Ltd.*, had registered a label bearing a target, with their name printed prominently upon it, supported on one side by the figure of a sportsman and on the other by that of a rifleman, an unsuccessful attempt was made by a rival powder-making company to have the mark removed from the Register, or to have a disclaimer of the words *Smokeless Powder* added to the registration. The application failed as to the disclaimer, because the words were not distinctive, and also because they were not additions within the meaning of sec. 74, and were part of the name of the proprietors of the mark. It was argued that the presence of the words in the label was in effect a claim of a monopoly of the words, although the manager of the respondent company stated that the company made no such claim; but Chitty, J., decided against the objection,[4] and held that the use of the words in the mark was not calculated to deceive.[5] No such identification of the words in question with the applicant's goods was proved in this case, as was shown in *The Fruit Salt* case of the words *Fruit Salt* with Eno's powder, and in *The*

The Smokeless Powder Co. case.

[1] *Compagnie Industrielle des Petrole's Application*, [1907] 2 Ch. 435; 24 R. P. C. 585.

[2] See *Dexter's Application*, [1893] 2 Ch. 262; 10 R. P. C. 269, Wright, J. (*Star Tobacco*), above, p. 255.

[3] 41 C. D. at p. 455.

[4] See Chap. VIII., at p. 192, "Label." Cf. *Application of Albert Baker & Co. (1898) Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

[5] So also in *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J., held that "Silverpan" in a mark registered for jam was descriptive and not calculated to deceive. On appeal, however, it was held that the word was distinctive and ought to have been disclaimed under sec. 74 of the Act of 1883, [1902] 1 Ch. 125; 18 R. P. C. 535. The registered proprietors stated that they did not claim any exclusive use by reason of their registration.

Stone Ales case[1] of the words *Stone Ales* with Joule & Sons' beer; but, apart from this, the case seems readily distinguishable, on the ground already mentioned, that the words concerned were the ordinary words which anyone would choose to describe the goods both of the applicants and the respondents, and words which, apart from the Acts, could never have become, for such goods, the subject of exclusive rights.[2]

Device suggesting the name of the opponent's goods.

And as the presence of a common word in a label does not make the label deceptive, although the word is used of the opponent's goods,[3] so neither does the presence of a device which suggests such a word. Thus, in *Kuhnoe's* case,[4] a label which included a picture of the Deer-leap rock at Carlsbad—a well-known and remarkable object in the environs of the town—was allowed to be registered for use with Carlsbad Salts, the name of the salts being common property, and applicable both to the natural product of the springs at Carlsbad and to artificial imitations of it. The opponents in the case were the Municipality of Carlsbad—who own both the springs and the rock in question—and their lessees of the springs. They sought to show that the use of the picture by the applicant would be calculated to lead purchasers to believe that the goods upon which it appeared were their goods; but the judge held that it would only suggest that the goods were Carlsbad Salts. And this would be true if, as he was bound to anticipate, the applicant used his mark honestly. The opponents had no monopoly in Carlsbad Salts.

Trade mark attached to part of the mark only may be deceptive.

In *The Apollinaris* case, Fry, L.J., in delivering the judgment of the Court of Appeal, expressed an opinion that a label which bears the word "trade mark" so printed upon it as apparently to refer only to a device which forms part of the label, the whole label being, in fact, the trade mark, is calculated to deceive,[5] notwithstanding that the objection might have been, but was not, taken in the earlier case of *Hudson's Trade Marks*,[6] where the Court of Appeal decided in favour of the mark propounded; and in *Re Wills' Trade Marks*, Wright, J., subsequently ordered a mark to be removed from the Register on this ground.[7] This

[1] [1891] A. C. 218; 8 R. P. C. 361.

[2] Chap. II., at pp. 35 *et seq.* See also sec. 44.

[3] See above, p. 252.

[4] 10 R. P. C. 401 (1893), North, J. Cf. also *Hubbuck* v. *Brown*, 17 R. P. C. 148 and 638.

[5] [1891] 2 Ch. at p. 233; 4 R. P. C. 478.

[6] 32 C. D. 311 (1886).

[7] [1893] 2 Ch. 262; 10 R. P. C. 269. The order was made subject to an application to amend being made within a reasonable time, but no such application was made.

objection caused considerable uneasiness to proprietors of trade marks, and led to several applications to the Court, under sec. 92, for leave to amend registered marks, for the word *Trade Mark* is often printed upon labels and other trade marks; but it is to be observed that it is only objectionable where its presence apparently implies that part of the actual mark is the whole trade mark. In the mark to which Fry, L.J., was directly referring, the word was placed immediately under a red disc, which was the most prominent feature in the label. In *Hammond & Co.* v. *Malcolm, Brunker & Co.*,[1] Chitty, J., said: "It is a question of fact in every case where a man puts the term 'trade mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade mark only." The question came again before the Court of Appeal in *Bass's Tms.*,[2] where the devices on which the words occurred were also separately registered, and the Court held the question to be one of fact, and decided that there was no deception. In *Colman's Trade Marks*,[3] Kekewich, J., allowed "trade mark" to be struck out of a number of labels, on condition that the proprietors should state what were and what were not the essential particulars of the marks.[4] But in a later case, Chitty, J., refused to allow a similar alteration to be made in an old mark on the ground that, in accordance with the decisions of the Court, an old mark ought to be registered and kept registered, in all essential particulars, as it was used before August 13th, 1875.[5] In the earlier case, two of the marks allowed to be altered had, in fact, been old marks, but in that case the Comptroller had raised no objection on this ground, as he did in the later case.[5] In *Re Wills' Trade Marks*,[6] the mark was ordered to be expunged unless an application to amend was

Alterations of marks to remove *trade mark*.

[1] 9 R. P. C. p. 307; and the observation of the same judge in *Gordon & Dilworth's Tm.*, 13 R. P. C. p. 634.

[2] [1902] 2 Ch. 579; 19 R. P. C. 529. Romer, L.J., intimated that he would probably not have come to the same conclusion of fact in the *Apollinaris* case as the Court of Appeal did.

[3] [1891] 2 Ch. 402; 8 R. P. C. 209.

[4] Cf. sec. 64 (2) of the Act of 1883, as amended. The condition would probably not now be required, as an applicant is not required to specify in his application what the essential particulars of the mark are; and see Chap. IX., at pp. 212 and 213.

[5] *Phillips' Tm.*, [1891] 3 Ch. 139; 8 R. P. C. 469; and see *Henry Clay & Co.'s Tm.*, [1892] 3 Ch. 549; 9 R. P. C. 449, Kekewich, J. Cf. sec. 34 of the Act of 1905.

[6] Supra, p. 271, note (7). The mark was a new one registered under the Act of 1883, as also was the mark referred to in the case next cited.

made within a reasonable time, but in *Day* v. *Riley and Whittaker*,[1] Buckley, J., refused to give such an opportunity. Section 25 of the Act of 1905 expressly permits separate registration of part of a registered trade mark, but the part so registered must itself possess all the qualifications of a good trade mark, and it must be registered as associated with the trade mark of which it forms part.[2]

Threats of prosecution in the mark may be deceptive.

Fry, L.J., also suggested, in *The Apollinaris* case,[3] that the indorsement, "imitations of this water will be prosecuted," upon a label registered for use in connection with a natural mineral water, *Hunyadi Janos*, caused the mark to be calculated to deceive, because it probably meant all imitations of the water, whether fraudulent or not, and was therefore addressed to artificial *Hunyadi Janos* waters which might have been legitimately made and legitimately sold under the name, provided that it was made clear that they were artificial waters.[3] It may be noted that the Registrar may refuse to register the words "patent," "patented," "by Royal Letters Patent," "registered," "registered design," "copyright," "entered at Stationers' Hall," or "to counterfeit this is a forgery."[4]

The Registrar refuses *patent*, *registered*, *copyright*, &c.

Mark referring to particular goods.

And when there appears on a trade mark the name or a description of any goods the Registrar may refuse to register the mark in respect of any goods other than the goods so named or described.[5]

Deceptive representation as to origin of goods.

The questions Who can register a trade mark?[6] and What is the implication of a trade mark with regard to the origin of the goods?[7] are dealt with elsewhere. It has been held that a mark comprising the consignees' names, and a representation of their house, which is used by the consignor, is calculated to deceive.[8]

The case of *Hill's Trade Mark*[9] furnishes a good illustration of a deceptive mark. The mark consisted of a fir tree, with the

[1] 17 R. P. C. 520 (1900).

[2] See above, p. 109, and Appendix, p. 609.

[3] Above, p. 271; [1891] 2 Ch. p. 226.

[4] Rule 11, below, p. 657. See also *Meikle's Tms.*, 46 L. J. Ch. 17 (1876), Hall, V.-C. In *Wright, Crossley & Co.* v. *Dobbin*, 15 R. P. C. 21 (1898). and *MacSymons' Stores, Ltd.* v. *Shuttleworth*, 15 R. P. C. 748 (1898), it has been held both in Ireland and England that "registered" in a mark means registered in the United Kingdom.

[5] Rule 16. By the same rule registration with a variation of a name or description may be permitted

[6] Chap. IV., at p. 67.

[7] Chap. II., at pp. 53 *et seq.*; see also Chap. XV., p. 383, "Joint trade marks."

[8] *Jones' Tm.*, 53 L. T. 1 (1885), C. A.

[9] 10 R. P. C. 113 (1893), Chitty, J.

words *Forrest* above and *London* below it in large letters, and it was registered and used by a Coventry watch-maker, who had no connection with the business formerly carried on by Forrest in London. He alleged, in answer to an application to remove the mark, that the words in question were commonly used by the trade in Coventry, although, in a correspondence with the applicant, he had previously claimed an exclusive right to them. The judge held that the mark was calculated and intended to deceive.[1]

On the other hand, a suggestion that "Mazawattee" was deceptive, as leading people to suppose from the character of the name that the tea came from a particular estate, did not prevail.[2]

A mark which has been used fraudulently, or for the purposes of a fraudulent trade, if offered for registration, is open to the objection that its further use will tend to continue the old deceptions, and it is therefore a deceptive mark, and registration of it should be refused.[3] Thus the use of the words "Registered Trade Mark" before registration would be a ground for refusal to register, except where, as in the cases cited below,[4] a *bonâ fide* mistake was proved to have been made or an adequate explanation given.

"Or otherwise."

The words "or otherwise" in the section, having regard to the last part of it, seem to be merely redundant.[5] They were, however, under the Act of 1875, held to be sufficient to exclude the registration, as part of a trade mark, of words which are merely descriptive of the article upon which the mark is to be used, whether they are merely descriptive from their nature, or whether they have become descriptive by the course of the trade and in the market.[6] But the decision in the case referred to rested upon the opinion of the learned judge that, if he allowed

[1] Its use was unquestionably an offence under the M. M. A. 1887; see Appendix, p. 805. It appears from the report of *Thorneloe* v. *Hill*, 11 R. P. C. 61 (1894), that the Comptroller afterwards refused to register the tree alone on account of its having been part of a fraudulent mark.

[2] *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271; and above, p. 172.

[3] *Fuente's Tm.*, [1891] 2 Ch. 166; 8 R. P. C. 214, Romer, J.; see further, as to trade marks vitiated by misrepresentation, Chap. XV., at pp. 426 *et seq.*

[4] *Altman's Application*, 21 R. P. C. 753 (1904), Kekewich, J.; *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.: in this case the representation as to registration had appeared for a short time only in a price list.

[5] Sec. 11 includes provisions formerly contained in a separate section, namely, sec. 86 of the Act of 1883.

[6] *Anderson's Tm.*, 26 C. D. at p. 415 (1884), Chitty, J. (*Brand Baron Liebig*).

the words in question to be registered as part of the applicant's mark, he would be giving him a monopoly in the words to which he was not entitled. In the Act of 1883 the word "disentitled" was substituted for the expression "not entitled," and in a later case[1] the decision just referred to was distinguished on the ground of the different wording of sec. 73 of the Act of 1883, and it was held that, although the word "Silverpan" was descriptive when used for jam, it was not thereby "disentitled" to protection within the meaning of this section.

"Disentitled."

[1] *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J. On appeal the Court did not decide this point, the word in question being held to be *prima facie* distinctive, [1902] 1 Ch. 125; 18 R. P. C. 535. See also *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109.

CHAPTER XI.

RECTIFICATION OF THE REGISTER.

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PROVISION is made for the rectification of the Register by four sections of the Act. Sec. 35 provides for cases where any person is aggrieved by the omission from, or by the entry upon, the Register of any particulars without sufficient cause, and enables the Court to direct the necessary rectification to be made; sec. 32 authorises the Registrar at the request of the proprietor to correct clerical errors in the registration, to enter any change in the name or address of the proprietor, to cancel the entry of a

trade mark on the Register, to strike out goods from those for which a mark is registered, and to enter on the Register certain disclaimers or memorandums; sec. 33 provides for the registration of the name and address of the new proprietor on assignment, transmission, or other operation of law;[1] and sec. 34 enables the Registrar to permit an addition to, or alteration of, a registered mark to be made in any manner not substantially affecting its identity. The Act also directs that after fourteen years from its registration a mark shall be removed from the Register unless the prescribed fee be paid. This provision is considered in another chapter.[2]

1. Rectification under Sec. 35.

Section 35. Rectification of register.

Sec. 35[3] is in the following terms:—

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) An 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."

This section corresponds to sec. 90 of the Act of 1883, which underwent a slight amendment by the Act of 1888.[4] The terms of the new section are wider and more general than those of the repealed one; in particular its provisions are expressly applicable to an entry wrongly remaining on the Register, as in the

[1] See Chap. XIII., at p. 357.

[2] Sec. 30; see Chap. XIV., p. 362.

[3] Cf. Companies Act, 1862, s. 35, and the Copyright Act, 1842 (5 & 6 Vict. c. 45), s. 14.

[4] Sec. 23. For the section as amended, see Appendix, below, p. 638. The corresponding section of the Act of 1875 was sec. 5, Appendix, below, p. 616.

case of a trade mark removable for non-user under sec. 37. It was, however, held, under sec. 90 of the Act of 1883, that a trade mark wrongly on the Register could be removed.[1] The general power of rectifying errors and defects is new. Sub-sec.(3), giving the Registrar power in certain cases to apply for an order for rectification, is also new.

The Court had under sec. 90 of the Act of 1883 power to award damages to the party aggrieved, but it was never exercised.[2] In addition to this, other provisions contained in that section have been dropped, namely, those as to directing issues and as to costs; these are covered by the general powers of the Court.[3]

Certain new provisions introduced by the Act of 1905 materially affect the practical working of sec. 35. First, by sec. 36, no trade mark which was upon the Register at the commencement of the Act, and which under this Act is a registrable trade mark, is to be removed from the Register on the ground that it was not registrable under the Acts in force at the date of its registration. This provision, and the decisions on it, have been considered in the chapter on what may be registered.[4]

Secondly, the power of the Court to require a disclaimer is now expressly extended to a case in which the Court is deciding whether a trade mark shall remain on the Register;[5] that is to say, on an application under sec. 35 to remove the trade mark.

Thirdly, by sec. 41, in applications under sec. 35, the original registration of a registered trade mark is, subject to certain exceptions mentioned in sec. 41, after the expiration of seven years from the date of such original registration (or seven years from the passing of the Act,[6] whichever shall last happen), to be taken to be valid in all respects.[7]

Who are persons aggrieved.

All persons substantially *inconvenienced* if the registration is wrong.

The application to rectify the Register must be made by a person who is aggrieved by the entry, if it is made without sufficient cause, or by the omission, error or defect complained of.

[1] *Batt's Trs.*, [1898] 2 Ch. 432; [1899] A. C. 428 (*sub nom. Batt* v. *Dunnett*, 15 R. P. C. 262. 534; 16 R. P. C. 411).

[2] See, for instance, *Reid* v. *Thomson & Co.*, 22 R. P. C. 376 (1905), Scotland.

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

[4] Chap. VIII., above, p. 127.

[5] Sec. 15. See Chap. IX., Disclaimers, above, p. 212.

[6] August 11th, 1905. The commencement of the Act was April 1st, 1906.

[7] See Chap. XII., Effect of Registration, below, p. 321.

The phrase in the section has been very liberally construed, and except, perhaps, in the case of a mark consisting of a name,[1] it would be difficult to find any person engaged in the trade concerned, or any allied or connected trade, who is prevented by the qualification which it requires from moving to rectify the Register. The persons who are aggrieved are, it is held, all persons who are in some way or other substantially interested in having the mark removed—where it is a question of removal—from the Register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that.[2]

The Apollinaris case.

One of the leading cases on the subject is that of *The Apollinaris Co.'s Trade Marks*. In that case, Fry, L.J., in delivering the judgment of the Court of Appeal, said: "We approach this question (Are the applicants persons aggrieved?) on the assumption, which is necessary, of course, to answer this question, that the trade mark was wrongly on the Register; and, further, with these two observations: in the first place, that the question is merely one of *locus standi*;[3] and in the second, that the words 'person aggrieved' appear to us to have been introduced into the statute to prevent the action of common informers, or of persons interfering from merely sentimental motives;[4] but that they must not be so read as to make evidence of great and serious damage a condition precedent to a right to apply. Further, we are of opinion that, wherever one trader, by means of his wrongly registered trade mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is an 'aggrieved person.'"[5] And in the same case the Court of Appeal held, that the fact that the applicants for registration of certain new marks had attempted to support their

The question is one of locus standi only.

[1] See *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131 and 377 (1898), cited below, p. 282.

[2] Per Bowen, L.J., in *Powell's Tm.*, [1893] 2 Ch. 388; 10 R. P. C. 195.

[3] In *Crompton's Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265, Swinfen Eady, J., held that a person who sought to remove a trade mark on the ground (*inter alia*) that the registration added nothing to a prior registration by the same proprietor was, if this were so, not a person aggrieved, but possibly he only intended to decide that such an objection was purely one for the Comptroller, and could not be taken after registration.

[4] See Ld. Selborne's judgment, in *Rivière's Tm.*, 26 C. D. at p. 54 (1884), and the judgments of Lindley and Fry, L.JJ., on the subsequent hearing of the same case, 55 L. J. Ch. 545.

[5] [1891] 2 Ch. p. 224; 8 R. P. C. 137.

application by reference to other marks already registered by them, notwithstanding that they subsequently abandoned the attempt, made the opponents to the registration of the former marks persons aggrieved by the registration of the marks already registered, and therefore persons entitled to apply for the removal of them from the Register.[1] They further held that an alleged infringer of a mark is always a person aggrieved by its registration.[2] "The practical conclusion of this view," said Fry, L.J., "is, we think, a sound one. It will stop the practice, of which we have seen instances in this case, of a trader registering his mark without justification, using it as a means to intimidate or coerce other traders, and then, at the bar, alleging that the threat was idle, and the persons against whom it was used are not aggrieved thereby."[3]

Any person intimidated or harassed by the registration.

The words in question have received their most liberal interpretation in the subsequent case of *Powell's Trade Mark*.[4] In that case the applicants were being sued to restrain them from passing off a sauce called *London Relish* as the goods of the registered proprietor of a mark consisting of the words *Yorkshire Relish* by means of a label said to resemble one of his trade labels. They moved to expunge the mark *Yorkshire Relish*, and they were held to be "persons aggrieved" notwithstanding that they did not trade in Yorkshire Relish Sauce, and had not even considered the question of trading in it, and that the Court thought it probable that they could not trade in it under the same name without wrongfully causing their goods to be taken for those of the respondent, the registered proprietor of the mark. Lord Herschell, in giving judgment, said that although the words were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer, it was undoubtedly of public interest that they should not be unduly limited; and he also said: "Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the Register, would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register he could not

Powell's case.

[1] [1891] 2 Ch. p. 228; 8 R. P. C. 137.
[2] See also *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.
[3] [1891] 2 Ch. p. 229.
[4] [1893] 2 Ch. 388; [1894] A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4, Chitty, J., C. A., and H. L.; followed in *Talbot's Tm.*, 11 R. P. C. 77 (1894), Stirling, J.

lawfully do that which but for the existence of the mark upon the Register he could lawfully do, it appears to me he has a *locus standi* to be heard as a person aggrieved." Lord Watson, in his judgment, said that the fact that a trader deals in the same class of goods, and could use the mark, was, *primâ facie*, sufficient evidence of his being aggrieved, which could only be displaced by the person who registered the mark, upon whom the onus lay, showing that there was no reasonable probability that the objector would have used it, although he were free to do so.

But the grievance of the applicant must be substantial, and a fanciful suggestion of grievance is insufficient. Thus, in *Wright, Crossley & Co.'s Trade Mark*,[1] a firm had registered their firm-name of "Wright, Crossley & Co." as an old trade mark, and a company, called the Royal Baking Powder Company, trading in the same trade, applied to remove it. There had been considerable litigation between the applicants and the registered owners as to the words "Royal Baking Powder," and it was suggested that the applicants had an interest as the mark was being used by the owners in connection with those words, and that there was a possibility of a wrongful user of the words "Trade Mark." It was also suggested that the applicants might at some time acquire the right to trade under the name Wright, Crossley & Co., or part of it. But Romer, J., and the Court of Appeal came to the conclusion that the suggestions of possible injuries to the applicants were fanciful, and that the applicants were not persons aggrieved. Rigby, L.J., pointed out that the judgments in the House of Lords in the *Yorkshire Relish* case did not support the contention that the mere fact that a man was in the same trade was sufficient to make him a person aggrieved. It is not necessary, however, for an applicant to show that he is interested in the sense of deriving any profit from his trade;[2] and it is sufficient to constitute trading if he is trading by his agents.[2] A merely sentimental grievance does not make a person "aggrieved" within the meaning of the section.[3]

Defendant in a passing-off action.

A defendant charged in an action with passing off his goods as those of the plaintiff[4] is aggrieved by the registration of a trade mark referred to in the plaintiff's pleadings, although no case of

[1] 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

[2] *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

[3] *Ellis & Co.'s Tm.*, 21 R. P. C. 617 (1904), Farwell, J. (*Quaker, for spirits*). In this case it was held that the Society of Friends were not persons aggrieved by the registration.

[4] See Chap. XVI., p. 477.

infringement is set up;[1] and so also is a trader who wishes or may wish to use the registered mark, not as a trade mark, but as a description of his goods.[2] And it is not necessary that the applicant should actually trade in the goods for which the mark is registered: it is sufficient if there is such a close connection between the business in those goods and the applicant's business that there is a probability that he may wish to extend his business to the other goods.[3] And the applicant does not cease to be a person aggrieved because the registered proprietor offers to register a disclaimer, or to confine the use of the mark to particular goods in such manner that if the disclaimer or limitation were actually registered the applicant's grievance would be removed;[4] for, as was pointed out by Fry, L.J., in the passage quoted above, the grievance is only necessary to give a *locus standi*, and it exists if at the time when the application is launched the registration is such as to occasion it.

Offer of a disclaimer is no answer to an application to rectify.

A person who has before registration used the registered trade mark is a person aggrieved.[5]

Person who has actually used the trade mark.

The exporter of goods made abroad, which are brought to England and then shipped to the Colonies, is a person aggrieved by the registration of a mark having such a resemblance to the mark which he has registered, and which he uses in his trade, as is calculated to deceive, although the mark objected to is employed in a trade confined wholly or almost wholly to England, and not extending to the Colonies.[6] So also a person who had made the goods in this country and exported them marked with the registered word from a date prior to its registration was held to be clearly a person aggrieved.[7]

Exporter aggrieved by mark for home trade.

And a foreigner may be a "person aggrieved" by the registration of a mark. This was decided by the Court of Appeal, over-

Foreigner.

[1] *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

[2] *Ralph's Tm.*, 25 C. D. 194 (1883), Pearson, J. (*Homewasher*); *Rose* v. *Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C. (*Limetta*); *Powell's Tm.*, supra, p. 281; *Talbot's Tm.*, 11 R. P. C. 77; 63 L. J. Ch. 264 (1894), Stirling, J. (*Emolliorum*).

[3] *Eastman, &c. Co., Ltd.* v. *John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J. There was no express finding, however, as to the applicants being persons aggrieved; but it was held that they could have successfully opposed the registration.

[4] *Ball's Tm.*, 6 R. P. C. 493 (1889), Chitty, J.; *Baker* v. *Bacon*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.

[5] *Zonophone Tm.*, 20 R. P. C. 450 (1903), Byrne, J.

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

[7] *Newstyle Manufacturing Co.'s Tm.*, 20 R. P. C. 803 (1903), C. A.

ruling the judgment of Pearson, J., in *Rivière's* case,[1] where the applicants, who carried on business in India, but did not trade or intend to trade in England, alleged that, on their request to register the mark in question for them, the registered proprietors had wrongfully registered it in their own names; and the Court, in holding that the applicants might be aggrieved, assumed, but did not decide,[2] that, as foreign traders, the applicants could not themselves have registered the mark.

Wider view now taken than in the earlier cases.

On the further hearing of the case just cited,[3] it was shown that the registered mark was an old mark belonging to the respondents, Rivière & Co., but that they had for many years allowed it to be used upon labels bearing the name of the applicants, McDowell & Co., for brandy manufactured by Rivière & Co., and shipped by them to McDowell & Co. for sale in India. The labels were used by McDowell & Co. upon brandy not made by or purchased from Rivière & Co., after the rupture of business relations between the parties, and Rivière & Co. had commenced proceedings in India for infringement in respect of this user. Under these circumstances, Pearson, J., and the Court of Appeal held that the applicants were not in fact aggrieved by the registration, but that it was rightly made, and they refused to annul it. Lindley, L.J., said: "Aggrieved in the sense of being annoyed (McDowell & Co.) certainly were, and, I think, not without cause; but aggrieved in the sense in which it is necessary they should be aggrieved—in the sense of sustaining legal damage either immediate or prospective—they have not shown that they were"; and Fry, L.J., said it was possible that they might be injured, but there was no reason to suppose that they would be, and therefore they were not within the section.[4] In subsequent cases the section, and the phrase "person aggrieved," has been more stringently construed against the registered proprietor; and although there is no conflict between this decision[5] and the decisions cited above, it is plain that in them a view

[1] 28 C. D. 48 (1884), decided on the Act of 1875. *Also European Blair Camera Co.'s Tm.*, 13 R. P. C. 600; 75 L. T. 63 (1896), Stirling, J., where the applicants' predecessor had used the mark in England.

[2] It is clear that the later Acts contemplate registrations by foreign traders; see secs. 103 and 104 of the Act of 1883, and sec. 8 of the Act of 1888. These sections were not repealed by the Act of 1905, but are now replaced by sec. 91 of the Patents and Designs Act, 1907.

[3] 55 L. J. Ch. 545; 53 L. T. 237 (1885).

[4] *I.e.*, sec. 5 of the Act of 1875.

[5] Because the Court held that the mark was properly registered.

was taken of the section different from that acted upon in it.

Purity of the register.

In one case it was suggested that, although the applicant was not a person aggrieved, the Court would, in the interests of the public, rectify the Register if the mark was bad;[1] but, even if the Court would, under any circumstances, take such a course in the absence of a person aggrieved,[2] it would only do so in the case of a registration which was on the face of it illegal or improper.[3]

Applications as to matters otherwise dealt with in the Act.

Under the Act of 1883 a refusal by the Comptroller to cause the name of a person who had become entitled by assignment, transmission, or other operation of law to a registered trade mark to be entered as proprietor of the trade mark in the Register under sec. 87 would have constituted such person a "person aggrieved" and given the Court jurisdiction under sec. 90 to order the entry to be made,[4] but if a person applied to the Comptroller for an alteration in a case for which the Acts did not provide, and it was refused, he was not a "person aggrieved."[4] Under the Act of 1905 both these matters are provided for by special sections with special rights of appeal,[5] and recourse should not be had to sec. 35.

In an application by the Registrar under sub-sec. (3) he would, of course, be in the position of a person aggrieved.

The Exercise of the Jurisdiction under the Section.

Where the mark was incapable of registration it must be removed.

The question of the grievance of the applicant being merely one of *locus standi*, if on the face of the proceedings the applicant is enabled, as a person aggrieved, to bring his application before the Court, the Court has jurisdiction to rectify the Register, which, in the case of a mark not belonging to the class of marks admitted to registration under the Acts,[6] it ought to exercise, even under circumstances in which the applicant is precluded from exercising the right with which the registration interferes. Thus, in *The Stone Ales* case,[7] the Court of Appeal removed the

[1] *Wright, Crossley & Co.'s Tm.*, infra, note (3).

[2] See the judgment of Bowen, L.J., in *Paine & Co.* v. *Daniells & Sons' Breweries*, quoted infra, p. 287. In that case, however, the defendants, being sued, were clearly persons aggrieved.

[3] *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131, 377 (1898), especially the judgment of Romer, J.

[4] *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J. See also *Patent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.

[5] Secs. 33 and 34.

[6] See Chap. VIII., p. 127. See also sec. 36, below, p. 291.

[7] *Thompson* v. *Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal to the H. L. against this

plaintiffs' mark, *Stone Ale*, from the Register on the application of the defendant, although they maintained the injunction granted by Chitty, J., restraining the defendant from selling goods not of the plaintiffs' manufacture under the name in question.

The conduct of the applicant is irrelevant.

And the demerits of applicant in any such case are irrelevant to the question whether rectification should be ordered or not, for the question is not between the applicant on the one hand and the respondent on the other, but between the public and the respondent. Where, therefore, a mark on the Register bearing the words *Forrest London* was shown to be deceptive, because it was used by a Coventry watch-maker who had no connection with the business of Forrest once carried on in London, Mr. Justice Chitty refused to enter upon an inquiry whether the conduct and the trade of the applicant were tainted with fraud, as the respondent alleged. "I state my opinion," he said, "that directly it is apparent that any part of the trade mark is calculated to deceive, it is the duty of the Court to order it to be removed."[1]

So an agreement by which the respondents, the registered proprietors of a mark, appointed the applicants sole agents for the goods which they sold under the mark, and the applicants agreed to sell no goods but those of the respondents under the mark, was held to furnish no answer to an application to remove the mark from the Register, and Chitty, J., said: "This is not a question of equity; this is a question of right under the statute; and the defence, which I find really a difficulty in appreciating, appears to me to fail altogether. I am at a loss to discover how any such agreement as this can displace the applicants' right to have the Register of trade marks disencumbered of that which is not a trade mark at all."[2]

Where the mark was capable of registration but might have been opposed. *Paine* v. *Daniells.*

But in cases where the mark attacked belongs to the class of symbols which are capable of registration, the Court has a discretion, under the Acts, either to expunge or vary the registration or to refuse the application. This was decided by the Court of Appeal in the case of *Paine & Co.* v. *Daniells & Sons' Breweries*,[3] where the matter was fully considered. In that case

[1] *Hill's Tm.*, 10 R. P. C. 113 (1893); see also *Eno* v. *Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890).

[2] *Ainslie & Co.'s Tm.*, 4 R. P. C. 212 (1887).

[3] [1893] 2 Ch. 567; 10 R. P. C. 71, 217. See also *Wright, Crossley & Co.'s*

order. The words had not been used as a trade mark before August 13th, 1875, and were not fancy words. See *Powell's Tm.*, [1893] 2 Ch. 388; 10 R. P. C. 63, 195; [1894] A. C. 8; 11 R. P. C. 4; Chitty. J., C. A. and H. L. (*Yorkshire Relish*), above, p. 281.

the defendants, in an action for infringement and passing off, applied to remove the words *John Bull* and *John Bull Brand* from the plaintiffs' registered labels. It appeared that at the time of the registration of the labels certain third persons, unknown to the plaintiffs, were using *John Bull* as a trade description of their goods in a district, in and around Sheffield, to which the plaintiffs' trade did not extend, but such user had wholly ceased before the date of the application to rectify. And it was assumed by the Court that these persons might have successfully opposed the registrations had they known of them and thought fit to do so. In the view which the Court of Appeal took, the defendants had been guilty for years of deliberate infringement of the plaintiffs' trade mark. The Court refused to direct the marks to be removed, and the following passage from the judgment of Bowen, L.J., fully explains the grounds of their decision :—

The Court has a discretion.

"The purity of the Register of trade marks—if one may use the expression—is of much importance to trade in general, quite apart from the merits or demerits of particular litigants. If on a motion like the present the attention of the Court is called to the entry on the Register of a trade mark which cannot in law be justified as a trade mark, it seems to me that the Court's duty may well be, whatever are the demerits of the applicant, to purify the Register and to expunge the illegal entry in the interests of trade, as was done in *The Stone Ales* case.[1] As a rule, the Court, on being seised of the matter, would doubtless put an end to the existence of a trade mark which could not possibly be justified by law. But the matter is wholly different when the trade mark complained of is one which is not in itself illegal or improper, although at the date of registration its registration might have been, perhaps, successfully opposed by some third party who did not in fact oppose it. In such a case, the defect in the Register is not a defect of which the law is bound to take cognizance at the instance of every complainant. Consent by the *Sheffield* company would, in the present case, have removed all difficulty in the registration of the plaintiff's trade mark.[2] The defendants have no right, as it appears to me, to take the point that such consent

Tm., 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

[1] Supra, p. 285. Any interest which the public may have in the matter is to be considered : *Harness' Tm.*, 17 R. P. C. 40 (1900).

[2] The Sheffield company had not registered *John Bull* beer, and therefore the question of conflicting registered marks would not have arisen.

was not in fact shown to have been given by the *Sheffield* firm, in order to displace a trade mark which they have been meanwhile dishonestly infringing. I am of opinion that the Court is not bound under sec. 90 of the Act of 1883, on the application of an unmeritorious applicant, to displace an entry on the Register, which, on the face of it, is not illegal, because the original registration might have been opposed on the ground of prior user by a third person who never opposed it on any such ground, and who, at the time of the motion to rectify, has discontinued his user."

The construction of sec. 90 of the Act of 1883, here adopted, was certainly in accordance with the apparent meaning of the section, for its terms empowered the Court to make "such order . . . as the Court thinks fit," or to refuse the application. Similar words occur in the present section.

Independent title acquired by registration and user.

So, in a case where the registered proprietor of a mark had adopted and registered it in ignorance of the rights of the applicant, who previously possessed, but had temporarily ceased to use, a similar mark, and the proprietor had largely used his mark for two years, an application to remove it from the Register was refused. The applicant, however, was allowed to register his mark also.[1]

There are, however, some reported cases which can hardly be reconciled with the view taken by the Court of Appeal in *The Stone Ales* case[2] by the distinction suggested in the judgments in *Paine* v. *Daniells*[3] between marks which are good marks under the Acts upon the face of them, although the registration of them might for some extrinsic reason have been opposed, and marks which are bad in themselves.

Mark allowed to remain in pursuance of a compromise.

Thus, in a case where Chitty, J., had ordered a mark to be removed from the Register, on the ground that it did not comply with sec. 64 of the Act of 1883, the Court of Appeal expressed a strong opinion that the applicant (the defendant) had made a binding agreement with the registered proprietor (the plaintiff) not to use the mark, and, the applicant consenting, they set aside the order for removal.[4] And, in an earlier case,[5] Kekewich, J.,

[1] *Mouson & Co.* v. *Boehm*, 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J. In *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J., refused to apply this case to a new mark. See now sec. 21, above, p. 264.

[2] See note (7), ante, p. 285.

[3] See note (3), ante, p. 286.

[4] *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1892).

[5] *Harrison McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889) (*Albion*). The variation is not stated in the Law Reports.

allowed an order expunging a mark from the Register to be varied (subject to any objection being made by the Comptroller) with the consent of the applicant, although he held that, having been used to indicate a design, and not as a trade mark, it ought not to have been registered.

Onus is on the applicant.

It was well established under the Act of 1883 that on an application to remove a trade mark from the Register the onus was on the applicant,[1] and by sec. 40 of the Act of 1905 registration is expressly made *primâ facie* evidence in applications under sec. 35 of the validity of the original registration and of all subsequent assignments and transmissions.[2] Where a trade mark has been long registered, and the validity of the registration depends on the facts which existed at or prior to the date of registration,[3] the Court will give the registered owner the benefit of any doubt.[4] The onus may be shifted, however, in the course of the hearing.[5]

The Registrar's decision is no bar to rectification.

The fact that the Registrar has exercised his discretion in favour of the registration of a mark, and has allowed it to be registered, does not prevent the Court from ordering its removal if the registration was made without sufficient cause;[6] but an applicant for rectification is in a somewhat less advantageous position than an opponent to registration.[7]

Effect of sec. 41.

Section 90 of the Act of 1883 was held not to be limited by sec. 76 of that Act, so that a mark registered without sufficient cause could be removed notwithstanding the fact that it had been five years upon the Register.[8] Section 41 of the Act of 1905, which makes registration valid after a period of seven years from original registration or the passing of the Act, whichever shall last happen, is expressly extended to applications under sec. 35.[9]

[1] *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Benjamin Edgington, Ltd.* v. *John Edgington & Co.*, 6 R. P. C. 513 (1889); *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342, C. A.; *Boord & Son* v. *Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907) (Scotland).

[2] Below, p. 329.

[3] *The Chesebrough* case, cited in note (1); also *Bass, Ratcliff and Gretton, Ltd.'s Tms.*, 19 R. P. C. 529, C. A. Romer, L.J., said that where there had been long uninterrupted user, and the mark had been long registered without attack, every reasonable intendment ought to be made by the Court in favour of the registration.

[4] *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217, C. A.

[5] *Edgington* v. *Edgington*, note (1), and *Dewar & Sons, Ltd.* v. *Dewar*, 17 R. P. C. 341 (Scotland).

[6] Sec. 54: and see *Arbenz's Application*, 35 C. D. p. 260; 4 R. P. C. 143 (1887), C. A. (*Gem*).

[7] See *Société, &c. de l'Étoile's Tm.*, p. 290, note (1), and cases on delay.

[8] *Lloyd & Sons Tm.*, 27 C. D. 646 (1884), Chitty, J.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.; *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.

[9] The section is treated of in Chap. XII., p. 321.

Delay in making the application to rectify is generally no bar,

The delay of the applicant in coming to the Court to ask for rectification of the Register is not of itself any bar to his application,[1] and marks have been removed or varied after being registered for long periods to the knowledge of the applicant,[2] and this may still be so under the Act of 1905, in cases not covered by sec. 41, for instance, cases of obtaining registration by fraud.

but delay may have a bearing on the evidence.

But where the objection alleged to a mark is that it is the same as that of the applicant, or that it has such resemblance to his as to be calculated to deceive, it will be some evidence against the applicant, on whom the burden lies of showing that the registration was made without sufficient cause, if he has stood by and allowed the registered proprietor to use the mark objected to for a length of time, especially if no case of actual deception is proved.[3] Where an opposition to an application to register on such a ground would have been successful two things are to be considered: first, what was the reason of the delay in the application to expunge; and, secondly, whether any substantial injury has been caused by the delay to the person who has registered.[4] Thus, if the objection depends upon proof of a state of facts at a given time—for instance, upon the question whether an old mark was used before August 13th, 1875, in the form registered—after a long lapse of time, and especially if important witnesses have died, the Court will receive the evidence of the applicant upon the point with hesitation.[5]

Entry formerly to be vacated or rectified if originally wrongly made.

Prior to the Act of 1905, it was held that an entry made with-

[1] *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165 (1889), North, J.; *Société, &c. de l'Etoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436; [1894] 2 Ch. 26; 11 R. P. C. 142; *Talbot's Tm.* (1894), W. N. 12; 11 R. P. C. 77, Stirling, J.; *Bourne* v. *Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J. But acquiescence may possibly be a bar in a case in which the ground of applying for rectification is that the applicant could have opposed the mark by reason of having rights in it. See *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 329, at p. 335 (1903), Kekewich, J. The case was reversed on appeal, 20 R. P. C. 803, being decided on other grounds.

[2] For instance in *The Apollinaris* case, some of the marks removed had been registered for fourteen years; [1891] 2 Ch. 186: 8 R. P. C. 137, C. A. See also *Paine & Co.* v. *Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

[3] *Talbot's Tm.*, supra, note (1).

[4] *Eastman Photographic Materials Co., Ltd.* v. *John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105, at p. 111 (1898), Romer, J. In *Société, &c. de l'Étoile's Tm.*, supra, three years' delay, which was explained by want of knowledge of the registration, was held by Stirling, J., and the Court of Appeal not to disentitle the applicant to relief.

[5] *Benjamin Edgington, Ltd.* v. *John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

out sufficient cause ought to be expunged, even though, so far as appeared at the hearing of the application to rectify, an application to re-register could be successfully made at once, for there ought to be fresh advertisements and a fresh opportunity for objectors to oppose the registration.[1] So, where a misstatement as to the length of time during which the mark had been used was made, not fraudulently but through carelessness, in the application for registration, North, J., directed the registration to be vacated.[2] And in *The Apollinaris* case, in dealing with the objection that the company, when only importers, had registered marks belonging to the producers of the goods as their own, Fry, L.J., said[3]: "On behalf of the Apollinaris Co. an argument was addressed to us to this effect, that as they had, in the year 1881, become the sole owners of the produce of the spring, they could now get these marks on the Register, and that we ought not to remove marks which, as soon as we have taken them off, can be put on again. But even assuming that the respondents are *primâ facie* entitled now to be placed on the Register, as to which we say nothing, we are of opinion that the course suggested is rendered impossible by the statutory provision for advertisements. To allow a mark which ought not to have been on the Register to remain on by reason of some intervening event would be to preclude the public from challenging the new title of the applicant for registration." But the rule laid down did not compel the Court to order the removal of a mark if the registration of a note, partial removal, or other variation met the justice of the case.[4]

Judgment of Fry, L.J., in *The Apollinaris* case.

The policy of the Act of 1905 is different, and sec. 36 provides that a trade mark shall not be removed from the Register if it is a registrable trade mark under the Act, although it was not registrable under the Acts in force at the date of its registration.[5] Moreover, the Court has now power to order a disclaimer,[6] and may, under sec. 35, vary the entry. It may do this instead of

Act of 1905.

[1] In *Hayward's Tm.*, however, where the objection was that the application on which the mark was registered ought to have been treated as abandoned, Kay, J., allowed the mark to stand, with a note limiting the date from which the five years should run before the registered proprietor acquired an absolute title to the date of actual registration; 54 L. J. Ch. 1003 (1885).

[2] *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891).

[3] [1891] 2 Ch. p. 230; 8 R. P. C. p. 163.

[4] See note (1) and the instances cited below, pp. 297 *et seq.*

[5] The section has been considered above, p. 132.

[6] Sec. 15, above, p. 212.

expunging the entry, on the application of the respondent in a suitable case.[1]

Entry, originally rightly made, may be expunged or varied.

Under the Act of 1883 the Court of Appeal took the view that an order could be made under the section to remove from the Register a mark the presence of which on the Register was not legitimate, even although the original registration was proper. In *Batt's Trade Marks*, Lindley, M.R., delivering the judgment of the Court, and referring to the words "entry made without sufficient cause in any such Register," said: "We are not disposed to put a narrow construction on this expression, nor to read it as if the word 'made' were the all-important word, and as if the words 'made without sufficient cause' must be read as if they were 'made *without sufficient cause* at the time of registration,' so as to be confined to that precise time. If any entry is at any time on the Register without sufficient cause, however it got there, it ought, in our opinion, to be treated as covered by the words of the section."[2] As pointed out in the judgment referred to, in the view taken by the Court of the facts the decision of the point was not necessary to the decision of the case, and no order has been made, it is believed, for the removal of a mark originally rightly registered.[3] The principle has, however, been recognised in sec. 35, for a person aggrieved by any entry wrongly remaining on the Register may apply to expunge it.

Removal for non-user, &c.

In *Batt's* case,[4] already referred to, it was decided by the House of Lords, that a trade mark not registered by the proprietor with a *bonâ fide* intention of using it may be removed

[1] *Gestetner's Tm.*, [1907] 2 Ch. 478: 24 R. P. C. 545; [1908] 1 Ch. 513; 25 R. P. C 156.

[2] [1898] 2 Ch. 432: 15 R. P. C. 534, Lindley, M.R., Chitty and Collins, L.JJ. The case was affirmed in the House of Lords, but no decision was given on this point.

[3] In *Valentine Extract Co.'s Tm.*, 18 R. P. C. 175 (1901), Farwell, J., the trade mark *Valtine* was ordered to be removed from the Register, an injunction having been granted at the instance of the applicants against its use (Appendix, p. 738), but they could no doubt have successfully opposed the registration.

[4] Decided in the House of Lords *sub nom. Batt* v. *Dunnett*, [1899] A. C. 428; 16 R. P. C. 411. It has been followed in several cases in which the registration has been limited by striking out goods for which there was no intention to use the mark, *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569; *Suter, &c. Composition Co.'s Tm.*, 19 R. P. C. 42; *Anglo-Swiss Condensed Milk Co.'s Tms.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904). In *Louise* v. *Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J., said that in order to remove a trade mark from the Register on the ground of non-user, there must be shown either want of *bonâ fide* intention to use at the date of registration and that it has not been used, or that it has been abandoned.

from the Register. With respect to this and non-user, sec. 37 of the Act of 1905 provides as follows:—

sec. 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."

The section creates special grounds of removal under sec. 35 of a trade mark from the Register, and, although the exercise of the jurisdiction is discretionary, the entry of a mark, which is liable to removal under this section, is one wrongly remaining on the Register. The application must be made by a person aggrieved.[1] The grounds of removal are alternatively either registration without any *bonâ fide* intention to use the mark in connection with the particular goods *and* no *bonâ fide* user in fact, or no *bonâ fide* user during the five years immediately preceding the application.[2] Where a trade mark has been registered for five years, the last ground will obviously be the one selected by an applicant for rectification. If it has been registered for less than five years, then the applicant must show in addition to non-user that it was registered without *bonâ fide* intention to use it in connection with the goods, and it is doubtful whether the want of such *bonâ fide* intention to use it would be inferred merely from non-user in fact. In *Batt's* case[3] the want of such intention was inferred from non-user, but the trade marks had been registered for many years. Other circumstances might assist to show the absence of intention to use, for instance, the fact that the proprietor's business had never extended to the particular goods, for the section enables an application for rectification to be made in respect of any of the goods for which the mark is registered.

The proprietor may, although a *primâ facie* case is made

[1] Above, p. 279.

[2] The Legislature is here evidently referring to non-user *after* registration.

[3] Cited above, p. 292.

against him, show that the non-user is due to special circumstances in the trade[1] *and* not to any intention not to use or to abandon the mark in respect to the goods in question.[2]

Associated trade marks.

Where a trade mark and a portion or portions of it are separately registered as associated trade marks, user of the whole trade mark is for the purposes of the Act to be deemed to be also a user of such registered trade marks as it contains.[3] And it is also provided generally by sec. 27 that, where under the provisions of the 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,[4] or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Section 41, which makes registration for a period of seven years from the date of original registration or from the passing of the Act (whichever shall last happen) conclusive as to the validity of the original registration,[5] subject to certain exceptions, contains no exception referring to sec. 37; but it would seem that it would not avail to save a trade mark from removal on the ground of non-user for five years immediately before the application to remove it, that being a matter subsequent to registration, and, as already pointed out, where the trade mark has been registered, but not used, for five years, it is not necessary under sec. 37 to show a want of intention to use it at the date of registration.

What Orders may be made under the Section.

The section empowers the Court to make "such order for making, expunging, or varying the entry," of the omission or registration of which complaint is made, as the Court thinks fit. The Court may therefore (1) direct an entry to be made on the Register; (2) order an entry already appearing thereon to be wholly removed; or (3) to be partially removed; or (4)

[1] "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." Per Chitty, J., in *Monson* v. *Bochm*, 26 C. D. 393 (1884). Cf. *Daniel and Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134.

[2] Abandonment, p. 370.

[3] Sec. 25.

[4] Associated trade marks, see above, p. 107.

[5] See below, p. 330.

to be modified by a disclaimer; or (5) by limiting it to particular goods; or (6) by limiting it to one or more specified colours; or (7) by the entry of conditions; or (8) to be varied as to its form; or (9) date; or (10) the name of its registered proprietor; or (11) by correcting any error or defect in the entry.

New entries.

(1) The jurisdiction to order a new entry to be made seems to be specially referable to the preceding words of the section, "aggrieved by the non-insertion in or omission from the Register of any entry," but the Court is not empowered by the section to order to be entered upon the Register a mark which the Registrar has refused, for a special mode of appeal from the Registrar's decision to the Board of Trade or to the Court is provided by sec. 12, and, consequently, no other appeal is permitted.[1] And it cannot direct a new mark to be registered with regard to which the proper procedure by application and advertisement has not been resorted to.[2] So far as actual marks are concerned, the reference to entries to be made upon the Register must, therefore, notwithstanding the words quoted above, be taken to refer only to the variation of marks already registered by addition to them.

New marks cannot be registered under the section.

Total removal.

(2) Orders for total removal of entries from the Register have been made in a great number of cases, and many examples have been given already in this and the two preceding chapters. The entry is to be expunged if made without sufficient cause, or if wrongly remaining on the Register. What is a sufficient cause for refusing an application to register is considered in Chapter IV.,[3] and generally the same reasons will afford grounds for removing an entry inadvertently made. But the Court has a discretion to refuse to vacate the registration of a mark, independently adopted and extensively used by the proprietor, if it falls within the class of symbols which may be registered as trade marks, and the only objection is that it had been previously used or acquired as his

Reasons for removal.

[1] *The Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. C. 123 (1887), Chitty, J., and C. A., decided under the Act of 1883.

[2] *Ritchie's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1885), C. A.; and as to transfers from one name to another, see below, p. 301, and cf. p. 291. In *Jackson* v. *Napper* there was an application for registration, and the summons was not, as stated in 4 R. P. C. 45, an application to rectify under sec. 90, but an application to proceed under sec. 62. It seems to have been irregular in any case, as there was no appeal from the Comptroller to the Board of Trade, so far as the report shows: 35 C. D. 162 (1886), Stirling, J.

[3] At page 71.

trade mark by another person.[1] The proprietor of a registered mark stands in a better position than an applicant for registration, since the Registrar's discretion[2] has been exercised in his favour, and the onus of showing that the registration was made without sufficient cause is cast upon the person applying to vary it.[3]

The reasons for removing a mark may be classified as follows: namely, that the registered proprietor is not the person entitled to use it;[4] the mark was not capable of registration,[5] or it fell within the restrictions forbidding registration contained in the Acts;[6] the registration was procured by a material misstatement;[7] or the person who registered had no *bonâ fide* intention to use the mark, and has not used it in fact[8] or has not used it for five years immediately preceding the application.[9]

Alteration of circumstances subsequent to registration.

The Court of Appeal held, under the Act of 1883, that the words "made without sufficient cause" did not relate merely to the date of registration,[9] and that there was jurisdiction to rectify although there had been no mistake or error in the original registration. This point does not arise under sec. 35 of the Act of 1905, because express power is given to the Court to remove an entry wrongly remaining on the Register. As already noticed,

Abandonment or misuser of mark.

a trade mark can be removed for non-user, and it would seem that if a registered proprietor ceases to carry on business, or abandons all further intention to trade in the goods for which the mark is registered,[10] or in any other way renders it improper that the mark should remain on the Register, it can be removed. It has been decided that no events subsequent to the date of

[1] *Monson* v. *Bochm*, 26 C. D. 398 (1884), Chitty, J.; *Paine & Co.* v. *Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, above, p. 280. The Court can now allow the objector's trade mark to be registered under sec. 21, but a substantive application in the prescribed manner would no doubt be necessary.

[2] Chap. IV., at p. 70; but see above, p. 289.

[3] Above, p. 289.

[4] Chap. IV., at p. 67.

[5] Chap. VIII., p. 127. This ground is subject to the provisions of sec. 36, see above, pp. 132 and 291.

[6] Chap. X., p. 221.

[7] *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.; *Gordon and Dilworth's Tm.*, 13 R. P. C. 629 (1896); *Eastman, &c. Co.* v. *John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), cited p. 269.

[8] Above, pp. 292 and 293.

[9] *Batt's Tms.*, [1898] 2 Ch. 432; 15 R. P. C. 534; supra, p. 292; *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 347 (1881), Hall, V.-C., was to the contrary effect. In *Louise & Co., Ltd.* v. *Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J., said that to remove a mark for non-user either want of *bonâ fide* intention to use the mark or abandonment must be shown.

[10] Cf. *Batt's Tms.*, supra, p. 292; and as regards the removal of an abandoned mark, see below, p. 372.

registration can be appealed to by the registered proprietor to defend his mark.[1]

Partial removal.

(3) If part only of a composite mark is objectionable, that part may be removed. This course was adopted in *Biegel's Trade Mark*,[2] where the applicants, Younger & Co., complained that the use of three interlaced triangles in the respondent's label caused it to resemble too closely their own label, which contained three superimposed solid triangles similarly placed. The remainder of the label was distinctive, and the applicants did not complain of it. The order made was to strike out the triangular device.

Deceptive mark wholly removed.

Where, however, the registered mark consisted of a fir tree, with the words *Forrest* above and *London* below printed in large letters, and, the proprietor being a Coventry watchmaker, having no connection with the business formerly carried on by Forrest in London, the mark was deceptive, Chitty, J., directed the whole mark to be struck out, but without prejudice to any application the respondent might make to register the fir tree alone.[3]

In the case last cited it was argued on behalf of the Comptroller that sec. 90 of the Act of 1883 did not authorise the alteration of a registered mark, and that any application to vary must have been made under sec. 92 of that Act;[4] and a similar contention may perhaps be raised on secs. 34 and 35 of the Act of 1905; but such a contention is opposed to the express words of sec. 35, and it would leave unprovided for cases which do not fall within sec. 34, which is confined to applications by registered proprietors themselves.

Registration of a disclaimer.

(4) Registration with a disclaimer has already been discussed.[5] *Edge's Trade Mark*[6] is an example of the compulsory registration of a disclaimer. The respondent had registered the words *Edge's*

[1] Above, p. 291. This, however, is subject to sec. 36.

[2] 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.; *Blair* v. *Stock*, 52 L. T. 123 (1884), Kay, J.; *Stratmore* struck out of mark.

[3] *Hill's Tm.*, 10 R. P. C. 113 (1893). Such an application was made, but refused: see the report of *Thorncloe* v. *Hill*, 11 R. P. C. 67 (1894).

[4] See now sec. 34, below, p. 316.

[5] Chap. IX., p. 212.

[6] 8 R. P. C. 207 (1891), Stirling, J. (see above, p. 196); *Burland* v. *Bracburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.; *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*), are other instances. But see *The Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611, Kekewich, J., and C. A. (*St. Raphael*), where disclaimers were not ordered, and *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535 (*Silverpan*), where the jurisdiction was questioned.

Filtered Blue, and a label containing these words with certain devices. Mr. Justice Stirling held that the word *filtered* was either descriptive or deceptive, and that the respondent could have no exclusive right to use it. He accordingly directed the first mark to be removed from the Register, and the exclusive right to the use of *filtered* in the other to be disclaimed. So, an order for the disclaimer of the exclusive use of the words *white zinc* and of the word *patent* and of the Royal Arms was made in the case of an old mark.[1] In some cases under the repealed Acts, it was, at the instance of the Comptroller, made a condition for granting leave to make alterations in a mark, that an entry be made of a statement of the essential particulars and a disclaimer of the exclusive use of the added matter;[2] the principle being that the applicants should put themselves in the same position as if they were registering under the Act for the time being in force; but under the present procedure such a statement of essential particulars is not required to be made in an application to register. Under sec. 15 the Court has now express power to require a disclaimer as a condition of a trade mark remaining on the Register.[3]

Limitation of the registration—

to particular goods;

(5) A limitation restricting the registration of a trade mark to those goods for which the registered proprietor actually used the mark, and to which alone the goodwill of the business transferred to him with the mark by the former proprietor extended, was adjudged to be notified upon the Register in *Edwards* v. *Dennis*.[4] And in *The Milkmaid Brand* case,[5] where the defendant's mark too nearly resembled the previously registered mark of the plaintiffs, it was ordered that the registration of the former should be confined to goods for which the plaintiffs' mark was not registered. In *Banks and James' Trade Mark*[6] the registration of a mark registered for cigars, cigarettes, and tobacco was, on a motion to rectify, and with the consent of the proprietor, ordered to be limited to cigars.[7]

Section 37, which enables a trade mark to be removed from the

[1] This appears in the report of *Hubbuck* v. *Brown*, 17 R. P. C. 148, where the mark is shown.

[2] *Colman's Tms.*, [1891] 2 Ch. 402; 8 R. P. C. 209, Kekewich, J.; *Orlando Jones & Co.'s Tms.*, 12 R. P. C. 278 (1895), Stirling, J.

[3] See above, p. 212.

[4] 30 C. D. 454 (1885), C. A.

[5] *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.

[6] 12 R. P. C. 333 (1895), Chitty, J.

[7] And in *Ball's Tms.*, 15 R. P. C. 534 (1898), one of the marks was only expunged as regards goods in one class.

Register on the ground of non-user, has been referred to earlier in this chapter,[1] and it is there pointed out that the mark may be removed in respect of any of the goods for which it is registered. The following cases were decided under the former Acts on the principle of *Edwards* v. *Dennis*[2] and *Batt's Trade Marks*.[3]

In *Suter, &c. Composition Co.'s Trade Marks*,[4] a trade mark registered for chemical substances used in manufacture, photography and philosophic research, anti-corrosives and anti-foulers, was limited to anti-corrosives and anti-foulers, for which only it was intended, and the registration of another mark was limited to such goods as, on the respondent's evidence, it had been used for. In this case it was said that on an application of this nature, the order should not be simply to exclude the articles in respect of which the applicant is interested, but to amend the entry so as to confine it to the goods in respect of which the registered mark has been used, so as to avoid further applications to limit. In *Hart's Trade Mark*,[5] an order was made excluding condensed milk from the goods for which the trade mark was registered, although the mark had been registered for twenty years, and the proprietor dealt in condensed milk, and had at the date of the application for rectification determined to use the mark on condensed milk. He had used other marks for such goods.[6] In the *Anglo-Swiss Condensed Milk Co.'s Trade Marks*[7] an order was made excluding butter from the goods for which a trade mark was registered on the ground that there had never been any intention to use it for butter, the mark having been registered without such use for over twenty years.

In *Bourne* v. *Swan and Edgar, Ltd.*,[8] the word "Swanbill," which was registered for ladies' corsets and other ready-made underclothing, was held to be descriptive of a particular shape of corset, and the Register was ordered to be rectified by confining the goods to ladies' ready-made underclothing other than corsets.

to particular market.

The Court has under sec. 90 of the Act of 1883 ordered a note of an undertaking by the registered proprietor restricting the use

[1] Above, p. 293.
[2] Note (4), p. 238.
[3] Above, p. 292.
[4] 19 R. P. C. 42 (1902), Byrne, J.
[5] [1902] 2 Ch. 621 ; 19 R. P. C. 569, Byrne, J.
[6] *Hare's Tm.*, 24 R. P. C. 263 (1907), Swinfen Eady, J., is an instance of limitation under the Act of 1905. The respondent did not oppose at the hearing, but was ordered to pay the costs.
[7] 29 R. P. C. 509 ; 21 R. P. C. 261 (1904), Joyce, J., and C. A.
[8] [1903] 1 Ch. 211 ; 20 R. P. C. 105, Farwell, J.

of the mark, in accordance with an agreement between the proprietor and the applicant, to be entered on the Register,[1] and the Court has probably power under the present Act to impose limitations and conditions, including limitations of area, as a condition of a trade mark remaining on the Register.[2]

Limitation to specified colours.

(6) Under sec. 10 of the Act a trade mark may now be registered with a limitation as to the whole or a part to one or more specified colours; and in cases where that is done colour may be taken into consideration for the purpose of distinctiveness.[3] This being so, if a registration without colour were successfully challenged, but the trade mark would be unobjectionable if confined to the colours in which it was used, it is probable that the Court would exercise its discretion by imposing a limitation to those colours instead of removing the mark from the Register.[4]

Entry of conditions.

(7) As already pointed out, registration subject to conditions is now permissible,[2] and in a proper case the Court could probably therefore enter a condition on the Register instead of expunging the mark.

Variation in form of mark.

(8) The only variation in the form of a registered mark ordered under sec. 90 of the Act of 1883 which occurs in any reported case is variation by striking out part of the mark.[5] Any alteration which, to use the language of sec. 34 of the Act of 1905, substantially affected the identity of the mark would be open to the objection that it would cause a new mark to be entered on the Register, the application for which had not been advertised,[6] and had not been approved by the Registrar. Possibly the Court would in a suitable case under the present Act adjourn the hearing to enable the respondent to make an application under sec. 34.

Variation of date of entry.

(9) A variation of the date of registration was directed in *Hayward's* case.[7] There a mark was registered in 1885 on an application made in 1879, and it was held that the registration, not having been completed within one year, ought to have been

[1] *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1885), Chitty, J.; cross undertakings for local user. As to entering such undertakings or at all events those referring to locality, on the Register, under the Acts of 1883 and 1888, see *Dewhurst's Tm.*, [1896] 2 Ch. 137; 13 R. P. C. 288, and supra, p. 230; and *Eastman, &c. Co., Ltd.* v. *J. Griffiths' Cycle Corporation, Ltd.*, 15 R. P. C. at p. 109 (1898) (the Comptroller's objection).

[2] Cf. sec. 12 (4) and sec. 14 (6).

[3] Colour, above, p. 209.

[4] Cf. sec. 36.

[5] See above, p. 297; and as to alterations under sec. 34, see below, p. 316.

[6] See above, pp. 291 and 295.

[7] 54 L. J. Ch. 1003 (1885), Kay, J.

treated as abandoned, under sec. 63 of the Act of 1883. Kay, J., however, refused to expunge the registration, but ordered that the five years which under that Act made registration conclusive evidence of exclusive right of user [1] should run from the date of the actual registration instead of from the date of the application to register.

Variation of name of proprietor.

(10) The Register could not be rectified under sec. 90 of the Act of 1883, where a mark had been wrongfully registered in the name of someone other than the proprietor, by expunging the name and substituting that of the person entitled to the mark, and this is probably so under the Act of 1905. The whole entry may be expunged, but the true proprietor must be left to make a fresh application for registration, which will be advertised in the ordinary course, and may lead to opposition.[2] So where an agent wrongfully registered his principal's trade mark in his own name, Jessel, M.R., refused to order the name to be changed.[3] And the same rule was applied where the entry was innocently made in the wrong name by mistake, as by a partner in his own name instead of his firm's,[4] or by an agent acting for two principals, in the name of the wrong principal.[5] In the former case, the proper course was for the registered owner to assign, and for the assignee's name to be registered under sec. 87.[6] But in a case where a partner registered the mark in his own name thus—"Arthur Rust, trading as T. W. Rust & Co."—Jessel, M.R., allowed the names of all the partners to be substituted for "Arthur Rust"; [7] and this case was distinguished in the later judgment, on the ground that the application had been made in the name of the true proprietors, the firm. And where the owners of the mark changed the name under which they were carrying on business, Stirling, J., on an application under

Registration in the wrong name.

Change of name of proprietor.

[1] See sec. 41 of the Act of 1905, below, p. 330.

[2] *Rivière's Tm.*, 55 L. J. Ch. 545 (1885). C. A. cited above, p. 283; *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

[3] *Marler's Tm.*, 44 L. T. 98, n. (1878). In the case of a design the name has been altered in the absence of fraud: *In re Grocott's Design*, 17 R. P. C. 139 (1900); but different considerations apply in the case of designs, and the case does not affect the practice as to trade marks.

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

[5] *Kingsford & Son's Application*, 6 R. P. C. 413; 61 L. T. 426 (1889), Kay, J.

[6] *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; and *Farina's Tm.*, supra. Sec. 33 of the Act of 1905 corresponds to this part of sec. 87 of the Act of 1883. Sec. 70 of the Act of 1883 (sec. 22 of the Act of 1905, trade mark to be assigned only with goodwill) was not an obstacle to such assignment: *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.

[7] *Rust's Tm.*, 44 L. T. 98, n. (1880).

the section, allowed the new name to be entered, with a note that the firm formerly traded under the old name.[1] But in a later case North, J., held that on an alteration of the name of a limited company, who were the proprietors of a trade mark, the Comptroller could enter the new name of the proprietors on the Register under sec. 87 of the Act of 1883, and unless he refused, the Court could not order rectification under sec. 90.[2] The Registrar now has power on request by the registered proprietor, or by some person entitled by law to act in his name, to enter any change of name of the person who is registered as proprietor of a trade mark;[3] so that an application under sec. 35 is not necessary for this purpose, and probably would not be entertained in a case to which sec. 32 applied. In *Re The Australian Wine Co.*[4] a mark had been registered in his own name by the sole consignee of wines from a particular vineyard, the consignee intending to use the registration solely for the protection of such wines, and so long only as he should remain consignee. The mark was transferred by his trustee in bankruptcy, with the consignee's business, to a purchaser who procured the entry on the Register of his own name as proprietor. Subsequently, upon the application, under sec. 90 of the Act of 1883, of the then owners of the vineyard, Chitty, J., directed their names to be entered as proprietors of the mark, in lieu of that of the purchaser of the consignee's business, on the ground that the mark had been registered for the benefit of the owner of the vineyard, not for that of the owner of the business.

And in a case where the registered proprietor of a mark had assigned her business and the use of the mark for six years to the respondents, with an express provision for the same reverting to her, and they had procured the registration of their own names as assignees, upon their application it was ordered that the Register should be rectified by removing their names and restoring that of the original proprietor.[5]

In a recent case an alleged assignment of trade marks was held to be wrongly registered, and was ordered to be expunged.[6]

Where an assignor by mistake purported to assign a mark and

[1] *Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890); followed by Kekewich, J., in *Burgon* v. *Wilkinson*, 40 Sol. J., p. 336 (1896).

[2] *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475.

[3] Sect. 32, below, p. 314.

[4] 61 L. T. 427, n. (1885).

[5] *Re Acril*, April 20th, 1888, Stirling, J.; Sebastian, 4th ed. pp. 374, 382.

[6] *Rey* v. *Lecouturier*, 25 R. P. C. 265 (1908) C. A.

goodwill after a previous agreement to assign to a third person, and the assignee was registered as proprietor, his name was expunged on the application of the executors of the person with whom the agreement had been made, the second assignment being inoperative by reason of there being no goodwill to assign.[1]

(11) The Court has power on the application of a person aggrieved by any error or defect in any entry on the Register to vary the entry as it may think fit. Some of the cases under the former Act referred to above under (10) would be covered by these words.[2]

Procedure on an Application under sec. 35.

"The Court."

"The Court" in England is His Majesty's High Court of Justice,[3] or, with reference to marks of which the registration was applied for in the Manchester Trade Marks Office,[4] the Palatine Court of Chancery;[5] and those Courts have jurisdiction to rectify a registered mark, whether the registered proprietor is domiciled or resident in England, or in Scotland, or Ireland, or elsewhere;[6] although where he is domiciled or resident in Scotland or Ireland, the Scotch or Irish Courts have, perhaps, a concurrent jurisdiction.[7] The question of the jurisdiction of the Scotch and Irish Courts to rectify the Register is somewhat doubtful. Under the Act of 1883 the Irish Courts held that they had no jurisdiction to rectify,[8] but it was held by the Scotch Courts that they had 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[9] became applicable.[10] 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

[1] *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

[2] Cf. sec. 32 (1), below, p. 314.

[3] Sec. 3 (sec. 117 of the Act of 1883).

[4] Chap. VII., p. 121.

[5] Sec. 71; Act of 1888, sec. 26.

[6] *Re King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350, Kekewich, J., and C. A. As to notice of motion in such cases, see below, p. 306.

[7] See the case last cited, and sec. 111 (2).

[8] *Bayer* v. *Connell Bros.*, 14 R. P. C. 275 (1897).

[9] Appendix, p. 643.

[10] *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, at p. 379 (1905), and in *Boord & Son* v. *Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland.

notice rectify the Register accordingly. The omission in the new 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.[1]

In practice, proceedings to rectify are almost always taken in the Chancery Division, except where they occur in the course of an action for infringement or passing-off, commenced against the applicant in the King's Bench Division;[2] and unless disputed questions of fact are involved which it is desirable to try by the aid of a jury, the Chancery Division will almost always be found to provide the more satisfactory tribunals for the trial of trade mark questions.

Sec. 35 states that the application is to be made in the prescribed manner, which in relation to proceedings before the Court means prescribed by rules of Court,[3] but no rules have been made under the Act prescribing the manner in which the application to the Court must be made. In practice the procedure has in recent years always been by motion, though formerly applications by originating summons were not infrequent.[4]

Not by action.

There is no reported English case where the application has been made by action; and in *Pinto* v. *Badman*,[2] Bowen, L.J., suggested that to proceed in that way would be an abuse of the process of the Court. It may be assumed, at any rate, that the plaintiff in an action, unless he could show some good ground for adopting a course which is both unusual and, in general, unnecessarily expensive, would have to pay the extra costs incurred, even though he were successful.

Not by counterclaim.

In the case last cited, it was held that the application could not be made by counterclaim, apparently on the ground that it did not fall within sec. 24 (3) of the Judicature Act of 1873.[5]

By motion.

As already stated, the application is now always made by motion. If an action is pending in the matter, the motion will almost always be adjourned to the hearing of the action. The notice of motion must, if issued in the Chancery Division, be marked with the name of a judge,[6] and the notice must, unless special leave for short notice is given by the Court or a

[1] Cf. secs. 94 and 95 of the Patents and Designs Act, 1907.

[2] As in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891).

[3] Sec. 3.

[4] As to the procedure by summons, see 2nd ed. of this work, p. 287.

[5] Cf. sec. 32, Patents and Designs Act, 1907.

[6] Ord. 5, r. 9 (c); *King & Co.'s Tm.*, [1892] 2 Ch. 469; 10 R. P. C. 350. Form, p. 723.

judge, be served two days before the motion is made.[1] By Rule 129 of the Trade Mark Rules, 1906, every application to the Court under the Act must be served on the Registrar. And sec. 47 of the Act provides as follows:— Service on the Registrar.

"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." Sec. 47.

Under the old practice the Comptroller had the right to appear on an application to rectify[2]; but 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. The words "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" would apply to appeals under secs. 23, 32, 33 or 34, in which the matter would have come before the Registrar in the first instance, and on appeal might come before the Court, directly (under sec. 33) or on a reference by the Board of Trade. They might also apply in cases under sec. 35 where there has been a previous decision of the Registrar relating to the entry.

The Court may in any application for rectification review a decision of the Registrar relating to the entry in question or correction sought to be made.[3] But 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

[1] Ord. 52, r. 5.

[2] Rule 49 of 1890; notice of an application to rectify had to be given to the Comptroller.

[3] Sec. 54.

out of an opposition, the matter would be *res judicata*, and it is presumed that the question could not, under sec. 35, be reopened by the defeated party.[1]

No special terms should be inserted in an order for rectification, even by consent, unless the Registrar has notice of them.[2]

Service on the registered proprietor.

It is proper, when the registered proprietor of the trade mark in question is resident within the jurisdiction, to serve him with the notice of motion;[3] but if he is resident abroad, under the existing rule of Court this cannot be done, nor is it necessary to enable the Court to entertain the application in question.[4] In the case of *La Cie. Générale d'Eaux Minérales, &c.*, notice of motion to remove a mark belonging to a foreign company not carrying on business in England was served upon the company in Paris; and Stirling, J., upon their application, set aside the service, because it would have founded a jurisdiction to give costs and damages[5] against the company, and there is, he held, nothing in the Acts to warrant this in the case of such a respondent. The notice of motion had been served abroad without the leave of a judge, but that was really immaterial, as there is no jurisdiction under Order XI. or otherwise to grant leave in respect of the application in question. On a subsequent application the learned judge directed that the name of the company should be struck out of the notice of motion, leaving the Comptroller as the sole respondent, but that information of the application should be given to the company.[6] This course was adopted and approved in *King & Co.'s* case,[7] where the registered proprietors of the mark in question were a company having its registered office and carrying on business in Ireland. In that case the Court of Appeal held that service of the formal notice of motion was not required to enable the Court to deal with the application, and that, as the Acts and Rules were silent on the subject, all that was required by natural justice, and therefore all that the Court would insist on, was that the persons interested in the mark should have actual notice of the applica-

Where the proprietor is resident abroad.

Notice of motion not to be served out of the jurisdiction.

Notice by letter only.

[1] See *Normal Co.'s Tm.*, 35 C. D. 231; 3 R. P. C. 269; 4 R. P. C. 123 (1887).

[2] See *Golding's Tm.*, 19 R. P. C. 375 (1902), Joyce, J.

[3] See *King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350.

[4] See *King & Co.'s Tm.*, supra, and *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J. And the steps taken by the applicant in *Ashton's Tm.*, 48 W. R. 389 (1900), where the registered proprietor, resident abroad, could not be traced.

[5] As to damages, see above, p. 279.

[6] [1891] 3 Ch. 451; 8 R. P. C. 446.

[7] Supra, note (3).

tion to be made respecting it.[1] If they should take advantage of the notice to appear and oppose the application it was, the Court held, open to them to do so, but in that event they would be liable, if they failed, to be ordered to pay costs. Lindley, L.J., expressed a doubt whether it was necessary, in the case before Stirling, J., to strike out the name of the foreign respondents from the notice.[2] He said: "If you go down to the root of the argument there is nothing in it except a false analogy based on the supposition that, because the notice of motion is marked by an English judge, the parties interested must be technically named at the foot of it as respondents, and you must get leave to serve them if they are to be affected by it. It appears to me that all that they want for the purposes of this Act is notice, and that they have had."[3]

Foreigner appearing on the application may be made liable for costs.

If it appears that the registered proprietor has not the equitable interest, the person having such interest ought to be added as a respondent unless he distinctly disclaims all interest.[4]

It has been held that a foreigner who is the registered proprietor of a mark which it is sought to remove from the Register is entitled, on receipt of information as to the intended application to rectify, to appear upon the application without giving security for costs, on submitting to the jurisdiction;[5] but if he appeal from an order made on the motion, he may be ordered to give security.[6]

Security for costs by foreigner.

The Court has in several cases refused to allow actions for infringement to be brought or proceeded with in England where it has considered the Scotch or Irish Courts to be more convenient, notwithstanding that motions to rectify were pending before it with regard to the same matters.[7]

Action for infringement in Scotland or Ireland.

[1] Cf. Ord. 52, r. 3.

[2] [1892] 2 Ch. p. 482.

[3] Cf. *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1888), and *Robertson, Sanderson & Co.'s Tm.*, [1892] 2 Ch. 245; 9 R. P. C. 213, where notices of appeals from the Comptroller were sent to persons out of the jurisdiction, but the notices of motion were not served on them.

[4] *Re Zonophone Tm.*, 20 R. P. C. 450 (1903), Byrne, J.

[5] *Société, &c. de l'Étoile's Tm.*, 10 R. P. C. 290 (1893), Stirling, J.; *Miller's Patent*, W. N. (1894), 4; 1 R. P. C. 55, Kekewich, J.

[6] In *Société, &c. de l'Étoile's Tm.*, 11 R. P. C. 142, an order was made by consent, the appellants having no place of business in England. On the other hand, in *Re Apollinaris Co.'s Tms.*, [1891] 1 Ch. 1, a foreign applicant who appealed was not ordered to give security, he having ample assets within the jurisdiction.

[7] *Kinahan* v. *Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1891), Kekewich, J.; *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

Evidence on the Application.

The evidence is, in accordance with the usual rule, generally given in the first instance by affidavit, subject to cross-examination of the dependents if ordered by the Court or a judge.[1] But applications under the section are very frequently heard upon *viva voce* evidence given in Court. And the Court had, by the terms of sec. 90 of the Act of 1883, power to direct an issue to be tried for the determination of any fact arising upon the application, but this is rarely, if ever, done. No special provision in this respect is contained in the Act of 1905, the matter being covered by the general powers of the Court.[2] Where an action is pending by the proprietor of the mark against the applicant, it is very usual, especially in cases where the application to rectify depends on questions of fact, to order the application to stand over until the trial, and to come on to be heard with the action, with leave to use the affidavits and cross-examine on them, and to adduce oral evidence. In such a case the applicant for rectification is generally ordered to give particulars of his objections to the entry attacked.

Declarations of the proprietor.

Statutory declarations, or certified copies of declarations, made on the application for registration of the mark sought to be removed or varied, and on the occasion of transfers of the mark by predecessors in title of the owners of the mark, may be put in evidence by the applicants, but not declarations made by persons who are neither parties to the application nor predecessors in title of the respondents.[3]

Discovery.

In a proper case discovery of documents may be ordered to be made by either party to the application.[4] In *Wills' Trade Marks*,[5] on an application by notice of motion to remove certain marks from the Register, and after the evidence had been completed (except as to the cross-examination of two witnesses, which was to be taken in Court), the applicants took out a summons for an order for discovery of documents by the respondents, the proprietors of the marks. Kekewich, J., required the applicants to make a statement in writing of the grounds upon which they sought to have the marks removed, and upon it formulated six questions relative to the use of the marks by the respondents,

[1] Ord. 38, r. 1.
[2] Ords. 33 and 36.
[3] *Thewlis and Blakey's Tm.*, 10 R. P. C. p. 373 (1893), North, J.
[4] Ord. 31, r. 12; see *Re Norwich Town Close Estate Charity*, 40 C. D. 310 (1889).
[5] [1892] 3 Ch. 201; 9 R. P. C. 346.

and ordered that a member of the respondents' firm should make discovery of the documents relating to the several questions, not disclosing all the documents, but only specimens representative of each class of them. The Court of Appeal held that this order, carefully limited as it was, was oppressive at the then stage of the proceedings, and upon the respondents undertaking to deliver to the applicants a statement of the labels on which they intended to rely, and to have the relevant documents in Court at the hearing, and not to object to produce them, the Court set aside the order, without prejudice to any order the judge at the trial might think fit to make as to discovery of documents.

Written statement by Registrar.

A statement in writing made by the Registrar under sec. 47 may form part of the evidence in the proceeding.[1]

Particulars.

Besides the particulars of objections referred to above, further particulars which are necessary to make the applicant's case clear are sometimes ordered. If the case set up is that the mark objected to is deceptive, and it is alleged that it has in fact deceived certain persons, particulars as to the persons deceived may be ordered to be given.[2] In a case in which common use in the trade was alleged, particulars of three instances of such user and certain other particulars were ordered.[3]

Order to be served on the Registrar.

An office copy of any order to rectify must be left forthwith at the Trade Marks Branch of the Patent Office together with Form TM No. 30, and the Register is to be thereupon rectified accordingly. The person to leave the order is the person in whose favour the order has been made, or such one of them, if more than one, as the Registrar shall direct.[4] The Registrar may, if he thinks that the order should be made public, publish it in the Trade Marks Journal.[5]

Certificate.

It is provided by sec. 46 :—

Certificate of validity.

"In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided

[1] See above, p. 305.

[2] *Humphries* v. *The Taylor Drug Co.*, 39 C. D. 693 ; 5 R. P. C. 687 (1888), Kekewich, J., an action for infringement. See also *Whitstable Oyster Co.* v. *Hayling Fisheries, Ltd.*, 17 R. P. C. 461 ; 18 R. P. C. 434 (1901), Buckley, J., and C. A., a passing-off case.

[3] *Aquascutum, Ltd.* v. *Moore and Scantlebury*, 20 R. P. C. 640 (1903), Kekewich, J. See also the particulars of common use ordered in *Schweppes, Ltd.* v. *Gibbens*, 22 R. P. C. 113, at p. 116, a passing-off case, and the cases cited below, p. 470.

[4] Sec. 35 (4) and Rule 129. For Form TM No. 30, see Appendix, p. 696.

[5] Rule 130.

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."

This section corresponds to sec. 77A of the Act of 1883, introduced into that Act by sec. 18 of the Act of 1888.[1] 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 some cases in which an action for infringement and a motion to rectify were heard together and on the same evidence, the Court gave the certificate.[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 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.[3]

The giving of the certificate of validity is a matter of discretion,[4] as is also the refusal of solicitor and client costs in the subsequent proceeding.[5] 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

[1] Appendix, p. 633.

[2] *Field, Ltd.* v. *Wagel Syndicate, Ltd.*, [1900] 1 Ch. 651; 17 R. P. C. 266, Buckley, J.; *Burroughs, Wellcome & Co.* v. *Thompson and Capper*, 21 R. P. C. 69 (1904), Byrne, J. See also *De Kuyper* v. *W. & G. Baird, Ltd.*, 20 R. P. C. 581 (1903). Porter, M.R., Ireland.

[3] 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. at p. 173; *Edison Bell Consolidated Phonograph Co., Ltd.* v. *Waterfield Clifford & Co.*, 19 R. P. C. 329 (1902).

[4] *Bourne's Tm.*, [1903] 1 Ch. 211: 20 R. P. C. 105, Farwell, J.

[5] See the cases referred to in note (3).

at the trial.[1] But where, on the hearing of an action for infringement and a motion to rectify, the defendant abandoned the motion as to one mark, a certificate as to that mark was refused under the circumstances of the case, it appearing that there was a fair question which might be raised at a future time as to some of the goods for which the trade mark was registered.[2]

"Subsequent legal proceeding" means one commenced after the date of the certificate of validity.[3] 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.[4]

Certificates have already been given under sec. 46 in some cases.[5]

Costs.[6]

The ordinary rule that the unsuccessful party must pay the costs of the proceedings is rarely departed from,[7] and these costs include the Registrar's costs, if he think fit to appear. His costs are in the discretion of the Court, but he cannot be ordered to pay costs.[8]

The Court has, however, a discretion whether to give costs or not, and, in the exercise of this discretion, Kekewich, J., refused to give costs to a successful applicant who, could not have been interfered with in the slightest degree in his business had he allowed the mark to remain unaltered;[9] and costs were

[1] *E.g.*, in *J. B. Brooks & Co., Ltd.* v. *E. Lycett, Ltd.*, 20 R. P. C. 390 (1903).

[2] *Bourne* v. *Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105.

[3] *Automatic Weighing Machine Co.* v. *International Hygienic Society*, 6 R. P. C. 175 (1889).

[4] *Haslam* v. *Hall*, 5 R. P. C. 144 (1888), C. A.

[5] *Board & Son* v. *Thom and Cameron, Ltd.*, 24 R. P. C. at p. 722; *Major Bros.* v. *Franklin*, 25 R. P. C. 406 (1908), Jelf, J.

[6] See also Chap. IV., at p. 99, and Chap. XV., at p. 458.

[7] *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878); *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878), both Jessel, M.R.; and where the mark is expunged costs may be given not only against the registered proprietor, but against another person who has claimed to be interested in the mark and brought proceedings in consequence: *Davis' Tms.*, 14 R. P. C. 903 (1897), North, J. (*Compactum*). The general rule as to costs applies to applications to limit a registration as regards the goods; see, for instance, *Hare's Tm.*, 24 R. P. C. 263 (1907), Swinfen Eady, J. As to whether an order for rectification is a "final judgment" within sec. 4, sub-sec. 1 (8) of the Bankruptcy Act, 1883, cf. *Re Owen*, Sol. J., Vol. 45, p. 103, Dec. 8, 1900.

[8] Sec. 48, see p. 615.

[9] *Humphries* v. *Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); see also *Perry Davis' Tm.*, 5 R. P. C. 337; 58 L. T. 695 (1888), Kay, J.

refused to applicants who had asked by their notice of motion not only for the expunging of the proprietor's name, but also for the entry of their own names on the Register, and they were ordered to pay the Comptroller's costs;[1] and, in a case where the defendant in an action for passing off his goods as those of the plaintiff successfully applied to expunge the plaintiff's registered mark, North, J., reserved the costs of the application till after the hearing of the action.[2] And where in a similar case the plaintiff obtained an injunction against the defendant, on the ground of the fraudulent passing off of the latter's goods as his, and the defendant's motion to rectify failed, and was dismissed with costs at the trial, but, when urged on other grounds, succeeded in the Court of Appeal, no costs of the appeal on that point were given, because the objection was not urged in the Court below, and the rest of the appeal was dismissed with costs.[3]

In *Hill's Trade Mark* the application to rectify was proceeded with at the applicant's instance, without waiting for the further investigation of charges of improper trading brought against him by the respondent, upon his undertaking not to ask for costs in any event.[4]

In *Talbot's Trade Mark*,[5] where the application to rectify succeeded, no costs were given, because the applicant failed in regard to one of the grounds relied on, and he had delayed to move for three years.

In a case in which an action for infringement and a motion to rectify were heard together, it was held that there was jurisdiction to deal with the costs of both together and divide the whole of them fractionally.[6]

Where the respondents did not appear, and the notice of motion did not ask for costs, but in a letter prior to the motion the applicants had warned the respondents that they

[1] *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J. The Comptroller is in the Act of 1905 referred to as the Registrar, sec. 4.

[2] *Gianacli's Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889); and in *Thompson* v. *Miller*, 13 R. P. C. 35 (1896), Stirling, J., whilst giving the costs of the motion to the defendant in the action, added a direction that such costs were not to include the costs of the affidavits used, except so far as should be directed at the trial.

[3] *Thompson* v. *Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889), Chitty, J., and C. A. (*Stone Ale*).

[4] 10 R. P. C. 113 (1893), Chitty, J.

[5] W. N. (1894), 12; 11 R. P. C. 77, Stirling, J. (*Emolliorum*).

[6] *Bourne* v. *Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, following *In re Pollard* (1902), W. N. 49, Kekewich, J.

would ask for costs, the respondents were ordered to pay the costs.[1]

Although Appendix N of the Rules of the Supreme Court does not provide for a fee for instructions on brief on an originating motion, the same can be allowed.[2]

As regards security for costs where the respondent is resident abroad, see above, p. 307.

Appeal.

An order made on an application under sec. 35 is a final order, and an appeal to the Court of Appeal against it must consequently be heard by not less than three judges,[3] except under the Supreme Court of Judicature Act, 1899,[4] by which the consent of all parties is requisite. The appeal must be brought within fourteen days, and must be by a fourteen days' notice of motion.[5]

Stay of execution.

The Court may stay execution of its order to rectify pending an appeal, and it will generally do so,[6] but the appeal itself does not act as a stay.[7] In *Re Palmer's Application*[8] the Court of Appeal, having reversed the decision of the judge of first instance on a preliminary objection, refused to stay the proceedings before the judge on the merits pending an appeal to the House of Lords against their decision, and in *Neostyle Manufacturing Co.'s Trade Mark*[9] the Court of Appeal refused to stay their order expunging the mark pending an appeal, to the House of Lords.

[1] *North Shore Mill Co., Ltd.'s Tms.*, 22 R. P. C. 599 (1905).

[2] *Burroughs, Wellcome & Co.'s Tms.*, 22 R. P. C. 164 (1905), Warrington, J. This was under Ord. 65, r. 27 (29). In the same case the costs of three counsel at the trial and in the Court of Appeal were allowed, see below, p. 467.

[3] *Riviere's Tm.*, 26 C. D. 48 (1884), C. A.; Judicature Act, 1875, s. 12; see the notes to Ord. 58, rr. 3 and 15, in the Annual Practice.

[4] 62 Vict. c. 6. As to the necessary consents, &c., see *Re Hope*, 43 Sol. J. 649; W. N. (1899), 113.

[5] Ord. 58, rr. 3, 9 and 15; see *Re Blyth and Young*, 13 C. D. 416 (1879); and *Onslow* v. *The Commissioners of the Inland Revenue*, 25 Q. B. D. 465 (1890); and cf. *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A., where it was held that an appeal on an application to proceed must be brought within twenty-one days (now changed to fourteen days, Orders of 1893).

[6] *Harrison* v. *Woodroffe*, 7 R. P. C. 25; 42 C. D. 691 (1889), Kekewich, J.; see also *In re Tm. Borril*, 13 R. P. C. 387; 74 L. T. 805 (1896), where Kekewich, J., said that if he had decided that the mark ought to be removed he should have stayed execution. In *Hommel* v. *Bauer & Co.*, 21 R. P. C. 576 (1904), Warrington, J., a stay was refused.

[7] Ord. 58, r. 16.

[8] 22 C. D. 88 (1882).

[9] 20 R. P. C. 803 (1903). Cf. *Re Bayer's Design*, 24 R. P. C. 65 (1907), where a stay was ordered on terms. It appears from the report of *The Neostyle* case that there is no established practice at the office not to act, pending an appeal, on an order to remove a trade mark from the Register.

Security for costs of the appeal may be ordered under special circumstances.[1]

2. Correction and Cancellation of Entries at the Proprietor's Request.

By sec. 32—

Correction of Register.

"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."

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 related to alterations of entries in the Register,[2] namely (b) and (c), so far as relates to trade marks, but it is much wider. The sub-sections referred to enabled the Comptroller to (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.

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. 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

[1] Ord. 58, r. 15. Security was ordered *In re Tm. Borril*, 13 R. P. C. p. 387. As to such security in the case of foreigners, see supra, p. 307.

[2] Appendix, p. 638. 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.

[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 enter the new name on the Register, and, if he refused, the Court could make the alteration.

sec. 33, 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 a 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]

Where the registered proprietor is desirous of cancelling the mark only with a view to another registration, as, for instance, a registration on dissolution of partnership, the existing registration being an obstacle to the intended registration, it is doubtful whether he could make an application under sub-sec. (3) for the cancellation conditionally on the other registration being effected; but in the course of the proceedings for registration of the new mark the result might perhaps be arrived at, assuming no other objection to be taken by the Registrar, by an acceptance of the mark conditional on the proper application for cancellation being made.[5]

Procedure.

The rules in regard to matters under this section are Rules 82 and 90 to 92.[6] An application for a disclaimer or memorandum

[1] Sec. 35, above, p. 278.
[2] Sec. 37, above, p. 293.
[3] Sec. 15, above, p. 212.
[4] Sec. 12 and sec. 14, above, pp. 66 and 85.
[5] The matter was considered in *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, where the Comptroller refused to accept an undertaking to cancel the existing marks. See now sec. 12 (2).
[6] Appendix, pp. 666, 667. Forms, on change of address, TM No. 20; for correction of clerical error, TM No. 22; on change of name, TM No. 23; for cancellation of entry, TM No. 24; on application to strike out goods, TM No. 25; on request to enter disclaimer, &c., TM No. 26; pp. 688 *et seq.*; fee in each case, 5*s*.

is to be advertised in order to enable any person desiring so to do to state in writing any reasons against the applicant being allowed to make such disclaimer or memorandum.[1] An application may be made under the section by the trustee in bankruptcy or liquidator (as the case may be) of the registered proprietor;[2] but applications on changes of proprietorship come under sec. 33. If a mark is removed from the Register, a record is to be entered of such removal and of the cause of it.[3]

Appeal. There is a right of appeal to the Board of Trade,[4] but there is no right of appeal to the Court,[5] although the Board may refer the appeal to the Court under sec. 59.

3. Alteration of a Registered Trade Mark.

Sec. 34. **Sec. 34** provides that—

> "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."

This section relates to alterations in the mark itself, and does not extend to alterations in the Register,[6] to which matter sec. 32 relates.

Act of 1883. The corresponding section of the Act of 1883 was sec. 92, from which two important changes have been made.[7] In the first place, under that section the Court alone had power to make an alteration in a registered trade mark, whereas under the Act of 1905 the Registrar has jurisdiction, and the Board of Trade on appeal from him. The Court has no jurisdiction, under sec. 34, except where an appeal to the Board of Trade is referred to the Court.[8] But it has on an application under sec. 35 power to vary the entry on the Register to which the application relates.[9]

[1] Rule 92.
[2] Rule 90.
[3] Rule 74.
[4] See p. 314.
[5] Sec. 54.
[6] *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 521; 13 R. P. C. 475, North, J., under the Act of 1883. See also *National Wholesale Tea Supply Association*, 10 R. P. C. 164 (1893), Chitty, J.; and *Patent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.
[7] See the section below, p. 638.
[8] Sec. 59, below, p. 618.
[9] Above, p. 286.

Secondly, a much wider power of altering a registered trade mark is conferred on the Registrar than was given to the Court under the old section, which excepted essential particulars from the part of a trade mark which might be varied.[1]

Section 34 allows alterations in the trade mark itself, notwithstanding that the change of an essential particular is involved. But the addition or alteration must not substantially affect the identity of the trade mark. It is probable that, except to meet changes of circumstances, *e.g.*, change of a name or address, the addition of the word "limited" on the incorporation of a firm, and so forth, leave will only be granted to alter essential particulars in very special cases.

Old marks.

Under the repealed Acts it was more difficult to obtain the alteration of a trade mark registered as an "old mark," *i.e.*, as used before August 13th, 1875, than of a new mark; and this may still be the case. The policy of the Acts has always been that old marks should be registered and kept registered substantially as they were used before the date mentioned.[2] In the absence of special circumstances therefore no alteration at all should be permitted.[3] The power to allow alterations is, however, in both cases subject to precisely the same limitation, which is also embodied in sec. 9.[4] That section allows 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 sec. 34.[5]

The more restricted operation of sec. 92 of the Act of 1883 in regard to old marks was partly due to the fact that old marks registered under sec. 64 (3) (ii.) of the Act, like old marks registered under sec. 9 of the Act of 1905, had no "essential particulars" necessarily, but were registered, if distinctive, as a whole, so that in regard to them "essential" in sec. 92 had to be read as equivalent to "substantial"[6] or "material."

[1] Essential particulars, sec. 9, above, p. 134. See *Hammond and Stow's Tm.*, 22 R. P. C. 299 (1905), where the Comptroller objected to the addition of "Limited" to a signature, which was an essential particular, and no such alteration was made. Cf. *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888) (an old mark) and *Hayward & Sons Tms.*, 13 R. P. C. 729 (1896).

[2] *Phillips' Tms.*, [1891] 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Adams' Tms.*, 9 R. P. C. 174; 66 L. T. 610 (1892), Kekewich, J.

[3] *Re Henry Clay*, [1892] 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

[4] Above, p. 129.

[5] Cf. sec. 26 (c) and sec. 27.

[6] *Adams' Tms.*, 9 R. P. C. 174; 66 L. T. 610 (1892), Kekewich, J.; cf. per Ld. Cairns in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. p. 484 (1879).

The following are instances of alterations in old marks allowed or disallowed by the Court under the Act of 1888. The Court has authorised the addition of the word *limited* to an old mark where the proprietors had assigned their rights to a company bearing their old firm name with that addition;[1] and has permitted the name of certain works abandoned by the proprietors to be struck out, and the name of other works retained by them to be printed in a different position in the registered mark;[2] and has allowed the addition of *and Son* to a name, and the substitution of new addresses for former ones;[3] and the alteration of a firm name;[4] and in *Orlando Jones & Co.'s Trade Marks*,[5] it allowed certain words to be added to two marks registered as old marks. Minor alterations have also been permitted.[6] But the Court has refused to expunge *trade mark* so printed upon a label as to suggest that part only of the matter of the label was the trade mark,[7] in a case where the mark had stood for twelve years on the Register;[8] or to strike out *patent* printed as part of the name of the goods upon a label, there being in fact no letters patent;[9] or to substitute the name of one former proprietor of a mark for that of another in the mark.[10] And in a mark consisting

"Trade mark."

"Patent."

[1] *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.

[2] *Burham Brick, &c. Co.'s Tm.*, 9 R. P. C. 422 (1892), Stirling, J.

[3] *Brown's Tms.*, 11 R. P. C. 365; 71 L. T. 156 (1894), Stirling, J. The Comptroller objected to mere striking out, so as to leave blank spaces. Also *Cockle's Tm.*, 20 R. P. C. 353 (1903), Farwell, J. In this case the order was, at the instance of the Comptroller, made in the form of allowing alterations as shown on an exhibited label, and on an undertaking to supply the Comptroller with a block of the mark as altered; see Rule 94, below, p. 667. This form of order was followed in *Davenport's Tm.*, 21 R. P. C. 726 (1904), Joyce, J.; Appendix, p. 740.

[4] *Maw, Son and Thompson's Tm.*, 19 R. P. C. 260 (1902), Buckley, J.

[5] 12 R. P. C. 278 (1895), Stirling, J. The words added were: "This label is issued only by *Orlando Jones & Co., Ltd.*" There appears to have been no opposition by the Comptroller. Presumably the marks had been used with these words, but *query* as to this.

[6] *E.g.*, in *Davenport's Tm.*, above, note (3).

[7] See Chap. X., at p. 271.

[8] *Phillips' Tm.*, supra. This alteration was allowed in the case of a new mark in *Colman's Tms.*, [1891] 2 Ch. 402; 8 R. P. C. 209, by Kekewich, J., the proprietors of the mark undertaking to register a statement of the essential particulars of their marks and to disclaim the remainder of them. A similar condition for certain alterations in a new mark was made in *Orlando Jones' Tms.*, 12 R. P. C. 278 (1895), Stirling, J. Such statements are not now required in applications to register, as they were under the Act of 1888.

[9] *Adams' Tm.*, supra, note (6), p. 317. It appears from the report of *Hubbuck* v. *Brown*, 17 R. P. C. 148 (1899), Kekewich, J., that in 1879 an order had been made for rectification of an old trade mark appearing in the report by entry of a disclaimer of the exclusive right to the words *White Zinc* and *Patent*, and the Royal Arms.

[10] *Re Henry Clay*, p. 317, note (3).

partly of Russian characters, alterations in the words on the mark, which were held to be alterations so material as to possibly prevent persons in England recognising it, were refused.[1]

Alterations allowed in new marks.

In a case in which the registration of a new mark was objected to on the ground of its resemblance to a registered trade mark, the judge, in deciding against the mark applied for, referred to the possibility of alteration in non-essential particulars.[2]

None allowed to the prejudice of other persons.

No alteration to the prejudice of other registered proprietors, or such as to cause the altered entry to infringe the restrictions of the Acts, can be allowed. Thus, in *Reiss' Trade Mark*,[3] the applicants, having a registered combination device trade mark bearing the words *Grass Bleach*, *Best Quality*, and having ceased to use the method of grass bleaching, desired to substitute for *Grass* their own trade name, *Reiss*. The Comptroller required[4] them to inform the Court that there were certain other trade marks containing the name *Reiss*, and North, J., refused to grant the application until he was satisfied that the altered mark would bear no resemblance to any of the marks referred to.

Instances of alterations.

Amongst the alterations allowed in reported cases under the repealed Acts are the addition of *limited* to a name;[5] the correction of an English letter printed by mistake for a Russian letter;[6] the omission of certain words;[7] the alteration of the name of the proprietor's works;[8] the substitution of the initials of the new name of a limited company for those of its former name;[9] the substitution of certain words so as to change the old name of a limited company to its new name, such name not being printed in a particular or distinctive manner.[10] An application to omit

[1] *Savin's Tm.*, 13 R. P. C. 21 (1896), North, J.

[2] *Murphy's Tm.*, 7 R. P. C. 163 (1890), Stirling, J.

[3] 5 R. P. C. 291 (1888), North, J.

[4] He consented not to appear on their undertaking to read his letters in the matter to the Court.

[5] *Bryant and May's Tm.*, 4 T. L. R. 675 (1887), Stirling, J.; *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.; *Burke's Tms.*, W. N. (1891) 2, North, J.; *Hayward & Sons' Tms.*, 13 R. P. C. 729 (1896), Stirling, J., but *Ltd.* was refused. *Holbrook's Tms.*, 18 R. P. C. 447 (1901), Cozens-Hardy, J. See also *Hammond and Stow's Tm.*, 22 R. P. C. 299 (1905), Farwell, J.

[6] *Ermon and Roby's Tm.*, 4 R. P. C. 70; 56 L. J. 177 (1886), Chitty, J.

[7] *Burke's Tm.*, supra, note (5).

[8] *Burham Brick, &c. Co.'s Tm.*, 9 R. P. C. 422 (1892), Stirling, J.

[9] *National Wholesale Tea Supply Association, Ltd.'s Tms.*, 10 R. P. C. 164 (1893), Chitty, J.

[10] *Stock-Owners' Meat Co. of New South Wales, Ltd.'s Tms.*, 14 R. P. C. 733 (1897), Romer, J. The company under its new name appears to have been registered as proprietor. See the practice laid down in *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475; and supra, p. 314. For other orders, see Sebastian, 4th ed., pp. 380 *et seq.*

two oval lines from a trade mark was, in one case, refused, the Comptroller contending that the mark was a combination mark,[1] and the addition of the words "superior quality," which were alleged to have been omitted on registration by the applicant's mistake, was refused, except on certain conditions as to disclaimer,[2] the mark having been registered for eighteen years.

When a limited company, which is the registered proprietor of a trade mark, changes its name, it should apply to the Registrar, under sec. 32, to make the necessary alteration in the Register, and should not, where no alteration in the mark itself is desired, apply to the Registrar under sec. 34.[3]

If a proprietor wishes to continue the registration and use of the unaltered mark he can apply to register the altered mark as an associated trade mark.[4]

Procedure.

The procedure under sec. 34 is regulated by Rules 93 and 94.[5] The application for alteration must be made on Form TM No. 27,[6] and the applicant must furnish the Registrar with six copies of the mark as it will be when altered. The Registrar may also require the applicant to furnish a block for the purpose of advertisements, and may advertise the fact of the application having been made. No procedure as to opposition is, however, provided by the section or rules. The only course therefore for a person thinking himself aggrieved by a proposed alteration is to submit his reasons to the Registrar,[7] or, if the alteration is allowed, to apply to the Court under sec. 35 for rectification. Advertisement of the trade mark after leave has been given is required by the section and provided for in Rule 94. The Registrar may refuse the application or may grant leave to alter the trade mark on such terms as he may think fit.

Appeal.

The only appeal against a refusal by the Registrar to allow the alteration or against conditions imposed by him is to the Board of Trade, but the latter can, under sec. 59,[8] refer the appeal to the Court.

[1] *Orlando Jones & Co.'s Tms.*, 12 R. P. C. 278 (1895), Stirling, J.

[2] See supra, p. 318, note (8).

[3] *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J.; decided under the Act of 1888, and see supra, p. 314.

[4] Sec. 24, above, p. 108.

[5] Appendix, p. 667.

[6] Appendix, p. 690. Fee £1 for first mark, 10s. for every other mark if the addition or alteration is the same in each case.

[7] Cf. Rule 92.

[8] Below, p. 618, and see sec. 54.

CHAPTER XII.

EFFECT OF REGISTRATION.

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Object of the Acts.

The general object of the Registration Acts was not to create new rights, but to regulate the use of, and the means of protecting, trade marks.[1] Their main effects, however, have been (1) to provide a new way in which title to a trade mark may be acquired, namely, by registration; (2) to simplify infringement actions, by making registration evidence, and, under certain circumstances, conclusive proof of title; and (3) to constitute registration, in general, a condition precedent to an action for infringement. The first of these changes was a substantive alteration of the old law.

The Acts have also defined and limited the classes of symbols which can be registered as trade marks,[2] and thereby, as a consequence of the third alteration just referred to, have restricted the number of marks in which trade mark rights can, as such, be effectively protected.[3]

1. Title to New Trade Marks conferred by Registration.

Title to new mark.

Registration, if properly made in accordance with the Acts,[4] confers upon the registered proprietor trade mark rights in the registered mark in respect of the goods for which it is registered and upon which it is used, subject (1) to the rights appearing from the Register to be vested in any other person;[5] (2) to rights conferred by concurrent registrations;[6] (3) to the rights of persons who have used their marks before the user of the registered trade marks;[7] (4) until the expiration of the period mentioned in sec. 41, to the conflicting rights of any other person in the same mark.[7] And the rights so acquired date back to the date of the application to register.

Trade mark acquired by user before registration.

As registration gives an independent title, the owner of trade mark rights acquired by user, when he has registered his mark, will only need to avail himself of his earlier title if the propriety of the registration is questioned, or if, within the period mentioned in sec. 41, conflicting rights to the marks are set up.

Before the Acts (except in the case of Sheffield cutlers' marks) user of the mark was the only way in which trade mark rights in it could be acquired.[8]

[1] *Lyndon's Tm.*, 32 C. D. p. 117; 3 R. P. C. 102 (1886), per Cotton, L.J.

[2] Chap. VIII., p. 127.

[3] As to this, see below, p. 339.

[4] Chap. VIII., p. 127.

[5] Sec. 38; Act of 1883, sec. 87: see *Mitchell's Tm.*, 28 C. D. 666 (1885), Chitty, J., and p. 325.

[6] Proviso to sec. 39; see also sec. 21, above, p. 264.

[7] Proviso contained in sec. 41.

[8] Chap. II., p. 22.

New and unused trade marks may be registered.

A serious question arose on the construction of the original Act, of 1875, as to whether new marks which had never been used could be registered under it;[1] but the view expressed above, that the Act created a new mode of acquiring trade mark rights, which had been acted upon from the first, was finally affirmed in *Hudson's Trade Marks*.[2] "In my opinion," Cotton, L.J., said in that case, "the language (of the Act), though not appropriate, means this, that a man who designs one of those special things pointed out in sec. 10[3] is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled, within the meaning of the Act, to the exclusive use of that which, in fact, has never been in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it, as that his user would be interfered with by the registration."[4]

Act of 1875.

Hudson's case.

Acts of 1883 and 1888.

The point decided in *Hudson's* case was provided for in the Act of 1883[5] by sec. 75, which enacted that—

> "[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 1st of January, 1876, to have been the date of registration]."

The words included in the brackets were added by the Act of 1888[6] upon the recommendation of Lord Herschell's Committee.[7] The alteration was merely directed to give legislative authority to the rule already in force.

Any other construction of the Acts would have led to very strange results, for no length of user was required to be shown in the actions or suits for infringement before the Acts.[8]

Applicant for registration must intend to use the mark.

But it was held under the Acts of 1883 and 1888, that although actual use of the mark was not a condition precedent to

[1] See *Edwards* v. *Dennis*, 30 C. D. 454 (1885); *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), both C. A.

[2] 32 C. D. 311; 3 R. P. C. 155 (1886), C. A. The application was made, and the case was decided, under the Act of 1875.

[3] *I.c.*, of the Act of 1875.

[4] See per Chitty, J., in *Barlow* v. *Johnson*, 7 R. P. C. at p. 404 (1890).

[5] The case was decided, however, in 1886, after the passing of the Act of 1883.

[6] Sec. 17.

[7] Report of 1888, p. 13.

[8] See Chap. II., at p. 35.

registration, the applicants must intend to use it for the goods for which it is to be registered, and that if he registered without such an intention the mark ought to be removed from the Register. Thus, where two marks had been registered for goods in class 42 for many years, but, on an application to remove them, Romer, J., found that there had been no real user before registration, and that there had been no real user in respect of such goods since registration, and that at the date of the registration there was no *bonâ fide* intention on the part of the applicants to so use the marks, he ordered the marks to be removed, and the decision was upheld by the Court of Appeal and the House of Lords.[1] Lindley, M.R., who delivered the judgment of the Court of Appeal, said: "Although sec. 75 of the Act of 1883 said that 'registration of a trade mark shall be equivalent to public use of the trade mark,' this language, even when in force, did not and could not mean that continued registration was equivalent to continued use. So to construe the language would lead to the irrational conclusion that a man might properly register a trade mark for any goods he chose, although he carried on no trade or business in them at all. . . . Section 75 was addressed to the time of registration; it substituted registration for previous user and reputation gained by it." And it was pointed out that the alteration of the section by the Act of 1888 made the matter still plainer. The subject of non-user is now dealt with in sec. 37 of the Act of 1905.[2]

Act of 1905.

The Act of 1905 contains no provision corresponding to the first part of sec. 75, but the definition for the purposes of the Act of a "trade mark" contained in sec. 3 includes a mark "proposed to be used" as well as a mark used, so that it is clear that the acquirement by registration of a trade mark not actually used before registration is authorised; and this is effected in a simpler manner than under sec. 75 of the Act of 1883.

Date of registration.

By sec. 16 of the Act of 1905, a trade mark, when registered, shall be registered as of the date of the application for registration, and such date is to be deemed for the purposes of the Act to be the date of registration. This corresponds to the last part of sec. 75, which, as already stated, was introduced by the Act of

[1] *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. See also *Edwards* v. *Dennis*, 30 C. D. 454 (1885); *Apollinaris Co.'s Tms.*, [1891] 2 Ch. p. 234; 8 R. P. C. 137; and *Hedley's Tms.*, 17 R. P. C. 719 (1900).

[2] Above, p. 293.

1888. Sec. 16, however, only applies to trade marks registered under the Act of 1905. As regards trade marks on the Register existing at the commencement of the Act and incorporated with the new Register, it is expressly provided that such trade marks shall retain their original date.[1]

2. Registration as Evidence of Title.

This subject was dealt with in sec. 76 of the Act of 1883, which provided that the registration of a person as proprietor of a trade mark should be *primâ facie* evidence of his right to the exclusive use of the trade mark, and should, 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 the Act. Act of 1883.

The most important of the provisions of the Act of 1883 referred to were the sections which enabled a second person who had an independent title to an old mark identical with or similar to a mark already registered, to be registered as proprietor of it;[2] the provision of sec. 65 that a trade mark must be registered for particular goods; the provision of sec. 70 for the assignment of registered marks in connection with the goodwill of the business to which they belong; and the provision of sec. 90 for the rectification of the Register. The operation of the last-mentioned section was to diminish very considerably the value of five years' registration as conclusive evidence of title.[3]

The Act of 1905 contains new provisions on the subject, namely, secs. 39, 40 and 41, differing considerably in substance from those of the Act of 1883, and being differently planned. Section 39 deals with the rights of the proprietor of a registered trade mark arising out of registration, if valid, and secs. 40 and 41 with the fact of registration being evidence, *primâ facie* or conclusive, of the validity of the registration.

Section 39 is as follows:

Rights of proprietor of trade mark.

"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

[1] Sec. 6.

[2] Secs. 62, 71, and 72 (1); *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. p. 55 (1887), Stirling, J.; and see *Mouson* v. *Boehm*, 26 C. D. 398, cited below, p. 370, and the "three mark rule," Chap. X., at p. 224.

[3] Above, p. 289.

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 is evidence of title. The phrase now used is that it gives the right "if valid," but by sec. 40 registration is *prima facie* evidence of the validity of the original registration, and by sec. 41, after seven years[1] 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. It would appear, therefore, that the onus of showing that the registered proprietor has no title, even within the seven years, rests upon any person denying it.[2] 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.

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.[3] 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.

Limitations on rights.

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.[4] A trade mark may be

[1] That is, from the date of original registration or from the passing of the Act, whichever shall last happen.

[2] Below, p. 329.

[3] See. 45, below, p. 338.

[4] Below, p. 331.

registered subject to conditions,[1] and in some cases, at all events, to limitations;[2] and, if so registered, the rights conferred are limited in a corresponding manner.

Right limited to goods for which the mark is registered.

Section 39 confines the rights conferred by it to use of the trade mark upon or in connection with the goods in respect of which it is registered. Although the old sec. 76 did not specify what was the extent of the exclusive right conferred, yet it was well settled that registration conferred no rights except in regard to the goods for which the mark was registered, whether that was the whole or only part of a register class,[3] and if the registration was limited by a note entered on the Register to some only of the goods which would be otherwise included under it, the rights conferred were limited also in the same way.[4] There is thus no alteration of the law in this respect. Sec. 39 is limited by the words "if valid"; so far as the trade mark is not protected by sec. 41 from an application for rectification, an application may be made either to remove the trade mark wholly or partially or to limit the entry as regards the goods for which it is registered, or otherwise vary the entry. Among other grounds for rectification is that under sec. 37 of non-user in respect of any of the goods for which the mark is registered. In substance, therefore, the exclusive right under sec. 39 is limited to goods in respect of which the trade mark is not open to attack under sec. 37, but an application to rectify may be necessary.[5]

Registration restricted to goods for which the mark is used.

Edwards v. *Dennis.*

It was held under the repealed Acts that if a mark were actually used for certain descriptions of goods only, although registered for others also, the exclusive rights conferred by sec. 76 did not extend to the latter. Thus, where the plaintiff in an action was the assignee of a mark registered for "unwrought and partly wrought metals used in manufacture," and, in fact, he only used it upon sheet iron goods, his business being confined to such goods, and the defendant was the agent of the proprietors

[1] Sec. 12 (2) and (4), sec. 14 (4) and (6), sec. 21.

[2] Sec. 21.

[3] *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J. The right of opposing an application for registration of another mark extends, however, to the same description of goods, supra, Chap. X., at p. 227.

[4] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J. In this case, besides the ordinary injunction to restrain infringement on the goods for which the mark was registered, the plaintiff obtained an injunction to restrain the defendant from using the plaintiff's trade mark, on other goods, so as to deceive. The head-note is too loosely stated.

[5] Sec. 37 is set out and considered above, p. 293.

of a similar mark subsequently registered for steel and iron wire, and had sold wire with the latter mark upon it, it was held that the plaintiff had no cause of action, and an order was made that the registration of the plaintiff's mark should be rectified by confining it to sheet iron.[1] In the case just cited the plaintiff was assignee of the registered mark, and the decision turned to some extent upon the rule that a registered mark can only be assigned in connection with the goodwill of the business concerned in the goods for which it has been registered,[2] the plaintiff's business being confined, as already stated, to sheet iron goods; but all the judges in the Court of Appeal indicated an opinion that the rights of the original registered proprietor would in any case have been limited by his actual user of the mark.[3] This opinion was subsequently adopted and followed by Chitty, J., in the case of *Hargreaves* v. *Freeman*;[4] and in *Batt & Co.'s Trade Marks*,[5] the Court of Appeal considered that the principle of the decision in *Edwards* v. *Dennis* was that the original proprietor ought not to have registered the mark for goods with which he had no concern, and, applying it to the case before them, they upheld the removal of certain marks from the Register on the ground that there had been no user and no intention to use them.[6]

However, it will probably be held that the right to apply for rectification on the ground of non-user is confined under the Act of 1905 to the cases specified in sec. 37, and the question may arise in an action for infringement whether the defendant can set up by way of defence a non-user which would not afford ground for rectification of the Register. The solution, perhaps, of the question would be found in refusing under the general discretion of the Court an injunction to restrain a use of the mark which could not possibly damage the plaintiff.[7]

Upon or in connection with the goods.

Section 39 confers the exclusive right to the use of the trade mark upon or "in connection with" the goods in respect of which it is registered. "In connection with" may refer to a physical connection, but it is submitted that it means any such use as indicates

[1] *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

[2] Sec. 70 of the Act of 1883. Sec. 22 of the Act of 1905.

[3] And see *Hudson's Tm.*, 32 C. D. at p. 319 (1886), and supra, p. 323.

[4] [1891] 3 Ch. 39; 8 R. P. C. 237.

[5] Cited supra, note (1), p. 324.

[6] The decision was affirmed in the House of Lords. See supra, note (1), p. 324.

[7] See the cases above cited, and particularly *Hargreaves* v. *Freeman*, note (4).

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;[1] but it is doubtful whether there could be a verbal infringement.[1]

The proviso to sec. 39 follows the provision for the concurrent registration of identical, or nearly identical, marks which is contained in secs. 19 to 21, and it is substantially new. Before the Acts and apart from them, each of two persons who were entitled to the same mark could sue an infringer for an injunction,[2] but if the plaintiff claimed on account of profits he was only entitled to the share appropriate to his own interest in the mark.[3] 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.[4]

Section 39 is also to be read in conjunction with sec. 44, which provides that no registration under the 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.[5] Sec. 44.

By sec. 40— Registration to be *primâ facie* evidence of validity.

> "In all legal proceedings relating to a registered trade mark (including applications under sec. 35 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."

This section corresponds to the first part of sec. 76 of the Act of 1883, which provided that the registration of a person as proprietor of a trade mark should be *primâ facie* evidence of his right to the exclusive use of the trade mark; except that now by

[1] In *Kodak, Ltd* v. *London Stereoscopic and Photographic Co., Ltd.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., supplying other goods in answer to a written order for a Kodak film appears to have been held to be an infringement of the trade mark Kodak. See also above, p. 30, and below, p. 397.

[2] *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C., and below, p. 385.

[3] *Dent* v. *Turpin*, supra.

[4] *Weingarten Bros.* v. *Bayer & Co.*, 22 R. P. C. 341 (1905).

[5] Below, p. 400.

sec. 40 registration is made *primâ facie* evidence of its validity, and if the registration be valid, the right to the exclusive use follows by virtue of sec. 39.

The main purpose of sec. 40 is to facilitate the proof of title by a plaintiff suing for an alleged infringement of his mark; in place of the evidence of user and reputation, by which he would have had to show his right to the mark before the Acts, he has only to produce his certificate [1] of registration of his mark, and that will be *primâ facie* evidence of his title.[2]

Registration *primâ facie* valid in application for rectification.

Registration is also *primâ facie* evidence in applications under sec. 35, that is to say, applications to rectify the Register, so that the onus is thrown on an applicant.[3]

Evidence rebutted by the plaintiff's own case.

The evidence afforded by the registration may be rebutted, if the registration is less than for the period named in sec. 41, that is, seven years from original registration or from the passing of the Act,[4] whichever shall last happen. Under the Act of 1883 the period was five years.[5] Thus, in the case just cited,[6] the plaintiffs were not content to rest their title, as in the first instance they might have, merely upon the registration, but they set out in their pleadings the steps by which they alleged that the trade mark in question had been transferred to them, and thereby showed that the original proprietors of the mark, and of the cigar factory and business in connection with which it had been acquired, had purported to assign the trade mark without assigning the good-will of the business. It followed, therefore, that the assignment was a nullity,[7] and, as the registration was less than five years old, the *primâ facie* title conferred by it was consequently rebutted by the evidence furnished by the plaintiffs' own case.

Registration to be conclusive after seven years.

Sec. 41 provides as follows:—

> "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,[4]

[1] Sec. 51, rule 102, Form TM No. 34.

[2] *Pinto* v. *Badman*, 8 R. P. C. 181 (1889), C. A.

[3] Above, p. 289.

[4] August 11th, 1905.

[5] Sec. 76. Thus, in *Leeer* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., held that the words *Self Washer*, although they had been two years on the Register, were not a trade mark. The case nevertheless succeeded on the ground of passing-off. See further the chapter on infringement, p. 387, note (8).

[6] *Pinto* v. *Badman*, supra, note (2).

[7] Sec. 70 of the Act of 1883.

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."

This section replaces the last part of sec. 76 of the Act of 1883, which provided that the registration of a person as proprietor of a trade mark should, 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 that Act.

Changes made by the Act of 1905.

Section 41 effects one of the most important changes made by the Act of 1905. Although the old sec. 76 in terms 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.[1] 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.[2] The presumption of validity does not extend to subsequent assignments entered on the Register,[3] and it is

[1] But a mark which had been long registered had every presumption made in favour of its validity: *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1: 19 R. P. C. 342, C. A. (*Vaseline*); and *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217, C. A.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), decided under the Act of 1875, *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.; *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J., and see the list of trade marks removed or varied after five years' registration given on pp. 310 and 311 of the 2nd Edition of this book. In *Ball's & Co.'s Tms.*, [1899] A. C. 428, cited above, p. 324, the trade marks had been registered more than five years.

[2] Above, p. 330.

[3] Cf. sec. 40, above, p. 329.

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.

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. As the last to expire of the two periods is to be taken, the first part of the section cannot come into operation till August 11th, 1912.

Name of patented goods.

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 when the seven years mentioned in sec. 41 have expired, the original registration of the name can 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. At all events the right of the public to use the name, once it has become merely descriptive, is secured by sec. 44.

The provision that registration is to be conclusive of the validity of the original registration after the expiration of the period named in the section is subject to the following savings or exceptions.

Fraud.

(1) If the original registration was obtained by fraud. In this case the Registrar himself may apply to rectify the Register,[3] at

[1] Above, p. 293.

[2] *Linoleum Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J., and other authorities cited pp. 43 *et seq.* In *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1 ; 19 R. P. C. 342, 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] Sec. 35 (3), above, p. 278.

all events if the fraud was directed against possible objections by the Registrar or otherwise with a view to deceive the office. But the exception is a general one, and the person defrauded is not prevented by sec. 41 from applying for rectification. It might 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 that it is in use by another trader; and although the proviso to the section might protect the other trader from interference, it is submitted that he would be able not merely to claim the benefit of the mark jointly with the registered proprietor, but to object to the registration notwithstanding the lapse of seven years. Another case of fraud which may be suggested is where the agent of a foreign manufacture registers the trade mark of the latter in his own name. The extent which will be given to the exception of fraud can, however, only be learnt from the practical working of the Act.

Marks forbidden by sec. 11 to be registered.

(2) If the trade mark offends against the provisions of sec. 11 of the Act. That section forbids the registration as a trade mark or part of a trade mark of 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. The provisions of sec. 11 have been fully considered in Chapter X.[1], and it will be seen from the decisions there referred to that a wide meaning has been placed on the words "calculated to deceive."

Concurrent registrations

(3) The proviso to sec. 39 saves the rights of persons concurrently registered in respect of the same goods for the same (or substantially the same) trade mark.[2] So that such a person does not need any protection which may also be conferred on him by the more general proviso contained in sec. 41.

Trade marks of anterior date.

(4) If the proviso to sec. 41 applies to a case at all, it extends to the whole Act, not merely to sec. 41. It is new and is a necessary consequence of conferring a conclusive title on the registered owner. 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] The registration of identical, or nearly identical, marks for the

[1] Above, p. 266.
[2] Above, p. 326.
[3] *Jelley's* case, 51 L. J. Ch. 639. n. (1878), Jessel, M.R.; *Monson* v. *Bochm*, 6 C. D. 398 (1884), Chitty, J. See also *Verity's Tm.*, 19 R. P. C. 58 (1902). Buckley, J.

same description of goods under the Act is dealt with in secs. 19, 20 and 21.[1]

The first part of the proviso applies whether the earlier user obtains registration under sec. 21 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.[2] 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." [3]

Matters subsequent to registration.

(5) Matters subsequent to the original registration. These are not strictly excepted from sec. 41, inasmuch as the effect of the first part of sec. 41 does not extend beyond the original registration. Among the matters subsequent to the original registration which may give rise to rectification of the Register are (*a*) wrongful registration of assignments or transmissions, (*b*) non-user of the trade mark for a period giving ground for removal of the trade mark under sec. 37,[4] (*c*) assignment of the trade mark without any goodwill in the whole or part of the goods for which it is registered.[5]

3. Registration as a Condition precedent to an Action for Infringement.

Sec. 42.

It is provided by sec. 42 that:—

"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 August 13th, 1875, and has been refused registration under this Act. The Registrar may, on request, grant a certificate[6] that such registration has been refused."

[1] Above, pp. 222, 223, 264.

[2] Above, p. 293.

[3] Per Chitty, J., in *Mouson* v. *Boehm*, 26 C. D. 398; cf. *Daniel and Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134. As to abandonment, see p. 370.

[4] Above, p. 293.

[5] Sec. 22, Chap. XIII., p. 346.

[6] See p. 337.

A trade mark can still be acquired by use,[1] but, if the trade mark is unregistered, trade mark rights in respect of it cannot be enforced except in the case of an old mark which has been refused registration under this Act.

Trade mark can be acquired by use.

The above section corresponds to sec. 77 of the Act of 1883,[2] which was as follows:—

Act of 1883, s. 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.*"

New marks

In the case of new marks, no substantial change is effected, but the change of language avoids some questions left open by the wording of the old sec. 77, and especially by the words "a trade mark capable of being registered under this Act." These words referred to the trade marks described in sec. 64 of the Act of 1883, and after the passing of the Act of 1888, to those described in sec. 10 of that Act.[3] They correspond to the expression "registrable trade mark" which is defined by sec. 3 of the Act of 1905,[4] and is used in sec. 9.[5] Section 77 of the Act of 1883 did not expressly enact that a new mark, incapable of registration, shall not be the subject of trade mark rights, but the general words of prohibition, as also the savings contained in the section, plainly showed that it was intended to prohibit proceedings to enforce rights in new unregistered marks, and although there was no direct decision as to a new mark incapable of registration, this is the view which has always been taken of the effect of the section as to such a mark.[6] Applica-

[1] *Sea-Sea Co.* v. *Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137, Stirling, J.

[2] The corresponding section of the Act of 1875 was sec. 1, but was amended by the Acts of 1876 and 1877. The Acts of 1875, 1876, and 1877 will be found in the Appendix, p. 646. These provisions were discussed in the 1st and 2nd Editions of this book, but they have no substantial bearing on the present Act.

[3] Printed in the Appendix, p. 626. See secs. 27 and 28 of the Act of 1888.

[4] Above, p. 24.

[5] Above, p. 129.

[6] In *The Normal Co.'s Tm.*, 35 C. D. 235; 3 R. P. C. 269 (1886), Chitty, J., said: "The result (of sec. 77) is that a person, who, I will assume, is entitled to

tions to expunge the plaintiffs' trade marks from the Register on the ground of their being incapable of registration have frequently been made in actions for infringement, and have been treated as effectual defences if successful, unless the plaintiff could make out a case of passing-off[1] by the use of the mark. The Act of 1905 makes the matter quite clear; no action for infringement of an unregistered trade mark can now be maintained, unless it is in respect of an old mark which has been refused registration under the Act of 1905.

Old marks.

The policy of the Acts has been to preserve old trade mark rights substantially without alteration.[2] Section 77 of the Act of 1883 excepted from its operation all old marks of which registration under that Act, or of an enactment repealed by it,[3] had been refused, and a similar saving was introduced into the Act of 1875 by the amending Act of 1876.[4] The new section, however, makes no exception in favour of old marks that have been refused registration under any of the repealed Acts; in order to obtain the benefit of the section there must be a refusal under the Act of 1905. Probably the draftsman had in mind that the Act of 1905 opened the Register to many trade marks formerly incapable of registration. It is provided in sec. 9 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 August 13th, 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[5] shall be registrable as a trade mark under this Act.[6] But, apart from this proviso, registration of trade marks

be, but by some error has not been, put on the Register by the Comptroller or by the Board of Trade, loses his right, because it is useless to have a trade mark which you cannot protect in case of infringement; as to old marks, however, a distinction is drawn. And where there has been a refusal, there is a right to institute proceedings to prevent infringement. . . . So that the validity of the old trade marks does not depend on the (non-)registration." See also Cotton, L.J., as to the policy of the Acts in *Von Duzer's* case, 34 C. D. 634; 4 R. P. C. 31 (1887); and cf. *Apollinaris Co.'s Tms.*, [1891] 2 Ch. at pp. 234 and 235; 8 R. P. C. 137, per Fry, L.J.

[1] See below, p. 338, and Chap. XVI., pp. 477.

[2] Per Ld. Blackburn, *Orr-Ewing* v. *Registrar of Tms.*, 4 App. Ca. p. 498 (1879).

[3] Acts of 1875, 1876 and 1877.

[4] 39 & 40 Vict. c. 33, s. 1, below, p. 650.

[5] Rule 20, p. 658, as to verification of the fact of user.

[6] Above, p. 198.

that have in fact become distinctive in actual use is permitted under sec. 9.[1]

Certificate of refusal.

Lord Herschell's Committee advised that the certificate of refusal should be altered to a certificate that the trade mark is incapable of being registered under the Act, on the ground that the former tends to prejudice the proprietor of the mark, especially in proceedings abroad;[2] but the suggestion was not adopted. The fee payable for the certificate of refusal is £1. The form of application is Form TM No. 31.[3]

It was suggested by Malins, V.-C., in *The Twentsche Stoom Bleekery Goor* v. *Ellinger & Co.*,[4] that the prohibition of sec. 77 does not apply to foreign owners of trade marks; but it is submitted that the suggestion is ill-founded, and that no distinction can be drawn between trade marks owned by subjects and those owned by aliens.[5]

Registration a condition precedent to action;

The section makes registration, in the cases falling within it, a condition precedent[6] to an action for infringement. Where, therefore, the sole consignee of goods for which his consignors had a label registered as a trade mark in France sought to restrain the use of a name which formed a material feature in the label, it was held that the action was in substance an action to restrain an infringement of the label, and, as that might have been registered in England as a trade mark under sec. 103 of the Act of 1883, it fell within the prohibition.[7] An action to restrain the use of a registered mark on goods for which the registration does not avail is also within the prohibition, for it is in effect an action in respect of an unregistered mark.[8]

not to acquisition of a trade mark.

The section does not enact that a man shall not have a trade mark until he registers,[9] and it has been compared[9] to sec. 24 of the Copyright Act, 1842,[10] which is satisfied by a registration

[1] Above, p. 183.

[2] Report of 1888. p. xiii. In many countries a foreigner cannot obtain registration for a trade mark not registered in his own country.

[3] Appendix. p. 696.

[4] 26 W. R. 70 (1877).

[5] See *Goodfellow* v. *Prince*, note (7); and Chap. XV., at p. 332.

[6] Per Ld. Blackburn in *Orr-Ewing* v. *Registrar of Tms.*, 4 App. Ca. 498. 499.

[7] *Goodfellow* v. *Prince*, 35 C. D. 9 (1887). C. A.

[8] *Hargreaves* v. *Freeman*, [1891] 3 Ch 39; 8 R. P. C. 237, Chitty, J.; cf. *Jay* v. *Ladler* and *Hart* v. *Colley*, cited below, p. 341, note (1). That the registration was blocked by delay at the office was considered to be no excuse: *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.

[9] *Sen Sen Co.* v. *Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137; Stirling, J.; and per Chitty, J., in *Barlow* v. *Johnson*. 7 R. P. C. at p. 405 (1890). See also Cotton, L.J., in *Hudson's Tms.*, 32 C. D. at p. 320; 3 R. P. C. at p. 161 (1886).

[10] 5 & 6 Vict. c. 45.

made subsequently to the wrongful act complained of, but before the commencement of the action. If a person has adopted and used words as a trade mark in this country, but has not registered them as a trade mark, it does not necessarily follow that, by describing such words on the goods as his trade mark, he is making a misrepresentation.[1]

Only the registered proprietor or his assignee can sue.

Only the registered owners, or the assignees of the registered owners, of the trade mark can sue in respect of an infringement of it,[2] but it is not necessary that an assignee should have registered the assignment before commencing his action.[3]

The judgment of North, J., in the case last cited seems to go further and to be founded on the view that an unregistered assignee can sue. In *The Magnolia Metal Company* v. *Atlas Metal Company*,[4] however, Collins, J., dismissed the action as to trade mark on the ground that the plaintiffs had not at the date of judgment been registered as proprietors of the marks sued on.[5] *Ihlee* v. *Henshaw*[3] does not seem to have been cited, and the two cases appear to conflict, for sec. 77 of the Act of 1883, like sec. 42 of the Act of 1905, expressly referred to the institution of proceedings, and therefore, if registration of an assignment is necessary at all, it would appear to be necessary before the action is commenced.

The Prohibition does not affect Passing-off Actions.

Section 42 of the Act of 1905 has, and sec. 77 of the Act of 1883 had, no application to actions to restrain a trader passing off his goods, or doing what is calculated to pass off his goods, as the goods of another. This is now expressly provided by sec. 45 of the Act of 1905, which enacts that nothing in the Act 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] *Sen Sen Co.* v. *Britten*, supra, note (9), p. 337, distinguishing and explaining *Lewis* v. *Goodbody*, 67 L. T. N. S. 194. Kekewich, J. See observations of Kekewich, J., on the last-mentioned case, in *Hubbuck* v. *Brown*, 17 R. P. C. at p. 156 (1900).

[2] *Richards* v. *Butcher*, 7 R. P. C. 288; 62 L. T. 687 (1890), Kay, J. Action by sole purchasers from registered proprietors. Leave to add the proprietors.

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

[4] 14 R. P. C. 389 (1897).

[5] It appears from the report of *Magnolia Co.'s Tms.*, 14 R. P. C. at p. 266, however, that the plaintiffs were registered as proprietors on the day before the trial: but it is presumed that this fact was not in evidence in the action.

Two questions arise in trade mark actions and in allied actions: first, is the defendant using a mark which is the same as, or which is a colourable imitation of, the plaintiff's registered trade mark? and secondly, is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff's goods?[1] The two questions are distinct, and the injunctions granted by the Court to meet the wrongs complained of are different in the two cases. Thus, in *Jay* v. *Ladler*,[2] the defendant was restrained "from infringing the plaintiff's said trade mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats (the only goods for which the trade mark was registered), or otherwise using the said trade mark in that connection," and he was also restrained "from using the device of a lady and bear (the trade mark in question), so as to deceive the public," that is, so as to lead the public to believe that the goods of the defendant were the goods of the plaintiff.

Distinction between trade mark and passing-off cases.

The jurisdiction to grant the last-mentioned injunction is part of the general jurisdiction of the Courts to prevent and to give compensation for frauds which cause injury to the person who comes to complain of them,[3] and this jurisdiction, which was well established before the Trade Marks Registration Acts, has not been taken away or altered by anything contained in them.[4]

It is no defence, therefore, to an action for passing off the defendant's goods as those of the plaintiff, that the grant of an injunction would practically confer on the plaintiff trade mark rights in an unregistered trade mark. This is well shown by *The Stone Ales* case. There the plaintiffs had registered the words *Stone Ale* as a trade mark, and they had other registered marks which comprised the same words. An application was

Unregistered trade marks practically protected. *The Stone Ales* case.

[1] *Mitchell* v. *Henry*, 15 C. D. 181 (1880), Thesiger, L.J.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Fry, L.J.; see Chap. I., p. 12, and Chap. XVI., p. 481.

[2] 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J.

[3] See Chap. I., p. 1.

[4] *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Singer, &c. Co.* v. *Loog*, 8 App. Ca. at p. 32 (1882), per Ld. Blackburn; *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.; *Montgomery* v. *Thompson*, [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ale*); *Reddaway* v. *Banham*, [1896] A. C. 199; 13 R. P. C. 218; *Lever Bros., Ltd.* v. *Bedingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A.

made by the defendant to vary the registration of the first-mentioned mark, by adding a disclaimer of the right to the exclusive use of the word *Stone*, and this application Chitty, J., refused. The Court of Appeal, however, ordered the mark *Stone Ale* to be removed from the Register altogether, on the ground that it was not shown to have been used separately as a trade mark before August 13th, 1875, but they, and subsequently the House of Lords, nevertheless maintained the injunction granted by Chitty, J. The injunction [1] restrained the defendant from "carrying on the business of a brewer at Stone, under the title of 'Stone Brewery,' or 'Montgomery's Stone Brewery,' or under any other title, so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling, or causing to be sold, any ale or beer not of the plaintiffs' manufacture, under the term 'Stone Ales,' or 'Stone Ale,' or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture, and from infringing the plaintiffs' registered trade marks, or any of them."

Lord Herschell's judgment.

"The respondents," Lord Herschell said,[2] "are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so because the practical effect of such restraint may be much the same as if persons seeking the injunction had a right of property in the particular name."[3]

In a later case in which it was contended that sec. 77 of the Act of 1883 was a bar to a passing-off action, Vaughan Williams, L.J., said that he read the section as defining the conditions which were necessary if anyone claimed the benefit of the statute, and it was held that the section was no answer to the claim in respect of passing-off.[4]

Passing off by the imitation of an unregistered trade mark.

In *The Stone Ales* case just quoted the deception was practised by the use of the trade name of the plaintiffs' goods upon the

[1] [1891] A. C. p. 218.
[2] [1891] A. C. p. 220.
[3] See also *Birmingham Vinegar Co.* v. *Powell*, [1897] A. C. 710; 14 R. P. C. 720, where the words *Yorkshire Relish* had been expunged from the trade marks Register: and *Reddaway* v. *Banham*, [1896] A. C. 199; 13 R. P. C. 218 (*Camel Hair Belting*). These cases are fully discussed below in Chap. XVI.
[4] *Faulder & Co., Ltd.* v. *Rushton*, 20 R. P. C. 477 (1903), C. A. (*Silverpan Jam*), where a trade mark including the word Silverpan had been expunged from the Register on the ground that that word ought to have been disclaimed.

defendant's goods. The jurisdiction existing, apart from the Acts, extends equally to cases where it is practised by the adoption of the plaintiff's trade mark, or of the "get up" of his goods, and it affords no ground of defence that the trade mark,[1] or an essential part of the get up,[2] might have been, but is not, registered under the Acts.

In *Thorneloe* v. *Hill*,[3] where the plaintiff sued on trade name, Romer, J., expressed the view that, as the name had been used only as a trade mark, the plaintiff could not sue on it, as it had not been registered; but a distinction seems to have been there made between setting up a pure right of property in a name and seeking protection from passing off by means of the name, and the latter ground of action failed for other reasons.

In *Birmingham Vinegar Co.* v. *Powell*,[4] Lord Halsbury, after quoting Lord Justice Turner's words in *Burgess* v. *Burgess*,[5] "that no man can have any right to represent his goods as the goods of another person," stated that that was the only question of law which could arise in such cases; all the rest were questions of fact.

Pinto v. Badman.

In the case of *Pinto* v. *Badman*,[6] the jury found, as a fact, that the defendant had fraudulently sold his cigars as those of the plaintiffs, and also that he had infringed the plaintiffs' trade mark, and Day, J., gave judgment in the plaintiffs' favour. The Court of Appeal reversed the decision and gave judgment for the defendant, on the ground that the trade mark on which the plaintiffs relied had been assigned to them without the goodwill of the business in the goods to which it belonged. The question whether the plaintiffs were not, notwithstanding, entitled to retain their judgment on the ground of the finding of the jury, first stated above, does not seem to have been argued, and the plaintiffs' case appears to have been substantially based upon their assumed trade mark right. The decision, therefore, cannot be regarded as conflicting with the proposition that passing-off cases lie outside the Acts.

The operation of sec. 77 of Act of 1883.

The cases cited above considerably limited the operation of the prohibition contained in sec. 77 of the Act of 1883. Trade

[1] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 9 (1890). North, J.

[2] *Great Tower Street Tea Co.* v. *Langford*, 5 R. P. C. 66 (1887), Stirling, J.

[3] 11 R. P. C. 61 (1894).

[4] See p. 340, note (3).

[5] 3 De G. M. & G. 896 (1853).

[6] 8 R. P. C. 181 (1891), C. A.

mark rights, as was shown in the introductory chapter of this book,[1] grew out of the right of a trader to prevent and to obtain compensation for deceptions practised upon the public, which caused, or were likely to cause, damage to him as an individual; and long after property in a trade mark had been practically recognised by the judgment of Lord Cottenham in *Millington* v. *Fox*,[2] Lord Westbury held that imposition on the public was the test of the property in a trade mark having been invaded or injured, although it was not the ground on which the Court rested its jurisdiction.[3]

The Registration Acts have altered the old law to this extent, that they give the registered proprietor of a mark, so long as he remains registered, the exclusive right to the use of the mark on the goods for which it is registered, so that if it, or an essential part of it, is appropriated by another trader, the proprietor can interfere to restrain the appropriation.[4] But where the complaint is not the appropriation but the colourable imitation of his mark, the test to be applied is still—Is the defendant's mark, by its resemblance to the registered mark, calculated to pass off his goods as the goods of the plaintiff?[4]

The alteration is not, however, of substantial importance, for it was settled law, apart from the Acts, that if a trader has taken a substantial part of the trade mark of another, the onus of showing that he is not using it in a manner calculated to deceive is cast upon him,[5] and this onus he could hardly discharge if the mark had, in fact, become identified by use with the other trader. So that the change is, in effect, no more than the natural consequence of treating registration as equivalent to public use of the registered mark.[6]

Proof of fraud is not necessary to escape the prohibition.

In most of the cases where the Court has interfered to prevent the passing off of the defendant's goods as those of the plaintiff,

[1] Page 1.

[2] 3 My. & Cr. 338 (1838); Chap. I., p. 4.

[3] *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury L.C.; 11 H. L. C. 523; 35 L. J. Ch. 53; and see Ld. Blackburn's judgment in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Ca. at p. 494 (1879).

[4] Secs. 39, 40 and 41 of the Act of 1905; sec. 76 of the Act of 1883; see per Cotton, L.J., in *Mitchell* v. *Henry*, 15 C. D. at p. 193 (1880); in *Edwards* v. *Dennis*, 30 C. D. at p. 471 (1885); and in *Lyndon's Tm.*, 32 C. D. at p. 117 (1886); and Chap. XV., at p. 400.

[5] *Orr-Ewing* v. *Johnston*, 13 C. D. 434, C. A.; 7 App. Ca. 219 (1882). This case was begun in 1877, before sec. 1 of the Act of 1876 came into operation; it was therefore decided under the old law; see 7 App. Ca. p. 228.

[6] Sec. 75 of the Act of 1883, above, p. 323.

the deception has been found to have been deliberately practised; but fraud is not necessary to enable the Court to act;[1] accordingly, the presence of fraud does not constitute a material distinction between cases where actions in respect of the unlawful imitations of trade marks do or do not fall within the prohibition of sec. 42.

Failure to register only deprives the proprietor of the advantages of the Acts.

It can rarely happen, therefore, that the prohibition of sec. 42 will prevent the owner of an unregistered mark, which has, in fact, become known to the public, or to a considerable although indefinite number of purchasers, as indicating that the goods upon which it appears are his goods, from protecting it against infringement, for the adoption of the mark, or of a substantial part, or a colourable imitation of it, can hardly fail to be calculated to pass off the goods of others as those of the owner; but the want of registration will cast upon the plaintiff in any action the necessity of proving that goods bearing the mark are known as his, and that goods bearing the mark complained of are likely, by reason of the resemblance between the marks, to be mistaken for his. And where an injunction is granted to restrain the use of a mark calculated to pass off the defendant's goods as those of the plaintiff, by reason of its resemblance to his unregistered mark, it should be so limited as to leave it open for the defendant to use any part, or the whole, of the plaintiff's unregistered mark, if he can do so, in any manner which is not calculated to lead to deception.[2]

Goodfellow v. *Prince*.

The case of *Goodfellow* v. *Prince*,[3] which is the only reported case[4] in which sec. 77 of the Act of 1883 proved fatal to a plaintiff where he sought relief on the ground of passing off, as well as in respect of an infringement of his trade mark, turned upon the view taken by the Court of Appeal that, as both plaintiff and defendants were importers, not producers, of the goods in question, the mark complained of was not calculated to suggest that the goods sold by the defendant were those of the plaintiff, but only that they were those of the producer from whom he bought.

[1] Chap. I., p. 4, and *Chivers & Sons* v. *S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900, Farwell, J. See Chap. XVI., p. 482.

[2] See the judgments in *Montgomery* v. *Thompson*, [1891] A. C. 217; 8 R. P. C. 351; *Reddaway* v. *Banham*, [1896] A. C. 199; 13 R. P. C. 218; and *Powell* v. *Birmingham Vinegar Co., Ltd.*, 11 R. P. C. at p. 572; 12 R. P. C. at p. 517.

[3] 35 C. D. 9 (1887), C. A.

[4] But see *Thorneloe* v. *Hill*, supra, p. 341.

Unregistered trade marks and the Merchandise Marks Act, 1887.

Failure to register a trade mark, whether it be occasioned by the incapacity of the mark for registration, having regard to the definition clauses, or be due to any other reason, is material on other grounds than those depending upon sec. 42, for the definition of a trade mark contained in the Merchandise Marks Act, 1887, is, as regards Great Britain and Ireland, restricted to trade marks registered under the Act of 1883, or, since the commencement of the Act of 1905, under that Act.[1] An unregistered mark is consequently deprived of the very valuable protection, under the criminal law, constituted by the penalties and punishments provided by the former statute for forging trade marks, falsely applying trade marks to goods, or selling, exposing, or having in possession for sale, or for any purpose of trade or manufacture, any goods or things to which a forged trade mark is applied. The provisions of the statute as to applying a false trade description do, however, extend to unregistered trade marks.[2]

[1] Interpretation Act, 1889, sec. 38, Appendix, p. 654.

[2] Sec. 3 (2); Appendix, p. 805.

CHAPTER XIII.

ASSIGNMENT AND DEVOLUTION OF TRADE MARKS.

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A trade mark is assignable only with the goodwill.

Title to a trade mark cannot be assigned or devolve in gross; but, unless the mark connotes a personal connection between its original owner and the goods in connection with which it is used, it may be assigned and transmitted, together with the goodwill[1] of the business in such goods.

This proposition was fully established before the first Registration Act was passed, and, as regards registered trade marks, it

[1] See the definitions of goodwill contained in *Commissioners of Inland Revenue* v. *Muller & Co.'s Margarine, Ltd.*, [1901] A. C. 217, quoted below, p. 360.

was, in part, embodied in that Act and subsequently in the Act of 1883. It is also contained in sec. 22 of the Act of 1905, which is as follows:—

Sec. 22. Assignment and transmission of trade marks.

"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.[1] 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."

The corresponding provisions of the Acts of 1875 and 1883[2] only differed from the first sentence of the above sections in having the words "in the particular goods or classes of goods" instead of the words "in the goods" simply. A trade mark must be registered for particular goods or classes of goods,[3] and the rights conferred by registration are limited to the goods for which it is registered.

Until it was established that there could be property in a trade mark, there could, of course, be no question of the assignment of trade mark rights,[4] although the successors of the original founders of a business no doubt took over and continued to use the old trade marks employed in it, and were protected when other traders sought to pass off their goods as the goods of the lawful users of the marks.[5] But as soon as trade marks were recognised as the subjects of property, the alienation of them, as of any other property rights, was permitted, subject only to such limitations as were necessary to prevent the use of the marks becoming deceptive.

Transfer by implication with goodwill.

And, conversely, it was held that the sale and transfer of the goodwill of a business assigned the trade marks used in the business to the purchaser and transferee by implication, and without any express grant being needed;[6] but it is a question of

[1] See the next Chapter.

[2] Act of 1875, part of sec. 2; Act of 1883, sec. 70.

[3] See. 8. above. p. 103.

[4] See per Fry, L.J., in *Pinto* v. *Badman*, 8 R. P. C. at p. 194 (1891).

[5] See for instance, *Webster* v. *Webster*, 3 Swan. 490 (1791), Thurlow, L.C.; and *Motley* v. *Downman*, 3 My. & Cr. 1; 6 L. J. Ch. (N. S.) 308 (1837), Cottenham, L.C.

[6] *Shipright* v. *Clements*, 19 W. R. 599 (1871), Malins, V.-C.

intention, to be gathered from the assignment as a whole, whether the trade marks do or do not pass, and an intention not to assign them may appear notwithstanding the use of the word "goodwill" in the assignment.[1]

Hall v. Barrows.

The leading cases on the subject are *Hall* v. *Barrows*[2] and *The Leather Cloth Co.* v. *The American Leather Cloth Co.*[3] They were decided at the same time, in 1863, by Lord Westbury, and his judgment in the latter case was affirmed by the House of Lords; in the first case, the question at issue was whether, in determining the sum to be paid by the surviving partner of a firm who took over the partnership assets at a valuation under the articles of partnership, the value of the trade mark used in the business ought to be taken into account, and the Lord Chancellor, reversing the decision of Romilly, M.R., held that it ought to be so taken, the valuation being made, however, on the footing that the surviving partner was entitled to carry on a similar business and to use the trade mark in it without payment.[4]

Trade mark comprising the name of the original proprietor.

The trade mark consisted of the letters B. B. H. (the initials of the partners composing the original firm), surmounted by a crown, and the Master of the Rolls had held that it could not be sold, because it designated the firm which manufactured the particular goods. "It would," he said, "obviously be a fraud on the public if the Court of Chancery were to attempt to sell to another person the right of holding out to the public that the goods manufactured by him were, in fact, goods manufactured by another and distinct firm." And he distinguished the mark in question from marks indicating the manufacture of a particular factory, which might rightly be transferred with the factory.

Lord Westbury's judgment.

Lord Westbury dissented from the view that the trade mark was a personal mark. "It must be borne in mind," he said, "that a name, although originally the name of the first maker, may in time become a mere trade mark or sign of quality, and cease to denote or be current as indicating that any particular person is the maker." And he held, as a fact, that the connection

[1] *Roger's Tm.*, 12 R. P. C. 149 (1895), Wood, V.-C., Westbury, L.C., and H.L. North, J.

[2] 32 L. J. Ch. 548; 33 L. J. Ch. 204; 4 De G. J. & S. 150, Romilly, M.R., and Westbury, L.C.

[3] 1 H. & M. 271; 32 L. J. Ch. 721; 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53, See also *Bury* v. *Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465 (1863), Romilly, M.R., and L.JJ.

[4] As to this, see also the cases discussed in Chap. XVI., below, pp. 528 *et seq.*

represented by the mark was a connection with the business and the factory at which it was carried on, not a connection with the persons who were the owners of these, and that, accordingly, the trade mark belonged to the partnership as part of its property, and might be sold with the business and works.

The Leather Cloth case.

In *The Leather Cloth* case,[1] the plaintiffs sued the defendants for an alleged infringement of their trade mark, and Lord Westbury, reversing the decision of Wood, V.-C., dismissed the suit on the ground that the trade mark of the plaintiffs contained material misrepresentations. The plaintiffs had purchased the marks from an American company—the Crockett International Leather Cloth Co.,—who were the successors of Crocketts & Co., and the marks contained the names both of the company and of the firm, as well as an American address which was not the address of the plaintiffs. The presence of the names and address amounted, in Lord Westbury's opinion, to a representation that the goods on which the mark was used were the goods of the original firm or of the American company, and the marks, therefore, could not be properly used by the plaintiffs, and consequently could not be validly assigned to them. And this judgment was fully indorsed by the House of Lords, although Lord Cranworth and Lord Kingsdown, on the appeal, based their judgments chiefly on the ground that there was in fact no infringement, and Lord Westbury placed his upon wider grounds than those he had adopted on the appeal from the Vice-Chancellor, namely, that the alleged trade marks were in fact only advertisements and not trade marks at all.

The mark is unassignable if deceptive when used by an assignee.

Lord Kingsdown's judgment in *The Leather Cloth* case.

The following passage from Lord Kingsdown's judgment in the House of Lords[2] shows the principle upon which the assignment of trade marks and trade names, as well as the limitations restricting such assignment, are based: "By the usage of trade, the name of a firm is understood not to be confined to those who first adopted it, but to extend to and include persons who had afterwards been introduced as partners, or persons to whom the original partners have transferred their business. The name of a firm continues to be used in many cases long after all the original traders have died, or have ceased to have any interest in the concern—as in the great banking houses of Child and Coutts, and many other mercantile houses. If a manufacturing company

[1] Note (3) p. 347. The case is further stated at p. 52, above.

[2] 35 L. J. Ch. p. 64; 11 H. L. C. 523.

uses the name of the firm, and stamps the name of its firm upon its goods, though the name of the firm no longer represents the same persons as at first, it is no fraud upon the public for the reasons I have already mentioned. For the same reason, the use of the old trade mark of the firm by the new partners or their successors (if the term 'trade mark' be understood in what I have already said is its proper sense)[1] is no fraud upon the public; it is only a statement that the goods are the goods of the firm whose trade mark they bear." And Lord Cranworth said: "The right to a trade mark may, in general, treating it as property or as an accessory to property, be sold or transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser."[2]

In the case of *Pinto* v. *Badman*,[3] Fry, L.J., stated the rule governing the assignment of a trade mark in concise and definite terms: "It may be assigned," he said, "if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when, in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor." The mark used by the assignee must indicate what it indicated when used by the assignor.

And as the judgments quoted above show, a trade mark is not deceptive in the hands of an assignee of the business of the original proprietor, and consequently unassignable, merely because it comprises the name or initials of the original proprietor, or of any of the former owners of the business.[4] But in special cases, as for instance where the reputation of goods depends on the personal skill of an artist or artizan, the use of his name or mark by a successor might be a misrepresentation, and in such a case the name or mark is not properly assignable.[5] A mark comprising the trader's name is assignable.

So, the right to use a trade mark for a sauce cannot be sold without the business in the sauce, or the secret of its manufacture,[6] or the right to the use of a brand for cigars, without the factory and business of the manufacturer who first acquired

[1] *I.e.*, a symbol or emblem, come by use to be recognised in the trade as the mark of the goods of a particular person (above, pp. 23 and 35).

[2] 35 L. J. Ch. p. 61.

[3] 8 R. P. C. 181 (1891), C. A.

[4] *Hall* v. *Barrows*; *Bury* v. *Bedford*, above, p. 347, notes (1), (2). See also *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

[5] Per Ld. Kingsdown in *Leather Cloth Co.* v. *American Leather Cloth Co.*, ubi supra, and per Romer, J., in *Thorneloe* v. *Hill*, 11 R. P. C. at p. 70 (1894). See also the judgment of Ld. Westbury in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199, as to marks becoming deceptive on assignment.

[6] *Cotton* v. *Gillard*, 44 L. J. Ch. 90 (1874), Jessel, M.R.

it;[1] and where a mark contains a special indication of the locality of the origin of the goods, it could not be properly assigned so as (using Lord Justice Fry's expression) to be divorced from such place of origin.[2]

There must be a business to assign in the United Kingdom.

As already stated, an assignment of a trade mark is inoperative if the assignor has no goodwill to assign.[3] And the goodwill must be that of a business in the United Kingdom.[4] The question whether an assignor has a goodwill of a business in the particular goods to assign may, of course, give rise to difficult questions of fact; but the words of the section as to goodwill are not to be construed narrowly.[5] Thus, where a mark was registered for anti-friction metal bearings, but the registered proprietors, who were an American company, had never sold such bearings in the United Kingdom, but they had imported specimens and also ingots of the anti-friction metal, with the mark on them, for making bearings, such ingots being purchased by an English firm; and the American company had a special agreement with the English firm, under which, as the Court held, the latter were in some respects, and particularly as to trade marks, agents of the company, and the goodwill was to revert on the determination of the agreement to the company; it was held that the company had a business concerned with metal bearings sufficient to support an assignment by them of the trade mark and goodwill.[6]

[1] *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

[2] See judgment of Ld. Westbury referred to in note (5), p. 349 supra, and judgment of Fry, L.J., quoted on p. 349, and *Mason* v. *Queen*, 23 Sc. L. R. 641 (1886).

[3] *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J., is an example of an assignment being held inoperative on this ground. See also *Valentine Extract Co., Ltd.'s Tms.*, 18 R. P. C. 175 (1901). Cf. *Linotype Co., Ltd.'s Application* (No. 2), 17 R. P. C. 380.

[4] So where the goodwill in France was held by the French Courts to have passed to the defendant, it was held by the Court of Appeal in England that this decision could not affect the trade marks and goodwill in England, and the registration of the alleged assignment of the trade marks to the defendant was ordered to be struck out of the Register, *Rey* v. *Lecouturier*, 25 R. P. C. 265 (1908). Cf. *Ullmann* v. *Lenba Frères*, Times, July 21st, 1908, P. C. See also *Magnolia Metal Co.'s Tms.*, below, note (5), where the point is assumed both by Kekewich, J., and C. A. Cf. also *Société Anonyme Panhard et Levassor* v. *Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405 (Farwell, J.), a trade name case, where the plaintiffs were held to have an English market, although having no place of business or agent in England. There appears to be no conflict between these cases and the cases on the Stamp Acts quoted below, p. 360.

[5] Per Rigby, L.J., in *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 621.

[6] *Magnolia Metal Co.'s Tms.*, above, note (5), Lindley, Lopes, and Rigby, L.JJ., reversing Kekewich, J., on this point. See also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600, where Stirling, J., held that there was user of

"The main object," Rigby, L.J., said, "of the restrictions upon assignments imposed by the Act was to prevent confusion or deception by suggesting that the articles to which the mark is applied continue to have some connection or other with the original registered owner."

Sale of trade marks with the goodwill of part of the business.

Trade marks used in a part of a business may be sold with the goodwill of that part only, and if the goodwill sold is restricted to some only of the goods in which the vendor dealt, the purchaser will only obtain the right to use the trade marks assigned to him upon the goods in question, even though they be registered for other goods. Thus a mark was registered for "unwrought and partly wrought metals used in manufacture," and the proprietors assigned it together with their goodwill "in the trade or business of galvanised iron merchants and manufacturers"; but the business, in fact, being entirely confined to sheet iron, the assignee's rights were held to be restricted to that description of goods only.[1]

Transfer of goodwill and trade mark not necessarily contemporaneous.

It is not essential that the assignments of the trade mark and the transfer of the goodwill should be exactly contemporaneous,[2] or even that there should be any legal conveyance of the latter, if the assignee is equitably entitled to it.[3] An assignment to the owner of the business in connection with which the trade mark is used or intended to be used has, consequently, been permitted in some cases where the mark has been registered by mistake or accident in the name of a person other than that owner.[4]

Where a company sold its trade marks and the goodwill of its business, but was dissolved without its making any assignment to the purchaser, the equitable owner was registered as the proprietor of the trade marks.[5]

the word *Bull's-eye* by a foreign importer in connection with cameras in this country, he having imported the cameras in cases which had the word on them, and having sent therewith to the consignee pamphlets containing the word. See above, p. 207, note (1).

[1] *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A. Cf. *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569, Byrne, J. The Register *(semble)* can be rectified, even after seven years, if the trade mark is assigned without goodwill, above, p. 316.

[2] *Wilcox's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.; *Hammond* v. *Meredith, Breaker & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

[3] In *McMillan* v. *Ehrmann Bros., Ltd.*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., a trade name case, a point was raised, but not decided, whether the plaintiffs to whom the business and trade name was only assigned after action brought by a limited company, the real owners, could sue.

[4] See Chap. XI., at p. 301; *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; *Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.; and see note (2).

[5] This appears in the report of *In re Taylor's Agreement Trusts*, 21 R. P. C. 713 at p. 715.

Foreign trade marks and goodwill.

The goodwill[1] 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. Registration under the Act is only operative for the United Kingdom and Isle of Man, and the proviso seems to have been inserted by way of precaution. The divisibility of goodwill is also recognised in sec. 23.

Trade marks on bankruptcy and dissolution of partnership.

Upon the dissolution of a partnership, in the absence of special agreement,[2] the trade marks of the firm are part of its assets, and are saleable as such with the goodwill;[3] but it seems that each of the partners is at liberty to make use of the trade name of the firm, and of its trade marks, provided he can do so and does so in such a way as to avoid deceiving the public, or casting any risk or liability upon his late partners.[4] Similarly, upon the death or bankruptcy[5] of a trader, his trade marks may be sold with the goodwill of his business by his executors or trustees.

Under certain circumstances, where the goodwill of a business becomes divided, as on a dissolution of partnership, an apportionment of trade marks can be effected. Section 23 provides—

Apportionment of marks on dissolution of partnership.

> "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

[1] As to the elements constituting goodwill, see below, p. 360.

[2] For instances of this, see *Bury* v. *Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465; and *Hanson* v. *Game, Harrison and Lacner, Ltd.*, 9 R. P. C. 186 (1892). This topic is fully discussed below, Chap. XVI., p. 528.

[3] *Hall* v. *Barrows*, above, p. 347, note (2).

[4] See the last case, and *Hookham* v. *Pottage*, L. R. 8 Ch. 91 (1872), C. A.; *Thynne* v. *Shove*, 45 C. D. 577 (1890), Stirling, J.; and *Burchell* v. *Wilde*, [1900] 1 Ch. 551, Byrne, J., and C. A. Where a business is conducted at two places and the goodwill at each is sold separately without special stipulations, the purchasers might have concurrent rights to the use of the trade name. In *Townsend* v. *Jarman*, 17 R. P. C. 649 (1900), Farwell, J., it was contended that such was the case, but in the particular case the defendant failed to establish a concurrent right with the plaintiff.

[5] *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301 (1892), Chitty, J.; in *Melrose Drover, Ltd.* v. *Hedlle & Co.*, 4 Fraser 1120 (1902), Ct. of Sess. interdict was granted against the use by the trader of the firm name, trade marks and labels, all of which had been assigned by the trustee in sequestration.

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."

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.

Associated trade marks, however, are only assignable or transmissible as a whole,[2] so that it would appear that an apportionment of them under sec. 23 could not be made.

The only appeal from the Registrar is to the Board of Trade,[3] but the Board of Trade may refer the appeal to the Court.[4]

The procedure under sec. 23 is regulated by Rules 87 to 89.[5] An application must be made on Form TM No. 21,[6] and must be accompanied by a case setting out all the facts fully. The Registrar may call for evidence and is to give the parties an opportunity of being heard, if necessary. Upon an apportionment a note is to be entered in the Register in connection with each of the marks of the fact of apportionment and referring to the date of the Registrar's decision.

Section 38 provides as follows:—

"Subject to the provisions of this Act—

(1) The person for the time being entered in the Register as

Power of registered proprietor to assign.

[1] [1897] 2 Ch. 495; 14 R. P. C. 665.
[2] See. 27, above, p. 110. See. 54, below, p. 617.
[3] See. 59, below, p. 618.
[4] Appendix, p. 666.
[5] Below, p. 688.

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."

No notice of any trust expressed, implied, or constructive is to be entered in the Register, nor is any such notice to be receivable by the Registrar.[1]

This section corresponds to the latter part of sec. 87 of the Act of 1883; the first part of that section relating to registration of assignments is now dealt with in a separate section.[2]

Licences.

The old section, which applied to patents and designs as well as to trade marks, contained a reference 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,[3] and is illegal, because leading to deception, if it is to be used in connection with the goods of anyone else.[4] The principle of sec. 22 seems to be as applicable to a partial assignment as to an absolute assignment.

Lease of goodwill and trade marks.

If the goodwill of a business be leased for a term, the right to use the trade marks identified with it would during the term pass to the lessee, in the absence of special agreement; and, if it were reserved, on the principles stated above the lessor could not rightly use the marks. It seems that the registration of the lessee as assignee of the marks without the consent of the lessor, would not, however, be rightly made.[5] Where a company, which had carried on business at Glasgow and elsewhere, sold its Glasgow businesses, and agreed not to carry on business there during ten years from the assignment, and expressly licensed the assignee to use certain trade marks during that term, and the

[1] Sec. 5.

[2] Sec. 33, below, p. 357.

[3] Chap. II., at p. 33.

[4] *Oldham* v. *James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862); and see the remarks of North, J., in *Roger's Tm.*, 12 R. P. C. at p. 158 (1895), and those of Moulton, L.J., in *Boussod, Valadon & Co.* v. *Marchant*, 25 R. P. C. at p. 53 (1908), a trade name case; also *Thorneloe* v. *Hill*, 11 R. P. C. 61 (1894).

[5] *Re Averil*, Stirling, J., April 20th, 1888; Sebastian, 4th ed. p. 374, cited above, p. 302.

assignee applied to register a trade mark containing a representation of Glasgow Town Hall similar to one that had appeared on labels for whisky bottled at Glasgow by the assignors (the label not being expressly mentioned in the assignment), and the assignors opposed the registration, as they did not admit the applicant's right to the exclusive use of the device, although they did admit his right to use it, the application for registration was refused.[1]

Although if the whole goodwill of a business is leased, the lessor cannot as a rule use the trade marks during the lease; yet where a foreigner, who had registered trade marks for metal bearings, entered into an agreement with persons in this country under which they were during a term of years to purchase the particular alloy for the bearings from him, and were to have the exclusive sale in this country, and the agreement contained clauses under which the goodwill was on the determination of the agreement to revert to the foreigner, it was held that he had sufficient goodwill in bearings during the continuance of the agreement to support an assignment by him of the trade marks and such goodwill.[2]

Action by licensee.

The sole authorised dealer in goods bearing a particular trade mark in the United Kingdom, who is in a sense a licensee of the trade mark rights, cannot sue for infringement of the trade mark.[3] But a true licensee of the rights, if there can lawfully be such a person, could not sue either.[4]

Purchase or lease of goodwill.

A difficult question of fact may arise in considering whether under particular circumstances a person has purchased the right to represent that he is the successor in business of another. Such a question arose in *Rickerby* v. *Reay*,[5] where the plaintiff had bought the stock in trade and patterns of a business at a price arrived at on the footing that the chattels were for use in a going concern, and had taken a lease of the premises, and during the lease he continued to use the device of a crown, and the word "crown" which had been previously used in connection with machines sold by the old firm. On the determination of the lease he removed to other works, and questions then arose as to

[1] *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J.

[2] *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621; see above, p. 350.

[3] *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J.

[4] *Heap* v. *Hartley*, 42 C. D. 461; 5 R. P. C. 603 (1888) (a patent case); *Woolley* v. *Broad*, [1892] 1 Q. B. 806; 9 R. P. C. 208, 429 (a design case).

[5] 20 R. P. C. 380 (1903).

his rights in the goodwill and such name and device. Byrne, J., referred to Lord Lindley's judgment in *Commissioners of Inland Revenue* v. *Muller & Co.'s Margarine, Ltd.*,[1] and added, "I may also say that it appears to me that one or more of the elements going to make up what is called goodwill may be retained while others may be parted with, and that all or every[2] of such elements may be disposed of without express mention," and the learned judge held on the facts that the purchaser acquired the right to describe himself as carrying on the business formerly carried on by the old firm, and to use the patterns and device as well as the name "crown" to describe his machines, and that his rights did not determine with the lease.[3]

Registered proprietor can make a title.

The registered proprietor can make a good title to a purchaser of the trade mark and goodwill, who has no notice of any conflicting equitable rights in either which may exist in a third person. But sub-sec. (2) keeps all equities open, so that they may be enforced in like manner as in respect of any other personal property.[4] Therefore in a patent case licensees who took their licence with notice of an agreement for assignment by the licensors and registered the licence were held not to have obtained a valid licence against the assignees, although the actual assignment was made subsequently to the licence, and no notification of the agreement was entered on the Register at the date of the licence.[4]

"Subject to the provisions of this Act."

"Subject to the provisions of this Act" in sec. 38 means, subject to the rule of sec. 22, that a trade mark shall not be assigned or transmitted without the goodwill of the business in the goods for which it has been registered,[5] and subject to the provision that associated trade marks are assignable or transmissible only as a whole and not separately.[6]

An assignment is subject to all rights appearing from the Register to be vested in other persons. These may appear in the registration of the trade mark assigned in the form of limitations or conditions,[7] or by the registration of identical or nearly identical trade marks having been permitted under the provisions of secs. 19, 20 and 21.

[1] Quoted below, p. 360.

[2] This should obviously be "any."

[3] A question also arose as to the name of the premises; see below, p. 361.

[4] *New Ixion Tyre and Cycle Co., Ltd.* v. *Spilsbury*, [1898] 2 Ch. 137, 484; 15 R. P. C. 380, 567, Kekewich, J., and C. A.

[5] Above, p. 345.

[6] Sec. 27, Associated Marks, above, p. 110.

[7] Sec. 12 and sec. 14. Above, pp. 66 and 85.

Section 33 provides as follows:—

Registration of assignments, &c.

"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."

This section corresponds to the first part of sec. 87 of the Act of 1883, which, so far as regards trade marks, was in the same terms except that the words "subject to the provisions of this Act" are added in the new section, and that the provision for an appeal is new.[1] The Board of Trade may under sec. 59 refer to the Court an appeal made to it. The words "subject to the provisions of this Act," refer to the rule embodied in sec. 22, that a trade can only be assigned in connection with goodwill,[2] and to the provisions of sec. 27 that associated trade marks cannot be assigned separately.[3]

This section relates to changes of proprietorship; a change of, or correction of an error in, the name or address of the registered proprietor comes under sec. 32.[4]

In view of the appeal expressly conferred by the section from the decision of the Registrar, an application under sec. 35 for the purpose of reversing a decision of the Registrar would probably not be allowed. Under the Act of 1883, an application to rectify was the only remedy against a refusal of the Registrar to register an assignment or other change of proprietorship.[5]

Action before registration.

Registration of the assignment is not, as registration of the mark itself is, a condition precedent to any action for infringement by the assignee.[6]

Alteration of registered mark in consequence of assignment.

In some cases the assignment of a trade mark to new proprietors makes an alteration in its form necessary or advisable. In the case of registered marks, such alteration may be obtained

[1] Cf. sec. 12 (3) and sec. 14 (5).

[2] Above, p. 345.

[3] Above, p. 110.

[4] Above, p. 313.

[5] Secs. 78, 87 and 90 of the Act of 1883; see *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J., and *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J.

[6] *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1884), North, J.; *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J. See, however, *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389 (1897), and above, p. 338.

under sec. 34, provided that the mark is not altered in a manner substantially affecting its identity.[1] Thus in *Guinness & Co.'s Trade Mark*,[2] Chitty, J., allowed the word *limited* to be added to the name upon an old mark, the business and trade marks of the old firm having been taken over by a company bearing the name of the firm with "limited" added to it, and in other cases the same alteration has been allowed in new marks.[3] But in the case of an old mark the Court, in whom the discretion was formerly vested by sect. 92 of the Act of 1883, was very unwilling to allow any alteration to be made, although it had jurisdiction to do so if special circumstances render it necessary, for it was considered that a mark registered as an old mark ought to be kept on the Register as it was actually used before August 13th, 1875. So, in *Re Henry Clay, and Bock & Co.*,[4] Kekewich, J., refused to allow an old mark to be altered by substituting, for the initials of one predecessor of the proprietors, the name of another and later predecessor, notwithstanding that the mark in its altered form had been registered for some years in Havanah, and had been extensively used by the applicants in England.[5] The present Act allows alterations in old marks under sec. 34, and appears to contemplate changes in them from time to time not substantially affecting their identity.[6]

Procedure.

The procedure by which registration of assignments and transmissions of title are governed is laid down in the following rules.[7]

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.[8] If the Registrar so require, the assignee shall furnish a declaration in Form TM No. 17.[9]

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

[1] *Murphy's Tm.*, 7 R. P. C. 163 (1890), W. N. 84.

[2] 5 R. P. C. 316 (1888).

[3] See Chap. XI., at p. 318.

[4] [1892] 3 Ch. 549; 9 R. P. C. 449.

[5] See further, Chap. XI., p. 276.

[6] See the proviso to sec. 9.

[7] The old rules were 36 to 40 of the Trade Mark Rules, 1890.

[8] Appendix, p. 686.

[9] Appendix, p. 686.

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,[1] 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)[2] 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."

On an assignment for value of trade marks and goodwill the *ad valorem* stamp duty applicable to a conveyance or transfer on sale is payable.

Stamp on assignment of goodwill and trade marks, &c.

In one case it was held that in the case of a foreign trader who had no place of business in the United Kingdom, but had registered a trade mark here, and had sent goods into this country, the trade mark and right to use it and the business connection here were property within sec. 59 of the Stamp Act, 1891, and, moreover, were not "property locally situate out of

[1] Appendix, p. 687.

[2] Appendix, p. 687.

the United Kingdom" within the exception contained in the same section, notwithstanding that they were assigned with freehold premises in America.[1] But the Court of Appeal has subsequently held that where goodwill and the exclusive right to use a trade name are assigned with premises entirely situate out of the United Kingdom, the goodwill is *primâ facie* annexed to the premises, and is, in the absence of facts rebutting the *primâ facie* presumption, property locally situate out of the United Kingdom.[2] In the case referred to the question was as to the stamping of an agreement for the sale of a wholesale manufacturing business carried on abroad, and having no customers in the United Kingdom or anywhere but in Germany. On appeal to the House of Lords[3] the judgment of the Court of Appeal was affirmed. The question what constitutes goodwill was very fully considered, and the following passages occur in the judgments.

What constitutes goodwill.

Lord Macnaghten said: "It" (goodwill) "is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. . . . For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again. No doubt where the reputation of a business is very widely spread, or where it is the article produced rather than the

[1] *Brooke & Co.* v. *Commissioners of Inland Revenue*, [1896] 2 Q. B. 356, Pollock, B., and Bruce, J.

[2] *Muller & Co.'s Margarine, Ltd.* v. *Commissioners of Inland Revenue*, [1900] 1 Q. B. 310; distinguishing *Smelting Co. of Australia* v. *Commissioners of Inland Revenue*, [1897] 1 Q. B. 175 (sole licence to work patent).

[3] *Commissioners of Inland Revenue* v. *Muller & Co.'s Margarine, Ltd.*, [1901] A. C. 217.

producer of the article that has won popular favour, it may be difficult to localise goodwill. But here, I think, there is no difficulty. We have it in evidence that the firm of Muller & Co. had no customers out of Germany, and it is a significant fact that the protected area—the limit within which the vendor is prohibited from setting up in business—is the limit of fifty miles from Gildehaus.[1] Moreover, under the Stamp Act, 1891, we are not required to define the local situation of the goodwill. We have only to determine whether it is or is not situate out of the United Kingdom."

And Lord Lindley said: "Goodwill regarded as property has no meaning except in connection with some trade, business or calling. In that connection I understand the word to include whatever adds value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition, or any of these things, and there may be others which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on. Such business may be carried on in one place or country or in several, and if in several there may be several businesses, each having a goodwill of its own." [2]

[1] Where the factory was situate.

[2] This passage was quoted by Byrne, J., in *Rickerby* v. *Reay*, 20 R. P. C. 380, quoted above, p. 356. It is clearly not necessary however for the purpose of sec. 22 of the Act that the assignor of a trade mark should have a place of business in England, he may have a goodwill in England without that. See *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 621, C. A.; *Société Anonyme Panhard and Levassor* v. *Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

CHAPTER XIV.

DETERMINATION OF TRADE MARK RIGHTS.

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Modes of determination

THE right of the proprietor of a mark (subject to the rights of other proprietors, if any, of the same mark)[1] to the exclusive use of it upon the goods of the kind in respect of which the right existed is determined :—

(1) When the mark so used ceases to be distinctive;

(2) When the proprietor is no longer able to use it in the business in connection with which the right was acquired;

(3) When he has abandoned it; and

(4) When he has forfeited his claim to protection of his right by using the mark deceptively or in a fraudulent trade.[2]

[1] See the "three mark rule," p. 224, sec. 38, p. 353, and sec. 39, p. 325.

[2] See Chap. XV., "the action for infringement," defences, at pp. 426 *et seq.*

In the first case the mark can no longer be the subject of trade mark rights, and anyone may use it; but in the others, if there are any independent proprietors of the mark for the same class of goods, their rights will be unaffected by the determination; and in the fourth case their rights will continue to be qualified by the right of the former proprietor to use the mark himself on the goods, so long as he uses it in the business in connection with which it was acquired.

The proprietor may, in general, use the mark after his exclusive rights have determined.

1. Loss of Distinctiveness.

The first case follows immediately from the definition of a trade mark. It is shown in Chapter II., both from the authorities and the statutory definition contained in the Act of 1905, that the function of a trade mark is to distinguish the goods to which it is applied or attached from similar goods, and to identify them with a particular trader and his successors in business. And distinctiveness is an essential condition of capacity for registration under the Acts.[1] Further, the test of infringement is that the use of the mark, or of a similar mark, by others than the proprietor, is calculated to cause their goods to be bought as his.[2] So that, apart from the Acts, a mark which has ceased to be distinctive is incapable of being the subject of trade mark rights, and no action for infringement could be successfully brought to prevent any trader using it, and if not already registered, it would be incapable of registration under the Acts.

How distinctiveness may be lost.

The elements of distinctiveness have been considered at length elsewhere,[3] and it will be sufficient here to refer to some of the modes in which a mark may cease to be distinctive, and to give a few examples of cases in which the question has arisen. Marks are not distinctive if they are merely descriptive,[4] and, in particular, if they have been adopted in the trade concerned as the names of the goods for which they are claimed as trade marks,[5] or are common marks,[6] or marks common to the trade,[7] or if they connect the goods not with their proprietor but with some other trader.[8]

[1] Chap. VIII., p. 127.

[2] *Mitchell* v. *Henry*, 15 C. D. 181 (1880), James, L.J.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Cotton, L.J.; see also *Ford* v. *Foster*, 7 C. D. 611, cited below, p. 365.

[3] Chap. II., at p. 35; Chap. VIII., at p. 174.

[4] See above, descriptive marks, pp. 37 and 183; devices, p. 184; words, p. 142.

[5] Page 37.

[6] Page 177: see also the "three mark rule," Chap. IX., at p. 215.

[7] Page 214.

[8] *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton*

By the action of the proprietor.

Distinctiveness may be lost through the action of the proprietor, or by reason of successful piracy.

Thus, if the proprietor abandons his mark,[1] it will almost inevitably become a common mark, unless there are other persons who have trade mark rights in it which they assert.[2] So, if he uses it himself as the name of the goods he deals in, the trade will probably adopt the same course, especially if he is for a time the only dealer in the goods.[3]

Before the Registration Acts a difficult question of fact was often raised in trade mark cases where admittedly a name or other mark had been introduced by the plaintiff, but it was alleged that it had by repeated use on the goods of other traders lost its original significance indicating a connection with the plaintiff, and had become *publici juris*.[4] A case of this type came before the Privy Council on appeal from New South Wales in *The National Starch Manufacturing Company* v. *Munn's Patent Maizena, &c. Company*.[5] The plaintiffs had invented the word *Maizena* for flour made from maize and had introduced flour under that name to New South Wales in 1863, but they had not registered the word there until 1889. The defendants' predecessors commenced to sell *Maizena* in New South Wales in 1867, and the plaintiffs took no steps against them there until the action, which was founded on the trade mark and common law rights, but they had taken proceedings successfully in other countries to restrain the use of *Maizena* in connection with the defendants' flour. It was held that, in view of the use in New South Wales by the defendants and other firms of the word in question before 1889, it had become *publici juris*, and the action was dismissed and the mark removed from the Register. The plaintiffs contended that the defendants' user had been originally fraudulent and was continued in fraud, but this was not so found. On this point Lord Ashbourne said: "If during the period in question,[6] the word was only used in the colony for the

Cigarettes); *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*); see, however, in C. A., 18 R. P. C. 27 (1901).

[1] See below, p. 370.

[2] As, for instance, in *Daniel and Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134; Barnes, J., a passing-off case, where the defendant lost a concurrent right by non-user for some years.

[3] *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J.: *Gatelner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156, Neville, J., and C. A. (*cyclostyle*).

[4] See *Ford* v. *Foster*, 7 Ch. 611 (1872); *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875).

[5] [1894] A. C. 275; 11 R. P. C. 281.

[6] 1865 to 1889.

fraudulent purpose of counterfeiting their goods, the right of the appellants to register it as their trade mark would not be impaired. If, on the contrary, it was used and understood before 1889 as a term descriptive of the article, as a product of maize, and did not denote such product to be the manufacture or merchandise of a particular person, then it must be regarded as having become, in the sense of law, *publici juris*." The difficulty is not so likely to arise in the case of a registered mark,[1] since the public advertisement of the registration, and the readiness with which the infringement of a properly registered mark can be prevented,[2] both tend to warn other traders against the use of the mark and to enable the proprietor to protect his rights.

By extensive piracy.

Extensive infringement by a single trader can hardly suffice to make a trade mark common. "It has been said that one murder makes a villain, and millions a hero; but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasion of his neighbour's rights is to convert his piracy into a lawful trade."[3] Nor will a few unprosecuted scattered infringements by several traders.[4]

The test whether a mark has become *publici juris*.

"There is no doubt, I think," said Mellish, L.J., in *Ford* v. *Foster*,[5] "that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of *Harvey's Sauce*.[6] I think the test must be whether the use of it by other persons is still calculated to deceive the public,[7] whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it

[1] See *Hudson's Application*, 24 R. P. C. 582 (1907), Joyce, J. (*Thunderer* for whistles), where the investigation on applications for registration by rival traders disclosed the fact that the name was *publici juris*.

[2] Secs. 39, 40 and 41. See above, pp. 325, 329, 330. Act of 1883, sec. 76.

[3] Per James, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 625.

[4] *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Rowland* v. *Michell*, below, p. 367, note (1).

[5] L. R. 7 Ch. p. 628 (1872).

[6] *Lazenby* v. *White*, 41 L. J. Ch. 354 (1871).

[7] So the long duration of fraudulent user is immaterial, if it is still calculated to deceive: *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J. (*Hoop* **L** *Iron*); and the judgment of Ld. Ashbourne in the *Maizena* case, quoted above, p. 364.

appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent the trader from being cheated by other person's goods being sold as his goods through the fraudulent use of his trade mark, the right to the trade mark must be gone."[1]

A mark may be *publici juris* in a particular branch of the trade only.

Upon the facts of the case, the Lords Justices held that the name in question had become *publici juris* to this extent, "that by the use of it in trade circulars, which are issued only to retail dealers, or by shirts being invoiced by the wholesale dealers as '*Eureka Shirts*,' no retail dealer would be likely to be deceived, or be led to buy shirts which were not made by Ford believing they were Ford's shirts," but that a considerable portion of the public who buy shirts for the purpose of wearing them would still be very liable to be deceived by the use of the word *Eureka* on the shirt itself. And the injunction granted by the Court accordingly left the defendants at liberty to advertise the name *Eureka* as between themselves and the trade.[2]

Amount of common user necessary.

Where common user is alleged of a trade mark that has been long used and registered, in order to establish this, the use by other persons should be substantial. Thus where it was alleged that a cat and barrel were common to the trade in gin at the date of the plaintiff's registration in 1879, it was held not to be sufficient to have proved nothing more than "a very sporadic use of the labels with a cat and barrel on them." It was found that there had been in the case of none of the users of such labels, other than the plaintiffs, any trade that would associate their goods with a cat and barrel.[3] But it has been held that it may be sufficient to prove common use in the trade in advertisements, show cards, &c., without actual use on the goods, if by reason of such use the mark is not distinctive of the goods of the alleged proprietor.[4]

Where a plaintiff is alleged to have lost his rights by not interfering with infringers, the character and extent of the trade of the latter, as well as their position, must be taken

[1] See also *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n.; and *Hyde & Co.'s Tm.*, 7 C. D. 724, both (1878), Jessel, M.R.

[2] L. R. 7 Ch. p. 634; cf. *Singer, &c. Co.* v. *Spence*, 10 R. P. C. 297 (1893), Romer, J., and *Singer, &c. Co.* v. *British Empire Manufacturing Co., Ltd.*, 20 R. P. C. 313 (1903), Kekewich, J.

[3] *Boord & Son* v. *Thom and Cameron, Ltd.*, 24 R. P. C. 697, at p. 721 (1907), Court of Session. *Query* whether it is necessary that there should be such user as would (if the mark were not common) associate the goods with the person using it. See the next case cited.

[4] *Louise* v. *Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J.

into account in considering whether he is barred by his neglect to take proceedings.[1]

2. Separation of the Mark from the Goodwill.

It has been shown in the last chapter that the trade mark rights in a mark are inseparable from the goodwill of the business in the goods upon which the mark is used, for the function of the mark is to connect the goods with the trader who owns the business, and his sucessors.[2] The indication of that connection is its original signification, and it cannot legally be used as a trade mark with any other.[3] It follows that if the goodwill is lost, or passes into other hands than those of the proprietor of the mark,[4] the exclusive rights of the proprietor in respect of the use of the mark are determined, and this rule is recognised by the Acts in the case of registered marks. Section 22 of the Act of 1905 enacts that a trade mark "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 the latter section expressly adds "and shall be determinable with such goodwill."[5] And, although an assignment of a trade mark be inoperative by reason of being an assignment in gross, the assignor may lose his right to the mark by such assignment, at all events if the assignee has acted upon the assignment. Thus, where an exclusive licence in gross for a term of years to use a trade name was granted, it was held that the assignor had at the end of the term lost his right to claim that the name indicated his manufacture.[6]

Sec. 22.

No exclusive right in a registered mark apart from the goodwill.

No question seems to arise as to whether the registered owner of a trade mark which has determined by separation from the goodwill of the business can sue for infringement; for sec. 39, which grants the right of exclusive use to the proprietor of a registered

[1] *Rowland* v. *Michell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see also *Ripley* v. *Bandey*, 14 R. P. C. 591 (1897), Kekewich, J., where judgment was given for the defendant on the ground of the neglect of the plaintiff to assert his right against infringers. An appeal was settled, 14 R. P. C. 944.

[2] See the statutory definition, Chap. III., p. 57, and the judgment of Mellish, L.J., in *Ford* v. *Foster*, cited above, and Chap. II., p. 22.

[3] See the judgment of Fry, L.J., in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), cited above, p. 349.

[4] *Thorneloe* v. *Hill*, 11 R. P. C. 61 (1894); and cf. *Harness' Tm.*, 17 R. P. C. 40 (1900).

[5] Sec. 2 of the Act of 1875 and sec. 70 of the Act of 1883, below, p. 631, were to the like effect.

[6] *Thorneloe* v. *Hill*, 11 R. P. C. 61 (1894), Romer, J.

mark, makes the grant subject to the registration being valid, and consequently subject to sec. 22. As already pointed out,[1] sec. 41 does not appear to assist a plaintiff in such a case. And by sec. 40 registration is *primâ facie* evidence only of the validity of the original registration, and of all subsequent assignments and transmissions.

By Rule 81 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 (that is, of the business concerned in the goods for which the trade mark has been registered) as he may require for his satisfaction.[2]

Removal of mark when the goodwill is determined.[3]

It was provided by Rule 34 of the Rules of 1876, that—"The Court may, on the application of any person aggrieved, remove any trade mark from the Register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods within the same class as the goods with respect to which a trade mark is registered." And in *Ralph's* case,[4] where the registered proprietor had not manufactured the machine for which the mark was registered for twenty-one months before the date of the application, Pearson, J., in accordance with the rule, directed the mark to be removed.

The rule has not been since re-enacted, and the Act of 1883 contained no express provision enabling a properly registered mark to be removed except for non-payment of fees after fourteen years,[5] or at the request of the proprietor.[6] But it was held under that Act that a mark was not properly registered, and it might be removed, if it was not registered with a *bonâ fide* intention to use it for the goods in respect of which it is registered;[7] and the judgment of the Court of Appeal in *Batt's Trade Mark* supports the proposition that if at any time after registration the proprietor ceased to have such intention, the mark was on the Register without sufficient cause and might be removed.[8]

The rectification section of the Act of 1905 (sec. 35) expressly extends to the case of a mark "wrongly remaining on the

[1] Above, p. 330.
[2] Above, p. 359.
[3] See below, p. 372.
[4] 25 C. D. 194 (1883), cited below, p. 369.
[5] Sec. 79.
[6] Sec. 91.
[7] *Batt* v. *Dunnett*, [1899] A. C. 428; 16 R. P. C. 411; and supra, pp. 292 *et seq.*
[8] [1898] 2 Ch. 432; 15 R. P. C. 534.

Register," so that if the goodwill of the business concerned in the goods for which a trade mark has been registered determines, it seems clear that by the combined operation of secs. 22 and 35 the trade mark would be liable to be removed from the Register. Moreover, although there has not been a total determination of goodwill, and although the proprietor still trades in the goods in question, yet non-user may be a ground for removal from the Register.[1]

Temporary separation from the goodwill or disuse of mark is immaterial.

A mere temporary cessation of business,[2] or delay in the transfer of the goodwill,[3] would not determine the trade mark rights. The judgment of Pearson, J., in *Ralph's* case,[4] notwithstanding the repeal of the Rule on which it was founded, may be referred to on the question what length of cessation of a business determines the goodwill, and therefore also the trade mark rights attached to it. "The only question I have to determine," he said, "is whether one year and nine months is sufficient cesser on the part of Mr. Ralph to show that he comes within the (34th) rule. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the Companies Act you may wind up a company if it has ceased to carry on business for a year. The Legislature in that has shown by its enactment when a business is supposed to be carried on, and what amount of cesser shows that the business is not being carried on." And it made no difference, he held, that the cessation of business was due to the ill-health of the proprietor. But the view that a goodwill would determine in so short a time is not consistent with the facts of ordinary business.[2]

In a case where the licensees of a patent had, by arrangement with the patentees, registered a trade mark and used it on the patented goods, and on the determination of the licence the patentees contended that the mark ought to be expunged from the Register on the ground that the goodwill of the licensees had determined, as they could not make the patented goods, the application was dismissed, it being held that the mark in fact indicated the licensees as the source of the goods.[5]

[1] Sec. 37. It is fully dealt with above, p. 293.

[2] See the next page. Sec. 31 suggests three years non-user as a minimum. See p. 373.

[3] *Welcome's Tm.*, 213 C. D. 76; 3 R. P. C. 76 (1886); *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), both Chitty, J.

[4] Above, p. 368.

[5] *Freeman Bros.* v. *Sharpe Bros. & Co., Ltd.*, 16 R. P. C. 205 (1899), North, J.

3. Abandonment.

A trade mark right, as any other right, can, of course, be abandoned by the owner; but, so long as he remained the registered proprietor of the mark and carried on the business to which the mark was attached, it would be difficult, if not impossible, to show abandonment, unless, either by repeated and undisturbed infringements, or by the use of the mark by the proprietor himself in some way inconsistent with the maintenance of its character as a trade mark, it had become a common mark so as to fall under the first case,[1] or a case could be made by any particular defendant sued for infringement by the owner to show that he had been led by the conduct of the plaintiff to believe that the mark was a common mark, and so to set up an estoppel.[2]

Agreement to abandon trade mark.

The possible case of an agreement by the proprietor to abandon his mark stands by itself. The other party to the agreement, if sued for infringement, could no doubt rely upon it as a defence, and probably could, if the mark were registered, obtain the removal of the mark from the Register, or an order, by way of specific performance of an implied term in the agreement, that the proprietor should apply under sec. 32 to cancel the registration.

Not mere disuse.

Mere disuse of the mark does not amount to abandonment of trade mark rights in respect of it. For "A man who has a trade mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade mark by not putting more goods on the market when it was glutted."[3] Accordingly, in the case cited, a mark was directed to be registered concurrently with a similar mark in the same class which had been previously registered, and which the Court refused to expunge, although the proprietor of the former mark, having adopted it in 1874 and used it largely

[1] Above, p. 363.

[2] See the next chapter; estoppel, p. 419; acquiescence, p. 421; and delay, p. 423. See also *Browne* v. *Freeman*, 12 W. R. 305; 4 New Rep. 476 (1864), Wood, V.-C., where the dismissal, at his own request, of a previous suit by the plaintiff against the defendant, to restrain the use by the latter of *Chlorodyne*, was treated as conclusive against him that he had no exclusive right to use the word. He brought a third suit in 1873; W. N. 178.

[3] Per Chitty, J., in *Mouson* v. *Boehm*, 26 C. D. 398 (1884). But if in the meantime the mark had come to indicate exclusively the manufacture of the registered owner, its use by another would have been deceptive. Cf. *Daniel and Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134 (a passing-off case).

in the two years following, from 1876 to 1882 had used it less and less, and had in the last-mentioned year forgotten and ceased to use it altogether. He had not, however, broken up the moulds he used for the marked goods, or erased the mark from his books or price lists. But if a proprietor ceases to have an intention of dealing in the goods for which the mark is registered, that would necessarily entail an abandonment of the mark so far as such goods were concerned.[1] And from a long disuse an intention to abandon might be inferred.[2]

Under sec. 37 of the Act of 1905 non-user for five years in connection with any goods for which the trade mark is registered may be a cause for removal of the mark from the Register, and in effect in such a case is treated as an abandonment of the trade mark so far as rights arising from registration are concerned, unless "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."[3] The Court, however, has a discretion under the section.

Adoption of a new mark.

The adoption of a new mark may be evidence of the abandonment of an old one.[4] But the fact of itself is not conclusive, for it is no justification for the defendant to say, "The plaintiff has two ways of identifying his goods, and I have only stolen one of them."[5] So where, in opposition to the registration in 1896 of a mark as an old mark, it was shown that a new label had been adopted in 1877, and it was contended that the old mark had been abandoned either then or previously, but it was proved that a large number of the old labels had been ordered in 1877, and that there had been occasional user of them since, and that the stock of them had never been exhausted, it was held that there had been no abandonment.[6]

Use in connection with the proprietor's name.

The fact that the owner of a word mark uses it always in connection with his own name is not conclusive to show that the mark is not a trade mark, or that he has waived his rights in it as such.[5]

Neglect to prosecute infringements.

Neglect to proceed in respect of infringements which do not

[1] *Batt's Tm.*, see above, p. 292.

[2] Per Farwell, J., in *Louise & Co., Ltd.* v. *Gainsborough*, 20 R. P. C. 61 (1903); and see *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569.

[3] Sec. 37 is more fully considered above, p. 293.

[4] *Lea* v. *Miller*, Seb. Dig. p. 305 (1876), Jessel, M.R.

[5] Per Wood, V.-C., in *Braham* v. *Bustard*, 1 H. & M. 447; 9 L. T. N. S. 199 (1863) (*Excelsior White Soap*).

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

amount to user sufficient to affect the distinctiveness of the mark does not affect the proprietor's rights if he is aware of the infringements,[1] still less if he is not.[2]

4. Forfeiture of Right to Protection.

The forfeiture of the right of the proprietor of a trade mark to have his trade mark protected by the Court is discussed elsewhere, under the head of defences to an action for infringement.[3]

5. Removal of Mark from the Register.

A trade mark may be removed from the Register, (*a*) at the instance of the registered proprietor or some person entitled by law to act in his name;[4] (*b*) by the Court on an application to rectify the Register under sec. 35;[5] or (*c*) by the Registrar on non-payment of renewal fees.

Removal by the Registrar for non-payment of fees.

Under the Act of 1883 the registration was perpetual, subject to liability to removal on non-payment of the prescribed fee at the end of each period of fourteen years.[6] Under the Act of 1905, registration is only for a period of fourteen years, but is renewable from time to time. The position is substantially the same assuming that, as is submitted is the case, the sections printed below do not authorise the Registrar to impose conditions other than those relating to the time and manner of the application for renewal. The sections of the Act of 1905 and the Rules dealing with the renewal of registration are as follows :—

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.'

[1] *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 Hall, V.-C. See the next chapter, at p. 423.

[2] *Re Farina*, 27 W. R. 456 (1879), 1863), Brady, C.; *Ford* v. *Foster*, L. R. 7 Ch. 611 (1872), L.JJ.; *Rowland* v. *Michell*, 13 R. P. C. 457 : 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see above, p 367.

[3] Chap. XV., at p. 426.

[4] Sec. 32, above, p. 314.

[5] Above, p. 278. Sec. 37 provides for rectification under sec. 35 on a special ground.

[6] Sec. 79 of the Act of 1883.

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 non-payment 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."

The Rules are as follows :—

"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.[1] 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

[1] Appendix, p. 684. The ordinary fee is £1 for each mark, but there are concessions in the case of a series of marks, and in the case of a mark registered under sec. 62 for goods in more than one class, see List of Fees, p. 704.

shall send to the registered proprietor at his registered address a notice in the Form O No. 3.[1]

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.[2]

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,[3] together with an additional fee upon Form TM No. 14,[4] 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,[5] 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.

Cause of removal to be registered.

"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."

The time table laid down by the above sections and rules is as follows:—During the third month before expiration of the registration, the registered proprietor or an authorised person may apply for renewal; in default the Registrar during the second month before expiration gives the first warning notice, on further default he gives a second warning notice during the fourth or third week before expiration; up to the date of expiration the ordinary fee only is payable; in default of renewal before expiration there is advertisement in the Journal forthwith, and if the additional fee is paid within one month after the advertise-

[1] Appendix, p. 684.
[2] Appendix, p. 684.
[3] Appendix, p. 685.
[4] Appendix, p. 685, additional fee, 10s.
[5] Appendix, p. 686, additional fee, £1.

ment, the Registrar may renew; in default the Registrar may remove the mark, but a discretion is given to him to restore it on payment of a higher additional fee. There appears to be an absolute right to renewal under sec. 29, if the application is made in the prescribed time and manner, including the payment of fee; and it is submitted that the words "the conditions as to fees and otherwise," in sec. 30, only authorise conditions as to fees, time, and manner, so that, for instance, the Registrar could not impose a condition that the registered proprietor should disclaim part of the registered mark; and this seems to be the view taken in drafting the forms of notice referred to in Rules 70 and 71. It is clear, however, that if the trade mark has been properly removed from the Register, the Registrar has a discretion as to restoring it, and it may be also that he has some discretion if the renewal has not been made before expiration, the wording of Rule 72 being permissive.

Right to renewal.

The owner of a trade mark which has been removed from the Register for non-payment of fees may, of course, make a new application for registration, but the removal may entail serious consequences, for the owner on a fresh application must justify the registration as at the date of the application. This is illustrated in a case in which an old mark had been removed for accidental non-payment of fees and was re-registered after a lapse of two years; but it was held that before the fresh registration the mark had, as to certain of the goods for which it was registered, become descriptive of the article, and that registration was therefore held to be invalid as to such goods.[1]

Re-registration.

Section 31 has reference to sec. 19;[2] its main object is the protection of the public. It is directed to prevent the registration by another trader, for the same goods or description of goods, of a mark the same as the removed mark, or so nearly resembling it as to be calculated to deceive, until such time after the removal of the other as is considered sufficient to allow the other to be forgotten, so that the new mark may not be taken for that of the proprietor of the old mark. The period provided for by the Act of 1883 was five years, but this was altered by the Act of 1888 to one year on the recommendation of Lord Herschell's

Status of removed mark.

[1] *Bourne* v. *Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J. (*Swanbill* for corsets).

[2] Chap. X., p. 222. It corresponds to sub-sec. 5 of sec. 79 of the Act of 1883, which was amended by sec. 19 of the Act of 1888.

Committee.[1] The proviso "unless, &c.," is new,[2] being substituted for one added by sec. 19 of the Act of 1888, which was as follows: "Unless it is shown to the satisfaction of the Comptroller that the non-payment of fees arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under the proprietor or under his bankruptcy is using the trade mark."

If the proprietor of the removed trade mark is in fact using it, then even after the expiration of the two years prescribed by the section he would have the ordinary right of the owner of an unregistered trade mark to oppose re-registration of the mark, or registration of a mark closely resembling it, on the ground that the proposed trade mark would be calculated to deceive.[3]

[1] Report of 1888, p. xiii.

[2] Cf. sec. 37.

[3] See 11, above, p. 266.

CHAPTER XV.

THE ACTION FOR INFRINGEMENT.

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Actions for infringement of trade mark and actions for passing-off.

It is convenient to deal separately with actions which are brought to prevent or to recover damages for the infringement of trade marks, and with what are compendiously described as "passing-off actions." In an action of the first class the plaintiff complains that the defendant has infringed his trade mark by taking it in its entirety, or by taking a substantial portion of it, or by colourably imitating it, and he relies on his title to the exclusive use of the mark in question for goods of a specified kind; in an action of the second class the plaintiff's case is less specialised, for he complains that the defendant is using means which are calculated to pass off, or to cause to be passed off, the goods of the defendant as and for those of the plaintiff, and the means may or may not comprise or consist of an infringement of a trade mark to which the plaintiff has a title. The distinction between the two classes of actions has been accentuated by the provision, already discussed, which makes registration a condition precedent, in general, to the institution of actions ranking in the first class, that is, trade mark actions proper.[1] They are, however, closely connected, and in practice they are frequently combined, the statement of claim alleging both infringement and passing-off. The first class is in reality a specialised variety of the second, having been divided off from other passing-off actions when property in a trade mark was first adopted as the ground of jurisdiction.[2] Moreover, as the test of infringement is still whether, by reason of its resemblance to the plaintiff's mark, the defendant's mark is calculated to lead purchasers to believe that the goods on which it appears are those of the plaintiff, every case of infringement would be a case of

[1] Chap. XII., p. 334. [2] Chap. I., pp. 4 and 13.

passing-off but for the fact that where the actual mark is taken, or an obvious imitation is made, the Court does not trouble to inquire whether deception is likely to result, and, in the former case, it seems that it is precluded from doing so by the provision that registration, if valid, gives an exclusive title to the use of the registered mark.[1]

1. Commencement of the Action.

In what Court a trade mark action should be commenced.

The great majority of actions in respect of the infringement of trade marks are commenced in the Chancery Division of the High Court,[2] but such actions are not specially assigned to that division, and they have been occasionally transferred from it to the King's Bench Division in order to be there tried by jury.[3] This was done by Kay, J., in a case where the defendant submitted to a perpetual injunction and the question of damages only remained, on the ground that in trade cases a jury is the best tribunal to assess damages;[4] but in an earlier case, where the right to the injunction was contested, the defendants having given notice requiring the trial to be by a judge and a special jury, Bacon, V.-C., ordered that the action should be by a judge alone.[5] The last-named judge also refused to order the complicated and difficult case of *The Singer Manufacturing Co.* v. *Loog*[6] to be transferred to the Common Law Division so that the issues involved might be there tried with a jury, on the ground that the questions to be determined involved matters of law as well as fact, and were unfit to be dealt with by a jury.

Jury.

No jurisdiction in the County Court.

An action for infringement of a trade mark cannot be brought in the County Court,[7] although a trade mark is not a franchise, as a patent is.[8] Such an action is not a personal action within the meaning of sec. 56 of the County Courts Act, 1888.

[1] Sec. 39, Chap. XII., p. 325; and see *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

[2] Or the Court of Chancery of the County Palatine of Lancaster. This Court has jurisdiction under sec. 71 of the Act of 1905, replacing sec. 112 of the Patents, &c., Acts, 1883 (Act of 1888, s. 26).

[3] See *Re Martin, Hunt* v. *Chambers*, 20 C. D. 365 (1882); and Ord. 36, r. 6.

[4] *Fennessy* v. *Rabbits*, 56 L. T. 138 (1887).

[5] *Spratt's Patent* v. *Ward & Co.*, 11 C. D. 240 (1879).

[6] 11 C. D. 656 (1879). In *Fennessy* v. *Clark*, 37 C. D. 184 (1887), the issues of fact were ordered to be tried by a judge and special jury.

[7] *Bow* v. *Hart*, [1905] 1 K. B. 592; 22 R. P. C. 222, C. A.

[8] *Queen* v. *County Court Judge of Halifax*, [1891] 2 Q. B. 263; 8 R. P. C. 338, Pollock and Charles, JJ., and C. A.

Service out of the jurisdiction.

Service of the writ out of the jurisdiction may be allowed if the case falls under any of the classes enumerated in Order 11, rule 1, for instance, if the plaintiff seeks an injunction to restrain infringements within the jurisdiction;[1] but if the defendant carries on business in Ireland or Scotland, and not at all, or only to an inconsiderable extent, in England, leave to serve the writ upon him in either of the first-mentioned countries will be refused, and the plaintiff will be left to pursue his remedies in the local Courts.[2] On this ground leave to serve out of the jurisdiction has been refused even where an application to register the defendant's mark was pending before the Comptroller in London on which the same witnesses would be required as in the action,[3] and also where a motion to expunge the defendant's mark was pending in the English Courts.[4] In the former case[5] the refusal was based partly on the fact that if an injunction were granted it could not be enforced against the defendant personally in England, but only against his agents. But where a Scotch manufacturing company had three branches and an important business in England, leave was granted to sue them here.[6]

Actions by foreigners.

An alien, not being the subject of a country actually at war with England, if he is the proprietor of a trade mark which exists as such in this country, may sue in the English Courts in respect of infringements in England.[7] So in a trade name case in which the plaintiffs had prior to the commencement of action no place of business or agent in this country, yet as England was a market for their goods, it was held that they

[1] See *Badische Anilin* v. *Johnson*, [1896] 1 Ch. 25; 12 R. P. C. 535, C. A. Difficult questions of fact often arise as to whether a foreign corporation is resident within the jurisdiction; see for instance, in the patent case, *Dunlop Pneumatic Tyre Co., Ltd.* v. *Actien Gesellschaft, &c., Vorm. Cudell & Co.*, [1902] 1 K. B. 342; 19 R. P. C. 46, where the defendants had simply a stand at an exhibition for show and sale of their goods; and other cases cited in Annual Practice, under Ord. IX., r. 8.

[2] *Kinahan* v. *Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1890), Kekewich, J. As to the rectification of the registrations of marks belonging to foreigners, see Chap. XI., at p. 306.

[3] *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

[4] *Kinahan* v. *Kinahan*, supra; cf. *King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350.

[5] *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

[6] *Burland* v. *Broxburn Oil Co.*, 41 C. D. 542; 6 R. P. C. 482 (1889), Chitty, J.

[7] *The Collins Co.* v. *Brown*, 3 K. & J. 423 (1857), Wood, V.-C.; *The Collins Co.* v. *Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

could sue to protect their trade name.[1] But sec. 42, prohibiting actions in respect of the infringements of unregistered trade marks, applies to trade marks belonging to foreigners.[2]

Notice of action is unnecessary.

No notice need be given to the alleged infringer before the action is brought,[3] and the plaintiff's right to bring the action is not affected by the ignorance of the defendant of the plaintiff's claim to the mark, or the readiness of the defendant to cease the infringement when called upon to do so.[4] "A plaintiff in these cases," Chitty, J., said, in *Upmann* v. *Forester*,[5] "is placed in circumstances of difficulty, because if he were to give notice there is great probability of the defendant at once getting rid of the spurious articles before the plaintiff could interfere; and the plaintiff therefore would in many instances be affording the defendant an opportunity of doing what the injunction would have prevented. I well remember that the late Master of the Rolls, Sir G. Jessel, stated that he was, when at the Bar, accustomed in cases like this to advise his clients not to give any notice, but to move at once."[6] And in a case in which the defendants had used a name to the exclusive use of which the plaintiffs were not entitled, but had also imitated a special scroll used by the plaintiffs, and it was suggested that the plaintiffs ought before action to have written to the defendants, stating that it was the scroll that they objected to, Lord Macnaghten said: "I cannot think that there is any substance in that objection. Why should a person assailed and injured by unfair competition teach his opponent how far he may safely go in undermining a rival business which he wishes to destroy? Why should he throw away the only chance of obtaining by process of law redress for injury already done?" Consequently the omission to give notice before action does not disentitle the plaintiff to costs.[7]

Agents and partners of infringer.

The action is one of tort, and, consequently, every infringer is liable to be sued, whether he acted on his own behalf or as agent for a principal. But a mere servant should not, it seems, be

[1] *Société Anonyme, &c. Panhard et Levassor* v. *Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

[2] See *Goodfellow* v. *Prince*, 35 C. D. 9 (1886), C. A.; and above, Chap. XII., p. 337; although Malins, V.-C., expressed a contrary opinion in *Twentsche, &c.* v. *Ellinger & Co.*, 26 W. R. 70 (1877).

[3] *Pierce* v. *Franks*, 15 L. J. Ch. 122 (1846), Knight Bruce, V.-C.

[4] *Burgess* v. *Hately*, 26 Beav. 249 (1858), Romilly, M.R.

[5] 24 C. D. 231 (1883).

[6] *Ibid.* The very life of a trade mark depends upon the promptitude with which it is vindicated. *Johnson* v. *Orr-Ewing*, 7 App. Ca. 219 (1882).

[7] See below, p. 458.

added as a defendant.[1] An innocent partner of the infringer defendant, who has repudiated the wrongful act of his co-partner, is not, it appears, liable to be sued.[2]

Directors. Directors of a limited company which is sued for infringement should not be joined as defendants if there are no specific allegations against them other than that they are directors.[3]

2. The Plaintiff's Title.

The plaintiff must be owner of the trade mark[4] which is alleged to have been infringed, and the onus of proving that he is entitled to the exclusive use of the mark for the particular class of goods (subject, if the case is so, to the concurrent rights of persons, other than the defendant, who are also owners of the same or a similar trade mark) lies upon him.[5] So where three persons, a manufacturer, a shipper, and a foreign consignee, devised a trade mark in concert, and used it for goods sent by the manufacturer through the shipper to the consignee, and afterwards the manufacturer began to use it for goods not sent through the shipper, and the shipper for goods not obtained from the manufacturer, and cross-actions for infringement were brought by the shipper and the manufacturer, it was held that

Joint trade marks.

[1] *Daniel and Arter* v. *Whitehouse*, 16 R. P. C. 71 (1899), North, J. (a motion to commit).

[2] *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. A passing-off case in which the innocent partner had repudiated the acts of his co-partners and sought a dissolution, and had, of course, separated in his defence. It was said by Collins, J., and Chitty, L.J., that the passing-off was not within the scope of the authority given by one partner to another, but the same remark would apply to an innocent employer whose manager commits the wrong. Cf. *Grierson, Oldham & Co.* v. *Birmingham Hotel Co.*, 18 R. P. C. 158 (1901), Buckley, J., where an hotel company was held responsible for passing-off by waiters contrary to orders; also *Cuenier Fils* v. *Gaiety Bars and Restaurant Co., Ltd.*, 19 R. P. C. 357 (1902), Buckley, J. It is submitted that *The Magnolia* case must not be considered as an authority for the general proposition that only partners who are aware of the wrongful acts can be sued. As to damages against an infringer who is innocent of fraud, see below, p. 455.

[3] *Cropper Minerva Machines Co., Ltd.* v. *Cropper, Charlton & Co., Ltd.*, 23 R. P. C. 388 (1906), Farwell, J. Cf. with the patent case, *Betts* v. *De Vitre*, 3 Ch. 441 (1868).

[4] The questions, What is a Trade Mark, and What can be Registered as a Trade Mark, are discussed in Chap. II., p. 22; and Chap. VIII., p. 127. The special right of suing to restrain the use of the Royal Arms, &c., conferred by sec. 68 is not, of course, a right to sue for infringement of a trade mark, and constitutes, therefore, no exception to the rule; see below, p. 386.

[5] *Robinson* v. *Finlay*, 9 C. D. 487 (1877), C. A. As to concurrent rights, see below, p. 388.

neither of them could make out a title to exclusive use, and both actions were dismissed.[1]

In a case where Messrs. Harper and Moore, the plaintiffs, had been the lessees of certain brickworks, and had been accustomed to make bricks of the clay produced by mines of which they were lessees also, and, after the expiration of their leases, the defendants, who had obtained a lease of the brickworks only, advertised themselves as "E. & J. Pearson (late Harper and Moore)," thereby suggesting that they were successors to the old brick-making business, Wood, V.-C., granted an injunction to restrain the advertisements, and he said he would have granted it as a matter of course had the owner of the mines been plaintiff in the suit. The learned Vice-Chancellor seems, therefore, to have been of opinion that both he and the plaintiffs were interested in the old firm name.[2]

Where lamps known as Stewart Arc Lamps had been manufactured by a company in America to the special order of an English company who had acted as the sole agents in this country of the American company, it was held that the name Stewart Arc Lamps had become associated in this country with the English company, and that their successors had the right to use the name and were entitled to an injunction to prevent the American Company from using the word "Stewart" without clearly distinguishing their lamps from those of the successors of the English company.[3]

A mere importer has no title to sue for infringement of the trade marks of the consignor or producer.[4]

Where the plaintiff is the sole purchaser from the proprietor.

The plaintiff does not become owner of the trade mark, or acquire any interest in it sufficient to enable him to sue for infringement, by a contract with the proprietor for the exclusive

[1] Last case. A custom in Manchester, by which the shipper, in the absence of agreement, was the owner of the trade mark, was alleged but not proved. *Jones' Tm.*, 53 L. T. 1 (1885), C. A., is a similar case. See also *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1885), Pearson, J., cited p. 280. Cf. *Van Zeller* v. *Mason, Cuttley & Co.*, 25 R. P. C. 37 (1908). Joyce, J. (*Köpke Roriz*), where that mark was held to indicate the produce of a particular vineyard, and not such produce when sold and shipped by a particular firm only.

[2] *Harpers* v. *Pearson*, 3 L. T. N. S. 547 (1860); cf. *Motley* v. *Downman*, 3 My. & Cr. 1; 6 L. J. Ch. (N. S.) 308 (1837), Cottenham, L.C.

[3] *Defries & Son, Ltd.* v. *Electric and Ordnance Accessories Co., Ltd.*, 23 R. P. C. 341 (1906), Joyce, J.

[4] *Hirsch* v. *Jonas*, 3 C. D. 584 (1876), Jessel, M.R.; see Chap. II., at p. 54; Chap. IV., at p. 68; and *Goulfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

purchase of the marked goods consigned to a particular district;[1] but it is submitted that if the contract were for the exclusive purchase of all the marked goods manufactured by the proprietor, so that no goods could be rightly marked which did not pass through the plaintiff's hands (subject to any question of registration),[2] he might maintain the action against any person who used the mark, or a spurious mark infringing it, on goods which were not the goods of the manufacturer. The question whether a trader, exclusively entitled by contract with the proprietor to purchase his goods, could rightly register the proprietor's mark as his own, of course with the proprietor's assent, was discussed but left undetermined in *The Apollinaris* case.[3]

Action by one proprietor or by several.

One or more of several persons concurrently entitled may bring the action.[4] This is expressly so provided by the proviso to sec. 39 of the Act of 1905 (the section which confers the exclusive right to use), which enacts 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. Several plaintiffs so entitled may join together to sue although their interests are distinct and separate.[5] But only a limited number of persons or firms can be concurrently entitled to a mark. If a large number, and, apparently, if more than three, become so entitled, the mark becomes a common mark.[6]

Plaintiff must use or intend to use the mark.

It would seem that the plaintiff must be using, or intending to use, the mark, for no damage would otherwise be occasioned to

[1] *Richards* v. *Butcher*, 7 R. P. C. 288 (1890). Kay, J., leave to add the proprietor as plaintiff granted; cf. *Woolley* v. *Broad*, [1892] 1 Q. B. 806, exclusive licensee of registered design; and *Heap* v. *Hartley*, 42 C. D. 461 (1889), exclusive local licensee of a patent cannot sue.

[2] *Goulfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

[3] [1891] 2 Ch. p. 231; 8 R. P. C. 137, Fry, L.J., cited above, p. 280.

[4] *Hine* v. *Lart*, 7 L. T. (O. S.) 41 (1846), Shadwell, V.-C.; *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Southorn* v. *Reynolds*, 12 L. T. (N. S.) 75 (1865), Wood, V.-C. As to passing-off actions, see below, p. 477.

[5] *Dent* v. *Turpin*, above, note (4), and *Universities of Oxford and Cambridge* v. *Gill*, [1899] 1 Ch. 55. Stirling, J.

[6] *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J. The question was as to the rights of the partners on dissolution of a firm. See now sec. 23 and cf. sec. 74, sub-sec. (3) of the Act of 1883, Appendix, p. 632.

him by the infringement.[1] It has been held that a mortgagee who does not intend to use the mark cannot bring an action in respect of its infringement,[2] and intention to use is one of the conditions precedent to proper registration.[3]

Action survives to executors, and they may sue.

Infringement of a trade mark is an interference with a right of property injuring the personal estate of the owner, and consequently the right of action in respect of it is not determined by the death of the owner, and proceedings may be begun or continued[4] by his executors. Of course, if the executors have possession of the goodwill of their testator's business, and are carrying on his trade, they can themselves be registered, and can sue as owners of the trade marks employed in the business and attached to the goodwill.[5]

Unauthorised assumption of the Royal Arms, &c., may be restrained.

A person who, without proper authority, uses the Royal Arms or arms so closely resembling them as to be calculated to deceive, or any device, emblem, or title in a manner calculated to lead to the belief that he is employed by or supplies goods to a member of the Royal Family, is liable to be restrained from so doing at the suit of any person who is authorised to use such arms, device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf.[6] Such an action, although analogous to an action for infringement of trade mark, is a purely statutory one, and differs in particular from an ordinary infringement action in that the person suing is not the proprietor of the mark, the unauthorised use of which is complained of in the action. In several actions under the section injunctions have been granted.[7]

3. Registration.

Proof of registration of the trade mark.

The plaintiff must, before the commencement of the action, or, at any rate, at the date of the hearing,[8] be the registered

[1] And see above, p. 328.

[2] *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J., a trade name case.

[3] Sec. 37; and *Apollinaris Co.'s Tms.*, [1891] 2 Ch. p. 233; 8 R. P. C. 137; *Batt & Co.'s Tm.*, [1898] 2 Ch. 432; [1899] A. C. 428; 15 R. P. C. 262, 534; 16 R. P. C. 411; see above, Chap. XI., at pp. 292 and 293.

[4] *Oakey* v. *Dalton*, 35 C. D. 700; 4 R. P. C. 313 (1887), Chitty, J.

[5] See Chap. XIII., p. 345; and *Massam* v. *J. W. Thorley's Cattle Food Co.*, 6 C. D. 574; 14 C. D. 748 (1877), Malins, V.-C., and C. A.

[6] Sec. 68. The section is fully set out below, p. 623. There is a proviso saving the right (if any) of the proprietor of a trade mark containing such arms, device, &c.

[7] For instance, in *Royal Warrant Holders' Association* v. *Slade & Co., Ltd.*, 25 R. P. C. 245 (1908), Swinfen Eady, J.

[8] *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389, at p. 394 (1897), Collins, J. See further, above Chap. XII., at p. 338.

proprietor, except that if the mark was in use before August 13th, 1875, the plaintiff may show that registration of it has been refused.[1] In each case the registration and the name of the registered proprietor, or the refusal, may be shown by the certificate of the Registrar, or by sealed and certified copies of or extracts from the Register.[2]

Registration of assignment is unnecessary before action.

But the registration of the successor in title of the original proprietor—his assignee, for instance—is not necessary to enable the successor to commence an action.[3]

Registration as evidence of title.

The registration of a person as proprietor of a trade mark is *primâ facie* evidence of the validity of the original registration and of all subsequent assignments and transmissions,[4] and is, subject to certain exceptions, after seven years from the date of the original registration, or from August 11th, 1905[5] (whichever shall last happen), conclusive evidence of the validity of the original registration;[6] and registration, if valid, confers the exclusive right to the use of the trade mark for the goods in respect of which it is registered.[7]

So that after the expiration of the above-mentioned period of seven years[8] objections to the original registration cannot be raised against the plaintiff,[9] unless the registration was (*a*) obtained by fraud, or (*b*) unless the trade mark is calculated to deceive, or

[1] Sec. 42; see Chap. XII., p. 334.

[2] Secs. 7, 50 and 51, and sec. 64 of the Patents and Designs Act, 1907, replacing sec. 84 of the Act of 1883. Form of Request for Certificate of Registration to be used in legal proceedings, TM No. 31, Appendix, p. 697. Fee £1. Form of Request for Certificate of Refusal to Register, TM No. 32, Appendix, p. 696. Fee £1.

[3] *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J. See further, above, Chap. XII., at p. 338.

[4] Sec. 40; Chap. XII., at p. 329.

[5] The passing of the Act.

[6] Sec. 41; Chap. XII., at p. 330.

[7] Sec. 39; Chap. XII., at p. 325.

[8] In *Apollinaris Co.* v. *Snook*, 7 R. P. C. 474 (1890), although the mark had not been registered for five years (the period under the Act of 1883), Kekewich, J., at the hearing refused to listen to an argument that it ought not to have been registered; but, apparently, his attention was not called to the point in question. And in *Compagnie Générale* v. *Rehder*, 5 R. P. C. 61, at p. 65 (1888), Kay, J., took a similar course upon an application for an interim injunction. See also *Hommel* v. *Bauer & Co.*, 20 R. P. C. 802 (1903), Byrne, J. In *Stuart* v. *Scottish Val de Travers Co.*, 13 Ct. of Sess. Ca. 1 (1885); and *Lever* v. *Goodwin*, 4 R. P. C. 492 (1887), Chitty, J., objections to marks registered for less than five years were allowed at the hearing, there being no application to rectify. And in *Free Fishers of Whitstable* v. *Elliot*, below, p. 518 (not reported on this point), Stirling, J., decided that this could be done. See also the Scotch case of *Dewar, Ltd.* v. *Dewar*, 17 R. P. C. 341 (1900), which, however, turned on the question of an inherent jurisdiction in the Scotch Court.

[9] For cases under the Act of 1883, see *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.; and *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.

otherwise offends against sec. 11 of the Act.[1] Other objections may, however, be taken;[2] it may be shown, for instance, that the plaintiff does not possess the goodwill of the business to which the mark is attached.[3]

Registration modified by a disclaimer or otherwise.

But the registration is, of course, evidence only of such title as it shows, and the plaintiff's right is accordingly subject to the modification imported by any limitation or condition entered upon the Register in connection with it.[4] In particular, if there is any disclaimer of part of the registered mark, the registered proprietor has no title to sue in respect of an alleged infringement constituted by the adoption of such part of the mark, for the disclaimer is an indication to all the world that he has no monopoly, by reason of the registration, of the use of that part, at all events by itself.[5]

The exclusive right to use conferred by sec. 39 is subject to the provisions of sec. 41, preserving the rights of users anterior to the first use of the registered mark. It is also subject to the general provision contained in sec. 44, that no registration under the Act shall interfere with any *bonâ fide* use by any person of his own name or place of business, or that of any of his predecessors in business, or to the use by any person of any *bonâ fide* description of the character or quality of his goods.

By concurrent rights.

And the right to exclusive use is subject to the rights of any person who has obtained concurrent registration,[6] and to the concurrent rights, if any exist, of other persons to use the mark upon obtaining registration.[7]

Plaintiff's title determined or barred.

The seven years' registration does not, it is submitted, prevent the defendant, although he has made no application to rectify, or although the Court has no jurisdiction to entertain any such application which he has made, from setting up as a defence that the plaintiff's right has determined by abandonment or otherwise,[8] or has been wholly assigned to another.[9] And it is, it is also

[1] Sec. 41, Chap. XII., at p. 330.

[2] Above, Chap. XII., at pp. 332, 333, 334.

[3] Sec. 22; *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

[4] Sec. 39, above, p. 325.

[5] *Rosenthal* v. *Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J.; *Pirie* v. *Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, C. A.; Chap. IX., at p. 218. A dictum of Ld. Alverstone in *Hubbuck* v. *Brown*, 17 R. P. C. 638 (1900), suggests that although the exclusive use of part of a mark is disclaimed, nevertheless the proprietor may rely on the whole combination: see also *Pirie* v. *Goodall*, [1892] 1 Ch. 35. As to passing-off cases based upon disclaimed matter, see next chapter, p. 516.

[6] The proviso to sec. 39, fully set out above, p. 325.

[7] Sec. 21 and below, p. 411.

[8] Chap. XIV., p. 362.

[9] This is consistent with the fact that an unregistered assignee can sue, see p. 387.

submitted, no answer to a personal bar which disentitles the plaintiff to sue.

4. What constitutes Infringement.

Infringement is the use by the defendant, for trading purposes [1] upon or in connection with goods of the kind for which the plaintiff's right to exclusive use exists [2] (*i.e.*, goods in respect of which his mark is registered,[2]) not being the goods of the plaintiff,[3] of a mark identical with [4] the plaintiff's mark, or comprising some of its essential features, or colourably resembling it,[5] so as to be calculated to cause goods to be taken by ordinary purchasers [6] for the goods of the plaintiff.

Inferiority of the defendant's goods.

It has long been settled that the question of the relative excellence of the plaintiff's and the defendant's goods is not relevant to the right of the plaintiff to maintain an action either for infringement or for "passing-off," [7] and this has, accordingly, no place in the above definition. It may, however, affect the amount of the damages to be recovered by the plaintiff if he succeeds, for damages are sometimes claimed and allowed in respect of injury occasioned to the trade reputation of the plaintiff by the defendant's infringement or fraud.[8] If the defendant's goods are as excellent as his own, the reputation of the plaintiff cannot have been injured by a substitution of one for the other.

Single act of infringement.

The Court has refused to regard an isolated act, done at the request of the plaintiff's agent, who was laying a trap for the defendant, as an infringement.[9] This must be taken as a special case,

[1] Page 390.

[2] Sec. 39, below, p. 392.

[3] Page 394.

[4] It is usually so expressed. What is meant is, of course, "similar to"; but "similar to" and "resembling" are constantly used to convey the proper meaning of the latter word; see *Welch* v. *Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

[5] Page 400.

[6] Page 404.

[7] *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833); *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; and see *per* Ld. Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 29.

[8] See, for instance, *Alexander* v. *Henry*, 12 R. P. C. 360 (1895), Kekewich, J.

[9] *Hennessy* v. *Kennett*, Seb. Dig. p. 331 (1877), Malins, V.-C.; cf. *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. 141 (1893), where a single instance of the sale of goods by the defendant's shopwoman, not shown to have been with his authority, was considered insufficient to support a case of passing-off; *Rutter* v. *Smith*, 18 R. P. C. 49 (1901), Kekewich, J.; and *Knight & Sons, Ltd.* v. *Crisp & Co., Ltd.*, 21 R. P. C. 671 (1904), Warrington, J., similar cases; and *Burberrys* v. *Watkinson*, 23 R. P. C. 141 (1906), Warrington, J., an isolated instance of mistake. See also *Carr & Sons* v. *Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), where Byrne, J., said that if one

however, for, in general, proof of a single act of infringement by the defendant is sufficient to justify the plaintiff in bringing his action,[1] and the evidence relied on is frequently the sale by the defendant of the spurious goods to the plaintiff or his agent, who has bought them merely for the purpose of procuring evidence.[2] Whenever trap orders are resorted to, they should be scrupulously fair.[3]

Employer responsible for servant's acts.

An employer will be held responsible for the wrongful acts of infringement or passing-off on the part of his servants done in the course of the employer's business and within the scope of his employment, notwithstanding that the acts were done without the employer's knowledge,[4] or even contrary to his express orders.[5]

Defendant must use or intend to use the marked goods for trading purposes.

The defendant must be shown to have used or intended to use the goods marked with the spurious mark for trading purposes, whether for sale or as samples to enable him to sell similar goods —and whether these are or are not themselves so marked—for the essence of the wrong is that purchasers of the spuriously

instance only had been proved he would have followed *Leahy* v. *Glover*; and *Kodak, Ltd.* v. *Greneille*, 25 R. P. C. 416 (1908), Eve, J., where the only question was as to costs. Cf. *Hennessy & Co.* v. *Neary*, 19 R. P. C. 36 (1902), Chatterton, V.-C., Ireland.

[1] See, for instance, *American Tobacco Co.* v. *Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218, where an injunction was granted but costs refused.

[2] *Dunlop Pneumatic Tyre Co.* v. *Neal*, [1899] 1 Ch. 807; 16 R. P. C. 247, North, J., a patent case, where the plaintiffs succeeded, although the only infringement proved was done for their agent.

[3] *Californian Fig Syrup Co.* v. *Taylor's Drug Co.*, 14 R. P. C. 564 (1897), C. A. Trap orders should, wherever possible, be in writing, and, whenever complete, some warning, by proceedings or otherwise, should as soon as possible be given to the defendant that the transactions are going to be called in question: *Carr & Sons* v. *Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), Byrne, J. And see *Burberrys* v. *Watkinson*, 23 R. P. C. 141 (1906), Warrington, J.

[4] *Tonge* v. *Ward*, 21 L. T. (N. S.) 430 (1869), Romilly, M.R.; *Twentsche* v. *Ellinger*, 26 W. R. 70 (1877), Malins, V.-C.; *Cusenier Fils* v. *Gaiety Bars and Restaurant Co., Ltd.*, 19 R. P. C. 357 (1902), Buckley, J.; *Hennessy & Co.* v. *Neary*, 19 R. P. C. 36 (1902), Chatterton, V.-C., Ireland.

[5] *Grierson; Oldham & Co.* v. *Birmingham Hotel Co., Ltd.*, 18 R. P. C. 158 (1901), Buckley, J. (*Big Tree Brand*); *Munro* v. *Hunter*, 21 R. P. C. 296 (1904), Channell, J. But in a Scotch case, *Montgomerie & Co., Ltd.* v. *Young*, 20 R. P. C. 781; 21 R. P. C. 285 (1904), Inner House, reversing Lord Ordinary, Ld. Young held that where a servant, either accidentally or otherwise, violates the express orders of her master not to commit a wrong of this nature, interdict ought not to be granted against the master. Ld. Trayner also held that in view of the precautions taken by the master, even if a few instances had arisen from inadvertence on the part of servants, an interdict should not be granted. The case was a somewhat special one, and a different view as to an employer's liability has been taken in the English cases. See *Parozone Co., Ltd.* v. *Gibson*, 21 R. P. C. 317 (1904), Ld. Low, Scotland; also above, p. 383, n. 2.

marked goods are deceived, and the plaintiff incidentally suffers by the loss of their custom which would or might, but for the fraud, come to him.[1] But the Court will not readily believe that the defendant does not intend to use vendible goods marked with the spurious mark for trading purposes if they are found in his possession, and either he is a trader in goods of the kind, or the quantity of the goods is considerable.[2] So where the defendant, a china manufacturer, had imported 5,000 spuriously marked cigars, he was held liable, although he did not know that the mark was spurious, and said that he intended the cigars "for family use." [2]

Infringement must be within the realm.

And the infringement must occur within the realm.[3] It is sufficient if the spuriously marked goods are brought by the defendant into this country for export to a country where the plaintiff's trade and marks are known,[4] and it is, of course, sufficient if goods are spuriously marked by him in this country for export.[5]

Whether infringement must be in plaintiff's market.

If the plaintiff's registered mark, or its essential particulars, are actually copied, it appears to be immaterial, in order to entitle the plaintiff to an injunction, whether the infringement takes place within the area in which the mark is known or not, because the exclusive right conferred by the Act extends, in the absence of any limitation on the Register, to the whole Kingdom.

If the case is one of colourable infringement, and the plaintiff's case is founded on the probability of deception in a particular market, the injunction granted might under special circumstances

[1] *Levy* v. *Walker*, 10 C. D. 436 (1879), C. A.; *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J.

[2] *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.

[3] Cf. the patent cases, *British Motor Syndicate* v. *Taylor*, [1900] 1 Ch. 577; [1901] 1 Ch. 122; 17 R. P. C. 189, 723, where goods were bought in England and sold abroad, with *Badische Fabrik* v. *Basle Chemical Works*, [1898] A. C. 200; 14 R. P. C. 919, where the defendants, who had effected a sale by post in Switzerland, and had despatched the goods addressed to an English trader from there, were held not to be liable. An English Court has no jurisdiction to prevent infringements which take place wholly abroad: *Morocco Bound Syndicate* v. *Harris*, [1895] 1 Ch. 534, Kekewich, J. (copyright); and see the patent case, *Badische Fabrik* v. *Hickson*, [1906] A. C. 419; 23 R. P. C. 433, where there was held to have been no vending in England.

[4] *Joseph Rodgers & Sons* v. *Rottgen*, 5 Times L. R. 678 (1889), Kay, J.; *Tm. of The Société, &c. des Verreries de l'Étoile*, [1894] 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A. (*Red Star Glass*).

[5] *Orr-Ewing* v. *Johnson*, 13 C. D. 434; 7 App. Ca. 219, is an illustration.

be limited to that market;[1] but, except in such cases, it is submitted that the question whether there is a probability of deception must be considered on the assumption of the defendant's mark coming into competition with the plaintiff's mark, and that the fact that the marks had hitherto been respectively confined to different districts within the jurisdiction would not be a defence in law. An injunction has been granted where the plaintiff's and the defendant's areas, though substantially local and distinct, were both within the realm and were beginning to overlap.[2]

Defendant must use the mark upon or in connection with the goods for which the plaintiff's right exists.

The use must be upon or in connection with the goods for which the plaintiff's right exists. The exclusive use conferred by sec. 39 is expressly so limited.[3] The authorities prior to the Act were to the same effect. "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract. Thus an ironfounder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed on cotton or woollen goods; for a trade mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity."[4] And the third essential ingredient for constituting an infringement, enumerated by Lord Westbury in *McAndrew* v. *Bassett*,[5] is "that the defendants have imitated the mark for the purpose[6] of passing in the market other articles of a similar description."

The limits of the class of goods over which the right in respect of a registered mark extends have been discussed already,[7] and the

[1] In "passing-off" cases where the plaintiff's mark has been used only in a limited area, he sometimes obtains an injunction restricted to such area. See next chapter, at p. 549. In the *Orr-Ewing* case, Cotton, L.J., thought that the injunction ought to have been limited to Eastern markets, had the defendants been trading in any others. It would rarely be practicable to give complete protection in such manner. See *Société* v. *de l'Étoile Tm.*, [1894] 1 Ch. 61, p. 67; 10 R. P. C. 441, Stirling, J.; and the observations of Kay, L.J., in the same case, during argument on appeal, 11 R. P. C. 145.

[2] *Paine & Co.* v. *Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, C. A. (*John Bull Beer*). The injunction was unlimited. In a passing-off case it is no defence that the plaintiff's trade in the defendant's market is small: *Grant* v. *Levitt*, 18 R. P. C. 361 (1901), Porter, M.R., Ireland (*Globe Furnishing Co.*); *Foulder & Co., Ltd.* v. *Rushton, Ltd.*, 20 R. P. C. 477, at pp. 484, 492, 494. And see Passing Off, Chap. XVI., pp. 491, 509.

[3] Above, p. 325.

[4] *Per* Ld. Westbury, in *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863).

[5] 4 De G. J. & S. 380; 33 L. J. Ch. 561 (1863).

[6] Fraudulent intent is not now essential, post, p. 401.

[7] Chap. V., p. 103, and Chap. XII., p. 321.

class has been shown to be not necessarily co-extensive with any register class,[1] and it has also been shown that the registered proprietor's right ought to be limited, and the registration restricted substantially to the kinds of goods upon which he actually uses or intends to use the mark,[2] and that the Court would probably refuse relief in respect of other goods.

and is registered.

The plaintiff cannot sue for infringement in respect of goods for which his mark is not registered,[3] although, if he can make a case, he may sue to restrain passing-off.

and used.

And if his mark is registered generally for a register class comprising a kind of goods for which he does not use it, or for which it is unsuitable, it is not to be considered as registered for such goods. Thus, the proprietor of a mark registered for class 45, "tobacco whether manufactured or unmanufactured," used it only for cut tobacco, and the mark contained the words *Three Crowns Mixture*. It was held that he could not sue to restrain an infringement in respect of cigars.[4] But in a recent case a label registered as an

[1] Marks may be calculated to deceive, though in different register classes, p. 227; *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A. (wines and spirits); *Eno* v. *Dunn*, 10 R. P. C. 261 (1893), Kekewich, J. (an aperient drink and baking powder); *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. (beer and rum). In some instances the Courts have interfered to prevent a defendant using or imitating the trade name of a well-known firm with the object of fraudulently suggesting that he has a connection of some sort with the firm, even where the defendant's trade is different from that of the firm, but the difference is not so great as to make the success of the fraudulent suggestion very improbable. *Eastman Co.* v. *John Griffiths Cycle Corporation*, 15 R. P. C. 105 (photographic materials and cycles); *Dunlop Pneumatic Tyre Co.* v. *Dunlop Lubricant Co.*, 16 R. P. C. 12, both 1898, Romer, J. (cycle tyres, &c., and cycle lubricants); *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ltd.*, 17 R. P. C. 673, C. A., overruling 17 R. P. C. 1 (1900), Stirling, J. (meat extract for food and for medicinal purposes); and *Walter* v. *Ashton*, [1902] 2 Ch. 282, Byrne, J. ("*Times*" *cycles*). In *Lucas, Ltd.* v. *Falcy Automobile Co., Ltd.*, 23 R. P. C. 33 (1906), Warrington, J. (cycle and motor accessories and motor tyres), and in *Dunlop Pneumatic Tyre Co., Ltd.* v. *Dunlop Motor Co., Ltd.*, 23 R. P. C. 761, 24 R. P. C. 572 (1907), H. of L. (tyres and cycle and motor repairs) the similarity of the businesses was held not to be so close as to make deception or confusion probable.

[2] *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C.A., cited p. 104. In this case the goods were substantially different, as pointed out in *Boord & Son* v. *Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J., where it was held that an old mark used before 1875 for gin, but not sloe gin, might be extended to sloe gin, and, being registered so as to cover it, was held to be infringed. See also *Finlay* v. *Shamrock Co.*, 22 R. P. C. 307, Porter, M.R., Ireland.

[3] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

[4] *Hargreaves* v. *Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; and see *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J. A person who does not use the mark at all cannot sue: last case, and *Delondre* v. *Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.

old mark for fermented liquors and spirits, including liqueurs, was held to be infringed by a label used for sloe gin, although the registered label contained the words "Cordial Old Tom," which were not used on the mark when employed by the plaintiffs for sloe gin.[1]

The infringement must be in respect of spurious goods.

Further, the use of the defendant's mark, which is relied on as an infringement, must be a use upon goods which are not the genuine goods—*i.e.*, those upon which the plaintiff's mark is properly used—for anyone may use the plaintiff's mark on the plaintiff's goods, since that cannot cause the deception which is the test of infringement.[2] So the retailer of goods obtained from the plaintiff may lawfully place or renew[3] the proper labels upon them, and may have sufficient labels printed for the purpose.[4] In the case last cited, the defendant failed to satisfy the jury, in an action at common law, that he had in fact printed the labels only for use on the genuine goods of the plaintiff; and the injunction, which had been granted in a suit in Chancery by Wood, V.-C., and dissolved on appeal by Cranworth, L.C., was accordingly restored.[5] The rule just stated is well illustrated by *The Angostura Bitters* case, where the injunction granted was so expressed as not to prevent the name being applied to an article identical with the plaintiff's, should any other person discover the secret of manufacture and make the goods.[6]

Adulterations, inferior qualities, and goods comprising authentic parts.

But goods of the plaintiff, adulterated by some other person,[7] are not goods on which the mark may lawfully be placed; nor may a mark used by the owner to denote one quality of his goods be put on goods of such owner of an inferior quality;[8] nor is the manufacture by the defendant of an article made up of several parts the less an infringement because one genuine part of

[1] *Board & Son* v. *Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J.

[2] Chap. II., p. 33.

[3] *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

[4] *Farina* v. *Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855).

[5] 4 K. & J. 650 (1850).

[6] *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J. In *The Yorkshire Relish* case (next chapter, p. 512) the defendant's sauce differed from the plaintiffs' by a "pinch of salt," but if the two had been indistinguishable the name would still (according to the evidence) have meant the latter only.

[7] *Condy* v. *Taylor*, 53 L. T. 891 (1887), Kekewich, J.

[8] *Jameson & Son, Ltd.* v. *Clarke*, 19 R. P. C. 255 (1902), Chatterton, V.-C., Ireland; *Teacher* v. *Levy*, 23 R. P. C. 117 (1906), Swinfen Eady, J.; *Palestine Wine and Trading Co., Ltd.* v. *Cohen*, 23 R. P. C. 568 (1906), Warrington, J., and see *Moseley & Sons, Ltd.* v. *Nathan & Co.*, 23 R. P. C. 345 (1906), Warrington, J. These, however, all seem to have been passing-off cases.

the plaintiff's manufacture, and bearing his mark, is included in it.[1]

What connection with the spurious goods is sufficient.

It is not necessary that the spurious mark should be actually affixed to the goods, provided it is so used in connection with them as to be calculated to cause them to be taken for the plaintiff's goods.[2] Use on the wrapper in which they are sold, or upon a slip placed in the package with them, or on a show-card to which the goods are attached,[3] or in circulars or advertisements offering them for sale is sufficient.[2] So printing the plaintiff's trade mark labels, without showing that they were for use on genuine goods only,[4] or using the plaintiff's marked or stamped bottles,[5] casks,[6] or boxes[7] for goods other than his genuine goods, is an infringement, unless the Court is satisfied that the use under the circumstances is not calculated to deceive.[8]

Before the Act of 1905 it was to some extent doubtful whether there could be infringement by the verbal use of a trade mark, or by its use otherwise than in some physical connection with the goods. The use of a descriptive word registered as an old trade mark, not in connection with the goods, but only in price lists referring to them, was held to be no infringement.[9] But on the other hand, in *Jay* v. *Ladler*,[10] a circular was held to be an infringement of a trade mark, and in a more recent case Farwell, J., after considering the case last mentioned, and referring to an argument that the use by the defendants of the alleged infringing device as an embellishment in advertisements and circulars, and other

[1] *Richards* v. *Williamson*, 30 L. T. (N. S.) 746 (1874). Bacon, V.-C., a gun with stamped lock.

[2] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

[3] *Chameleon Patents, &c. Co.* v. *Marshalls*, 17 R. P. C. 517 (1900), Kekewich, J. (passing-off).

[4] *Farina* v. *Silverlock*, p. 394, note (4); *Guinness* v. *Ullmer*, 10 L. T. (O. S.) 127 (1847), Shadwell, V.-C.; *Jameson & Son, Ltd.* v. *Johnston & Co., Ltd.*, 18 R. P. C. 259 (1901); *Kuyper & Son* v. *Baird, Ltd.*, 20 R. P. C. 581, both Porter, M.R., Ireland.

[5] *Rose* v. *Henley*, 47 L. J. Ch. 577 (1877), Malins, V.-C.; *Rose* v. *Loftus*, *ibid.* Filling syphons marked with the plaintiff's trade mark and sending them out to be resold held to be an infringement: *Barr & Co.* v. *Mair*, 21 R. P. C. 665 (1904), Ld. Kyllachy, Scotland. See also *Thwaites & Co.* v. *McEvilly*, 21 R. P. C. 397, C. A. Ireland; and cf. *Woolley & Son* v. *Morrison*, 21 R. P. C. 63, Ld. Kyllachy, Lord Ordinary.

[6] *Hennessy* v. *Cooper*, Seb. Dig. p. 327 (1877), Malins, V.-C.

[7] *Barnett* v. *Leuchars*, 13 L. T. (N. S.) 405 (1865), Stuart, V.-C.

[8] As in *Welch* v. *Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

[9] *Talbot* v. *Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Baffle*, for safes); cf. "Singer system," in *Singer* v. *Looy*, 8 App. Ca. 15 (1882), and above, p. 39.

[10] 40 C. D. 649; 6 R. P. C. (1889), Kekewich, J.

ways, was not infringement, said that he did not think it was necessary that the mark should be used by the defendants as a trade mark, but that the mode of use was an element to be considered, and he held that there was in fact no infringement.[1] The question was also discussed in the Court of Appeal with reference to a pictorial poster.[2]

In a case in which all that the defendants had done was to supply their goods in response to written orders for "Rugby" cement, that word being a prominent part of the trade mark, Vaughan Williams, J., said: "I am, for my own part, not at all sure that you can prove an infringement of a trade mark without proving that the defendants have imitated the plaintiff's trade mark upon something capable of receiving the impression of the mark. Either the material itself, or the paper which is used, or the sacks, or bags, or boxes, or whatever it is that the material is put into, I should have thought must have been imitated to constitute an infringement of a trade mark."[3] The question actually decided in the case was that the sale of goods by the descriptive name *Rugby Cement* was not an infringement of a trade mark comprising those words. In one case in Scotland the use of the plaintiff's trade mark by application by word of mouth to articles sold was held to be an infringement.[4]

The abstract question was, however, of little or no importance, since, in the case put, the use of the word mark by the defendant, in any manner calculated to deceive, could be restrained in a "passing-off" action. "It will be observed," Fry, J., said, in *The Linoleum* case,[5] "that the inquiry with regard to the use of the word *Linoleum* as a constituent element in the trade mark,

[1] *Bourne* v. *Swan & Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105.

[2] *Price's Patent Candle Co., Ltd.* v. *Joyes' Sanitary Compounds Co.*, 19 R. P. C. 17 (1901). In *Bass, Ratcliff & Gretton, Ltd.* v. *Davenport & Sons' Brewery, Ltd.*, Kekewich, J., considered, as a question of infringement of trade mark, the question whether a show-card intringed the plaintiffs' rights.

[3] *Rugby Portland Cement Co., Ltd.* v. *Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; affirmed on appeal, 9 R. P. C. 46 (1891).

[4] *Montgomerie & Co., Ltd.* v. *Young*, 20 R. P. C. 781 (1903), Ld. Kyllachy; on appeal the decision was reversed on other grounds, 21 R. P. C. 285 (1901). In *Kodak, Ltd.* v. *London Stereoscopic Co.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., it was practically admitted by the defendants' counsel that their use of the plaintiffs' trade marks in invoices was an infringement, and an injunction against infringement of trade mark was granted. Under the Merchandise Marks Act, 1887, a description in an invoice sent with goods has been held to be "applied to goods" within sec. 5 (*d*): *Budd* v. *Lucas*, [1891] 1 Q. B. 408, Pollock and Charles, JJ.

[5] *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D., p. 836 (1878).

and the inquiry as to the use of the word *Linoleum* as a misrepresentation, are one and the same inquiry, and I must consider what the word *Linoleum* meant as used at the time when the defendants intended to attribute it to their manufacture."

By sec. 39 of the Act of 1905 the exclusive right conferred on the registered proprietor of a trade mark is "to the use of such trade mark upon or in connection with the goods in respect of which it is registered." And this accords with the statutory definition of a trade mark.[1] It is submitted that the words quoted are sufficiently wide to cover any such use as indicates, or purports to indicate, the proprietorship of the goods, whether the mark is attached to the goods, or used in invoices, trade descriptions, or as a trade name of the goods.[2]

The infringing mark may either (*a*) be an actual or substantial copy of the plaintiff's mark; (*b*) consist of or comprise its essential features; or (*c*) be a colourable imitation of it.[3]

Where the plaintiff's mark has been copied.

(*a*) The first case presents no difficulties. By sec. 40, the registration of the plaintiff as proprietor of the trade mark is *primâ facie* evidence of the validity of the registration,[4] and, after the period of seven years mentioned in sec. 41 and subject to certain exceptions, conclusive evidence of his right to the exclusive use of the trade mark.[5] The registered proprietor can therefore make a case in an action for the mere using of his mark in connection with goods of the class over which his right extends, without showing that the use is calculated to deceive.[6] And this is not, substantially, an alteration of the law as it stood before the Acts[7] if registration be taken as equivalent to public user,[8] although proof of the probability of deception was usually, but not invariably,[9] mentioned as an element of right of action;

[1] Sec. 3.

[2] See, however, the judgment of Warrington, J., in *Peters, Ltd.* v. *Domestic Inventions Co.*, 25 R. P. C. 387 (1908), above, p. 31, note (1). See also above, p. 328.

[3] It will be seen that (*b*) and (*c*) are not distinct cases, although they are separated for convenience in the text. The test of infringement is the same in each (p. 400). In case (*b*) the whole mark must be infringed, and in case (*c*) essential features are necessarily imitated or copied.

[4] Above, p. 329.

[5] This is the effect of secs. 39 and 41 combined. The exceptions are dealt with above, p. 332.

[6] See the judgment of Cotton, L.J., in *Edwards* v. *Dennis*, 30 C. D. 454 (1885), and *Lambert* v. *Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.

[7] Cf. with the judgment last referred to that of Hall, V.-C., in *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874).

[8] See sec. 75 of the Act of 1883, p. 632.

[9] For instance, see the judgments of Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. p. 442 (1875), and of Ld. Cranworth in *The Leather Cloth* case, 11 H. L. C. p. 533; 35 L. J. Ch. 53 (1865).

for if the defendant had taken a "material and substantial" portion of the plaintiff's mark, and, *à fortiori*, if he had taken the whole, the onus of showing that his conduct was not calculated to deceive was cast upon him,[1] and it was practically, at any rate, impossible for him to support it. Moreover, unless he could give a reasonable explanation to show how he came to adopt a mark identical with that of the plaintiff, the Court would infer that he intended to deceive,[2] and would not consider whether or not his attempt was likely to be successful.[3]

False claim to the plaintiff's registered marks.

The infringement proved in *Paine & Co.* v. *Daniells & Sons' Breweries*[4] was effected in a very unusual way. The plaintiffs' marks consisted of labels bearing a figure of John Bull, and the words *John Bull* and *John Bull Brand*. The defendants used a label bearing a different figure of John Bull, with the words *John Bull, Registered*. Their label, though entered as their copyright at Stationers' Hall, had been, in 1885, refused registration as a trade mark, on the ground of the plaintiffs' opposition, but they had, notwithstanding the refusal, continued to use it in their business. Although the labels had been in use so long, no evidence of actual deception was tendered, for the trades of the plaintiffs and defendants had been carried on in different districts, and were only beginning to overlap at one point at the date of the trial. There was no other evidence than that furnished by the labels themselves that the defendants' label was calculated to deceive; but the Court of Appeal regarded the false claim of registration in their label as amounting in effect to a representation that the plaintiffs' marks—the only John Bull marks which really were registered—were their own, and this was held to be an undoubted infringement;[5] and in a later case the use of the word "registered" on the label complained of, registration of which had been refused, was held to be a disparagement of the plaintiffs' mark as registered, and to be an

[1] *Ford* v. *Foster*, 7 Ch. 611 (1872), James, L.J.; *Orr-Ewing* v. *Johnston*, 13 C. D. 434 (1879), Fry, J., and C. A. See also Ld. Herschell in *Reddaway* v. *Banham*, 13 R. P. C. at p. 228.

[2] See *The Orr-Ewing* case, in the H. L., 7 App. Ca. 219; *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.

[3] See *per* Lindley, L.J., in *Slazenger* v. *Feltham*, 6 R. P. C. p. 538 (1889). See, however, *Lever* v. *Bedingfield*, cited below, p. 399, note (3).

[4] [1892] 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

[5] *Lawrie* v. *Baker*, 2 R. P. C. 213 (1885), Day, J., is a similar case. There the defendant described his goods as *patent cups*, the plaintiff having the only patent. Cf. *Pneumatic Stamp Co.* v. *Lindner*, 15 R. P. C. 525.

element tending to show want of good faith in the manufacturers who issued the label.[1]

(*b*) The right of the registered proprietor exists in regard to the whole mark, not in regard to any particular part of it,[2] and an infringement must be an infringement of the whole mark.[3] "It is established by the history of the defendant's label and by comparing it with the plaintiffs' label of 1894, that the central space and curved scroll on the plaintiffs' label have been utilised, and to some extent copied, by the person employed by the defendant to prepare his label. If, notwithstanding this circumstance, the defendant's label as a whole is not a copy of the plaintiffs' labels, and is not as a whole a colourable imitation of them, it cannot be truly said that the defendant has infringed the rights conferred upon the plaintiffs by the registration of their marks."[4] But the adoption of a single characteristic and distinctive particular from the plaintiff's mark, and its use alone, or with other matter, may well be an infringement of the entire mark. At any rate, it throws upon the defendant the onus of proving the contrary.[5] But it is not an infringement to take non-essential particulars from a mark: for instance, to take merely descriptive or other common words[6] or common matter.[7] In

Where an essential feature has been copied.

[1] *Boord & Son* v. *Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J. See also *Finlay* v. *Shamrock Co.*, 22 R. P. C. 301, Porter, M.R., Ireland. Cf. *Warsop & Sons, Ltd.* v. *Warsop*, 21 R. P. C. 481 (1904), Kekewich, J., where the defendant's use of "registered" was as between him and the plaintiffs innocent.

[2] *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), Cotton, L.J.; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), C. A.

[3] *Lever* v. *Bedingfield*, 16 R. P. C. 3, at p. 10 (1899) (*Sunlight and Redmaid Soaps*); so *Rugby Cement Co.* v. *Rugby and Newbold Co.*, note (6), and *Hennessy & Co.* v. *Dompé*, 19 R. P. C. 333 (1902), Kekewich, J.; on appeal, in this case, however, the defendants admitted that they had infringed by the use of the labels complained of, 20 R. P. C. 175.

[4] Per Lindley, M.R., in *Lever* v. *Bedingfield*, note (3).

[5] *Ford* v. *Foster*, 7 Ch. 611 (1872), James, L.J.; *Johnston* v. *Orr-Ewing*, 13 C. D. 434 (1879), Fry, J., and C. A. See *Finlay* v. *Shamrock*, 22 R. P. C. 301 (1904), Porter, M.R., Ireland, where, the plaintiff being registered for a shamrock leaf, the defendants had taken the top leaf only of the trefoil, but used it in connection with the word "shamrock." This was held to be an undoubted infringement.

[6] *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J. (*Linoleum*); *Watt* v. *O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M.R. (*Old Innishowen*); *Humphries* v. *Taylor's Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); *Native Guano Co.* v. *Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L. (*Native Guano*); *Rugby Cement Co.* v. *Rugby and Newbold Co., Ltd.*, 8 R. P. C. 241: 9 R. P. C. 46 (1891), Vaughan Williams, J., and C. A.; cf. Chap. X., p. 252: and *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J. See, further, next chapter, p. 507.

[7] See *Hennessy* v. *Dompé*, 19 R. P. C. 333 (1902), Kekewich, J. (reversed by consent on appeal), 20 R. P. C. 175; and *Hennessy* v. *Keating*, 25 R. P. C. 125 and 361 (1908), C. A., Ireland, and H. of L.

particular, it is provided by sec. 44 of the Act of 1905 that no registration 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 the goods. By sec. 48 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.

Usages of the trade.

Where there is a colourable imitation.

(c) A colourable imitation is the most common case, for, if the resemblance is intended, the defendant will have tried to introduce apparent differences sufficient to prevent the Court from interfering, while preserving a likeness which is near enough to enable him to profit by the reputation of the plaintiff's mark. So far as the Court succeeds in carrying into effect the principles which govern its interference, the two ends are inconsistent with each other.

Colourable Imitation.

The test of infringement

In both the second and third cases the test of infringement is the question whether or not the defendant's mark is calculated to cause his goods to be taken by ordinary purchasers[1] for the goods of the plaintiff,[2] and the Registration Acts have made no alteration of the law in this respect.[3]

"It is not a question whether this (the use of the defendant's mark) necessarily is deceptive, but whether there is not a strong probability of its causing deception."[4] So that the imitation of the plaintiff's mark cannot be justified by showing either that the device or inscription on the imitated mark is ambiguous, and capable of being understood by different persons in different

[1] See above, p. 236.

[2] *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.: *Leather Cloth Co., Ltd.* v. *The American Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury, L.C.; 11 H. L. C. 523; 35 L. J. Ch. 53. The suggestion in the Scotch case of *Crawford* v. *Bernard*, 11 R. P. C. 580 (1894), Ld. Kyllachy, that colourable infringement can be judged of apart from probability of deception, is not in accordance with the authorities.

[3] *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Singer Manufacturing Co.* v. *Loog*, 18 C. D. 395, C. A.; 8 App. Ca. 15 (1870); *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Cotton, L.J.; *Lever* v. *Bedingfield*, p. 399, note (3). *Lambert & Butler, Ltd.* v. *Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.

[4] *Per* Cotton, L.J., in *The Upper Assam Tea Co.* v. *Herbert & Co.*, 7 R. P. C. p. 186 (1889).

ways, or that a person who carefully and intelligently examined and studied it might not be misled.[1]

There can be no infringement, therefore, in cases where the plaintiff's mark is not actually copied, if there is no reasonable probability of deception.[2] It was held by the Court of Common Pleas, as early as 1847, that the following questions were properly left to the jury by Williams, J., in *Rodgers* v. *Nowill*[3]:— (1) Whether there was such a resemblance to the plaintiffs' marks, in the marks put on the knives made by the defendants, as was calculated to make an ordinary person believe that the marks were the marks of the plaintiffs, denoting that the knives were the knives of the plaintiffs? and (2) Did the defendants, with an intention to deceive, sell these knives representing them to be the manufacture of the plaintiffs? It will be shown immediately that, if the plaintiffs' mark was their trade mark, the second question has long been held to be immaterial, except so far as it dealt with the mere fact of the sale of the knives.

Questions for the jury.

The same test, as will be shown in the next chapter, applies also to actions for "passing-off." It is sometimes suggested that a less degree of resemblance between the plaintiff's and defendant's marks will suffice to support an action for "passing-off" than is required to support an action for infringement, or, what is the same thing, proof of a lower degree of probability of deception. This distinction is, it is submitted, unnecessary and inconvenient. In the cases before the Acts, when the two classes of actions were not yet separated, there could have been no ground for it, and there is nothing in the Acts to require its introduction. The essential difference is plain enough. In an infringement action the plaintiff can rely only upon the imitation of his registered mark, while in an action for "passing-off" he may rely on other things, or on additional things, which are proved to be connected with his trade or goods.

Actions for infringement and for passing-off.

Proof of actual deception, if the mark is, in the opinion of the Court, calculated to deceive, or if the plaintiff's registered mark

Actual deception need not be proved:

[1] Per Ld. Selborne in *The Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 18 (1882).

[2] *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Beddow & Sons* v. *Boyd*, 4 R. P. C. 310 (1887), Chatterton, V.-C.; see also *Woollam* v. *Radcliff*, 1 H. & M. 259 (1863), Wood, V.-C.; *Bradbury* v. *Becton*, 39 L. J. Ch. 57 (1869), Malins, V.-C.; *Civil Service Supply Association* v. *Dean*, 13 C. D. 512 (1879), Malins, V.-C.; and *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., in all of which an injunction was refused.

[3] 5 C. B. 109; 17 L. J. C. P. 52.

has been substantially copied,[1] is unnecessary, although the absence of it, where the plaintiff's and defendant's marks have circulated side by side for a considerable time, may go far to negative the probability of deception, unless it is explained, for instance, by the practical impossibility of calling evidence from a distant country to show that purchasers there have been deceived.[2] The plaintiff is not bound to wait to see whether his customers will, in fact, be deceived, for "the very life of a trade mark depends upon the promptitude with which it is vindicated."[3]

nor yet an intention to deceive.

Nor where the defendant's mark has in fact deceived, or is, in the opinion of the Court, calculated to do so, is it necessary to show that the defendant intended to deceive. This was first decided by Lord Cottenham, in *Millington* v. *Fox*,[4] as regards the relief by an injunction, and by Lord Westbury, in *Edelsten* v. *Edelsten*,[5] as regards both injunction and account. It is now well-settled law.[6] The dicta of Lord Chelmsford in *The Glenfield Starch* case, that, where the trade mark is not actually copied, fraud is a necessary element in the plaintiff's case—"that is, the party accused of piracy must be proved to have done the act complained of with the fraudulent design of passing off his own goods as those of the party exclusively entitled to the trade mark"[7]—and of Jessel, M.R., and the Court of Appeal, in *The Singer Manufacturing Co.* v. *Wilson*,[8] that, where the defendant has not actually put the plaintiff's trade mark, or a colourable imitation of it, on his goods, or on the bottles or boxes containing them, but has otherwise acted so as to represent his goods as those of the plaintiff,[9] a fraudulent intent must be proved, cannot now be taken to be law. In the former case,

[1] Above, p. 397; and see *Paine & Co.* v. *Daniells & Sons' Breweries*, cited ante, p. 398.

[2] Page 259; and see *Lambert and Butler, Ltd.* v. *Goodbody*, 19 R. P. C. 377 (1902); *Bourne* v. *Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), both Farwell, J., and *Iron Ox Remedy Co.* v. *Co-operative Wholesale Society, Ltd.*, 24 R. P. C. 425 (1907), Parker, J., a passing-off case.

[3] *Johnston* v. *Orr-Ewing*, per James, L.J., 13 C. D. p. 464; and Ld. Blackburn, 7 App. Ca. p. 230 (1880).

[4] 3 My. & Cr. 338 (1838).

[5] 1 De G. J. & S. 185; 10 L. T. N. S. 780 (1863).

[6] *Reddaway* v. *Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882); *Powell* v. *Birmingham Vinegar Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235, in the C. A. As to damages at law, see the first-mentioned case.

[7] *Wotherspoon* v. *Currie*, L. R. 5 H. L. p. 519 (1872).

[8] 2 C. D. 432 (1875).

[9] As already shown, these may be cases of infringement if the representation is effected by using a mark in connection with the defendant's goods (though not on them) which resembles the plaintiff's mark, or by using a distinctive name taken from the plaintiff's mark; above, p. 395.

Lord Hatherley said it had been pointed out that a *mala fides* towards the first purchaser was not the ground of the Court's interference; for it is sufficient if such purchaser is furnished by the defendant with goods bearing a label, of which the necessary consequence is that he is enabled to deceive others by means of them.[1] And in *The Singer* case Lord Cairns said: "I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade mark";[2] and in this Lord O'Hagan concurred.[3] Lord Blackburn said: "I am not as yet prepared to assent either to the position that there is a right of property in a name, or, what seems to me nearly the same thing, to assent to its full extent to the proposition that it is not necessary" (in trade name cases) "to prove fraud."[4] But the last-mentioned judge, in a subsequent case, stated that he thought it clear, at any rate, that if the defendant persevered in using a trade mark calculated to deceive after notice of the facts, that would be evidence to support a claim for damages for knowingly selling his goods as and for those of the plaintiff.[5] "However honest or inadvertent the original mistake may have been, the continuation of the use of it after that was pointed out is of itself evidence of a fraudulent intention."[6]

And it has already been shown that the proprietor of a trade mark may obtain an injunction against an innocent consignee of spuriously marked goods, and an order for the spurious marks to be expunged from the goods, without having given the defendant any notice before the commencement of the action.[7]

On the other hand, the mere intention of the defendant to deceive, if the Court is clearly of opinion that the mark complained of is not calculated to deceive, cannot constitute an infringement;[8] but if there be an intention to deceive, success will easily be presumed.[9]

What resemblance is calculated to deceive.

It follows that the question to be answered, when an infringe-

[1] L. R. 5 H. L. p. 517.

[2] 3 App. Ca. p. 391, quoted and adopted in *Bodega Co., Ltd.* v. *Orens*, 7 R. P. C. 31 (1889), Chatterton, V.-C.

[3] 3 App. Ca. 396.

[4] Page 400.

[5] *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. 31 (1882); and *Cochrane* v. *McNish*, [1896] A. C. 225; 13 R. P. C. 100. Privy Council.

[6] Per James, L.J., in *Orr-Ewing* v. *Johnston*, 13 C. D. p. 454 (1880); see also *Paine & Co.* v. *Daniells & Sons Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A., cited above, p. 398.

[7] Above, p. 382; *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.; *American Tobacco Co.* v. *Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

[8] See next chapter, p. 523.

ment without taking the actual mark is alleged, is the same question as arises when a mark tendered for registration is objected to, or, having been registered, is sought to be removed from the Register, on the ground that it so nearly resembles a trade mark already on the Register as to be calculated to deceive, within the restriction of sec. 19. The principles governing the comparison of the marks, and determining what amount of resemblance is calculated to deceive, are the same in both cases, although a higher standard of resemblance must be conformed to in an action for infringement than that set up in cases of the other class. These principles have been already discussed at length,[1] and it will therefore be sufficient in this place to shortly summarise the conclusions deduced from an examination of the authorities.

The probable purchasers are to be considered.

(1) The persons with regard to whom the test question—Is the spurious mark calculated to deceive them?—ought to be asked are the persons who are probable purchasers, whether they buy, or are likely to buy, directly from the plaintiff or defendant, or from, or through, intermediate purchasers from either of them, and whether they are English or foreign, and not merely very careful or intelligent persons, but ordinary unwary purchasers.[2] No rule has, or probably can be, laid down as to what amount of intelligence or knowledge of the trade in question ought to be attributed to them, since this must necessarily vary with the nature of the case.[3]

The net impressions left by the marks are to be contrasted.

(2) No definite rule as to the amount of resemblance required can be formulated *à priori*, but the net impression produced and "the main idea left on the mind" by one mark must be compared with that left by the other, for marks may well be confused by purchasers, who see the defendant's mark when they have present in their memories only an indefinite recollection of the plaintiff's, in cases where the marks could not be mistaken for each other if they were seen side by side.[4] So that the whole mark of the defendant may too nearly resemble that of the plaintiff, although all the essential particulars of the two are distinguishable;[5] but

[1] Chap. X., pp. 231 *et seq.*

[2] Page 235; and *Shrimpton* v. *Laught*, 18 Beav. 164 (1854), Romilly, M.R. As to infringements alleged to be instruments of fraud in the hands of retailers, see below, p. 408.

[3] See the "passing-off" cases, *Payton* v. *Snelling*, 17 R. P. C. 48; and *Payton* v. *Titus Ward*, *ibid.* 58 (both 1899, C. A., and above, p. 236). The first-mentioned decision was affirmed in the H. of L., 17 R. P. C. 628.

[4] Page 237.

[5] Page 240.

special regard must, nevertheless, be paid to the essential features of the plaintiff's mark in considering whether the defendant has infringed it.[1]

(3) Further, the marks must be compared as they are seen in actual ordinary use[2] on the goods they are used for; remembering, however, that so far as the plaintiff's mark substantially differs from the mark on the Register it is an unregistered mark.[3]

The marks are to be considered as seen in ordinary use.

(4) The circumstances of the trade[4] and market in which the marks are used must be considered also,—the language of the purchasers, for instance, and the number of analogous marks in use in connection with the same goods.[5] Section 43 of the Act of 1905 provides that 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. Where the defendant's mark is identical with or substantially the same as the plaintiff's registered trade mark, the similarity or dissimilarity of the get-up of the respective goods can have little, if any, bearing on the question of infringement;[6] but where there is no such close resemblance, the get-up of the goods may become a material factor. Thus in a passing-off case where it was alleged that the defendants' "Ivory" soap was calculated to deceive on account of its similarity to the plaintiffs' "Ivy" soap, and there was no similarity in the get-up of the goods, the action and an appeal by the plaintiffs were dismissed.[7]

Regard is to be paid to all the circumstances surrounding the marks in use.

Usages of the trade.

Also the distinctiveness or degree of distinctiveness of a trade mark may be affected by other trade marks used by rival traders. Thus the owner of a registered trade mark consisting of a star might be prevented from claiming the exclusive right to use such a device generally by the existence of other star trade marks, but might at the same time have a perfectly good right to protect his special form of star.[8]

[1] Pages 237 and 246; and cases in note (3), p. 404: also *Hubbuck* v. *Brown*, 17 R. P. C. 148 and 638 (1900), Kekewich, J., and C. A., and *Marshall* v. *Sidebotham*, 18 R. P. C. 43 (1901), Kekewich, J.

[2] Page 244.

[3] Page 246.

[4] [illegible] v. *McNish*, [1896] A. C. 225 [illegible] P. C. 100, P. C. (*Club Soda*).

[5] [illegible].

[6] *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A.

[7] *Goudrin* v. *Ivory Soap Co.*, 17 R. P. C. 689; 18 R. P. C. 389 (1901), Kekewich, J., and C. A.

[8] See *Wills' Tms.*, 10 R. P. C. 269 (1893), Wright, J.: *Bass, Ratcliff and Gretton, Ltd.'s Tms.*, 19 R. P. C. 129 and 529 (1902), C. A., reversing Kekewich, J. and *Star Cycle Co., Ltd.* v. *Frankenburg*,

Colour.

But, since colour is not admitted to consideration in estimating the distinctiveness of a mark tendered for registration, unless the mark be limited in whole or in part to one or more specified colours,[1] similarity of colour is not to be greatly relied upon in deciding a question of infringement,[2] although it is an element to be considered. If a trade mark is registered with a limitation to a certain colour or to certain colours, there could be no infringement by the use in other colours, for by sec. 39 the exclusive use is only conferred subject to the limitation, but a case of passing-off might be established.

And, in particular, to the adoption of a special name for goods bearing the plaintiff's mark.

If the plaintiff's mark, or some feature of it, has led to the application of a particular name to his goods, it is an infringement for the defendant to use a mark which is calculated to cause the same name to be applied to his,[3] unless the name is applied not merely to the plaintiff's goods, but to all goods of the kind,[4] for instance, because it is suggested by matter in the mark which is common to the trade;[5] and the defendant's use of his mark is none the less an infringement of the plaintiff's rights because the exclusive use of the name may give the plaintiff a practical monopoly in certain goods in a particular market.[6]

What importance is to be attached to differences between the marks.

Attention must be paid, of course, not only to the points of resemblance between the marks, but also to the points of difference. But it will not be sufficient for the defendant to show that the differences might prevent purchasers being deceived. If there is a case for him to answer, the Court must hold that they are "such as to prevent its being likely that they would be deceived."[7]

Instances of infringements by marks

In the following cases it was held that the use of words taken from the plaintiff's mark by the defendant was an infringement,

24 R. P. C. 46 and 405 (1907), Swinfen Eady, J., and C. A., a passing-off case in which, the plaintiffs having at a certain stage in the case claimed the word "Star" in any combination, evidence was admitted of users by other persons of such combinations as "Eastern Star."

[1] Sec. 10. *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., at p. 209.

[2] *Nuttall* v. *Vining*, 28 W. R. 32 (1880), C. A. If, and so far as, a trade mark is registered without limitation of colour, it is to be deemed to be registered for all colours, sec. 10. Colour is often of great importance in a case of "get up." See the next chapter.

[3] Page 250 *et seq.* This appears to have been treated rather as "passing-off" than infringement by Romer, J., in *Hodgson* v. *Kynoch*, 15 R. P. C. 465, at p. 477 (1898).

[4] Page 252.

[5] Page 254. See note (3), p. 404, above.

[6] Page 255. See *The Yorkshire Relish* case, cited below, p. 513.

[7] Per Ld. Blackburn, in *Johnston* v. *Orr-Ewing*, 7 App. Ca. p. 230 (1882), quoted and followed by the Privy Council in *Somerville* v. *Schembri*, 12 App. Ca. p. 458; 4 R. P. C. 170 (1887). Cf. p. 407, note (2).

notwithstanding that he always added his own name:—*Perry* v. *Truefitt*, 6 Beav. 66, PERRY'S MEDICATED MEXICAN BALM, TRUEFITT'S MEDICATED MEXICAN BALM; *Braham* v. *Bustard*, 1 H. & M. 477, BUSTARD & Co.'s EXCELSIOR WHITE SOFT SOAP; *Kinahan* v. *Bolton*, 15 Ir. Ch. 75, KINAHAN'S LL WHISKY, BOLTON'S LL WHISKY; *Ford* v. *Foster*,[1] L. R. 7 Ch. 611, FORD'S EUREKA SHIRTS, FOSTER, PORTER & Co.'s IMPROVED EUREKA SHIRTS; *Eno* v. *Stephens*, Seb. Dig. p. 372; *Eno* v. *Dunn*, 10 R. P. C. 261, ENO'S FRUIT SALT, STEPHENS & Co.'s EFFERVESCING VINOUS FRUIT SALTS; DUNN'S FRUIT SALT AND CHLORATE OF POTASH LOZENGES. In *The Glenfield Starch* case,[2] *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508, the defendant's own name appeared in bold letters upon the infringing labels, and this was also the case in *Johnston* v. *Orr-Ewing*, 13 C. D. 434, and 7 App. Ca. 219, but there the Indian customers of the plaintiff could not, it was assumed, read English.[3] So, in *Rose* v. *Loftus*, 47 L. J. Ch. 576, the defendant washed the plaintiff's labels off the bottles, leaving only the moulded marks, and pasted his own labels upon the bottles in their place, but was, nevertheless, held to have committed an infringement. And in *Curtis and Harvey* v. *Pape*, 5 R. P. C. 1[illegible]n imitation of a diamond mark was held to be an infringement, although the defendant put a K in the middle of his diamond which did not appear in that of the plaintiffs.

which prominently displayed the defendant's name.

But the use of the defendant's name as part of the mark complained of is an element to be considered, and in some cases it has turned the scale in his favour. Thus, in *Beard* v. *Turner*, 13 L. T. N. S. 746, KIRBY'S NE PLUS ULTRA NEEDLES, on a label, was held not to be infringed by TURNER'S NE PLUS ULTRA NEEDLES on a label generally resembling the plaintiff's, the words NE PLUS ULTRA being common to the trade; and in *Blackwell* v. *Crabb*, 36 L. J. Ch. 504, BLACKWELL'S PICKLES on a label, not to be infringed by CRABB'S PICKLES on a label resembling the plaintiffs', the name of the manufacturer, under

[1] Cited p. 38.

[2] Cited p. 51. In *The Yorkshire Relish* case, cited p. 512, the defendants did everything possible to distinguish their goods, the name of Holbrook, their predecessor in business, being prominent on the labels, but this proved to be insufficient while they used the (unregistered) trade mark. The name *Stevenson's*, prefixed to "camel hair belting," which by itself admittedly meant the plaintiff's belting (see *Reddaway* v. *Banham*, cited p. 42), was held not to distinguish sufficiently. *Reddaway & Co., Ltd.* v. *Stevenson and Brother, Ltd.*, 20 R. P. C. 276 (1903), Hall, V.-C.: but cf. *Stone* v. *Frictionless Engine Packing Co., Ltd.*, 19 R. P. C. 504 (1902), Hall, V.-C.

[3] *Henderson* v. *Jones*, Seb. Dig. p. 110 (1861). Wood, V.-C., is a similar case.

the circumstances of the case, being the thing which a customer would rely on most to establish the identity of the goods he wanted. In each of these cases the elements of all the labels were for the most part common to the trade.[1]

Differences which may be removed by retailers are disregarded.

Where any such additions or precautions are relied on by the defendant to rebut an alleged infringement, it is necessary to inquire whether they may not be removed or obliterated by fraudulent retail dealers leaving the imitated marks to effect deception without any check.[2] On this ground, in *Barlow* v. *Johnson*,[3] the Court paid no regard to the tickets and labels attached by the defendant to the towels sold by him under the name, *Osman*, which he had taken from the plaintiff's trade mark.

Decided cases do not assist in determining the question of fact.

Probability of deception is, of course, a question of fact, and, except so far as they lay down any general principle of comparison, the decided cases are of no assistance in the determination of new questions of fact raised upon other materials. "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?" Lord Watson asked, in *Johnston* v. *Orr-Ewing*,[4] but the habit of referring to reported cases at the trial of such questions is inveterate, and it has been thought useful, therefore, to collect the cases just cited, and those cited at pp. 260 and 264, above.

Inconspicuous additions a badge of fraud.

The reported cases show that attempts are frequently made to prevent the interference of the Court by the use, along with the spurious or deceptive marks, of words, descriptions, or other additions which, if carefully examined, would prevent the deception, and at the same time, by writing the additions in small letters, or otherwise causing them to be comparatively inconspicuous, to make the probability of careful examination as small as the infringer thinks he safely can. It is obvious that, so far from affording an answer to a charge of infringement, such colourable precautions are themselves a badge of fraud. The defendant is met at once with the questions, if the additions are necessary, why are they not made conspicuous? and, if they

[1] See also the "passing-off" cases, *Jamieson* v. *Jamieson*, 15 R. P. C. 160 (1898), C. A.; *Payton* v. *Snelling*, 17 R. P. C. 18 and 628 (1900), C. A. and H. of L.; and *Payton* v. *Titus Ward*, *ibid.* 28 (1899), C. A., cited p. 242; and *King & Co., Ltd.* v. *Gillard & Co., Ltd.*, 22 R. P. C. 327 (1903), C. A.

[2] See below, p. 456.

[3] 7 R. P. C. 395 (1890), Chitty, J., and C. A.

[4] 7 App. Ca. 219 (1882).

are superfluous, why are they used at all?[1] In the following cases the several additions noted in brackets were added in small letters to the plaintiff's name or trade mark, or to an imitation of it: [Equal to] Day & Martin's, injunction granted, *Day* v. *Binning*, C. P. Cooper, 489; [Late of] Lundy, Foot & Co., dismissed pending verdict at law, *Foot* v. *Lea*, 13 Ir. Eq. 484; [From] Thresher & Glenny, injunction granted, *Glenny* v. *Smith*, 2 Dr. & Sm. 476; [From] Hookham & Pottage, injunction granted, *Hookham* v. *Pottage*, L. R. 8 Ch. 91;[2] [Agent for] Mason & Brand's Essence of Beef, injunction granted *Dence* v. *Mason*, W. N. (1877), 23; W. N. (1878), 42; C. B. [& Co.], the plaintiff's mark was C. B., the infringing goods were made by Connell Brothers & Co., injunction granted, *Bayer* v. *Baird*;[1] [Successors to] Jefferson Dodd, held on a motion to sequestrate to be calculated to deceive, the name being on the fascia of the shop, and the words "successors to" on the plate glass front, *Jefferson Dodd, Ltd.* v. *Dodd's Drug Stores, Ltd.*, 25 R. P. C. 16 (1908).

5. Defences.

The defences commonly set up may be tabulated as follows, that:— The ordinary defences.

(1) The plaintiff has no title to the trade mark in question;[3]

(2) The defendant has an independent or a concurrent right to use the mark complained of;

(3) The plaintiff has not complied with the provision of sec. 42 by obtaining the registration or refusal of the mark;[4]

(4) There is no infringement;[5]

(5) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (*a*) an agreement or some personal estoppel (other than those next alluded to); (*b*) acquiescence or licence; (*c*) delay; or (*d*) because the trade mark is deceptive, or his trade is fraudulent.[6]

(1), (3) and (4) are traverses of parts of the plaintiff's case, but (1) may be something more.

[1] *Bayer* v. *Baird*, 15 R. P. C. 615 (1896), Court Sess.; *Bayer* v. *Connell*, 16 R. P. C. 157 (1899), M.R. of Ireland.

[2] Where the widow of a late servant of the plaintiffs continued his business with the use of the words "from G. F. Cockerell & Co., Ltd." rightly used by him, an injunction against such use by her was refused; *Rickett, Cockerell & Co., Ltd.* v. *Nevill*, 21 R. P. C. 394 (1904), Kekewich, J.

[3] Pages 383 *et seq.* and 410. The question whether the mark concerned is a trade mark at all, as to which see Chap. II., p. 22, seldom arises in practice, except on an application to expunge an entry from the Register.

[4] Chap. XII., p. 334.

[5] Page 389.

[6] Page 419.

Application to vary.

Attack on the plaintiff's title.

(1) If the plaintiff's mark has been registered for seven years from the date of the original registration or from the date of the passing of the Act of 1905 (August 11th, 1905),[1] whether in his name or in that of his predecessor in title,[2] the registration is conclusive evidence of his exclusive right to the use of the mark,[3] subject to the provisions of the Act.[4] The defendant is not, however, precluded from proving the invalidity of any assignment or transmission, but the registration of the plaintiff as proprietor is *primâ facie* evidence of the validity of his title in these respects.[5] The defendant can adduce evidence to show,[6] or he may show from the plaintiff's own evidence,[7] that the plaintiff does not possess the goodwill of the business in the goods to which the trade mark is attached; but he cannot attack the plaintiff's title generally, for instance, by showing that the mark is not a trade mark,[8] or is not within the classes of registrable symbols enumerated in sec. 9, except on an application under sec. 35,[9] and can only so attack the original registration if the plaintiff is not protected by sec. 41. The application cannot be made by counterclaim in the action.[10]

If the plaintiff's mark has not been registered for the period mentioned in sec. 41, the defendant can (probably) attack his title without an application to vary the Register.[11]

Application to expunge or limit the plaintiff's registration.

It follows that the defendant in an infringement action, unless satisfied that the plaintiff's title cannot safely be attacked, generally applies to expunge the mark of the latter from the Register, or to so limit it as to defeat the action, and, according to the usual practice, the application comes on for hearing with the trial of the action, or with the plaintiff's motion for an interlocutory injunction, if any. The Court will, in a proper case, adjourn the decision of the last-mentioned motion in order to enable the defendant to make his cross application to rectify or expunge.[12]

[1] Sec. 41, ante, p. 330.
[2] Above, p. 330.
[3] Secs. 39 and 41. Above, pp. 325 *et seq.*
[4] Above, p. 332.
[5] Sec. 40, above, pp. 329 and 334.
[6] *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.
[7] As in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.
[8] See Chap. II., p. 22.
[9] As to which see Chap. XI., p. 276.
[10] *Pinto* v. *Badman*, supra. Cf. sec. 32 of the Patents and Designs Act, 1907. As to procedure in Scotland, see above, p. 303.
[11] See above, p. 387, note (8).
[12] Cf. *Edwards* v. *Elkan*, p. 411, note (5).

In any case, it is submitted, and notwithstanding that there is no application to rectify, the defendant may show that the plaintiff's right has determined by abandonment or otherwise by matters subsequent to the original registration.[1]

Determination of the plaintiff's title.

Concurrent Right.

(2) Where the Court has so decided, and in certain cases by agreement approved by the Registrar or the Board of Trade, two or more persons may be registered as proprietors of the same mark for the same goods,[2] and they will then have concurrent rights. In such cases no rights of exclusive user are (except so far as their respective rights shall have been defined by the Court)[3] acquired by any one of such persons as against any other by the registration. But where more than three persons are independently entitled to use a mark for the same goods it is treated as common to the trade, so that if any of them has obtained registration, the entry ought to be expunged.[4]

Concurrent or independent right.

The defendant, therefore, if he have an independent right, can apply for registration himself, and in a proper case the Court will order a motion for an interlocutory injunction in an action against him to stand over until his application is disposed of;[5] or, if he allege that the mark is common, he can, subject to sec. 41, apply to remove the plaintiff's mark from the Register.

In *Mouson* v. *Boehm*,[6] where the plaintiffs had independently adopted, and in 1880 had registered, a mark closely resembling a mark which the defendant had previously acquired by user for the same goods, and which he had never abandoned, the plaintiffs brought their action to restrain the defendant from using the latter mark. The defendant applied to register the mark as his, and moved to have the entry of the plaintiffs' mark expunged

Mouson v. *Boehm*.

[1] See Chap. XIV., p. 364.

[2] Secs. 19, 20, and 21. It must be a right to use the mark as a trade mark; not, for instance, as a family crest: *Standish* v. *Whitwell*, 14 W. R. 512; *Beard* v. *Turner*, 13 L. T. N. S. 746, both (1866), Wood, V.-C.

[3] And presumably except so far as such rights have been defined by agreement under sec. 20, although sec. 39 does not in the proviso so provide; see first part of the section.

[4] Chap. X., p. 224.

[5] *Edwards* v. *Elkan*, 5 R. P. C. 7 (1887), Stirling, J.

[6] 26 C. D. 398 (1884), Chitty, J. A similar case of an old mark is cited by Mr. Sebastian, *Re United Vineyards, &c. Co.* (1889), Stirling, J.; and *Re Bryant and May*, 4 Times L. R. 675 (1888), Stirling, J., is another. In *Daniel and Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*), cited below, p. 515, the defendant lost by non-user a concurrent right to an (unregistered) trade name.

from the Register. The application to register came before the Court on a summons to proceed, and was heard, together with the motion for an injunction, at the trial of the action. Chitty, J., allowed the defendant to be registered as a proprietor of the mark, but he refused to order the registration of the plaintiffs' mark to be expunged, and he dismissed the action.

Jackson v. Napper.

Jackson v. *Napper*[1] is a similar case. There the defendant, in 1876, applied through an agent to register a mark as his trade mark, and he supposed that it was registered accordingly, but, in fact, the application was not proceeded with and was, as the Court held, abandoned. In the next year the plaintiffs registered a similar mark, and more than five years after their registration[2] they brought the action to restrain the defendant from using his mark, and thereupon the defendant took out a summons for a direction to the Comptroller to proceed with the registration of his mark. Stirling, J., found that the defendant had acquired and used his mark as a trade mark before August 13th, 1875, in respect of the goods in question, except one particular class (sheep-shears); and he held that, notwithstanding that the five years' registration of the plaintiffs was conclusive evidence of their right to the "exclusive use" of their mark, he had jurisdiction to allow the defendant to be registered in respect of his own mark, upon the analogy of the rule that an entry on the Register might be rectified, under sec. 90 of the Act of 1883,[3] after five years' registration. He accordingly directed the defendant to be registered as proprietor of his mark for the goods in question, other than the sheep-shears, and dismissed the action, except so far as regarded the last-mentioned goods, in respect of which he granted the injunction the plaintiffs sought.

Defendant should apply for registration.

In the two cases above cited, the defendants' marks were old trade marks, and in a case prior to the Act of 1905[4] the Court refused to extend the principle of those cases so as to allow the registration of a new mark similar to one already registered.[5] But, as already stated, the Act of 1905 permits concurrent regis-

[1] 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

[2] Sec. 76 of the Act of 1883 after this period made the Register conclusive evidence in the absence on an application to rectify. Sec. 3 of Act of 1875.

[3] Chap. XII., p. 325.

[4] *Hall and Woodhouse's Application*, 19 R. P. C. 58 (1902), Buckley, J.; and see *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

[5] In a recent case it was held that applicants for a trade mark had established equal rights by concurrent user with the opponents of the word "Kinahan's" in connection with whisky, and that their mark would not be deceptive by reason of that word appearing on the

tration of identical or nearly identical trade marks in cases of honest concurrent user or under other special circumstances. Where the defendant wishes to set up an independent right, he should, unless he has a defence under sec. 41, apply to register his own mark, and apply for a stay of proceedings pending a decision of his rights under such application.[1] Prior and continuous user by the defendant is, however, under sec. 41, a good defence to an action for infringement. The proviso to that section is as follows: "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[2] 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 on the Register for such similar trade mark under the provisions of sec. 21 of this Act." The first part of the proviso applies whether the earlier user obtains registration under sec. 21[3] 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.[4] 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."[5]

Defence under sec. 41.

It was assumed in the judgments delivered in the cited cases of

Registration gives the

mark as used: *Lyle and Kinahan, Ltd.'s Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.

[1] In *Boord & Son* v. *Thom and Cameron*, 24 R. P. C. 697 (1907), Inner House, Scotland, it was held in an action commenced in 1905 that the defendants could not set up a concurrent right without a claim that they were entitled to have their mark put on the Register. It is submitted, however, that an application to the Patent Office in the ordinary way is necessary, and that the Court could not deal with an application for registration.

[2] Above, pp. 392 and 395.

[3] Above, p. 261.

[4] Above, p. 371.

[5] Per Chitty, J., in *Monson* v. *Bochm*, 26 C. D. 398; cf. *Daniel and Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134.

defendant a right to use his mark *prima facie* or conclusive.

Mouson v. *Boehm* and *Jackson* v. *Napper*, and is besides clearly implied by the Act, that registration when properly made gives the defendant an equal title to use the mark with the plaintiff, but only, of course, according to the terms of the entry.[1] It is just as much an infringement for the defendant to use a registered mark for goods,[2] or in a market, in respect of which it is not registered, and the plaintiff's mark is registered, as if the defendant's mark were not registered at all. If the plaintiff alleges that the use of the registered mark of the defendant for the goods in respect of which it is registered is an infringement of his mark, his proper course is to apply in the first place to remove the defendant's mark from the Register before commencing, or concurrently with,[3] the action for infringement. But the registration of the defendant's trade mark may possibly be held to be no answer to an action of infringement based on the use of that mark, at all events in a case in which the defendant has not acquired by the lapse of the period of seven years mentioned in sec. 41 rights under that section. Thus, where under the Act of 1875 the defendant's mark had been registered for less than the period of five years mentioned in sec. 3 of that Act, an interlocutory injunction was granted by the Court of Appeal in terms which in effect restrained the use of the defendant's mark.[4] And in a later case under similar circumstances a final injunction was granted by the Court of Appeal in an action founded on trade name and passing-off which in effect restrained the use of a registered trade mark.[5] And where an action for passing-off was commenced and very shortly afterwards the plaintiffs gave notice of motion to rectify the Register by the removal of the defendant's mark, and the action and motion were heard together, the defendants'

[1] Sec. 39.

[2] *Upper Assam Tea Co.* v. *Herbert*, 7 R. P. C. 183 (1889), C. A.

[3] As in *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 23 (1886), Kay, J., where the Register was rectified by limiting the goods for which the defendant's mark was registered, and an injunction was granted in respect of other goods. And see *Eastman Photographic Materials Co., Ltd.* v. *John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898). Romer, J., and *Macmillan* v. *Ehrmann*, 21 R. P. C. 357 (1904), Buckley, J.

[4] *Read* v. *Richardson*, 45 L. T. 54 (1881). See also *Goodwin* v. *Venning*, 24 Sol. J. 690 (1880), Jessel, M.R. See now the proviso to sec. 39, above, p. 326, and referred to below, p. 416.

[5] *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ltd.*, 17 R. P. C. 673 (1900). No point seems to have been taken by the defendants as to their having registered "Valtine" as a trade mark. The plaintiffs subsequently obtained the removal of the mark from the Register: *Valentine Extract Co.'s Tm.*, 18 R. P. C. 175.

mark was ordered to be expunged from the Register, and the defendants' were restrained from using it.[1] In both the cases last cited the defendants were endeavouring to get the benefit of the plaintiffs' trade reputation by the use of the mark.

The question whether, in a passing-off action, it would be a defence that the defendant's mark was a registered trade mark arose in a recent case in which the registration of the trade mark was opposed on the ground that it would be deceptive if used with a certain blank in it filled up in the manner proposed; a concurrent user within a certain area was established, and Buckley, L.J., in giving his judgment, said, in reference to an argument that the registration of the applicant's mark would give them a right to use it everywhere in the United Kingdom: "The registration of a trade mark does not confer any right at all of the description there pointed to, but it does confer a right, and the only right is the right to prevent anybody else from using that trade mark as a mark for their goods, but it does not give the registered owner of the trade mark any right to use that trade mark if the trade mark would deceive. I conceive that if at the date when application is made to register a trade mark there is no ground of objection upon the footing that it will be calculated to deceive, and if subsequently by alterations in the character of the business of the two parties respectively the use of the trade mark will be calculated to deceive and a passing-off action were brought by one party against the other, it would be no defence at all on the part of the owner of the registered trade mark to say—'Deception or no deception I am entitled to do it because that is my registered trade mark.' That could not be advanced for a moment. In other words, the registration of a trade mark does not confer any right to do that which could not have been done irrespective of the trade mark, in the sense of doing any acts which would be competition in business. The only right which it confers is a right to restrain others from using that trade mark."[2] The passage quoted seems not to deal directly with the question whether the proprietor of a registered trade mark can maintain an infringement action in respect of the mere use by the defendant of a registered trade mark, or whether he must first obtain the removal of the defendant's trade mark from the

[1] *Eastman Photographic Materials Co., Ltd.* v. *John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J.

[2] *Lyle and Kinahan, Ltd.'s Application*, 24 R. P. C. 249 (1907), C. A., at p. 262. See also *Van Zeller* v. *Mason, Cattley & Co.*, 25 R. P. C. 37 (1908), Joyce, J.

Register. The principle, however, seems to be the same whether the action is founded on infringement of trade mark or passing-off, and whether by means of an unregistered or registered mark, so that, unless there is anything in the Act preventing an action to restrain the use of a registered trade mark, there seems to be no reason why in a proper case such relief should be refused. It may be that, notwithstanding the proviso to sec. 39, such an action can in the case supposed, and apart from rights acquired by the defendant under sec. 41, be maintained, for sec. 39 confers on the defendant the exclusive right to the use of his trade mark only if the registration of it was valid, and on the supposed facts, namely, that the defendant's mark is identical with or closely resembles the plaintiff's mark, the registration of the defendant's mark could (apart from an independent right such as was established in *Lyle and Kinahan's* case) have been successfully opposed by the plaintiff. And furthermore, even if the period of seven years mentioned in sec. 41 had elapsed, the defendant's trade mark ought, on the supposed facts, not to have been registered, by reason of its offending against the provisions of sec. 11 of the Act.[1] It would appear, therefore, that in any such case, if the original registration could have been opposed by the plaintiff on the ground of the deceptiveness of the defendant's trade mark, and the defendant's mark is still deceptive, a defence founded on sec. 41 is not available to the defendant. But, as already stated, it is advisable for the plaintiff in such a case to apply to remove the defendant's mark from the Register.

Is the introduction of the defendant's own mark into a new market an infringement?

If the plaintiff and defendant are severally entitled to, and are the proprietors of, two marks which are in ordinary markets distinct and unlikely to be confused, is it an infringement for the defendant to introduce his mark into a market where the plaintiff's is already known, if from the character of the customers there—their ignorance of English, for instance—its use is calculated to cause the defendant's goods to be taken for the goods of the plaintiff? It is submitted that it is an infringement, for the case put falls within the principle that one trader must not do what is calculated to cause his goods to be taken for those of another, and the defendant's action is in this sense the cause of deception. The question was raised, but not determined, in *Johnston* v. *Orr-Ewing*, in the House of Lords, and the words of the order of Fry, J., having special reference to

[1] Above, p. 333.

the Bombay trade were, with the assent of the respondents, directed to be omitted. Lord Selborne said, in his judgment in the case: "Your Lordships are not called upon to decide whether a ticket, which was a rightful and *bonâ fide* trade mark of the trader using it, could be excluded by injunction from particular markets (though unimpeachable everywhere else) merely because in those markets it might be liable to be called by a name which the mark of another trader had already acquired there. . . . To that proposition I should not myself, as at present advised, be prepared to assent."[1] The passage quoted above from the judgment of Buckley, L.J.,[2] supports the proposition that if the use of the mark in a new district would cause deception the plaintiff could succeed at all events in a passing-off action. On the other hand Lord Alverstone, in the same case, after stating that the Court had not in that case the powers conferred by the Act of 1905, and after referring to the argument that the applicant's concurrent user had only been in a certain district, said: "We have not the materials before us for saying so, but I feel very great difficulty, when once you get a *bonâ fide* concurrent user, in saying that a man is to be limited in a subsequent user if he is entitled to have the registered trade mark for the user that he then possessed. I do not want in any way to fetter the judgment of this Court, or my own judgment, in case it may turn out that some large and extended user would be unfair having regard to the circumstances of the case, but once you get that an honest trader is entitled to come and ask for a registration of his trade mark, I do not think it is an objection to the registration that he is going to use the trade mark in a much more widely competitive area than that in which he has been selling his goods in up to the time his application is made." Within the United Kingdom, if the defendant's mark is registered without limit of area, he has a *primâ facie* right so to use it, and in order to challenge that right the plaintiff should take proceedings to rectify the register.[3]

Introduction into a new trade.

The introduction of the defendant's marks into a new trade in goods for which it is not, and the plaintiff's mark is registered, is undoubtedly an infringement.[4]

[1] 7 App. Ca. p. 227 (1882). See also *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891). Romer, J. An injunction, on the ground of "passing-off," limited to Ireland was granted in *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.

[2] Above, p. 415.

[3] See above, pp. 414 to 416.

[4] Above, p. 414, note (2). In *Hodgson* v. *Kynoch*, 15 R. P. C. 465 (1898),

Where the case made is one of colourable infringement by using part of the registered mark, or a word taken from the registered mark, the defendant may show that he has a concurrent right to the use of the part or word, as, for instance, by prior user of it.[1]

Registration at Stationers' Hall.

Registration for copyright purposes of a mark at Stationers' Hall confers no trade mark rights, and constitutes no defence if the mark is an infringement of another person's trade mark.[2]

Trade mark rights on a dissolution of a partnership.

Where a partnership is dissolved without a sale of the goodwill, or any arrangement having been made for its disposal, or governing the use of the trade marks of the firm, each of the late partners who carries on the business may use the trade marks,[3] for he is, as to a portion of the goodwill, a successor of the firm;[4] but if the goodwill is sold as part of the assets of the firm, the exclusive right to use the trade marks may be sold with it, and in that case the late partners cannot lawfully use the trade marks, even though they set up a similar business in competition with the purchaser.[5]

But a late partner cannot grant to others who are in no way successors to the firm's business, or any part of it, a right or licence to use the trade marks, even though he be registered as proprietor of the marks. The case of *Hanson* v. *Game, Harrison and Larner, Limited*,[6] was decided on the construction of a consent order under which the partnership in question had been

Romer, J., the defendants were makers of ammunition. Their works were known as Lion Works, and they had lion trade marks. Held, that they were not justified in using lion marks for soap.

[1] *Edge* v. *Gallon*, 16 R. P. C. 509, and 17 R. P. C. 557 (1900). C. A. and H. of L. (*Dolly Blue*); *Meaby* v. *Triticine*, 15 R. P. C. 1 (1897), North, J., both "passing-off" cases. In an infringement action, the defendant would probably argue alternatively that he had not infringed or that the plaintiff's mark was wrongly registered. See also *Lyle and Kinahan, Ltd.'s Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.

[2] *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. (*Family Salve*); *Paine* v. *Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217

[3] *Banks* v. *Gibson*, 34 Beav. 566 (1865), Romilly, M.R.; *Condy* v. *Mitchell*, 37 L. T. N. S. 268 and 766 (1877), Bacon, V.-C., and C. A.; *Beadbow* v. *Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C. See Chap. XIII., p. 352. As to cases where the severance of business relations determines a joint trade mark, see *Robinson* v. *Finlay*, 9 C. D. 487; and *Jones' Tm.*, 53 L. T. N. S. 1. As to trade name on dissolution of partnership, see next chapter, p. 528.

[4] The Act of 1905 permits the apportionment of trade marks by arrangement and with the approval of the Registrar on a dissolution of partnership or other division of goodwill, sec. 23, above, p. 352. As to the law under the Act of 1883, see *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

[5] See *Re David and Matthews*, [1899] 1 Ch. 378, Romer, J., cited below, p. 529, where all the authorities are reviewed.

[6] 9 R. P. C. 186 (1892), Stirling, J.

dissolved, and which provided that the late partners "and any partners they may take respectively" were to have the common use of the trade marks; but it is submitted that the decision might have been put on the general ground that the defendants —a limited company, of which one late partner was a shareholder and director—could not use the marks without infringing the rights of the plaintiffs, the other late partner and his partners, because they were not possessed of the goodwill of any part of the old business.

Sale of trade marks in bankruptcy.

So if the trustee in bankruptcy of a trader sells the goodwill and trade marks of the latter's business, the trader has no right to continue to use the marks.[1]

Honest use of the defendant's name is no infringement.

A trader who is honestly using his own name in his business will not be guilty of infringement because its similarity to a name appearing in another's trade mark is calculated to lead to deception. Section 44 provides that no registration under the Act of 1905 shall interfere with any *bonâ fide* use by a person of (*inter alia*) his own name.[2] But to support this defence the business must be the defendant's own, for a fraudulent attempt to cover an infringement by employing or taking into partnership a man who happens to bear the name which is to be used to effect the fraud, still less by buying from him the right to use his name, will not avail to protect the offender.[3]

(3) The necessity for registration of the plaintiff's marks, having regard to sec. 42, has already been discussed.[4]

(4) And so has the question, What constitutes an infringement? including the special provisions of secs. 43 and 44 of the Act.[5]

Estoppel.

(5) (*a*) With the exception of the several defences which are considered below, there is nothing peculiar to the law of trade marks to determine what agreements, or what circumstances constituting a personal estoppel, will prevent a plaintiff from suing a particular defendant for infringement. It is to be remembered, however, that an infringement is primarily a fraud on the public, in respect of which the plaintiff is allowed to sue, because its

[1] *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), Chitty, J.; *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.; *Melrose Drover, Ltd.* v. *Heddle*, 4 Fraser, 1120 (1902), Scotland.

[2] See the corresponding provision of the Act of 1888, s. 10.

[3] See the next chapter, p. 543, where this matter is fully discussed in relation to trade names.

[4] Above, p. 386; Chap. XII., at p. 334.

[5] Above, pp. 389 *et seq.*

Agreement to condone infringements.

natural effect is to cause damage to him.[1] An agreement, therefore, not to prosecute future infringements would be an agreement to permit a fraud, and although, if established, it would undoubtedly prevent the Court from interfering in favour of any party to it,[1] it could not be specifically enforced, and, unless the intention were clearly indicated, the Court would presume that a lawful arrangement, for instance, a waiver of the remedy in respect of past infringements only, was intended.[2]

Uncandid conduct.

As an instance of estoppel by conduct, the case of *Maxwell* v. *Hogg*[3] may be taken. There the defendants had received, and published for reward from the plaintiffs, advertisements of an intended new magazine, bearing the title of a magazine which they were themselves preparing to publish, without warning the plaintiffs of their own intention; and this uncandid conduct was held to be sufficient ground for dismissing the cross suit of the defendants for an injunction to prevent the plaintiffs using the name.

And anything in the nature of a representation by the plaintiff to the defendant that his mark was not an infringement, or that it might be lawfully used,[4] or of an encouragement to him to continue using it, would be an answer to a subsequent claim for damages for infringement, although a mere failure by the plaintiff as soon as he had knowledge of the infringement to warn the defendant, would be no bar.[5]

Failure to give warning.

The plaintiff is not barred because he uses his registered mark with additions.

It is sometimes urged, on behalf of the defendant, as an objection to the plaintiff's case, that the plaintiff in actual practice uses his mark in a form different from that for which he has obtained registration; but the variation of his registered mark by the plaintiff, provided it is not an infringement of any other

[1] See *Grazier* v. *Aubran*, 13 R. P. C. 1 (1896) (*Charta use*), where an agreement was set up, Chitty, J., said, "I need hardly state that the plaintiffs do not move in any sense on behalf of the public."

[2] *Oldham* v. *James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862), Brady, C., and Blackburn, L.J.

[3] L. R. 2 Ch. 307 (1867), Turner and Cairns, L.JJ., cited p. 34.

[4] A defence of this nature was successful on appeal in *Burgoyne* v. *Godfree*, 21 R. P. C. 550; 22 R. P. C. 168 (1905), Warrington, J. and C. A., where wine rejected by the plaintiffs and sold on their orders was contained in casks bearing the words "Burgoyne, London," and the defendants bought it, and afterwards sold it as Burgoyne's wine under a *bonâ fide* mistake on their part which, it was held, the conduct of the plaintiffs had induced.

[5] See *Proctor* v. *Bennis*, 36 C. D. 740 (1887), C. A., a patent case; and the notes to *Savage* v. *Foster*, 2 White & Tudor's Leading Cases, 6th ed., 680. The rule is "*qui potest et debet velare jubet*"; *Osborn* v. *Lees*, 9 Mod. 96; *Willmott* v. *Barber*, 15 C. D. 96; 17 C. D. 772. As to delay, see p. 423.

person's mark, or a breach of any agreement binding upon him, is perfectly lawful, although so far as the mark actually used differs substantially from his registered mark, it is an unregistered mark, as has been already pointed out. If the registered mark is in substance not used at all, that would be an independent objection to the plaintiff's action.[1] It is well settled that the use of a varied mark by the plaintiff does not in any way estop him from proceeding against infringers. Thus, in *The Melachrino* case,[2] the plaintiffs had tried to register a label comprising three coats of arms, but the coats of arms had been rejected and the label registered without them. The plaintiffs, nevertheless, always used the labels with the arms in it, and the defendants, who had imitated the label, were enjoined from continuing the infringement. In a subsequent case,[3] Chitty, J., said: "I adhere to what I said in *Melachrino's* case, that the mere addition of something, as, in that case, a coat of arms, to the trade marks, is not sufficient to disentitle a person who otherwise uses the whole of his trade marks to sue for an injunction."

Similarly, it is no ground of estoppel that the plaintiff extends the use of his mark to goods in respect of which it is not registered.[4]

(*b*) Acquiescence in the infringement on the part of the plaintiff is a complete defence,[5] but it can only be inferred where he is shown to have had knowledge of it.[6] And, assuming that it is shown that the plaintiff knows of the infringement, the Court will not readily infer that he has assented to what is likely to be so detrimental to his property. It has been held that, where it is pleaded in answer to a motion to commit the defendant for the breach of an injunction restraining him from infringing, it must amount to a licence "sufficient to create a new right in him."[7] Acquiescence.

[1] Above, p. 385.

[2] *Melachrino & Co.* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), Kekewich, J., and C. A. In *Rowland* v. *Mitchell*, 13 R. P. C. 457; 14 R. P. C. 37 (1896), Romer, J., and C. A., the plaintiff omitted some of the added words and used other words. This was held to be immaterial.

[3] *Hammond* v. *Brunker*, 9 R. P. C. p. 307 (1892).

[4] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

[5] Per Chitty, J., in *Monson & Co.* v. *Boehm*, 26 C. D. p. 406 (1884).

[6] *Weldon* v. *Dicks*, 10 C. D. 247 (1878), Malins, V.-C.; *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C., and the last case. See, generally, *De Bussche* v. *Alt*, 8 C. D. 286, C. A.; and *Willmot* v. *Barber*, 15 C. D. 96; 17 C. D. 772, Fry, J., and C. A.

[7] *Rodgers* v. *Nowill*, 3 De G. M. & G. 614; 22 L. J. Ch. 404 (1853), per

In *Rowland* v. *Mitchell*[1] Romer, J., said: "I quite agree that merely threatening a person in cases of this kind, without taking proceedings, is not sufficient. If the plaintiff really does stand by and allow a man to carry on business in the manner complained of, to acquire a reputation, and to expend money, he cannot then, after a long lapse of time, turn round and say that the business ought to stopped." On the other hand, Lord Russell, L.C.J.,[2] said in the same case: "It cannot be stated as a general proposition in respect of a person, irrespective of the character of the trade done, and the extent of that trade in respect of the position and impecuniosity of that person, that the moment it comes to the knowledge of a manufacturer that somebody has been trying to do a fraudulent thing on his part he is bound to take proceedings, or if he does not take proceedings, it is concluded against him that he means to acquiesce in the right of that other person to continue to do what he has been doing."[3] The facts of each case must be examined to see whether there has been an acquiescence or not.

Licence.

A licence by the plaintiff to the defendant to use the mark would be proof of acquiescence in user falling within the terms of the licence, and would be a defence.[4] Under sec. 87 of the Act of 1883, any registered proprietor could grant licences to use the mark, subject to any equities affecting it, unless, for instance, he had agreed with the plaintiff not to do so.[5] But the Act of 1905 contains no power for the registered proprietor to grant licences,[6] and a licence to a person who has no interest in the goodwill of the business would seem to be invalid as leading to

Turner, L.J. As to what constitutes acquiescence, see *Proctor* v. *Bennis*, ante, p. 420, note (5); "delay," p. 423; and *Hogg* v. *Scott*, L. R. 18 Eq. 444, Hall, V.-C.; *Weldon* v. *Dicks*, 10 C. D. 247, Malins, V.-C. (copyright); and *Smith* v. *Smith*, L. R. 20 Eq. 500, Jessel, M.R. (ancient lights). See also, generally, the article *Acquiescence* in the Encyclopædia of English Laws.

[1] 13 R. P. C. p. 464. It was held there had been no acquiescence or abandonment in this case, see below, p. 425, note (2). See also on the defence of "standing by," per Byrne, J., in *Jamieson* v. *Jamieson*, 15 R. P. C. 169, at p. 179.

[2] 14 R. P. C. at p. 44. See also Kekewich, J., in *Ripley* v. *Bandey*, 14 R. P. C. at p. 596.

[3] Followed in *Reddaway* v. *Stevenson and Brother, Ltd.*, 20 R. P. C. 276 (1903), Hall, V.-C., where the plaintiffs knew of the acts complained of three and a half years before action, but took no proceedings after inquiring into the defendants' position.

[4] *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.

[5] *Hanson* v. *Game, Harrison and Larner, Ltd.*, 9 R. P. C. 186 (1892), Stirling, J.

[6] Cf. sec. 38 with sec. 87 of the Act of 1883.

deception,[1] but it would if given by the plaintiff estop him from complaining of the improper use.

Delay does not bar the right of action

(*c*) Mere delay, after knowledge of the infringement, to take proceedings, not sufficient to call the Statute of Limitations into operation, or where the infringement continues, is no bar to the action. Before the Judicature Acts it might have furnished an answer to an application for an injunction,[2] at least until the plaintiff had established his rights by recovering damages in an action at law, unless the deception resulting from the use of the defendant's mark were still continuing.[3] But both branches of the Court now enforce legal and equitable rights together, and consequently, wherever an injunction could have been obtained after an action for damages, it can now be obtained at once or concurrently with the judgment for damages. The rule is not peculiar to trade mark cases, but is part of the general law.[4] It was stated by Fry, J., in the following terms, in *Fullwood* v. *Fullwood* (2):[5] "In my opinion that delay" (from early in 1875, when the plaintiff first knew of the infringement, till November, 1876, when he commenced his action) "—and it is simply delay—is not sufficient to deprive the plaintiff of his rights. The right asserted by the plaintiff in this action is a legal right. He is, in effect, asserting that the defendants are liable to an action for deceit. It is clear that such an action is subject to the Statute of Limitations,[6] and it is also clear that the injunction is sought merely in aid of the plaintiff's legal right. In such a case the injunction is, in my opinion, a matter of course, if the legal right be proved to exist. In saying that I do not shut my eyes to the possible existence in other cases of a purely equitable defence, such as acquiescence or acknowledgment,[7] and the various other equitable defences which may be imagined. But lapse of time, unaccompanied by anything else (and to that I confine my observations), has, in my judgment, just as much effect, and no more, in barring a suit for an injunction as it has in barring an action for deceit. In my judgment, the same rule

[1] See above, p. 354.

[2] *Hovenden* v. *Lloyd*, 18 W. R. 1132 (1870), Bacon, V.-C., fifteen months' delay: *Estcourt* v. *The Estcourt Hop Essence Co.*, 10 Ch. 276 (1875), Cairns, L.C., and L.JJ., seven months' delay.

[3] *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285 (1874), L.JJ.

[4] See *The Three Towns Banking Co.* v. *Maddever*, 27 C. D. 533 (1884), C. A.

[5] 9 C. D. p. 178 (1878); and see *L. C. & D. Rail. Co.* v. *Bull*, 47 L. T. 413.

[6] But where the tort is continuing, the right of action is also continuing.

[7] *Quære* abandonment.

applies since the Judicature Act as formerly applied in the Court of Chancery when the legal right had to be determined in an action at law."[1]

but delay may modify the relief granted;

But delay may affect the nature of the relief granted. It may cause the Court to refuse the ordinary interlocutory injunction, either on terms of the defendant keeping an account, or absolutely,[2] or to refuse to give damages, or to direct an account of profits in lieu of damages, or to restrict such account to profits made since the beginning of the action.[3]

And in a case where the plaintiffs took no action on hearing that the defendant had received a small consignment of spuriously marked goods, preferring to wait until he received a larger consignment, Malins, V.-C., ordered the injunction to be directed to future receipts by the defendant only.[4] Unless, however, this case can be supported on the ground of acquiescence, it is submitted that it is inconsistent with the rule established by the cases cited above.

In *Liebig's Extract of Meat Co.* v. *Chemists' Co-operative Society*,[5] the defendants had used the wrapper complained of in 1893. The plaintiffs discovered in 1894 that the defendants were using it, but they did not know to what extent. They commenced their action in May, 1896, and obtained full relief. *i.e.*, an injunction, an inquiry as to damages, and costs.[6]

In an Irish case, where there had been over a year's delay in bringing the action, the injunction was stayed for six weeks to allow the defendant time to make the arrangements necessary for the alterations of his trade name required by it.[7]

and may amount to abandonment.

But delay to pursue infringers, where the infringements are numerous and notorious, may amount to abandonment[8] of the trade mark, and lead to its becoming *publici juris*.[9]

[1] Cf. the judgment of Mellish, L.J., upon the defence of misrepresentation in *Ford* v. *Foster*, L. R. 7 Ch. p. 632.

[2] See below, "Interlocutory injunction," p. 445.

[3] See below, "Profits," p. 455. The American law is the same on both points. It is well stated in *McLean* v. *Fleming*, 96 U. S. Rep. 245, followed in *Menendez* v. *Holt*, 128 U. S. Rep. 514 (both Supreme Court), Cox, pp. 326, 467.

[4] *The Anglo-Swiss Condensed Milk Co.* v. *The Swiss Condensed Milk Co.* (1871), W. N. 163.

[5] 13 R. P. C. 635, 736 (1896), Kekewich, J., and C. A. A trade name and passing-off case.

[6] In *Reddaway* v. *Stevenson and Brother, Ld.*, 20 R. P. C. 276 (1903), Hall, V.-C., damages were refused after a delay of three and a half years.

[7] *Grant* v. *Levitt*, 18 R. P. C. 361 (1901), Porter, M.R. (*Globe Furnishing Co.*).

[8] Page 370.

[9] As in *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878), Jessel, M.R. (*Bank of England Sealing Wax*); Chap. XIV., p. 363.

Delay may be explained.

The delay may be of little importance if it appears that the plaintiff had been led to believe that the infringement had ceased,[1] or if the infringement is of slight amount. Its bearing on the case must always depend upon the circumstances under which it occurs. Thus in *Rowland* v. *Mitchell*[2] the plaintiff knew of an infringement by a third party in 1892. The third party when threatened with proceedings refused to stop, but was not worth suing. The plaintiff lost sight of him, and thought that the infringement had stopped. The action was begun in October, 1895, and the plaintiff obtained an injunction, with an inquiry as to damages and costs.

It has a bearing on the weight of evidence.

And, as already pointed out, delay may have an important bearing on the weight of the evidence in the case, for if, in spite of long user by the defendant of the alleged infringing mark, no case of actual deception is proved, and the absence of evidence of such deception is not otherwise accounted for, it may be difficult for the Court to believe that the defendant's mark is calculated to deceive. Thus where the owners of a trade mark consisting of the word "glacier" registered for transparencies sued for infringement by the use of the word "glazine," and they had known of the defendant's user for at least four years, and no case of deception was proved, the action was dismissed.[3] It has been suggested that, where the infringement has lasted a number of years, it is necessary for the plaintiff to prove that some persons have actually been deceived,[4] but this is not, it is submitted, a rule of law.[5]

In passing-off cases, where the transaction complained of is purely oral, it is matter of comment if the defendant's attention is not called to it as early as possible.[6]

See also *National Starch Manufacturing Co.* v. *Munns & Co.*, [1894] A. C. 275; 11 R. P. C. 281 (*Maizena*), there cited. In *Ripley* v. *Bandey*, 14 R. P. C. 591 (1897), Kekewich, J. (*Oral Blue*), the action was dismissed, because the plaintiff had known of the use by others of the get-up of which he complained beginning sixteen years before the action. This use was at first small, but ultimately became important. An appeal was compromised, 14 R. P. C. 944.

[1] *Daniel and Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J.

[2] 13 R. P. C. 457; 14 R. P. C. 37, Romer, J., and C. A., not reported on this point in L. R. The third party was a costermonger. See the passages quoted above, p. 422. Cf. *Ripley* v. *Bandey*, p. 422, note (2).

[3] *McCaw, Stevenson & Orr, Ltd.* v. *Lee*, 23 R. P. C. 1 (1906), Swinfen Eady, J.

[4] *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285 (1874), per Mellish, L.J.; *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

[5] See "Proof of Actual Deception," p. 259.

[6] *Carr & Sons* v. *Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), Byrne, J.

Moreover, lapse of time may prevent conduct which would at first be an infringement from being calculated to deceive. Thus, in *The Marquis of Londonderry* v. *Russel*,[1] an action against the defendant, for sending coals to the London market as "Londonderry Wallsend Coal," was dismissed because the defendant had used the name for twenty-five years, and the plaintiff had long known of his use of it. Whatever might have been the result had the plaintiff applied in 1861 to restrain the defendant from selling his coals under the name, it was clear, as the Court of Appeal held, that at the time of their judgment the defendant's conduct could not be taken to amount to any representation that his coals came from the plaintiff's Londonderry collieries.

Deceptive trade mark and fraudulent trade.

(*d*) The Court will not interfere to protect the use of a deceptive trade mark, or to assist a trader who is using his mark for the purposes of a fraudulent trade. This principle was well established in the Court of Chancery, and, although no case seems to be reported upon the point, it would no doubt have been recognised also in the Courts of Common Law before the Judicature Acts, had any case occurred, for the maxim *ex turpi causa non oritur actio* is a rule of law.[2]

"The plaintiff," Lord Westbury said, in *The Leather Cloth* case,[3] "desires to restrain the defendant from selling his own goods as the goods of another person; but if, by the use of the trade mark in question, the plaintiff himself is representing and selling his goods as the goods of another, or if his trade mark gives a

[1] 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.

[2] See the judgment of Mellish, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 631 (1872), cited below. In a "get up" case, *Jamieson* v. *Jamieson*, 15 R. P. C. 169, V. Williams, L.J., said, *obiter*, that misrepresentation to the public would be no answer to an action for damages. The misrepresentation alleged was not comprised in the matter sought to be protected, and the Court, in fact, thought there was no misrepresentation. In *Wolff* v. *Nopitsch*, 18 R. P. C. 27 (1901), Ld. Alverstone, L.C.J., said that he wished to reserve his opinion on the question whether there was any distinction between cases of trade mark and of fraudulent passing off. In *Bile Bean Manufacturing Co.* v. *Davidson*, 23 R. P. C. 725 (1906), Inner House, Scotland, Ld. Stormonth Darling said that he could not imagine a principle of so general a nature and intended to protect the public against fraud as turning on any mere question of proceeding as between courts of law and courts of equity; and the principle was then applied to a trade name case, see below, p. 440; and the principle was held by Farwell, J., to be applicable in a trade name case, *Cropper Minerva Machines Co., Ltd.* v. *Cropper Charlton & Co., Ltd.*, 23 R. P. C. 388 (1906), in which he considered that the description "the old and original firm" was not justified by the circumstances.

[3] 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863).

false description of the article, he is violating the rule upon which he seeks relief against the defendant."

Deceptive trade marks are outlawed.

The deceptive mark, in Sir Roundell Palmer's phrase, adopted by James, V.-C., in *The Leather Cloth Co.* v. *Lorsont*,[1] is "outlawed."

Collateral misrepresentation.

The earliest of the cases commonly cited, in which the Court of Chancery refused to interfere, on the ground of the plaintiff's own deceptive conduct, until the plaintiff had established his right by action at law, is *Pidding* v. *How*,[2] and the leading authority on the subject is the judgment of Mellish, L.J., in *Ford* v. *Foster*.[3] There it was objected by the defendants that the plaintiff in certain invoices and advertisements had falsely described himself as a patentee; but as the false description was collateral and did not appear in the mark in question, and the plaintiff's trade was not shown to be fraudulent, the Court decided that the plaintiff's legal right of action in respect of the defendants' infringement was not barred, and that he was consequently entitled to an injunction, with an account from the filing of the bill, and costs. If the false representation had been in the trade mark itself, the Lord Justice held, no Court of Equity, and, according to his opinion, no Court of law, would have entertained the plaintiff's action, and the same rule would apply if the trade were fraudulent; but, he said, "where the trade is, as in this case, a perfectly honest trade, and where the trade mark is, as in this case, a perfectly honest trade mark, I am clearly of opinion that there is no common law principle upon which it is possible to hold that the fact that the plaintiff has been guilty of some collateral fraud would be an answer to an action. It would be impossible to plead at law as a justification for the defendant's committing the fraud, that the plaintiff had committed a fraud on someone else." "It is true," he added, "that in this case the bills containing this false representation as to its being a patented article are proved to have been given to the defendants themselves; but there is not the slightest evidence, or the slightest reason for supposing, that the defendants were ever deceived by

Ford v. *Foster*.

The judgment of Mellish, L.J.

[1] L. R. 9 Eq. p. 352 (1869).

[2] 8 Sim. 477; 6 L. J. Ch. (N. S.) 345 (1837), Shadwell, V.-C. Lying advertisements as to the origin of tea (*Howqua's Mixture*). The Vice-Chancellor said, "It is a clear rule, laid down by Courts of equity, not to extend their protection to persons whose case is not founded upon truth."

[3] L. R. 7 Ch. 611 (1872) (*Eureka Shirts*). For the American authorities, which are very numerous, see Mr. Cox's note to this case.

that representation, because they knew perfectly well that there was no patent for these shirts."[1]

Examples of collateral misrepresentations.

The following are some miscellaneous examples of cases where objections to the plaintiff's case on the ground of collateral misrepresentation failed: title of a magazine protected, although the magazine purported to be written by someone other than the author, *Hogg* v. *Kirby*, 8 Ves. 215; 7 R. R. 30; similar cases with regard to songs, *Chappell* v. *Sheard*, 2 K. & J. 117; *Chappell* v. *Davidson*, 2 K. & J. 123; 8 De G. M. & G. 1; "Holloway's pills and ointment" protected, although the plaintiff called himself Professor Holloway without warrant, and published exaggerated commendations of his pills, *Holloway* v. *Holloway*, 13 Beav. 209; an objection on the ground that the plaintiffs retained a brass plate on the door of their business premises, bearing their predecessor's name, overruled, *Hudson* v. *Osborne*, 39 L. J. Ch. 79.

Section 11 provides that 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,[2] and the registered proprietor of a trade mark offending against this section acquires no rights under sec. 41 of the Act, after seven years' registration.

Application to remove deceptive mark from the Register

It follows that a trade mark which contains false statements or misrepresentations ought not to be entered or retained upon the Register, and, in modern cases, if the defendant wishes to rely upon the defence now under consideration, and to allege that the plaintiff's trade mark itself is deceptive, he commonly applies under sec. 35 to have it removed from the Register.[3] This is a convenient method of bringing the question to an issue, if the plaintiff is suing in respect of a registered mark, and it is

[1] See p. 426, note (2) above. The matter is well stated in an American case. "Courts of equity will not protect a trade mark that deceives the public. We do not suppose, however, that that deception need be of such a character as to work positive injury to purchasers, nor, on the other hand, that every erroneous impression which the public or a portion of the public may receive will be sufficient to destroy the validity of a trade mark. The question is whether . . . the representation is of such a character as to defeat the petitioner's claim to protection": *Meriden Britannia Co.* v. *Parker*, 12 Amer. Rep. 401, cited by Cox, p. 29.

[2] Chap. X., p. 266.

[3] *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Dexter's Tm.*, [1893] 2 Ch. 262; 10 R. P. C. 269, Wright, J. See Chap. X., p. 266.

the most advantageous course for the defendant; but there is no reason to suppose that the Court would be any more ready to interfere to protect a deceptive trade mark because it was registered, or that it is not open to the defendant to give evidence in support of a plea of the defence in question without there being any application under sec. 35 before the Court.[1]

(i.) Where the trade mark itself contains misrepresentations—

The Leather Cloth case.

In *The Leather Cloth* case,[2] the plaintiffs' case failed because, in the label in question, they had described their goods as "tanned leather cloth," "patented," and "J. R. and C. P. Crockett" as the manufacturers, adding an American address, whereas, in fact, much of the cloth for which the mark was used was not tanned, none of it was made under any patent, and the manufacturers were not J. R. and C. P. Crockett, but the plaintiffs themselves, who had no American address. It was urged on behalf of the plaintiffs that the misrepresentations, and in particular the representation that the goods were tanned, could not deceive any ordinary purchaser; but in answer to this Lord Westbury said: "I cannot receive it as a rule either of morality or equity that the plaintiffs are not responsible for a falsehood because it is so gross and palpable that no one is likely to be deceived by it. If there is a wilfully false statement, I will not stop to inquire whether it is too gross to mislead."[3]

It is immaterial that the misrepresentation does not deceive;

It is no answer to the objection that the trade, or any other given class of persons, know the actual facts and are not deceived;[4] for, as in the case of the test of infringement, the question is—is the mark calculated to deceive any probable purchasers who buy from the plaintiff directly or indirectly through others to whom he sells?

or that the facts are known to the trade.

False claim of patent right.

The employment of the word "patent" in a mark used for goods which are not manufactured under an existing patent right has given rise to much discussion;[5] but the authorities

[1] As to this point, see *Hubbuck* v. *Brown*, 17 R. P. C. 638 (1900), C. A.

[2] 4 De G. J. & S. 137; 33 L. J. Ch. 199, Ld. Westbury; and 11 H. L. C. 523; 35 L. J. Ch. 53; H. L. overruling 1 H. & M. 271; 32 L. J. Ch. 721, Wood, V.-C. (1863). See also *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A., mark representing German cigars as of Havana make, cited p. 439.

[3] 33 L. J. Ch. p. 203. So per Fry, L.J., in *Newman* v. *Pinto*, 4 R. P. C. p. 520 (1887).

[4] *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; cf. *Eno* v. *Dunn*, 10 R. P. C. 261 (1893).

[5] Its use may amount to a criminal offence; sec. 89 of the Patents and Designs Act, 1907, replacing similar provisions of sec. 105 of the Act of 1883, below, p. 585; and Merchandise Marks Act, 1887, s. 3 (1) (e). Appendix, p. 807.

do not seem to have established any more definite rule than that it is in each case a question whether or not the employment of the word makes a false and deceptive claim to a non-existent patent right for the goods.[1] It is not necessarily deceptive to describe as "patent" goods made according to a process which once was patented, or even those made according to a process which is, or was when the epithet was first applied, different from the common process, though never protected by a patent, for ordinary usage and understanding have long sanctioned such descriptions, as the names patent leather, patent medicine, patent metal, patent yellow, and patent hoe, show.[2]

Lord Kingsdown's judgment in *The Leather Cloth* case.

The following passage from Lord Kingsdown's judgment, in *The Leather Cloth* case,[3] in reference to the subject under consideration, is very frequently cited in argument: "If a trade mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *primâ facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade mark to relief in a Court of Equity against anyone who pirated it. In *Hlavel* v. *Harrison*,[4] Wood, V.-C., intimated his opinion that this would be so when there never had been any patent at all. But in the subsequent case of *Edelsten* v. *Vick*,[5] he seems to doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade mark being true when first introduced, had been continued after it had ceased to be true. I confess that I should have had great difficulty in assenting to that distinction. If the word 'patent' be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that term (and this I collect to have been the main ground of his Honour's decision), then I quite agree with his view. In such case nobody is meant to be deceived, or is deceived. A patent may have

[1] The authorities cannot easily be reconciled under one rule: per Kekewich, J., *Hubbuck* v. *Brown* (1899), W. N. 251; 17 R. P. C. p. 156.

[2] See per Wood, V.-C., in *Edelsten* v. *Vick*, 11 Hare, 78 (1853); *Morgan* v. *McAdam*, 36 L. J. Ch. 228 (1866) (*Patent Plumbago Crucibles*): and *Cridley* v. *Swinborne*, 5 Times L. R. 71; 52 J. P. 791 (1888), Coleridge, L.C.J., and Grantham, J., (*Swinborne's Patent Refined Isinglass*). "The illustrious race whose drops and pills, have *patent powers* to vanquish human ills"—Crabbe, quoted in Ogilvie's Dictionary.

[3] 11 H. L. C. 523; 35 L. J. Ch. p. 64 (1865).

[4] 10 Hare, 467; 22 L. J. Ch. 866 (1853).

[5] 11 Hare, 78 (1853).

expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it. But if the trade mark represents the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection has never existed or has ceased to exist."

Expired patent.

And in a later case, Jessel, M.R., said: "No doubt a man may use the word 'patent' so as to deceive no one. It may be so used as to mean that which was a patent but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent that has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade mark. Protection only extends to the time allowed by statute for the patent, and if the Court were afterwards to protect the use of the word as a trade mark, it would, in fact, be extending the time for protection given by the statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade mark. But further, no man can claim a trade mark in a falsehood. It is a falsehood to represent that the patent is still existing."[1]

In *The Club Soda* case the plaintiff's mark consisted of a label bearing the words "Club Soda," and also "Manufactured in Ireland by H.M. Royal Letters Patent." This was explained to mean "manufactured by the aid of patented machinery." The offending words were also used in advertisements, but the goods were never called "patent club soda water." The Privy Council held that, having regard to the nature of the goods, no one could be deceived, and they gave judgment for the plaintiff.[2]

Where "patent" is not deceptive.

From the principles stated in these judgments, and from the decided cases, it follows that the use of the word "patent" in a trade mark for unpatented goods is not to be taken to be misleading where either it is shown that the market name of the goods comprises the word,[3] or where the goods are made according to an expired patent, and the word is so used as to be

[1] *Cheavin* v. *Walker*, 5 C. D. p. 862 (1877), C. A.

[2] *Cochrane* v. *Macnish*, [1896] A. C. 225; 13 R. P. C. 100.

[3] *Marshall* v. *Ross*, L. R. 8 Eq. 651 (*Patent Thread*); cf. *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 345, both (1869), James, V.-C.

understood to refer to this,[1] or wherein from the nature of the cases it is unlikely to mislead.[2]

The following is a summary of the reported cases on the subject[3]:—

Summary of cases where "patent" used.

Action barred.

First, where the plaintiff's action was barred: FLAVEL'S PATENT KITCHENER, no patent, *Flavel* v. *Harrison*, 10 Hare, 467; 22 L. J. Ch. 866; PATENTED JAN. 24, '56, patent void, *Leather Cloth Co., Ltd.* v. *American Leather Cloth Co., Ltd.*, p. 429; *Leather Cloth Co., Ltd.* v. *Lorsont*, L. R. 9 Eq. 345; PATENT PLUMBAGO CRUCIBLES, no patent, *Morgan* v. *McAdam*, p. 430; ROYAL LETTERS PATENT, no patent, but duty paid in respect of a patent medicine, *Lamplough* v. *Balmer*, W. N. (1867), 293;[4] MANUFACTURER AND PATENTEE, no patent, *Nixey* v. *Roffey*, W. N. (1870), 227; G. CHEAVIN'S IMPROVED PATENT GOLD MEDAL SELF-CLEANING RAPID WATER FILTER, expired patent, *Chearin* v. *Walker*, p. 431. In *Hubbuck* v. *Brown*, 17 R. P. C. 638, where the mark included the words HUBBUCK'S PATENT LONDON in circular form with the words WHITE ZINC within the circle, the mark being an old one registered for paints, it was shown that the plaintiffs had never had any patent for White Zinc Paint, and that although they had had a patent, long since expired, relating to the manufacture of oxide of zinc, they had ceased to confine their mark to paint made with oxide of zinc manufactured under the patent. Rigby, L.J., said that, if necessary, he should have held that the plaintiffs were disentitled to sue.[5]

[1] *Ransome* v. *Graham*, 51 L. J. Ch. 897 (1882), Bacon, V.-C. In *Morgan* v. *McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C., suggested that in these cases the date of the patent should be given. Cf. sec. 33 of the Patents and Designs Act, 1907, as to marking being notice to infringers.

[2] See note (2) previous page.

[3] The pages given refer to this book. See also *Adams' Tm.*, 9 R. P. C. 174; 66 L. T. N. S. 610 (1892), where Kekewich, J., refused to allow "patent" to be struck out of an old mark for furniture polish.

[4] "Patent medicines" are excepted *from* the prohibition upon the sale of poisons in the Pharmacy Act, 1868. The exception relates to medicines manufactured under letters patent only: *Pharmaceutical Society* v. *Piper*, [1893] 1 Q. B. 686; *Same* v. *Armson*, [1894] 2 Q. B. 720.

[5] See also *The Triticumina* case, *Meaby & Co.* v. *Triticine*, 15 R. P. C. 1 (1898), where North, J., held that that word was the name of a patented article (above, p. 47), and expressed the opinion, without deciding the point, that as the plaintiffs had represented the article as patented, they would be in no better position if the representation were untrue. And see the copyright case, *Slingsby* v. *Bradford Patent Truck and Trolley Co.*, [1906] W. N. 50, in which it appeared that many of the articles described in the plaintiffs' catalogue as "patent" had not been patented in England, and the action was dismissed on the ground that by reason of this and other misrepresentations the catalogue was not entitled to the protection of the Court.

Secondly, where the plaintiff's action was not barred: SYKES' PATENT, patent invalid, no plea having reference to the misrepresentation, *Sykes* v. *Sykes*, 3 B. & C. 541;[1] TAYLOR'S PATENT SOLID-HEADED PINS, expired patent, labels printed from the old blocks in use while the patent existed, *Edelsten* v. *Vick*, 11 Hare, 78; PATENT THREAD, no patent, evidence that patent was understood in the market to denote the character of the goods, *Marshall* v. *Ross*, L. R. 8 Eq. 651; CLUB SODA, MANUFACTURED IN IRELAND BY H.M. ROYAL LETTERS PATENT, *Cochrane* v. *Macnish*, above, p. 431. The case of *Ransome* v. *Graham*, 51 L. J. Ch. 897, must probably be explained as one of collateral misrepresentation, if it can be supported at all. There the trade mark consisted of letters and numbers stamped upon the working parts of the plaintiff's ploughs, and "patent" was stamped also, although the only patent which had ever existed related to the ploughshares merely, and had expired in 1817. The plaintiff's advertisements and catalogues stated that the patent had expired, but this could hardly be an answer to the objection, as the notice would not, or might not, reach all the persons who saw the stamp.

Action not barred.

The Registrar may refuse to accept any application upon which any of the following appear, namely, "Patent," "Patented," "By Royal Letters Patent," or words to like effect.[2]

"Patent," &c., not to be registered.

It is a misrepresentation which disentitles a label or other trade mark to protection or to registration, to indorse upon it anything which is calculated to mislead the public as to what is the mark of which the proprietor claims the exclusive use. The matter was first brought forward in *The Apollinaris* case,[3] where some of the labels in question had the word *trade mark* printed immediately under the red triangle or disc, which was their most prominent feature, although other parts of the labels, and, in particular, the words *Apollinaris* and *Friedrichshall*, were claimed as essential features of the trade marks. The application before the Court was to remove the marks from the Register on several grounds; and Fry, L.J., who delivered the judgment of the Court of Appeal, dealt with the present objection in the following passage[4]:—

"Trade mark."

The Apollinaris case.

[1] See *Hubbuck* v. *Brown*, cited above, p. 432.

[2] Rule 11, p. 651.

[3] [1891] 2 Ch. 186; 8 R. P. C. 137, C. A. In *Bass, Ratcliffe and Gretton, Ltd.'s Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 129, 529, C. A., cited p. 435, Romer, L.J., said that he should not have come to the same conclusion on the facts as the Court of Appeal did in the *Apollinaris* case.

[4] [1891] 2 Ch. p. 233.

"One (objection) was, that the mark was calculated to mislead, inasmuch as the whole label is registered as a trade mark, and yet contains the assertion that the red disc, which is the most conspicuous part of the whole label, is 'trade mark'—not saying 'a trade mark,' not saying part of 'the trade mark'—but an assertion pointing to the conclusion that it, and it alone, is 'the trade mark,' and therefore that the label, as a whole, is not the trade mark. Such would have been the impression produced (I am speaking for myself) on my own mind, had I approached the reading of the label unbiassed by what I have learned while sitting in this seat, and such, we think, is the true result of this case. An owner of a registered trade mark may put it on a registered label, but not so as to mislead a reader of that label, and induce him to believe the only thing registered is the distinctive mark." It is true, the learned Lord Justice added, that the objection might, apparently, have been taken in *Hudson's* case, where the mark there in question was upheld by the Court of Appeal,[1] but it was, in fact, neither discussed in argument nor considered by the Court.

This judgment caused a number of applications, under sec. 92 of the Act of 1883,[2] for leave to remove "trade mark" from registered marks to be made to the Court. The results of these are stated in Chapter X.[3]

It is to be observed that Fry, L.J., does not say that the use of the words "trade mark" within a label is necessarily misleading; it may be, but it is a question of fact whether it is or not.

Hammond v. Brunker.

In *Hammond* v. *Brunker*,[4] the registered label of the plaintiffs comprised a number of devices, and among them a small blank shield in the middle of the upper half. In use, the plaintiffs printed within the blank shield a hand and forearm holding a dart, and having the words "trade mark" beneath it. Chitty, J., in rejecting an objection founded upon this, said:[5] "It is a question of fact in every case where a man puts the term 'trade mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade mark only. In *The*

[1] 32 C. D. 311; 3 R. P. C. 155 (1886).

[2] Corresponding to sec. 34 of the Act of 1907.

[3] Page 272.

[4] 9 R. P. C. 301 (1892). Chitty, J., came to a similar conclusion of fact in *Benedictus* v. *Sullivan*, 12 R. P. C. 25 (1894), cited below, where the registered trade mark was the words "La Flor de Margaretta," see at p. 32.

[5] 9 R. P. C. 307.

Apollinaris case, the Lord Justice's observations were addressed to a label which had been registered, and had the term *Friedrichshall* above a disc, with a quantity of printed matter; the disc was coloured red, and underneath the disc were the words 'trade mark.' Without expressing a final opinion on the matter,[1] the Lord Justice thought that there were grounds for saying, on that label, that the trade mark referred to the disc, and if I may say so myself, with great respect, it seems to me that there were grounds. But, as I say, this is a question of fact, and I am satisfied that these words 'trade mark' in the middle of this label do not indicate to the public that the shield only is the trade mark. In *The Apollinaris* case there was no other device except the disc, which was coloured red, in use.[2] That being so, I think that these two grounds of objection to the plaintiff's suing, namely, the addition of the arrow and the forearm, and the addition of the words 'trade mark,' do not disentitle the plaintiff to ask for an injunction with regard to his trade mark."

In a later case,[3] Wright, J., held the objection to be fatal to one of the respondents' marks, a label, and ordered it to be removed from the Register. There the main portion of the label was occupied by a picture of the head of a negro, inclosed by a circular band containing the words *W. D. & H. O. Wills, Bristol.* Underneath this picture was printed in very large letters the word *Star*. At the side of the label, on the right, was a representation of an eight-pointed star; and in immediate proximity to the star the words "trade mark" occurred.

Bass' case.

A similar question came again before the Court of Appeal in *Bass' Tms.*,[4] in which Kekewich, J., had ordered the removal from the Register of a label, having in its centre a diamond (in black as registered) with the words "trade mark" on it; one of the grounds of removal was that the words were deceptive, as leading to the inference that the rest of the label was unregistered. A diamond coloured red on the Register was in fact separately registered and owned by the respondents. They successfully appealed, the Court of Appeal holding that no one could be

[1] This is hardly borne out by the report of the judgment of Fry, L.J.

[2] But there were the important words *Apollinaris* and *Friedrichshall*.

[3] *Dexter's Tm. and Wills' Tm.*, [1893] 2 Ch. 262; 10 R. P. C. 269. See also *Day and Riley* v. *Whittaker*, 17 R. P. C. 517 (1900), Buckley, J., as to the mark No. 70,347.

[4] [1902] 2 Ch. 579; 19 R. P. C. 129, 529.

misled or injured by the words as they appeared on the label. Romer, L.J., delivering the principal judgment, said that it could not be laid down as a general rule that, whenever the word "trade mark" appeared on a label, it must be intended to denote only that particular part of the label on which it was placed; and he continued as follows: "In the present case the word 'trade mark' is placed in the centre of the label upon the diamond, and I do not know why I should be bound to assume that the word is intended to apply only to the diamond. But it may so apply, and I will assume that it does. What then? In every case in which the word 'trade mark' is placed upon a particular portion of a label to denote that that portion is a trade mark, is the Court bound of necessity to hold that the label is calculated to deceive? In my opinion it is not. It may, no doubt, in some circumstances be calculated to deceive. If, for example, the part of the label to which alone the word is intended to refer is not in fact the subject of a separate trade mark, I think the label would be calculated to deceive, because it would lead an ordinary person reading it to suppose that the owner of the label as a whole had a specially greater right as against the public than he really had. But if there were a separate trade mark for that part of the label which is designated by the word 'trade mark,' why should it be assumed in every case that the word is calculated to deceive? As I have pointed out in the course of the argument, it is not sufficient to say that the label is 'calculated to deceive.' It must be shown that it is reasonably calculated to injure some one—to lead him to do or to abstain from doing some act the doing or the abstaining from doing which may possibly injure him. Now, there may be a perfectly innocent deception, which would injure no one. If there were such an innocent deception, it ought not to be a ground for removing a trade mark from the Register. The truth is the Court ought in each case to see in the first place whether, assuming that the word 'trade mark' refers to a particular portion only of the label, there would be a natural inference that the rest of the label, or the label as a whole, was not a trade mark. Speaking for myself, I refuse to take it as a natural or necessary inference in every case, from the fact that a particular portion of a label is designated as a 'trade mark,' that the whole of the label is not a trade mark. In my opinion such a conclusion ought not to be drawn in every case. You ought to go further, and to ask in each case, can it

be supposed from the particular facts of the case that there is any substantial probability of injury."

A combination trade mark and a part of it can be each registered, but, if registered under the Act of 1905, they must be registered as associated trade marks.[1]

False assertion of registration.

It is a penal offence to describe a trade mark as registered when it is not.[2] Such a misrepresentation is, it seems, sufficient to deprive the proprietor of the mark of his right to protection against infringers, or against persons who pass off their goods as his under cover of the mark.[3] In *The Melachrino* case,[4] however, Chitty, J., held that the use of the word "registered" with a mark in which blanks appearing on the registered form were filled up by coats of arms in use, was not a bar to the plaintiff's case; and it has been held by the Court of Appeal that the use of the words "special registered trade mark," before registration had been obtained, was not a sufficient objection to prevent the Court granting an interlocutory injunction.[5] And the Court of Appeal has allowed a mark to be registered which had been used with the words "registered shape." In this case both the mark (a dome-topped cylinder) and the words had been impressed on the blocks of blacklead, which were the goods in question, although the registration of the shape as a design had expired in 1864; but the case was not argued on behalf of the respondents.[6]

In *Benedictus* v. *Sullivan*,[7] the plaintiff had printed at the bottom of one of the labels used upon his cigar boxes "Regd. by H. B. 6458." The label comprised a number of devices and also the words *La Flor de Margaretta*. The words alone had been registered in the trade mark registry, and they were so registered under Number 6458. It was, however, held upon a consideration of the whole box and its other labels that there was

[1] Sec. 25, above, p. 109.

[2] Sec. 67, below, p. 585, replacing as to trade marks sec. 105 of the Act of 1883, s. 105, below, p. 642; Merchandise Marks Act, s. 3 (1) (c); see Appendix, p. 807.

[3] In *Sea Sea Co.* v. *Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137, Stirling, J., said, "Of course, if the plaintiffs are brought within the terms of that section they must be denied relief."

[4] 4 R. P. C. 215 (1887).

[5] *Read* v. *Richardson*, 45 L. T. 54 (1881), C. A. In *Lewis* v. *Goodbody*, 67 L. T. 194 (1892), Kekewich, J., refused an interlocutory injunction in a passing-off case, because the plaintiffs had represented that their mark was a registered trade mark. See p. 438, note (1).

[6] *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886). And see p. 438, note (5).

[7] 12 R. P. C. 25 (1895), Chitty, J. The label is printed in the report. The label was, in fact, registered at Stationers' Hall, but not under No. 6458.

no representation that anything besides the words of the label was registered.

"Trade Mark."

The description of an unregistered trade mark as a "trade mark" is no offence within sec. 67, and if the mark is, in fact, as it may be, a trade mark acquired by user, such description is not by itself a misrepresentation.[1] But a person is to be deemed for the purposes of sec. 67 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.[2] The use of the words "Trade Mark—Registered," or "Registered," is a representation of registration in this country, and, in the absence of words qualifying that meaning, the use of either expression referring to an unregistered mark is an offence under the section.[3]

Other misleading statements.

It was further suggested, in *The Apollinaris* case, and the Court of Appeal were inclined to hold, that the indorsement upon one of the labels used for natural mineral waters, and claimed as a trade mark, "imitations of this water will be prosecuted," meant all imitations, whether fraudulent or not, of the water, and was addressed, therefore, to artificial waters which might lawfully be made and sold as imitations of the natural water, and that, if it bore this meaning, it was calculated to deceive.[4]

The Registrar may refuse to accept any application upon which any of the following appear, namely the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," or words to like effect, and accordingly such words should not appear upon the representations of trade marks forming part of an application.[5]

The operation of a deceptive misstatement as to the origin of

[1] *Sen Sen Co.* v. *Britten*, p. 437, note (3). The mark there was registered in the United States. An interlocutory injunction was granted. Stirling, J., held that the use of the words "trade mark" was not a pretence of registration. Kekewich, J., who was reported in *Lewis* v. *Goodbody*, p. 437, note (5)), as having decided the contrary, has adopted this ruling: *Hubbuck* v. *Brown*, 17 R. P. C. 148; (1899), W. N. 250.

[2] Sub-sec. 2.

[3] *Wright, Crossley & Co.* v. *Dobbin*, 15 R. P. C. 21 (Q. B. D. Ireland); *MacSymons Stores, Ltd.* v. *Shuttleworth*, 15 R. P. C. 748 (Day and Channell, JJ.), both 1898, and decided therefore under the Act of 1883. See also *Winser & Co., Ltd.* v. *Armstrong*, 16 R. P. C. 167, as to use of "registered" after expiration of protection of design.

[4] [1891] 2 Ch. p. 226. As to the refusal of costs to a defendant on the ground of his misrepresentation, see below, p. 463.

[5] Rule 11, Appendix, p. 657. Cf. *Altman's Application*, 21 R. P. C. 753 (1904), Kekewich, J., and *Lyle and*

the goods in destroying the distinctive character of the mark, has been referred to in an earlier chapter.[1] In *The Eton Cigarette* case,[2] it was held that an English tobacconist, who put a Russian name, as that of the maker, upon his goods could not protect the mark which they also bore as his trade mark against infringements.

Fraudulent trade.

(ii.) Where the plaintiff uses the trade mark in aid of a fraudulent trade, the rule which bars his action is so clear that it will be sufficient to summarise the few cases reported on the subject.

Summary of cases.

A plea that the plaintiff made a practice of selling by short weight failed because it was not supported by the evidence, *The Guinea Coal* case, *Lee* v. *Haley*, L. R. 5 Ch. 155. A Pianoforte Tutor, described as "600th edition, specially revised by Hemy," although the musician referred to had not revised the work for ten years, was held not to be misleading, evidence being given that in the trade an issue of 250 was called an edition, *Metzler* v. *Wood*, 8 C. D. 606. A trade in German cigars sold in boxes bearing a label with the words LA PUREZA (an old Havana brand), HABANA, RAMON ROMEDO, and additional labels with other words and a sham address in Spanish was held to be fraudulent, the whole get-up being described by Bowen, L.J., as "an elaborate concatenation of pictorial lies" intended to pass off the cigars as made in Havana, although evidence was given that the name *Havana* in the cigar trade indicates the shape of the cigars only, *Neuman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31;[3] but the sale of English cigars under a label bearing the word HABANA, in boxes marked BRITISH MANUFACTURE, was held not to be fraudulent in the absence of evidence that the plaintiffs represented that their cigars were made in Havana, *Hargreaves* v. *Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237.[4] The application of the name CALIFORNIAN SYRUP OF FIGS to an aperient drug in which fig syrup

Havana cigars.

Kinahan's Application, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A., where representations before registration as to the marks being registered made by *bond fide* mistake or slip were not held sufficient ground for refusing registration.

[1] Chap. VIII., p. 200.

[2] *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*); on appeal this point was not specially dealt with, 18 R. P. C. 27.

[3] Cf. *Fuente's Tms.*, [1891] 2 Ch. 166; 8 R. P. C. 214; and *Dexter's Application*, [1893] 2 Ch. 262; 10 R. P. C. 269.

[4] Cf. *Benedictus* v. *Sullivan*, above, p. 437, where a Spanish look about the box, and the words "Fabrica de Tabacos de la Vuelta Abago," was held not to be a representation of foreign manufacture in the face of the words "Regalia Britannica," "Londini"; and *Robinson and Barnsdale, Ltd.'s* case, Times, April 2nd, 1901.

The Bile Bean case.

was used as a flavouring only was held not to be a misrepresentation: *Californian Fig Syrup Co.* v. *Taylor's Drug Co.*[1] In *Bile Bean Manufacturing Co.* v. *Davidson*, 22 R. P. C. 553; 23 R. P. C. 725 (1905), a case of alleged passing-off by means of the words "Bile Beans," the plaintiffs' advertisement falsely stated that the basis of their Bile Beans was an Australian herb discovered by an eminent scientist, whose name was given. There was no such person, and the story of the discovery given in the advertisements was an invention. These advertisements were not, however, on the pill boxes themselves. It was held by the Lord Ordinary that the plaintiffs' trade was a fraudulent one, and that the plaintiffs were disentitled to protection for it, and the action was dismissed on this as well as on other grounds, and the decision was upheld on appeal, it being held that the misrepresentation was not a collateral one, but affected the very essence of the article offered for sale.

Misrepresentation abandoned before, or commencing after action brought.

A misrepresentation which has been corrected and abandoned before the action is no bar.[2] The same rule is said to apply to one adopted after the commencement of the action. So Fry, J., stated in *Siegert* v. *Findlater*,[3] for, he said, applying the test laid down by Mellish, L.J., in *Ford* v. *Foster*,[4] its adoption could not, before Sir John Rolt's Act, have warranted the Court of Chancery in restraining the action had it been commenced in a common law Court. The learned Judge held, however, that in the case before him there was in fact no fraudulent misrepresentation which ought, in any case, to debar the plaintiffs. It is submitted, with great deference, that on principle it can make no difference, supposing the plaintiff is seeking the aid of the Court for a fraudulent trade, or for a trade conducted by fraudulent means, that the frauds commenced after the action was begun. The objection is not that the plaintiff's case is incomplete, or that the

[1] 14 R. P. C. 341 (1897), Kekewich, J., reversed on appeal on another point; 14 R. P. C. 564.

[2] *Benedictus* v. *Sullivan*, p. 437. See also the American case, *Siegert* v. *Abbott* (2) (1891), Cox, p. 486.

[3] 7 C. D. 801 (1878) (*Angostura Bitters*).

[4] L. R. 7 Ch. 611, cited p. 427, and *Faulder & Co., Ltd.* v. *Rushton*, 20 R. P. C. 477, at p. 489 (1903), Hall, V.-C., where the plaintiffs' trade mark had been removed from the Register after the commencement of the action, but the plaintiffs succeeded on passing-off. It was contended that the use by the plaintiffs of the words "trade mark" was a misrepresentation, and it was held that, if after the judgment removing the mark the continued use of the words was a misrepresentation, it was an honest and natural mistake and not such a mistake as disentitled them to relief. See p. 438, "Trade Mark."

defendant has any answer as of right to oppose to it, but that the plaintiff and his business are, when the Court takes cognizance of the matter, unworthy of its protection or assistance.

Alleged offences against Companies Acts.

It may here be noticed that in a firm name case the defendants set up that the use of the name by the plaintiffs, a limited company, had been in contravention of sec. 41 of the Companies Act, 1862, but Farwell, J., held that this was no defence,[1] and his decision has been followed in a later case.[2] But if a limited company sets up a claim to a trade name which they have used in association with their statutory name, they may find it difficult to establish that the trade name by itself indicates them or their goods; and if they omit all reference to their statutory name they may render themselves liable to penalties under sec. 42 of the Companies Act, 1862.[3] A trade mark is not necessarily an advertisement within sec. 41 of that Act.[4]

6. The Relief granted.

If the plaintiff succeeds in an action for infringement, he may obtain an order for—(i.) an injunction restraining further infringements of his rights; (ii.) the delivery up for destruction, or for the erasure of the marks, of any goods already marked with the spurious mark and in the possession or under the control of the defendant; (iii.) and damages in respect of the past infringement, or, in lieu of damages, an account of the profits made by the defendant by the sale of the spuriously marked goods, or for some one or more of these.

(i.) Injunction.

This was the characteristic remedy by which the Court of Chancery protected trade marks, either after the plaintiff had recovered damages for past infringements at law, or where it had been appealed to in the first instance and no action had been brought. It is generally the most beneficial relief for the plaintiff, because it summarily stops the particular infringement

[1] *Pearks, Gunston and Tee, Ltd.* v. *Thompson, Talmey & Co.*, 18 R. P. C. 185 (1901) (*Talmey & Co.*). On appeal the case was settled. Cf. Ld. Robertson's judgment in *Royal Baking Powder Co.* v. *Wright, Crossley & Co.*, 18 R. P. C. at p. 103.

[2] *H. E. Randall, Ltd.* v. *British and American Shoe Co.*, [1902] 2 Ch. 354; 19 R. P. C. 393, Swinfen Eady, J.

[3] See the judgments of Cozens-Hardy, M.R., and Farwell, L.J., in *H. E. Randall, Ltd.* v. *Bradley*, 24 R. P. C. 773 (1907).

[4] *Application of Albert Baker & Co.* (1898), *Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

which the defendant has practised, and makes it highly dangerous for him to commence any other, and it is operative against impecunious infringers who might care little for repeated judgments for damages against them. The Merchandise Marks Act of 1862[1] empowered a court of law, in any action for fraudulent infringement, to grant an injunction to the successful plaintiff; and, since the Judicature Acts, both divisions of the High Court have the same power as that formerly exercised by the Court of Chancery.

Further infringement must be threatened or be likely to occur.

The grant of an injunction in trade mark cases is governed by the general rules governing it where other rights are concerned. There must be some threat or probability that the infringement will be commenced, continued, or repeated, or the Court will not interfere;[2] but if an actual infringement is shown to have occurred that is usually sufficient, and the plaintiff is not bound to wait until it has been frequently repeated, or until warning has been given and been disregarded,[3] for "the life of a trade mark depends upon the promptitude with which it is vindicated."[4] So an injunction has been granted where the defendant had altered the device and discontinued the use of the labels complained of, and offered to undertake not to use any more of them,[5] although, in some instances, the undertaking of an innocent infringer has been accepted by the Court.[6] Nor is it necessary that any actual infringement should have occurred if it is proved that the defendant contemplates committing or has threatened to commit one,[7] and it is sufficient evidence of this that he is in possession of a considerable quantity of spuriously marked goods,[8] even though it is only as a forwarding agent.[9]

[1] 25 & 26 Vict. c. 88, s. 21, now repealed; see Chap. I., p. 17.

[2] See the cases in which isolated instances of infringement or passing-off only have been proved, above, p. 389. Also the patent case, *Hudson* v. *Chatteris Engineering Co.*, 15 R. P. C. 438 (1898), Stirling, J. The Court will presume that a trader will use his mark so as not to be deceptive, if it is capable of being used without the probability of being deceptive, unless some reason to the contrary is shown: *Kathoe's Tm.*, 10 R. P. C. 401 (1893), cited p. 271.

[3] See *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J., see above, p. 382.

[4] *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219.

[5] By Malins, V.-C., in *Guinness* v. *Heap*, Seb. Dig. p. 377 (1878); cf. *Tonge* v. *Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.

[6] *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

[7] See *The Emperor of Austria* v. *Day and Kossuth*, 3 De G. F. & J. 217; 30 L. J. Ch. 690 (1861), Campbell, C. and L.JJ.

[8] See above, note (3).

[9] *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

Proof of fraud not necessary.

It has already been shown that the fact that the infringement was not fraudulent,[1] or even that it was made in ignorance of the plaintiff's right,[2] is no defence to the claim for an injunction.

Form of injunction.[6]

The injunction is sometimes directed generally to restrain the infringement of the plaintiff's trade marks to which his title is established in the case,[3] but it is usually expressed with more particularity, to restrain the use by the defendant of such trade marks, or of marks only colourably differing from them, in connection with goods of the kind for which they are registered, by selling or otherwise disposing of the goods marked with such marks. Sometimes the particular colourable infringement of which the defendant has been proved to have been guilty is expressly referred to in the order, a general restraint being added. And, in some cases, the form of injunction which seems more appropriate to the unspecialised action for "passing-off" is made use of also, the defendants being restrained from "in any other way passing off their goods as those of the plaintiff."[4] To avoid a discussion upon a motion to commit for an alleged breach of the injunction,[5] it is obviously advantageous for the plaintiff to combine in the order a particular reference to the form of the infringement which has actually been committed or threatened, with general words, as wide as are obtainable, directed to prevent a colourable evasion of the decree.[6]

As it is not an infringement to use the plaintiff's mark upon his own goods, that is, goods which possess the attribute connoted by the mark,[7] the injunction is commonly expressed so as to prevent this being a breach of its terms.[8]

[1] *Millington* v. *Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.

[2] *Moet* v. *Couston*, 33 Beav. 578 (1864), Romilly, M.R.; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, C.

[3] *The Bodega Co., Ltd.* v. *Riviere*, 6 R. P. C. 243 (1888), Chatterton, V.-C.; *Montgomery* v. *Thompson*, [1891] A. C. p. 218; 8 R. P. C. 361.

[4] *Slazenger & Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

[5] See, for instance, the question which arose in *Ripley* v. *Arthur*, 19 R. P. C. 443 (1902), where on a division of opinion between V. Williams and Stirling, L.JJ., the judgment of Farwell, J., dismissing a motion to commit was affirmed.

[6] See the forms of injunction collected in the Appendix, p. 730, and in Seton, 6th ed., Vol. I., 623. The Court will not in anticipation lay down a course of conduct for the defendant, *Kerfoot* v. *B. A. Cooper, Ltd.*, 25 R. P. C. 508 (1908), Eve, J., *Street Lips Cachous*.

[7] Chap. II., p. 33. And see *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

[8] Cf. the "passing-off" cases; *Siegert* v. *Findlater*, 7 C. D. 801; and *Braham* v. *Beachim*, 7 C. D. 848, both (1878), Fry, J. In *Palestine Wine and Trading Co., Ltd.*, v. *Cohen*, 23 R. P. C. 568 (1906), Warrington, J., the defendants contended that the goods in question were goods sold by the plaintiffs, but it was held

And in cases where the infringement has been effected by the employment of a word, to the exclusive use of which the plaintiff has no title, the injunction should, it seems, be directed to restrain the defendant from using the word without clearly distinguishing his goods from those of the plaintiff, not to forbid his using it altogether.[1]

Injunction directed to future consignments of goods only.

In a case where the plaintiffs refrained from taking proceedings on learning that the defendants had received a small quantity of the infringing goods, but waited until they had got a larger consignment, Malins, V.-C., ordered the injunction to be directed to stop the sale of future consignments only.[2] It is submitted, however, with great deference, that the calculated conduct of the plaintiffs was not a sufficient reason for allowing the goods already received to be sold under the deceptive labels, although it might have been an answer to a claim for damages for past infringements. It has certainly been held that acquiescence, not sufficient to bar the plaintiff's right, may, in some classes of actions, cause the Court to refuse relief by injunction, and to grant the plaintiff damages only,[3] but the case last referred to did not involve any continuing fraud or deception.[4]

Injunction refused because of acquiescence.

Injunction limited to a particular market.

The injunction may also be limited with reference to the use of the mark in a particular country or market,[5] for instance, if it is calculated to deceive there only,[6] or in a particular manner, as

that there was a trick to sell as the plaintiffs' brandy something which was not in substance the plaintiffs' brandy, the defendant having diluted the same.

[1] *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1865), Wood, V.-C., and Cranworth, L.C.; *Johnston* v. *Orr-Ewing*, 13 C. D. 434; 7 App. Ca. 219 (1880), Fry, J., C. A. and H. L.; and see *Montgomery* v. *Thompson*, [1891] A. C. 217; 8 R. P. C. 361; and *Reddaway* v. *Banham*, [1896] A. C. 199; 13 R. P. C. 218; and also the special proviso to the injunction in *Beecham* v. *Hughes*, 15 R. P. C. 290 (1898), North. J.

[2] *The Anglo-Swiss Condensed Milk Co.* v. *The Swiss Condensed Milk Co.*, W. N. (1871). 163.

[3] *Sayers* v. *Collyer*, 28 C. D. 103, per Fry, L.J. A case relating to a restrictive covenant in regard to buildings. In a passing-off action a delay of three and a half years was under the circumstances of the case held not to disentitle the plaintiffs to an injunction: *Reddaway* v. *Stevenson*, 20 R. P. C. 276 (1903). Cf. *McCaw, Stevenson and Orr, Ltd.* v. *Lee*, 23 R. P. C. 1 (1906), Swinfen Eady, J. And below, p. 455.

[4] The action for infringement may wholly fail, because the defendant has used the plaintiff's mark so long that there is no longer any deception, as in *The Marquis of Londonderry* v. *Russel*, 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A. Above, p. 426.

[5] *Carver* v. *Bowker*, Seb. Dig. p. 350. (1877), Little, V.-C.; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; see *Société, &c. de l'Etoile's Tm.*, 10 R. P. C. 436; [1894] 1 Ch 61, Stirling, J., and above, pp. 232 and 391.

[6] See *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J., and above, p. 391. Cf. *Cowie* v. *Herbert*, 14 R. P. C. 436 (1897), Court of Sess.

by sending goods marked with it to English ports for shipment to the colonies.[1]

Interlocutory application for an interim injunction.

The plaintiff in an infringement or "passing-off" action usually moves, as soon as the action is commenced, for an interim injunction to restrain the defendant, until the hearing of the action or further order, from continuing or committing the infringement or deceptive conduct of which he complains, either getting leave to serve notice of motion with the writ,[2] or serving it after the defendant has appeared. In a plain case the motion is, in the first instance, sometimes made *ex parte* for an injunction until the day for which the notice of motion is given; and in a case where the defendant is committing a deliberate fraud, it is important, if possible, to obtain an *ex parte* order before giving him a notice which may lead to the disposal of any spurious goods which he is about to put upon the market.

Balance of convenience.

Where the plaintiff's title is disputed, or the fact of infringement is doubtful, or misrepresentation amounting to a bar to the action, or some other defence is plausibly alleged upon the interlocutory motion, the Court, in granting or refusing the interim injunction, is guided principally by the balance of convenience, that is, by the relative amounts of damage which seem likely to result if the injunction is granted and the plaintiff ultimately fails, or if it is refused and he ultimately succeeds. Thus, in *Read* v. *Richardson*,[3] on the defendants undertaking to keep an account, Jessel, M.R., refused an interlocutory injunction; but the Court of Appeal granted it because, while the defendants had only recently commenced to use their mark, and their trade was admittedly not dependent on it, the plaintiffs had a large trade in connection with which they used the label alleged to be infringed, and their rights would have been irremediably and incalculably injured unless the injunction were granted, if their case should be established at the trial. In this action the defendants' mark had been registered as well as the plaintiffs', and the defendants asserted that the plaintiffs' action was barred

[1] *Rodgers* v. *Rottgen*, 5 Times L. R. 678 (1889), Kay, J.

[2] Ord. 52, r. 9.

[3] 45 L. T. 51 (1881) (*Dog's Head Beer*). In *Evans* v. *Smith*, 3 Times L. R. 390 (1887), Kay, J., refused an interlocutory injunction because it was a serious question whether the plaintiff's registered trade mark *Montserrat* was a "special and distinctive word." But *quære* whether sufficient weight was given to sec. 76 of the Act of 1883 in this case; see *Hommel* v. *Bauer*, 20 R. P. C. 801 (1903), Byrne, J., and above, p. 387, note (8).

because the plaintiffs had, before registration, printed the words "specially registered trade mark" upon their labels.[1]

As appears by the cases just cited, it is not necessary for the plaintiff, upon the interlocutory application, to give conclusive evidence as to his title to the mark. It is sufficient if he makes it appear probable that he will succeed at the hearing, at least in order to bring the question of balance of convenience before the Court, and where there is reason to doubt the good faith of the defendant, the Court is more easily induced to interfere.[2]

Interim injunction refused on account of delay.

The interim injunction will not be granted if the plaintiff has delayed interfering until the defendant has built up a large trade in which he has notoriously used the mark,[3] or if the plaintiff has delayed for a considerable time after he knew of the matters complained of, unless the delay is explained.[4] And in a case in which the acts complained of had been going on for five years, and the plaintiffs failed to satisfy the Court that they did not know of them, an interlocutory injunction was refused.[5] But a slight use of the defendant's mark, chiefly upon sales to a few purchasers for their private use, will not prevent the Court from interfering in a case where the plaintiff's trade is considerable.[6]

[1] As to this plea, see above, p. 437. Jessel, M.R., had refused the injunction on the ground of no apparent infringement. See also *Parker and Smith* v. *Satchwell*, 17 R. P. C. 713 (1900), where the Court of Appeal in a passing-off case granted an interlocutory injunction, which had been refused by Cozens-Hardy, J., on the ground of no probability of deception; a perpetual injunction was granted at the trial, 18 R. P. C. 299 (1901), Farwell, J. In *Alaska Packers' Association* v. *Crooks*, 16 R. P. C. 503, an interlocutory injunction granted on the balance of convenience by Kekewich, J., was discharged on special (arranged) terms. The plaintiffs failed at the trial. 18 R. P. C. 129 (1901).

[2] *Radde* v. *Norman*, L. R. 14 Eq. 348 (1872), Wickens, V.-C.

[3] Above, pp. 421 and 424.

[4] *North British Rubber Co.* v. *Gormully Co.*, 12 R. P. C. 17 (1894), Chitty, J., a patent case. In *Army and Navy Co-operative Society, Ltd.* v. *Army, Navy and Civil Service Co-operative Society of South Africa, Ltd.*, 19 R. P. C. 574 (1902), Buckley, J., a trade name case, a delay of three months after the plaintiffs became aware of the incorporation of the defendant company was held to be sufficiently explained.

[5] *Yost Typewriter Co., Ltd.* v. *Typewriter Exchange Co.*, 19 R. P. C. 422 (1902), Buckley, J. In *Van Oppen & Co., Ltd.* v. *L. Van Oppen*, 20 R. P. C. 617 (1903), Swinfen Eady, J., the plaintiffs failed to get an interlocutory injunction as to part of the relief claimed, there having been a protest on their part some two years before, without result. See also *Royal Warrant Holders' Association* v. *Slade & Co., Ltd.*, 25 R. P. C. 245 (1908), Swinfen Eady, J.

[6] *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A. *Apollinis*, used in Germany from 1876, and in England from 1881. *Derby Photographic Dry Plate Co., Ltd.* v. *Pollard*, 2 Times L. R. 276 (1886), Bacon, V.-C.; *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

If the plaintiff intends to ask for an interim injunction he ought to apply for it as soon as possible after commencing proceedings.[1]

Application adjourned to the trial.

And if no actual infringement is in progress, and no harm is likely to be done, and the motion is seriously contested, it is usually referred to the trial.

Interim injunction limited as closely as possible;

only granted on undertaking as to damages.

The interim injunction, being intended only to preserve the plaintiff's rights from serious detriment until the hearing, is, at any rate in cases which appear to be doubtful or honestly disputed, limited as closely as possible to what is sufficient to attain that end.[2] It is only granted upon the plaintiff undertaking to be responsible in damages for the loss (if any) occasioned by it to the defendant, should it turn out at the hearing that it ought not to have been granted.[3]

A common form of interlocutory injunction is to restrain a wharfinger or consignee from passing into the market goods alleged to bear spurious marks until the trial or further order.[4]

Cross motions for injunction and to expunge.

A large proportion of the seriously contested trade mark cases commence with cross motions for an interim injunction, and to expunge or vary the plaintiff's registered mark. The question in what cases it is open to a defendant, without such a motion to expunge or vary to dispute the validity of the plaintiff's registion has been discussed elsewhere,[5] but it would seem that on an application for an interlocutory injunction, the validity cannot as a rule be so disputed.[6]

[1] *Knowles* v. *Bennett*, 12 R. P. C. 137 (1894), Robinson, V.-C., a designs case.

[2] See *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; and *Alaska Packers' Association* v. *Crooks*, above, p. 446, note (1).

[3] Whenever an undertaking to the Court is given in lieu of an interlocutory injunction there is inserted in the order a cross-undertaking in damages by the applicant unless the contrary is agreed and expressed at the time, Resolution of Chancery Judges (1904), W. N. pp. 203, 208, and see *Oberrheinische Metallwerke* v. *Cocks* (1906), W. N. 127. The Court of Appeal had previously held that there was no general practice under which such a cross-undertaking was implied, *Howard* v. *Press Printers, Ltd.* (1904), W. N. 198. As to the calculation of the damages covered by the undertaking, see *Mansell* v. *The British Linen Co. Bank*, [1892] 3 Ch. 159. Under special circumstances the defendant may be left to move specially to enforce the undertaking: *J. & J. Cash, Ltd.* v. *Cash*, 18 R. P. C. 213 (1901), Kekewich, J., where the final order was narrower than the interlocutory order, the terms of the perpetual injunction being modified on appeal, 19 R. P. C. 181 (1902).

[4] *Rivero* v. *Norris* (1868), Seb. Dig. p. 178; Seton, 5th ed., p. 536, Giffard, V.-C.; *Del Valle* v. *Mayer* (1870), Seb. Dig. p. 195; Seton, *ibid.*, James, V.-C.

[5] Above, pp. 325 and 386. *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; *Read* v. *Richardson*, 45 L. T. 54, cited p. 445.

[6] *Hommel* v. *Bauer*, 20 R. P. C. 801 (1903), Byrne, J., but see *Evans* v. *Smith*, 3 T. L. R. 390 (1887), Kay, J.

In a case where the defendant claimed a right to the mark in question, and had applied to register it himself, an interlocutory motion for an injunction by the plaintiff was ordered to stand over pending the result of the application.[1]

Undertaking to keep an account.

And sometimes, where there is a substantial case to be tried, the application for an interim injunction is ordered to stand over to the hearing upon the defendant undertaking to keep an account of his sales under the mark objected to.[2]

Enforcement of the injunction

Breaches of the injunction are contempts of Court, which may be punished by the committal or attachment[3] of the guilty person, or by ordering him to pay a fine or costs. "Committal was the proper remedy for doing a prohibited act, and attachment the proper remedy for neglecting to do some act ordered to be done," but there is now no substantial difference between the two.[4] The course usually adopted is to move to commit, the notice of motion being personally served upon the respondent, or if this is impracticable, leave for substituted service being obtained.[5]

The order granting the injunction should be forthwith drawn up and served upon the defendant, but no formal service or notice of it is necessary to enable the Court to enforce it. It is sufficient to subject him to the risk of committal, if he infringes it, that the defendant or other respondent is shown to have been in fact aware of the order for the injunction having been granted or made,[6] although, as a general rule, a person intending to ask the Court to enforce an order by committal or attachment should proceed strictly.[7]

Where an injunction is granted in general terms, and the defendant is not doing the specific thing on which the judgment was founded, or the injunction having been obtained on default, no specific thing has been admitted or found to be an infringement, the plaintiff may, when moving to commit, be in some difficulty,

[1] *Edwards* v. *Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

[2] *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Apollinaris Co.* v. *Saook*, 7 R. P. C. 474 (1890), North, J.

[3] Ord. 42, r. 7, or in the case of a corporation, by sequestration of its property or attachment of its officers, Ord. 42. r. 31.

[4] *Callow* v. *Young*, 56 L. T. 147; *Harvey* v. *Harvey*, 26 C. D. p. 654; *Evans* v. *Nolan*, [1893] 1 Ch. 252. The proper remedy for the breach of an *undertaking* is committal: *D.* v. *A. & Co.* (1900), W. N. 30.

[5] See the notes to Ord. 44. r. 1, in the Annual Practice.

[6] *Marcovitch* v. *Bramble, Wilkins & Co.*, Seb. Dig. p. 363 (1878), Malins, V.-C. Annual Practice note to Ord. 42. r. 7; and see *United Telephone Co.* v. *Dale*, 25 C. D. 778.

[7] *Incandescent Gas Light Co.* v. *Riemer*, 17 R. P. C. 378 (1900), C. A.

for in a case in which a mere comparison of the two marks or things does not show that the defendant is committing a breach of the injunction, it is necessary for the plaintiff to prove by evidence that there is probability of deception.[1]

Unintentional breach of the injunction.

The principal question upon an application to commit for breach of an injunction restraining the infringement of a trade mark is, generally: Does the new mark of the defendant constitute an infringement or not? And it may be assumed that if the Court is satisfied that the defendant has honestly tried to select a mark which is not objectionable, having regard to its order, it will be unwilling to send him to prison because he has failed in his endeavour. But the Court has jurisdiction to commit for disobedience to an order which is not shown to have been wilful.[2] If the defendant is in the wrong, even though by mistake or misfortune, he is usually ordered to pay the costs of the motion.[3] A mere servant of the defendant should not be joined as respondent to a motion to commit.[3]

Choice of a new mark by the defendant.

It may be safely assumed also that in the case suggested above the Court will be careful not to compel an honest trader to alter his mark more than is necessary to protect the plaintiff's rights. But the following passage from Lord Romilly's judgment in *Bass* v. *Dauber*,[4] goes, perhaps, too far, for the plaintiff is entitled to have the full extent of his right secured to him, without reference to the loss which it occasions to the defendant. "If a person has *bonâ fide* taken a label or trade mark which does resemble the label of another person, and this is not done with the intention to deceive, the Court will not require him to change it completely, because the change of a trade mark is a serious thing. . . . It is like beginning a new firm."

In a case where the plaintiff refused to take any notice of a label which the defendant suggested and proposed to adopt in lieu of the label against the use of which the injunction was

[1] *Ripley* v. *Arthur*, 19 R. P. C. 443 (1902), Farwell, J., and C. A., a passing-off case. "An admission by default in pleading never admits anything beyond what is *necessary to carry the judgment*." Per Vaughan Williams, L.J., at p. 448.

[2] *Hewitt* v. *Mansell*, 29 Sol. J. 66. In *Parker Manufacturing Co.* v. *Cooper*, 18 R. P. C. 319 (1901), Cozens-Hardy, J., refused to commit the defendant for an isolated instance of passing-off by the defendant's son without the defendant's knowledge; no order was made as to costs.

[3] *Daniel and Arter* v. *Whitehouse*, 16 R. P. C. 71 (1899). North, J. See note (2).

[4] 19 L. T. N. S. 626 (1869), Seb. Dig. p. 186.

granted, Langdale, M.R., himself undertook to determine whether the distinction between the labels was sufficient.[1]

Delay in application to commit.

If the plaintiff delays taking steps to enforce the injunction for a considerable time after he knows of the fresh infringement, the delay may cause the Court to refuse to commit; but if the infringement is continuing, it has been said that "there must—in order to deprive the party who has obtained the injunction of the right to move for committal upon the breach of it—be a case made out almost amounting to such a licence to the party enjoined, to do the act enjoined against, as would enable him to maintain a bill against others for doing the act. The party enjoined must, I think, show such acquiescence as would be sufficient to create a new right in him."[2] In the case just quoted, the injunction was granted in 1847, the new infringement began in 1848, and was continued until the motion to commit in 1853. The Lords Justices, however, were not satisfied that the plaintiffs were aware of it. Stuart, V.-C., refused the motion on the ground of the delay, but the Lords Justices directed that the defendant should be committed unless, within a week, he suggested, and undertook to use for the future, a mark which the Court should consider satisfactory, and they ordered that he should pay the costs of the motion.

In *Cartier* v. *May*,[3] where the plaintiff delayed moving for fifteen months after the defendant had commenced a new infringement not expressly covered by the injunction, Wood, V.-C., refused to commit the defendant, but ordered him to pay the costs of the application, and enlarged the injunction so as to make it extend to the new fraud.

(ii.) Delivery up of the marked articles.

Erasure of the spurious marks.

The Court not only forbids further infringement by its injunction, but, where the defendant is proved to have spuriously marked articles in his possession or under his control, it also orders the erasure of the marks,[4] or the delivery up of the marked

[1] *Croft* v. *Day*, 28 Leg. Obs. 378; *Nowill*, 3 De G. M. & G. 614; 22 L. J. Ch. 404 (1853).

[2] Per Turner, L.J., in *Rodgers* v. *Nowill*, note (2); and p. 443, note (6).

[3] Seb. Dig. p. 111 (1861).

[4] *Dent* v. *Turpin*, 2 J. & H. 139: 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Upmann* v. *Elkan*, L. R. 12 Eq. 140; 7 Ch. 130, Romilly, M.R., and Hatherley, L.C., p. 451, note (5) below.

Seb. Dig. p. 39 (1844), *on a motion to commit*. The French Courts, apparently, will order affirmatively what the defendant is to do: see *Grezier* v. *Autran*, 13 R. P. C. at p. 10; see also *Rodgers* v. *Nowill*, note (2); and p. 443, note (6).

articles for that purpose, or, if erasure is impracticable, for destruction.[1] Thus, in *Slazenger* v. *Feltham*,[2] where the word *Demotic*, an infringement of the plaintiffs' mark *Demon*, was stamped upon the defendants' tennis racquets, the order of Kekewich, J., for the destruction of the racquets, was varied by the Court of Appeal, upon it being pointed out that the spurious mark could be planed off; and it was ordered that the defendants should make an affidavit verifying the number of the racquets, and that they should either deliver up the racquets to the plaintiffs, to be destroyed, or satisfactorily erase from them the name *Demotic*, in the presence of the plaintiffs or their agent.

Delay.

A plaintiff may lose his right to delivery up if he unduly delays the commencement of his action.[3]

Interests of innocent persons in the marked goods unaffected.

Lien for costs.

The lien of a wharfinger for his charges in regard to goods deposited with him, including the costs he is put to by being made a defendant in a trade mark action, is not destroyed if the goods turn out to be spuriously marked;[4] and although, in some earlier cases,[5] the plaintiff was adjudged to have a lien upon the goods, subject to that of any wharfinger or mortgagee who had an earlier charge, and who was innocent in regard to the infringement, the Court of Appeal, in the case last cited,[4] expressed considerable doubt whether such a lien could be supported. Of course, neither the wharfingers nor any other persons interested in the goods would be allowed to sell or dispose of the goods until the spurious marks were removed.

The duty of the bailee of infringing goods.

A wharfinger, transport agent, or other bailee who finds that goods committed to his charge are spuriously marked, therefore,

[1] *Farina* v. *Silverlock*, 4 K. & J. 650 (1858), Wood, V.-C. The repealed Merchandise Marks Act of 1862, s. 21, empowered the Court to direct any chattel to which any trade mark had been fraudulently applied, or which had been exposed for sale with a forged or counterfeited trade mark applied to it, to be destroyed or otherwise disposed of. The Act of 1887 empowers it to forfeit every chattel by means of, or in relation to which, an offence under the Act has been committed, to her Majesty, and it contains a power for the Court to order the destruction of the forfeited articles; sec. 2 (3), (4); Appendix, p. 806. In *Maréchal and Ruchon* v. *M'Colgan*, 18 R. P. C. 262 (1901), Chatterton, V.-C., Ireland, the stamp was ordered to be delivered up.

[2] 6 R. P. C. 531; 5 T. L. R. 365 (1889), Kekewich, J., and C. A.

[3] *County Chemical Co., Ltd.* v. *Frankenburg*, 21 R. P. C. 722 (1904), Ld. Alverstone, L.C.J., five months' delay before complaint, the boxes complained of being capable of being used in ways not a breach of the injunction.

[4] *Moet* v. *Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), C. A., reversing Fry, J.

[5] *Ponsardin* v. *Pelo*, 33 Beav. 642; 33 L. J. Ch. 371 (1863), Romilly, M.R.; *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

is justified in refusing to deliver them up until the objectionable marks have been erased.[1] And, further, he is entitled to an indemnity from the bailor against the damages and costs incurred by him by reason of his dealing with the goods at the latter's request.[2] His proper course, on being informed by the owner of the trade mark infringed, or his agents, that goods in his possession are spuriously marked, is to give all necessary information to enable them to stop the infringement, to undertake that the goods shall not be removed or dealt with until the spurious marks have been obliterated, and to give the persons injured all requisite facilities for that purpose.[3] If he takes this course, the costs of any proceedings subsequently taken against him by the plaintiff will be ordered to be paid to him;[4] but he must pay the costs of proceedings previously taken, even though in an action commenced without notice to him,[5] unless the value of the infringing goods in his possession is trifling.[6]

(iii.) Damages or Profits.

Nominal damages.

It was long ago decided at common law, that the mere proof of an infringement entitles the plaintiff to nominal damages,[7] and that, consequently, no allegation of special damage is a necessary part of his case.[8] And the natural consequence of an infringement, even though it be made in complete ignorance of the plaintiff's rights, is that the infringer must pay at least nominal damages, and the costs of action, so that, if he acted under the direction of a third person, he may reasonably compound with the proprietor of the trade mark on these terms, and claim an indemnity from his employer.[9]

Indemnity to agent or purchaser

[1] *Hunt* v. *Maniere*, 34 Beav. 157; 34 L. J. Ch. 142 (1864). Romilly, M.R., and L.JJ. Action by indorsee of dock warrants against wharfingers restrained. In *Knowles* v. *Bennett*, 12 R. P. C. 137 (1894), Robinson, V.-C., shipowners were restrained from parting with the goods except to the plaintiffs.

[2] *Dixon* v. *Fawcus*, 3 E. & E. 537 : 30 L. J. Q. B. 137 (1861).

[3] *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Latherley, C.

[4] Last case, and *Moet* v. *Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

[5] See last cases, and *Upmann* v. *Forester*, 24 C. D. 231 (1883). Chitty, J.

[6] *American Tobacco Co.* v. *Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

[7] *Blofeld* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833). In *Daniel* v. *Whitehouse*, 15 R. P. C. 134 (1898), Gorell Barnes, J., 40s. damages were given.

[8] *Rodgers* v. *Nowill*, 5 C. B. 109; 17 L. J. C. P. 52 (1847). See also *Baldwin* v. *Benthum Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503.

[9] *Dixon* v. *Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861). As to implied warranty by the use of a trade mark, see below, Chap. XVII., p. 552. As to third

Onus of showing substantial damage lies on the plaintiff.

But, if the plaintiff claims substantial damages, the onus of showing what loss he has actually sustained by reason of the defendant's conduct, lies upon him; and it will not be presumed, in the absence of evidence, that the amount of goods sold by the defendant under the infringing trade mark would, but for the defendant's unlawful use of the plaintiff's mark, have been sold by the plaintiff.[1] The proper form of an order for an inquiry as to damages occasioned by the infringement of a trade mark is, therefore, what damage (if any) has the plaintiff sustained.[2]

In general, the only injury which is done by an infringement is that the defendant's goods are sold instead of those of the plaintiff, and the sale of the latter is, in some degree, diminished in consequence. But it may, under exceptional circumstances, appear that further damage has been done, for instance, where the spurious goods are so inferior to the genuine as to injure the trade reputation of the plaintiff,[3] or where the stress of the competition compels the plaintiff to lower his prices in order to avoid being driven from the market, and the reduction does not, as it may, bring him a sufficient increase of business to make up for the loss of profit on each article sold.[4]

The case of *Alexander* v. *Henry*[4] is an example of such exceptive decision on the subject is *Faber* v. *Hoey* (Codd. Dig. 39, 40 (1875)), decided by the General Term of the Supreme Court of New York, and affirmed on appeal by a divided Court, in which the latter rule was applied, although the mark involved was of a strictly technical nature." As is stated in the text, the plaintiff in England has usually the option of taking the defendant's profits in lieu of damages.

party notice claiming an indemnity, see *Hennessy* v. *Dompé*, 19 R. P. C. 333 (1902).

[1] *Leather Cloth Co.* v. *Hirschfield*, L. R. 1 Eq. 299 (1865), Wood, V.-C.; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. (a passing-off case). If there is a demand which remains unsatisfied after the infringing goods have been sold, it may be inferred that genuine goods would have been sold in place of all the latter: *Alexandre* v. *Henry*, 12 R. P. C. 360 (1895), Kekewich, J. In the United States there appears to be a question whether any recognised rule of law exists on the point or not. Mr. Cox says (p. 198): "There is a conflict between the cases as to the proper measure of damage for the infringement of a trade mark. It has been held in many instances that the profits of the defendant is the true measure, and in others that it is the profits which would have been realised by the plaintiff had he sold the quantity of goods shown to have been sold by the defendant. Perhaps the most authorita-

[2] *Davenport* v. *Rylands*, L. R. 1 Eq. p. 308, per Wood, V.-C.

[3] *Sykes* v. *Sykes*, 3 B. & Cr. 541; 3 L. J. K. B. (O. S.) 46 (1824).

[4] See the patent cases: *American Wire Co.* v. *Thomson*, 44 C. D. 274; 7 R. P. C. 152 (1890), C. A.; and *United Horseshoe Co.* v. *Stewart*, 13 App. Ca. 401; 5 R. P. C. 260 (1888), both discussed in *Alexander* v. *Henry*, 12 R. P. C. 360 (1895), Kekewich, J., *British Motor Syndicate* v. *Taylor*, 17 R. P. C. 189, 723 (1900); and *Leeds Forge Co., Ltd.* v. *Deighton's Patent Flue and Tube Co., Ltd.*, 25 R. P. C. 209 (1908), Swinfen Eady, J.

tional circumstances as are referred to above. There the plaintiffs had had complete command of the Mexican market for their thread until it was taken from them by the fraudulent imitations of their marks in respect of which the damages were awarded. The result of the imitations was (1) to enable the defendants to make sales which would otherwise have been made by the plaintiffs; (2) to compel the plaintiffs to reduce their prices; and (3) so to injure the plaintiffs' reputation that the defendants were able to sell goods, without disguise,[1] in competition with them. The action was not defended, and the assessment of damages was referred to an Official Referee who awarded £772 under head (1), and £2,295 under head (2) against one set of defendants (the Henrys), and a lump sum of £5,000 (apparently) under head (3) against the other set of defendants (the Wallers). On an appeal to Kekewich, J., this award was supported.

If the infringement is a continuing one, the damages ought to be assessed down to the time of the assessment.[2]

Damages or profits.

The plaintiff may, in general, make his choice of either an account and payment to him of the profits which the defendant has gained by his wrongful conduct, or an inquiry as to, and payment of, the damages occasioned to the plaintiff by reason of it,[3] that is, unless the case is tried before a jury and damages are assessed by the jury at once, or assessed by the judge sitting alone, acting as a jury.

Account of profits and damages are alternative.

The account and inquiry are alternative remedies,[4] for though in some of the earlier cases they were both allowed, they are now considered to be inconsistent. "If you take an account of profits, you condone the infringement," Lord Westbury said, in a patent case,[5] and the same rule applies in trade mark cases also.

Account or inquiry only granted if substantial damage is shown.

But neither an account nor an inquiry as to damages will be granted if the evidence of sales under the objectionable mark is not sufficient to make it worth while,[6] or if it appears that the

[1] This appears to be the meaning of paragraph 3 of the referee's report.

[2] Ord. 36, r. 58.

[3] *Weingarten* v. *Bayer*, 22 R. P. C. 341 (1905), H. of L., a passing-off case, in which Vaughan Williams and Cozens-Hardy, L.JJ., had intimated that if they had considered the plaintiff entitled to any relief, damages and not an account of profits ought to be given. In the House of Lords the plaintiff partially succeeded, and an account of profits was ordered. See also *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863); *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Saelchner* v. *Apollinaris Co.*, 14 R. P. C. 645; cf. *Hodgson* v. *Kynoch*, 15 R. P. C. 465 (1898), Romer, J.

[4] Per Cotton, L.J., in *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887).

[5] *Neilson* v. *Betts*, L. R. 5 H. L. 1 (1871); followed in *De Vitre* v. *Betts*, L. R. 6 H. L. 319 (1872).

[6] *Sanitas Co., Ltd.* v. *Condy*, 4 R. P. C. 530 (1887), Kekewich, J.; neither was

defendant has only used his mark for a short time.[1] For instance, no account or damages was allowed or given in a case where the only infringement proved was by the defendant, at the request of a customer, filling with lime-juice of his own make, a bottle embossed with the plaintiff's mark, removing the plaintiff's label, and replacing it by his own.[2]

They only go back for six years;

Damages can only be recovered, and the profits to be included in the account can only be reckoned, in respect of infringements occurring within six years from the issue of the writ,[3] subject to the exception in the case of concealed fraud, which is part of the general law.

and, as against innocent purchasers or bailees, only to notice of infringement.

It has been shown that it is no answer to the claim for an injunction that the infringement was effected innocently, in ignorance of the existence of trade mark rights; but damages or an account of profits are only calculated as against an innocent dealer in, or purchaser of, the spuriously marked goods, in respect of sales, dealings, or other infringements, if any, of which he is guilty after becoming aware of the plaintiff's rights.[4] In a case in which at the most there were only proved one or two inadvertent sales by servants of goods under the plaintiff's special trade name for his goods, and this contrary to the defendant's orders, the Inner House in Scotland held the plaintiff to be entitled to no relief, reversing the Lord Ordinary, who had granted an interdict with a small sum for damages.[5]

The case of a manufacturer who copies a mark he finds on goods which he knows are not his own is different. He may not know whose mark it is, and may possibly be in doubt whether it is a trade mark or not, but he knows that he has no right to the mark, and the damages or account are therefore calculated as against him from the first infringement, within six years of the writ.[6]

Refused because of delay or acquiescence.

The Court has refused, in some cases, to order an account of profits where the plaintiff has neglected to take proceedings after

granted in *Magnolia Co.* v. *Atlas Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A., although the plaintiffs obtained an injunction.

[1] *McAndrew* v. *Bassett*, 10 Jur. (N.S.) 495 (1864), Westbury, C.

[2] *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

[3] Per Mellish, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 633 (1872).

[4] *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; 10 L. T. (N. S.) 780 (1863), Westbury, L.C.; *Moet* v. *Couston*, 33 Beav. 578; 10 L. T. (N. S.) 395 (1864), Romilly, M.R.; *Ellen* v. *Slack*, 24 Sol. J. 290 (1880), Jessel, M.R.

[5] *Montgomerie* v. *Young*, 21 R. P. C. 285 (1904).

[6] *Moet* v. *Couston*, supra; *Curtier* v. *Carlile*, 31 Beav. 292; 8 Jur. (N. S.) 183 (1862), Romilly, M.R.

becoming aware of the infringement;[1] and it may be assumed that it certainly would not assist the plaintiff to recover profits which he had deliberately allowed the defendant to earn in the expectation of obtaining them from him.[2] And damages have also been refused on the ground of delay.[3] But delay in order to obtain evidence necessary to establish his case would not bar the plaintiff of his ordinary remedy,[4] nor, it is submitted, would any reasonable delay in the hope of avoiding litigation after a definite warning to the defendant.

Limited because of misrepresentation.

In a case where there had been some delay, and some amount of misrepresentation in his business on the plaintiff's part, and the defendant's proper trade was larger than that of the plaintiff's, the account was limited to profits earned since the commencement of the suit, and Mellish, L.J., said that it was a case where a jury would have given forty shillings damages only.[5]

Form of order for account.

The ordinary form of the order for an account directs an account of the profits made by the defendant in selling or otherwise disposing of the goods bearing the spurious mark or marks to be taken by the master or the official referee, and orders payment of the amount found to be made by the defendant to the plaintiff within a time fixed from the date of the certificate or report.[6]

In the case of *Lever* v. *Goodwin*,[6] it was objected that the account should be limited to sales made to persons who bought the goods as and for the goods of the plaintiff, by reason of the use of the infringing mark upon them. The Court overruled this objection.[7] They said that the mischief done by the spurious marking of the goods is not merely that it is calculated to deceive immediate purchasers from the infringers, but that it puts "a weapon calculated to be fraudulently used by the middlemen"[8] into their

[1] *Harrison* v. *Taylor*, 11 Jur. (N. S.) 408; 12 L. T. (N. S.) 339; *Beard* v. *Turner*, 13 L. T. (N.S.) 746, both (1865), Wood, V.-C.

[2] Cf. *Anglo-Swiss Condensed Milk Co.* v. *Swiss Condensed Milk Co.* (1871), W. N. 163, Malins, V.-C., cited above, p. 444; *Beard* v. *Turner*, supra, and see *Crossley* v. *Derby Gas Light Co.*, 1 Webster's P. C. 119, a patent case.

[3] *Baddaway* v. *Stevenson*, 20 R. P. C. 276 (1903), Hall, V.-C., three years' delay before action.

[4] See *Care* v. *Myers* (1868), Seb. Dig. p. 181, Giffard, V.-C.; *Lee* v. *Haley*, 21 L. T. (N.S.) 546; L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J., and *Crossley* v. *Derby Gas Light Co.*, note (2).

[5] *Ford* v. *Foster*, L. R. 7 Ch. p. 633 (1872), L.J.J.

[6] *Weingarten* v. *Bayer*, 22 R. P. C. 341 (1905), H. of L.; *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; Appendix, p. 733.

[7] See also *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; 10 L. T. (N. S.) 789 (1863), Westbury, L.C.

[8] Per Cotton, L.J., in *Lever* v. *Goodwin*.

hands, by which they may, intentionally or not, deceive the ultimate purchasers. In a subsequent case Kekewich, J., made an order in the same form notwithstanding that he did not believe that there had been a single sale of the defendant's goods as those of the plaintiff, and notwithstanding that the goods had been fairly competing.[1]

Costs of inquiry or account.

The costs of the inquiry as to damages or the account of profits, should generally be reserved until the result of the inquiry or account is known,[2] at any rate, unless it is clear that it will be of substantial value to the plaintiff; for if no damages or profits are found to have been incurred or made,[3] or if the proceedings subsequent to the judgment are oppressively conducted by the plaintiff, he ought to pay the costs. But where the defendant had filed a false affidavit greatly understating the number of goods sold, although the account showed that he had made no profit, Chitty, J., said it was a case for investigation, and allowed the plaintiff the costs.[4]

Recital in order of offer.

Where at the trial the defendant offers a sum as damages, but the plaintiff elects to take an inquiry, the offer will, at the defendant's request, be recited in the order.[5]

Account where plaintiff not sole owner.

The plaintiff is entitled to the ordinary inquiry as to damages, or account of profits made by the defendant by the use of the infringing mark, although the plaintiff is not the sole owner of the mark. If he elects to have an account of profits, however, he can only claim payment of such proportionate share of the profits as may be found to be appropriable to his interest in the mark.[6] It is submitted that this is so, notwithstanding the language of the proviso to sec. 39, which (*inter alia*) enacts that where two or more persons are registered proprietors of the same

[1] *Saxlehner* v. *Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645.

[2] Per Fry, J., in *Stark* v. *Midland Rail. Co.*, 16 C. D. 81 (1880), a case of nuisance.

[3] *Tonge* v. *Ward*, 21 L. T. (N. S.) 480 (1869), Romilly, M.R.

[4] *Dicks* v. *Jackson*, March 31st, 1884, cited Sebastian, 3rd ed., p. 255, 4th ed., p. 231.

[5] *Iron-Ox Remedy Co., Ltd.* v. *Leeds Industrial Co-operative Society, Ltd.*, 24 R. P. C. 434 (1907), Parker, J.

[6] In *Dent* v. *Turpin*, 2 J. & H. 139 (1861), Wood, V.-C., which is substantially the only authority on the matter, both of the two owners of the mark had filed bills asking, in each case, for payment of so much of the profits made by the defendant as the plaintiff was entitled to. The Vice-Chancellor said the fact that both owners were suing avoided the difficulty in regard to the account. In *Southorn* v. *Reynolds*, 12 L. T. (N. S.) 75 (1865), the same Vice-Chancellor followed his previous decision, but the order as to payment (if any) is not reported. In the latter case, contrary to the modern rule, the inquiry and the account were both ordered.

(or substantially the same) trade mark in respect of the same goods each of such persons shall otherwise (*i.e.*, except as against one another) have the same rights as if he were the sole registered proprietor thereof. The defendant is, it seems, entitled to have all the co-owners of the mark made parties, before the account is taken, in order that they may be bound by it, and that it may be taken once for all.[1]

7. Costs.

Costs in the discretion of the judge.

Subject to sec. 46 of the Act, which is referred to below, the costs of and incident to an action for the infringement of a trade mark, as the costs in any other action, are in the discretion of the Court or judge, and the Court or judge has full power to determine by whom and to what extent such costs shall be paid.[2] Provided that where the action is tried with a jury, the costs follow the event, unless the judge by whom it is tried, or the Court, for good cause, otherwise orders.[3]

Unsuccessful party usually ordered to pay costs.

The Court or judge in general follows the ordinary rule that the unsuccessful party shall pay the costs of the litigation, such costs being taxed upon the usual scale between party and party; but the discretion conferred by the Act and Rule just cited is constantly exercised in trade mark cases, where the nature of the case, or the conduct of the parties, or of one of them, makes it just that the ordinary practice should be departed from.

Infringer must offer

An unsuccessful defendant must usually pay costs, although he has only defended a mark which he honestly adopted without being aware of its too great resemblance to the plaintiff's mark,[4] and though he has acted without fraud and in ignorance of the plaintiff's rights,[5] and the action has been commenced against him without notice.[6] But by offering the plaintiff all that he is

[1] See the patent cases, *Bergmann* v. *Macmillan*, 17 C. D. 423 (1881), Fry, J.; and *Van Gelder* v. *Sowerby Society*, 44 C. D. 374; 7 R. P. C. 208 (1890), C. A., see per Cotton, L.J., 44 C. D. p. 392. The defendant cannot, as appears from the last case, object to judgment on the ground of want of parties, but can apply to have the owners who are not plaintiffs added (as plaintiffs or defendants) for the purposes of the account after judgment. See Ord. 16. r. 11, in the Annual Practice.

[2] Supreme Court of Judicature Act, 1890, s. 5.

[3] Ord. 65, r. 1.

[4] *Blair* v. *Stock*, 52 L. T. 123 (1884), Kay, J.; cf. the registration cases, *Hyde & Co.'s Tm.*, 7 C. D. 724; *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n., both (1878), Jessel, M.R.

[5] *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; 10 L. T. (N. S.) 780 (1863), Westbury, L.C.; *Tonge* v. *Ward*, 21 L. T. (N. S.) 480 (1869), Romilly, M.R.

[6] *Field* v. *Lewis*, Seb. Dig. p. 167 (1867), Wood, V.-C.; *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J. See *Weingarten* v. *Bayer*, 22 R. P. C. 341, at p. 350 (1905), Ld. Macnaghten.

entitled to,—that is, in the case of the innocent holder[1] of spuriously marked goods, an undertaking[2] not to part with them until the spurious marks have been removed,[3] and all requisite information to enable the plaintiff to stop the infringement[4] and the payment of the taxed costs[5] (if any) already incurred by him in the action, if an action has been commenced,—the defendant may escape liability for subsequent costs.[6] If the plaintiff, after such an offer has been made, commences or continues proceedings against the defendant making it, he will be ordered to pay him his costs subsequently incurred.[7] In a case where, as it turned out, the plaintiff was entitled to an injunction only, and his right to this was admitted on the second day of the trial, he was given costs up to that time, and was ordered to pay the subsequent costs.[8]

complete redress before action.

and will then get subsequent costs.

Where an action was brought for infringement of trade mark by the use of a label and to restrain passing off, the act complained of being the use of the same label, and the defendants

[1] In a case of fraud, the plaintiff may, notwithstanding that the defendant has made a full offer to submit, be allowed the whole costs although he proceeds to trial. *Jameson & Son, Ltd.* v. *Clarke*, 19 R. P. C. 253 (1902), Chatterton, V.-C., Ireland.

[2] The plaintiff is not bound to accept an undertaking in the case of an infringer with notice, or where there is reasonable risk that it will be necessary to take steps to enforce it. In such a case the plaintiff will usually be allowed the costs of a motion for judgment. *Gaudy Belt Manufacturing Co., Ltd.* v. *Fleming, Firkby and Goodall, Ltd.*, 18 R. P. C. 276 (1901), Byrne, J.; but at all events the defendant must pay the costs of the plaintiff obtaining an injunction by consent in chambers; *Slazenger* v. *Pigott*, 12 R. P. C. 439 (1895), North, J. Cf. the patent case, *Jenkins* v. *Hope*, [1896] 1 Ch. 278; 13 R. P. C. 57, North, J.

[3] An innocent consignee or bailee may become liable for damages if he sends the spurious goods out of the country, or otherwise puts them beyond the control of the Court. *Upmann* v. *Elkan*, note (7), and cf. the patent case, *British Motor Syndicate, Ltd.* v. *Taylor*, [1901] 1 Ch. 122; 17 R. P. C. 723, C. A.

[4] Above, p. 422. The plaintiff is not entitled to the publication of an apology: *Hudson* v. *Beaumont*, 14 L. T. (N. S.) 698 (1866), Stuart, V.-C.; *Hudson* v. *Chatteris Co.*, p. 460, n. (2); or to receive a list of the defendant's customers, if not entitled to an enquiry or account: *Hipkins* v. *Plant*, 15 R. P. C. 294 (1898).

[5] *Burgess* v. *Hills*, 26 Beav. 244; 28 L. J. Ch. 356 (1858), Romilly, M.R.; *McAndrew* v. *Bassett*, 33 L. J. Ch. 561; 4 De G. J. & S. 380 (1864), Wood, V.-C., and Westbury, C.; *Feanessy* v. *Day and Martin*, 55 L. T. 161 (1886), Bacon, V.-C.

[6] But the defendant must not ask for a term which he is not legally entitled to, as, for instance, that the plaintiff should not advertise the undertaking: *Hipkins* v. *Plant*, above, note (4).

[7] *Millington* v. *Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.; *Mart* v. *Couston*, 33 Beav. 578 (1864), Romilly, M.R.; *Upmann* v. *Elkan*, L. R. 12 Eq. 140; 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.; *Mart* v. *Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

[8] *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389, at p. 400 (1896), Collins, J. A passing-off case.

offered to submit to an injunction as regards trade mark, and, after accepting such offer, the plaintiffs continued the action as regards passing-off, the plaintiffs were ordered to pay the costs from the date of the offer.[1]

If the plaintiff moves for an interlocutory injunction after being offered all that he can obtain on such a motion, unless there is ground to believe that the offer will not be carried out, the motion should be refused with costs.[2]

In *Moet* v. *Pickering*,[3] where wharfingers with whom the spuriously marked goods had been warehoused in the ordinary course of trade, and who were entitled to a lien for their charges, were added as defendants, and the plaintiffs proceeded to trial against them, the Court of Appeal, reversing Fry, J., ordered that their costs of action should be paid by the plaintiffs. The wharfingers had pleaded that they had no knowledge of the infringement, and that they submitted to act as the Court should direct, upon payment of their charges and costs; but the Court of Appeal regarded this as meaning only that they claimed nothing adversely to the plaintiffs or the infringer. The case does not conflict with the rules stated above, for the plaintiffs had claimed to override the wharfinger's lien by a lien of their own for costs, and this was held to be wrong; and besides, it was clearly unnecessary to have added the wharfingers as defendants or to have proceeded to trial against them, since not only had they made no threat to part with the goods, but after notice of the injunction obtained against the infringer it would have been a contempt of Court for them to do so.

Stay of proceedings.

Where the plaintiff has obtained, or is offered, all that he is

[1] *Vernon & Sons* v. *Buchanan's Flour Mills, Ltd.*, 23 R. P. C. 17 (1906), Farwell, J.; cf. *Hat Manufacturers Supply Co., Ltd.* v. *Tomlin Bros.*, 23 R. P. C. 413 (1906), Swinfen Eady, J. Where on a motion for an injunction which was treated as the trial, the plaintiff failed as to the relief claimed in the writ, and the motion and evidence were also directed to another complaint, as to which the defendants had made a reasonable offer, including costs to that date, the action was dismissed, the plaintiffs being ordered to pay the subsequent costs, *Clarke* v. *Hudson*, 18 R. P. C. 310 (1901), Farwell, J.

[2] *Snuggs* v. *Seyd and Kelly's Credit Index Co.* (1894), W. N. 95. Chitty, J. In *Hudson* v. *Chatteris Co.*, 15 R. P. C. 438 (1898), Stirling, J., a patent case, where the defendant had paid sufficient money into Court to cover damages and an injunction was refused at the trial, costs subsequent to the acceptance of the money were given to the plaintiff. See also p. 459, note (2).

[3] A similar order was made in *Upmann* v. *Elkan*, p. 459, note (7).

entitled to, the Court will stay further proceedings in the action, at the defendant's instance.[1]

Trivial cases.

And in a trivial case, where an action had been commenced without notice against the innocent purchaser of an inconsiderable quantity of spuriously marked goods, and he at once submitted to do as the Court directed, Stirling, J., refused to give any costs.[2] In some cases of isolated instances of infringement or passing-off, the plaintiff has been refused relief at the trial, and been ordered to pay the costs of the action.[3]

It is no reason for not giving costs that the defendant is an infant.[4]

Costs refused because plaintiff claimed too much.

Costs have been refused to a successful plaintiff because he claimed, besides the injunction to which he was entitled, an account to which he was not, against an innocent purchaser of the spuriously marked goods;[5] and in a similar case, where the plaintiffs set up claims to a copyright in a music tutor, as well as an exclusive right to its title, and failed as to the copyright, they were allowed only half their taxed costs of action.[6] On similar grounds, plaintiffs have been ordered to pay,[7] or have been deprived of,[8] the costs occasioned by allegations which they have failed to prove, although they have succeeded and obtained the general costs of their actions. Thus, in a Scotch case, the plaintiffs were deprived of costs because they had alleged personal fraud without proving it, had claimed substantial damages and offered no proof thereof, and had had to make an indispensable

[1] *Rudd* v. *Rowe*, L. R. 10 Eq. 610 (1870), James, V.-C.; *Curtis and Harvey* v. *Pape*, 5 R. P. C. 146 (1888), North, J. (*Diamond Gunpowder*).

[2] *American Tobacco Co.* v. *Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218; cf. *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

[3] *Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. of L., and *Rutter* v. *Smith*, 18 R. P. C. 49 (1901), Kekewich, J., where only a single act of passing-off by a servant, since discharged, was proved, and costs were given against the plaintiffs; and see the other similar cases cited above, p. 389, note (9). In *Burberry* v. *Watkinson*, 23 R. P. C. 141 (1906), Warrington J., an isolated case of a wrongful act, the defendant acting unwittingly, the action was dismissed without costs.

[4] *Chubb* v. *Griffiths*, 35 Beav. 127 (1865), Romilly, M.R.

[5] *Moet* v. *Couston*, 33 Beav. 578; 10 L. T. (N. S.) 395 (1864), Romilly, M.R. In *Hipkins* v. *Plant*, p. 462, note (4), the defendants were given the costs of the action so far as it asked for damages or an account.

[6] *Metzler* v. *Wood*, 8 C. D. 606 (1877), Malins, V.-C., and C. A.

[7] *Pierce* v. *Franks*, 15 L. J. Ch. 122 (1846), Knight Bruce, V.-C.

[8] *Standish* v. *Whitwell*, 14 W. R. 512 (1866), Wood, V.-C., an affidavit charging fraud. So *Saxlehner* v. *Apollinaris Co.*, p. 462, note (4), Kekewich, J., where a charge of fraud failed in part.

amendment in their pleadings.[1] But where the plaintiff, in an action for infringing his trade mark and also for "passing-off," failed as regards the infringement in respect of some of the goods for which he used, but had not registered, the trade mark, and succeeded as to the rest of the action, and the defendant was held to have been guilty of deliberate infringement in breach of an undertaking previously given by him, Kekewich, J., refused to deprive the plaintiff of any part of his costs.[2] If the plaintiffs' case has been overlaid with unnecessary evidence, he may be deprived of the costs of such evidence.[3]

The usual rule is to apportion the costs, each party getting costs of the substantial issues upon which he has succeeded, the plaintiff getting the costs of the action except so far as these are increased by the issues upon which costs are given against him,[4] unless there is one main issue upon which he has failed.[5]

In a case, where an action for infringement and two motions by the defendants, one to expunge the plaintiff's registration, and the other for an order to the Comptroller to register a mark propounded by the defendants, were tried together, and the action and the second motion failed, but the first motion succeeded, and both parties made unfounded allegations of fraud, North, J., refused to give any costs to either, principally on the ground that it was absolutely impossible for any taxing master to do justice between the parties by distinguishing the costs of one part of the case from another.[6]

Apportionment of costs.

The judge at the trial has jurisdiction to decide what proportion of costs a party is to pay, thus, where the plaintiffs and

[1] *Montgomerie & Co., Ltd.* v. *Young Bros.*, 20 R. P. C. 781 (1903), Ld. Kyllachy. On appeal the defendants wholly succeeded, 21 R. P. C. 285 (1904), Inner House.

[2] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888). So *Rowland* v. *Mitchell*, 13 R. P. C. 457 (1896), Romer, J. In *Hodgson* v. *Kynoch*, 15 R. P. C. 465 (1898), Romer, J., there was no fraud, and the claim as to infringement had not substantially increased the costs, consequently no order as to them was made.

[3] In *Daimler Motor Co., Ltd.* v. *London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A., the plaintiffs were given only one half the costs of the evidence.

[4] *Saxlehner* v. *Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645; *Lever* v. *Bedingfield*, 15 R. P. C. 453 (1898), both Kekewich, J.; *Hipkins* v. *Plant*, 15 R. P. C. 294 (1898), Byrne, J. *Worthington Pumping Engine Co.* v. *Moore*, 20 R. P. C. 41 (1902), Byrne, J., a claim that the defendant was trustee for the plaintiffs of these patents, no evidence being offered as to one of them.

[5] *Pneumatic Stamp Co.* v. *Lindner*, 15 R. P. C. 525 (1898), Byrne, J.

[6] *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890); *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

defendants each succeeded partially, the defendants were directed to pay one-third of the plaintiffs' costs, and no order was made as to their own.[1] And where the defendants in an infringement action succeeded in their defence, and in a motion by them for rectification succeeded partially as to one mark, but failed as to another, the plaintiffs were ordered to pay to the defendants two-fifths of the costs of the action and motion, treating them as a whole, and including the costs of an interlocutory motion which were made costs in the action.[2]

Successful defendant deprived of costs.

A successful defendant is much more often deprived of his costs than a successful plaintiff, for the plaintiff may fail in his action notwithstanding that the evidence makes it clear that the defendant has acted, or intended to act, dishonestly, and in such a case, although the Court declines to assist the plaintiff, it generally refuses to give costs to the defendant.

Where, for example, the plaintiff failed because of misrepresentations contained in his trade mark,[3] but the defendant had closely imitated the mark, the action was dismissed without costs; and the same course was followed where there was no sufficient proof that the defendant's mark was calculated to deceive, having regard to the long delay of the plaintiff to take proceedings, and the absence of evidence of actual deception;[4] and in cases where the action was dismissed, but the Court thought that the defendant's conduct had been uncandid and unfair;[5] and North, J., dismissed an action without costs because he thought that the defendants had kept back information;[6] and where the defendants had by their conduct brought the action on themselves, they were given no costs.[7]

So, too, no costs were given where it was proved that the

[1] *Findlater, Mackie, Todd & Co.* v. *Newman & Co.*, 19 R. P. C. 235 (1902), Kekewich, J.

[2] *Bourne* v. *Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), Farwell, J. And see *In re Pollard* (1902), W. N. 49, Kekewich, J. See also the patent case, *Gawthorp* v. *Mason*, 23 R. P. C. 401 (1906), Kekewich, J.

[3] *The Leather Cloth Co., Ltd.* v. *The American Leather Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53 (1863), Westbury, L.C., and H. L. The House of Lords held that there was no infringement.

[4] *Rodgers* v. *Rodgers*, 31 L. T. (N. S.) 285 (1874), L.JJ.

[5] *Estcourt* v. *The Estcourt Hop Essence Co.*, 31 L. T. (N. S.) 567; L. R. 10 Ch. 276 (1874), Malins, V.-C., Cairns, C., and L.JJ.; *Maxwell* v. *Hogg*, 15 L. T. (N. S.) 204; L. R. 2 Ch. 310 (1866), Stuart, V.-C., and L.JJ.; but see *King* v. *Gillard*, cited p. 464, note (5).

[6] *Mcaby & Co., Ltd.* v. *Triticine, Ltd.*, 15 R. P. C. 1 (1898).

[7] *Lambert and Butler* v. *Goodbody*, 19 R. P. C. 377 (1902), Farwell. J.

defendant had represented the goods he sold as being those of the plaintiff, although the proof of the plaintiff's title failed.[1]

In *The Patent Plumbago* case,[2] however, where the plaintiffs failed on the ground of misrepresentation, but the imitation of their trade name was clearly made out, the action was dismissed with costs, the plaintiffs having continued to misdescribe their goods as "patent" after a summons taken out at their instance had been dismissed by the magistrate because of such misdescription.

Defendant *in pari delicto.*

So, in cases in which the plaintiff fails because he is carrying on a fraudulent trade, and the defendant stands *in pari delicto*, the practice is to dismiss the action without costs.[3]

Unfounded charges of fraud.

And a successful defendant has also been deprived of costs because he has made an unfounded charge of fraud.[4]

In a case in which the judge at the trial dismissed the action, but without costs, on the ground of what he found to be untrue statements on the defendants' goods as to prize medals and awards, the Court of Appeal found that there had been no dishonesty on the part of the defendants, but held that even if the statements had been misrepresentations to the public, yet if that was unconnected with a wrong done to the plaintiffs, the judge could not in his discretion on that ground deprive the defendants of costs.[5]

In an earlier case the same judge refused a successful defendant his costs because he put the word "registered" on his goods although his device was not registered; in this case, however, the plaintiffs might have been to some extent affected as they used the word registered, their mark being registered.[6]

[1] *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C.; and see *Browne* v. *Freeman* (1), 12 W. R. 305 (1864), Wood, V.-C., where the defendant misdescribed his goods as *The Original Chlorodyne*.

[2] *Morgan* v. *McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C.

[3] *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.; *Thorneloe* v. *Hill*, 11 R. P. C. 61 (1894), Romer, J.; cf. *Baschet* v. *London Standard Co.* [1900] 1 Ch. 73, Kekewich, J., a copyright case.

[4] *Humphries* v. *The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J.; *Hargreaves* v. *Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J. As to unfounded charges of fraud by the plaintiff, see p. 461.

[5] *King* v. *Gillard*, [1905] 2 Ch. 7; 21 R. P. C. 589; 22 R. P. C. 327, Kekewich, J., and C. A. *Estcourt* v. *The Estcourt Hop Essence Co.*, cited p. 463, note (5), was not cited to the Court in this case.

[6] *Warsop & Sons, Ltd.* v. *Warsop*, 21 R. P. C. 481 (1904), Kekewich, J. Cf. the cases cited above, in which a false representation of registration was held to constitute an element in infringement, above, p. 398.

In a trade name case, where the plaintiffs' action was dismissed by the Court of Appeal on the ground that they were not satisfied that the name adopted by the defendants would cause any deception likely to occasion damage to the plaintiffs, costs, both of the appeal and in the Court below, were refused because the Lords Justices believed that the defendants had chosen the name in dispute with the hope of obtaining some illicit advantage from the plaintiffs' reputation.[1] Costs of appeal.

But, in general, the reasons for depriving the defendant of costs do not apply to the costs of an unsuccessful appeal brought by the plaintiff against the dismissal of his action. Thus, the appeal to the House of Lords in *The Leather Cloth* case [2] and the appeal to the Court of Appeal in *Newman* v. *Pinto* [3] were both dismissed with costs. In the former case the plaintiff obtained judgment in the first instance, and when this was reversed on appeal by Lord Westbury no costs were given.[4]

A party who succeeds on appeal and recovers the costs paid under the judgment below is not entitled to interest.[5] But where the defendants succeeded at the trial, and received their costs from the plaintiffs, but failed on appeal and repaid the amount so received with interest to date, and on appeal to the House of Lords the defendants succeeded, they were held to be entitled not only to the return of the costs and interest repaid by them, but to interest on the costs from the date of such repayment by them to the date of the return after the House of Lords' decision.[6] nterest on costs repaid

The Court or judge may order the costs adjudged to be paid to be taxed upon the higher scale, if special grounds arising out of the nature and importance, or the difficulty or urgency, of the case appear to exist.[7] Such an order was made by North, J., in *The Great Tower Street Tea Co.* v. *Smith*,[8] where the hearing occupied a long time, and the facts were complicated, and a great number of witnesses were called. But some special reason for the order must be shown, for, although the application is almost Higher scale.

[1] *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A.

[2] 11 H. L. C. 523; 35 L. J. Ch. 53.

[3] See note (3), ante, p. 464.

[4] 4 De G. J. & S. 137; 33 L. J. Ch. 199. This course was taken also in *Borthwick* v. *The Evening Post*, supra.

[5] *Edge* v. *Gallon*, 16 R. P. C. 509, at p. 520 (1899), C. A.

[6] *Ashworth* v. *English Card Clothing Co., Ltd.*, 21 R. P. C. 355 (1904), Joyce, J.

[7] Ord. 65, r. 9. See the note in the Annual Practice.

[8] 6 R. P. C. 165 (1889).

always made in heavy trade mark or patent actions, it is not granted as of course;[1] and it is not granted as a punishment,[2] or merely because a case of gross fraud is made out.[1] The order ought only to be made in cases of very unusual difficulty requiring skill, antiquarian research and things of that kind.[3] That scientific witnesses are necessarily called has been held to be a special reason.[4] An appeal lies on the question whether there are "special grounds" or not.[5]

Costs as between solicitor and client.

It is provided by sec. 46[6] that—

"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."

This section corresponds to the statutory provisions with regard to actions for the infringement of a patent.[7]

Certificate that title to trade mark came in question.

A certificate cannot be granted unless the right to the exclusive use of the trade mark has, in fact, come in question, and, therefore, it was refused in a case under the repealed Acts where the defendant's counsel admitted that, upon the failure of the defendant's application to remove the plaintiff's mark from the Register, he had no defence to the action.[8] Under sec. 77A of the Act of 1883,

[1] *Sanitas Co., Ltd.* v. *Condy*, 4 R. P. C. 530 (1887), Kekewich J. In *Rodgers* v. *Rottgen*, 5 Times L. R. 678 (1889), Kay, J., said he gave costs on the higher scale very charily. In *Leonhardt* v. *Kallé*, 12 R. P. C. 103, at p. 120 (1895), Romer, J., said he had never done it except by consent. Collins, J., gave such costs in *Reddaway* v. *Banham*, 12 R. P. C. 86, and his judgment was restored by the H. of L., [1896] A. C. at p. 222.

[2] *Hudson* v. *Osgerby*, 32 W. R. 566; 50 L. T. 323 (1884), Pearson, J.; and see *Pooley's Trustee* v. *Whetham*, 33 C. D. p. 120; and *Paine* v. *Chisholm*, [1891] 1 Q. B. 531, and the cases there cited.

[3] *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 516, at p. 535, Lindley, L.J. See also *Dunlop Co.* v. *Wapshare Co.*, 17 R. P. C. 433 (1900), Buckley, J., and *Chamberlain and Hookham* v. *Mayor of Bradford*, 17 R. P. C. 493 (1900), Farwell, J., where the order was made. These are all patent cases.

[4] *Ellington* v. *Clark*, 5 R. P. C. 328; 58 L. T. 818 (1888), C. A.; *The Robin*, [1892] P. 95, Jeune, J.; *Dunlop Co.* v. *Wapshare Co.*, supra.

[5] *Paine* v. *Chisholm*, [1891] 1 Q. B. 531, C. A.

[6] Replacing sec. 18 of the Act of 1888.

[7] Patents and Designs Act, 1907, sec. 35.

[8] *Benjamin Edgington, Ltd.* v. *John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1899), Kay, J.

introduced into that Act by sec. 18 of the Act of 1888, a certificate could only be given in an action for infringement; but it was held that it could under some circumstances be granted upon a motion for rectification where the mark had been registered for five years, since the mark could then only be attacked by proceedings for rectification. Thus where, under an order of the Court, a motion for rectification and an action for infringement were heard together and on the same evidence, it was held that there was jurisdiction to grant a certificate, and the grant was made.[1]

In a case where the Court of Appeal refused an application by the defendant to expunge the plaintiffs' marks, partly on the ground that the defendant was a deliberate infringer, they declined to give the plaintiffs a certificate under the section.[2]

The order granting a certificate is not appealable.[3]

Costs of motion to rectify in aid of defence.

Considerations similar to those above stated govern the grant or refusal of costs in respect of the application to rectify the Register by expunging or varying the registration of the plaintiff's mark, which is an ordinary incident of the defence in an action for infringement. The usual practice is to give the applicant costs, if he succeeds;[4] but if the application is made by the defendant for the purposes of the action, and it is doubtful whether he is not acting fraudulently, the costs may be reserved till the trial,[5] or may be refused.[6]

Three counsel.

The costs of three counsel have sometimes been expressly allowed by the Court in trade mark and similar cases,[7] but the present practice of the taxing masters is to exercise their discretion as to allowing such costs without an order of the Court.[8]

[1] *Field & Co.* v. *Wagel Syndicate*, [1900] 1 Ch. 651; 17 R. P. C. 266, Buckley, J. A certificate was however refused in *Kodak, Ltd.* v. *London Stereoscopic, &c., Co.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., where passing-off was the chief issue; and on special grounds in *Bourne* v. *Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), Farwell, J. A certificate was given in *Barlow* v. *Johnson*, 7 R. P. C. 395, at p. 411 (1890), Chitty, J.; there was a motion to rectify, but the mark had been registered less than five years.

[2] *Paine & Co.* v. *Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, cited p. 398.

[3] *Haslam & Co.* v. *Hall*, 5 R. P. C. 144 (1888), C. A.

[4] *Richards* v. *Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 37, Kay, J.

[5] *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

[6] *Perry-Davis' Tm.*, 5 R. P. C. 333; 58 L. T. 695 (1888), Kay, J.; *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J. See further Chap. XI., p. 311.

[7] For instance, in *Weingarten* v. *Rosenthal*, 21 R. P. C. 212 (1904), Farwell, J.

[8] See *Andrews' Patent*, 24 R. P. C. 349, at p. 378 (1907), C. A.; and *Burroughs, Wellcome & Co.'s Tms.*, 22 R. P. C. 164 (1905), where such costs at the trial and in the Court of Appeal were allowed by the taxing master, and Warrington, J., refused to overrule his discretion.

8. Appeal.

Appeal advanced.

In a case where the defendant desired to appeal against an interim injunction which the plaintiff had obtained, the Court, on his application, and on the ground that the continuance of the injunction would do irreparable damage to his business, advanced the case to the head of the list.[1]

Stay pending appeal.

A stay of an injunction pending appeal will only be granted on special grounds, and generally on terms.[2] But a stay as to delivery up is more readily granted.[3] An inquiry as to damages or an account of profits is not often stayed, but sometimes liberty to apply when the inquiry has been answered has been given.[4] A stay of the injunction pending an appeal from the Court of Appeal to the House of Lords, the defendants undertaking to keep an account, was granted in a patent case on the ground of difference of opinion in the Court, coupled with the fact that there was no possible doubt as to the plaintiffs getting their damages if an appeal failed.[5]

Stay of order.

An application to stay a new trial ordered to take place by the Court of Appeal, pending an appeal against the order to the House of Lords, was refused in *Edge* v. *Johnson*.[6]

nterlocutory appeal barred by delay.

In *Burgess* v. *Burgess*,[7] delay for five months in appealing against an order for an interim injunction, where the plaintiff was appellant, seeking to have the scope of the order enlarged, was held to be a bar to the appeal.

[1] *Lazenby* v. *White*, L. R. 6 Ch. 89 (1870), James, L.J.

[2] See the patent cases, *Leeds Forge Co., Ltd.* v. *Deighton's Patent Flue & Tube Co., Ltd.*, 18 R. P. C. 233 (1901), stay arranged in C. A.; *Pilkington* v. *Massey*, 21 R. P. C. 421 (1904), Kekewich, J.; *Jandus Arc Lamp, &c. Co.* v. *Arc Lamp Co.*, 22 R. P. C. 277 (1905), C. A., stay granted on terms; and *Worcester Royal Porcelain Co., Ltd.* v. *Locke*, 19 R. P. C. 479, at p. 491 (1902), Byrne, J., passing-off, stay on terms including an undertaking to keep an account and to pay over profits if the appeal failed; *Mouchel* v. *Coignet*, 23 R. P. C. 649 (1906), Warrington, J. See generally as to stay pending appeal, Annual Practice, notes to Ord. 58, r. 16.

[3] *E.g.*, granted in *Parker and Smith* v. *Satchwell*, 18 R. P. C. 299 (1901), Farwell, J., where the delivery up was stayed, although a stay of the injunction was refused. Also *Presto Gear Case, &c. Co., Ltd.* v. *Orme, Evans & Co., Ltd.*, 17 R. P. C. 218 at p. 227 (1900), Farwell, J.: *Mouchel* v. *Coignet*, note (2).

[4] See the case last but one cited, and *British United Shoe Machinery Co., Ltd.* v. *A. Fussell & Sons, Ltd.*, 25 R. P. C. 368 (1908), Swinfen Eady, J.

[5] *Consolidated Pneumatic Tool Co., Ltd.* v. *Clark*, 24 R. P. C. 593, at p. 640 (1907).

[6] 9 R. P. C. 134 (1892).

[7] 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), L.JJ. So also in *Re Palmer's Application*, 22 C. D. 88 (1882), C. A., where the Court had decided against a preliminary objection. The time for appealing against an interlocutory order is now fourteen days. R. S. C., Ord. 58, r. 15.

Where the judge of first instance has found, or has refused to find, fraud it is difficult, and usually impossible, for the Court of Appeal to reverse his finding. In a recent case, however, a finding of fraud was reversed, the Court being able to act without relying on the evidence of the defendant, which the judge below had not believed.[1] Appeal in case of fraud.

If an appeal is brought, and the defendant succeeds, judgment is entered in his favour, not a non-suit;[2] but the Court of Appeal, in dismissing the plaintiff's action, may reserve to him liberty to sue again in respect of any part of his claim. This course was adopted in an action where the plaintiff sought to raise a new case of "passing-off," not set up by the pleadings, at the trial, and was not allowed to proceed with it.[3] Non-suit.

9. Practice.

There are no rules as to pleadings which are peculiar to actions for the infringement of trade marks;[4] all that is necessary, therefore, is that the statement of claim, defence, and reply, if any, in any such action, shall respectively contain statements, in a summary form, of the material facts upon which the party pleading relies for his claim or defence,[5] giving particulars of the frauds, if fraud is alleged.[6] What are material facts, having regard to the circumstances of the case, may be gathered from the statement of substantive law, given in the earlier part of the present chapter. Pleadings.

The forms provided by the appendices to the Supreme Court Rules are set out below. They, when applicable, and when they are not applicable forms of a like character, and as near as may be to them, are to be used for all pleadings; and, where they are applicable and sufficient, any longer forms are to be deemed prolix, and the costs occasioned by such prolixity are to be Forms in the Rules of the Supreme Court.

[1] *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1897). In *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ltd.*, the Court of Appeal found fraud, where Stirling, J., had failed to do so, 17 R. P. C. 1 and 673; 83 L. T. 259 (1900).

[2] *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A. No plaintiff can, under the modern practice, claim to be non-suited: *Fox* v. *Star Newspaper Co.*, [1900] A. C. 19.

[3] *Native Guano Co.* v. *Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L.

[4] Sec. 9 of the Merchandise Marks Act, 1887, provides that in any pleading, proceeding, or document in which any trade mark or forged trade mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade mark or forged trade mark to be a trade mark or forged trade mark. Appendix, p. 810.

[5] Ord. 19, r. 4.

[6] Ord. 19, r. 6.

disallowed, or to be borne by the party so using the same, as the case may be.[1]

INDORSEMENT ON THE WRIT.

The plaintiff's claim is for damages for wrongfully using (or imitating) the plaintiff's trade mark.

STATEMENT OF CLAIM.

(1.) The defendant has infringed the plaintiff's trade mark.

(2.) The trade mark is (*describe it*). (*If the plaintiff is not the original proprietor of the trade mark, show shortly how his title is derived.*)

(3.) The following acts are complained of, viz.:—(*Set them out.*)

The plaintiff claims an injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade mark, and in particular from (*stating any particular injunction sought*).

The plaintiff also claims an account or damages.[2]

DEFENCE.

(1.) The trade mark is not the plaintiff's.

(2.) The alleged trade mark is not a trade mark.

(3.) The defendant did not infringe.

It will be observed that the form of statement of claim here given does not comprise an allegation that the plaintiff's trade mark has been registered, or that sec. 42 of the Act has been otherwise complied with; but such an allegation is certainly proper, and, it is submitted, necessary.

Some more elaborate and detailed forms are given in the Appendix.[3]

Particulars.

The ordinary rule[4] that the parties must state the facts upon which they rely and which they plead in their pleadings, or in particulars separately delivered, with sufficient particularity to prevent their opponents being taken by surprise at the trial, applies to trade mark cases.

So if the plaintiff alleges that actual deception has occurred.

[1] Ord. 19, r. 5.

[2] Rules of the Supreme Court, Appendix C., sec. 6, Form 8.

[3] Pages 724 *et seq.*

[4] See the notes to Ord. 19, rr. 6 and 7, in the Annual Practice.

he will be ordered to give particulars of the persons deceived.[1] And if the defendant pleads that the plaintiff's trade mark is invalid, he must give particulars of the invalidity alleged.[2]

In a passing-off case in which the plaintiffs alleged that their cigars had come to be known by a name consequent on the use of red bands, they were ordered to give particulars of the dates when the cigars in question first became known by the name, as well as certain particulars as to the alleged passing-off.[3]

If a motion to expunge the plaintiff's mark is made by way of reply to the usual interlocutory application on behalf of the plaintiff for an interim injunction, and both the motion and application stand over to the trial, unless there are affidavits sufficiently showing what the defendant's case is upon his motion to expunge, he is frequently directed to deliver particulars of it. Where a defendant alleges common use of the mark in question, he may be ordered to give particulars of such user, for instance, the date of first user in the trade, and the names and addresses of a certain number of persons alleged to have used the mark.[4] So also where a defendant alleges user by himself he may be ordered to give particulars of the user alleged.[5]

Discovery.

The ordinary rules[6] governing discovery also apply to trade mark actions.[7]

Orders for discovery in trade mark cases modified to prevent abuse.

But a process which enables a rival trader to extract from his opponent information concerning his customers, his trade, and his mode of doing business, is extremely likely to be abused, and in cases where a large trade mark business is affected, even the ordinary order for discovery of documents upon oath may be

[1] *Humphries* v. *Taylor Drug Co.*, 3 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J.; *Whitstable Oyster Fishery Co.* v. *Hayling Fisheries, Ltd.*, 17 R. P. C. 461 (1900) (the decision at the trial was affirmed on appeal, 18 R. P. C. 434 (1901)).

[2] *Rowland* v. *Mitchell*, 13 R. P. C. 457 (1896), Romer, J.

[3] *Imperial Tobacco Co., Ltd.* v. *Purnell & Co.*, 20 R. P. C. 719 (1903), Kekewich, J.

[4] *Aquascutum, Ltd.* v. *Moore*, 20 R. P. C. 640 (1903), Kekewich, J.; *Schweppes* v. *Gibbens*, 22 R. P. C. 113, at p. 116 (1905).

[5] *Macmillan* v. *Ehrmann Bros., Ltd.*, 21 R. P. C. 357 (1904).

[6] Ord. 31. The Merchandise Marks Act, 1887, provides that nothing in that Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action: sec. 19. Appendix, p. 812.

[7] *Orr* v. *Diaper*, 4 C. D. 92 (1876), Hall, V.-C., demurrer to an action for discovery against shippers, brought in aid of an intended action against the consignors, dismissed.

very oppressive.[1] The Court, therefore, will, upon a proper case being shown, modify the common orders so that they shall occasion no more inconvenience to the party to whom they are directed than is necessary to ascertain the rights of his opponent.

Thus, in *Carver* v. *Pinto Leite*,[2] it was held that the defendants in a suit for infringement, who had been ordered to file an affidavit of documents and to produce the documents in the ordinary way, ought not to be ordered to disclose the names of customers, or of persons to or from whom letters referring to the matters in issue were sent or received, inasmuch as such discovery might be used in a manner prejudicial to the defendants in their trade, and was not likely to assist the plaintiffs in making out their case at the hearing.

And in a later case, where the defence was that the plaintiff was carrying on a fraudulent trade by selling as foreign cigars goods made in England, the plaintiff, who admitted the fact that his goods were in fact made in England, was allowed to refuse to say who was the manufacturer because, under the circumstances, the question was irrelevant.[3]

Disclosure of sales.

Discovery in regard to the sales effected by the defendant under the disputed mark is not, in general, where the infringement is denied, material, until the fact that the mark is an infringement of the plaintiff's rights has been decided;[4] but where the giving of an account would occasion little trouble to the defendant, and may enable the plaintiff to get final judgment at the trial, without further inquiry, the judge, in his discretion, may order it to be given.[4] In a case where the questions of fact had been ordered to be tried by a jury, such discovery was refused, before the trial, on the ground that the plaintiff had not elected whether to claim damages or an account of profits if he succeeded.[5] After an account of profits or an inquiry as to damages has been

Discovery in aid of inquiry or account.

[1] *Wills' Tms.*, [1892] 3 Ch. 201; 9 R. P. C. 346, C. A.

[2] L. R. 7 Ch. 90 (1871). C. A. See also *Benbow* v. *Low*, 16 C. D. 93 (1880), C. A.; and *The Attorney-General* v. *The North Metropolitan Tramways Co.*, [1892] 3 Ch. 70, North, J. Full discovery was ordered in *Howe* v. *McKernan*, 30 Beav. 547 (1862). Romilly, M.R., where the defendant was charged with advertising himself as the plaintiff's agent after the agency was determined.

[3] *Benedictus* v. *Sullivan, Powell & Co.*, 12 R. P. C. 25 (1895), Chitty, J. If the question had been relevant, the plaintiff must have answered it.

[4] *Benbow* v. *Low*, 16 C. D. 93 (1880), C. A. See also Ord. 31, r. 20, and the note in the Annual Practice thereon. And for the decisions in patent cases, see Frost on Patents, 3rd ed., p. 440, and *De la Rue* v. *Dickinson*, 3 K. & J. 388 (1857).

[5] *Fennessy* v. *Clark*, 37 C. D. 184 (1887), Kay, J., and C. A.

directed, discovery of the names and addresses of the persons to whom the marked goods were sold, or, if this cannot be had, of persons to whom goods—as to which the accounting party cannot swear that they were *not* marked with the objectionable mark—were sold, may be ordered.[1]

Inspection, &c.

The Court or a judge has wide powers, under Ord. 50, r. 3, to make any order for the detention, preservation, or inspection[2] of any property or thing, being the subject of litigation, and to authorise any persons to enter upon or into any land or building in the possession of any party to the litigation, and, for all or any of the purposes aforesaid, to authorise any samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence.

Under this power the Court could, for instance, authorise the plaintiff to inspect goods upon which he showed reasonable grounds for suspecting that a mark infringing his mark had been placed.[3]

The application is made in the Chancery Division by motion or summons; in the King's Bench Division by summons.[4]

Documents referred to in the pleadings, &c.

Production and inspection of copies of the trade marks, or of other documents which are referred to in any of the pleadings or affidavits of any of the parties in a case, may be obtained by giving notice in writing to such party to produce them, unless some cause or excuse for not complying with the notice is shown, which the Court or judge deems sufficient.[5]

[1] *The Leather Cloth Co., Ltd.* v. *Hirschfeld*, 1 H. & M. 295 (1863), Wood, V.-C.; *Powell* v. *Birmingham Brewery Co.*, 14 R. P. C. 1 (1897), Stirling, J., and C. A.; *Saccharin Corporation* v. *Chemicals and Drugs Co.*, [1900] 2 Ch. 556; 17 R. P. C. 612, C. A.

[2] Sec. 21 of the repealed Merchandise Marks Act of 1862 gave jurisdiction to order inspection. As to the powers of justices to issue *search warrants* for goods by means of or in relation to which an offence has been committed under the Merchandise Marks Act, 1887, see sec. 12 of that Act, p. 810. A person charged with an offence under the Act may find it necessary to show that "on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things": sec. 2 (2), and sec. 6. See Appendix, pp. 806 and 808.

[3] Such inspection is frequently authorised in patent cases. See Frost on Patents, 3rd ed. pp. 440 and 498; and *Neilson* v. *Betts*, L. R. 5 H. L. p. 11, per Ld. Westbury.

[4] See the Annual Practice notes to Ord. 50, rr. 3 and 6.

[5] Ord. 31, r. 15. *Smith* v. *Harris*, 48 L. T. 869 (1883), Chitty, J. The learned

Evidence.

The Registrar's certificate, and sealed copies of the Register.

The registration of the plaintiff's mark, or the refusal to register it, is proved by the production of a certificate under the hand of the Registrar, and the actual terms of the registration, and proof of the mark itself as it is registered, are shown and given by the production of an extract or copy from the Register certified by the Registrar and sealed with the seal of the Patent Office.[1]

The request for the certificate should be made to the Registrar in writing, stating for what purpose it is required, in the form given in the second schedule to the Rules.[2] It may be sent by post.[3] The fee for a certificate for use in legal proceedings is one pound.

By **sect. 50**—

Copies of the Register.

"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."

And by **sect. 51**—

Registrar's certificates.

"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 left undone."

These sections correspond to secs. 89 and 96 of the Act of 1883.

The registered mark is, in practice, usually shown by the production of a copy of the advertisement in the Trade Marks Journal, leading to its registration, and this is generally accepted as sufficient.

Proof of title of registered proprietor;

Where the mark is registered, and the plaintiff is the registered proprietor, proof of the registration, and of the identity (if any question as to this is raised) of the registered proprietor with the plaintiff is *primâ facie* evidence of the plaintiff's exclusive right

judge refused to order barrels branded with the mark to be produced. See also *Wills' Tms.*, above, p. 472, note (1).

[1] See. 7, Chap. III., p. 62, and sec. 50 *infra*.

[2] Rule 102, Form TM No. 34, Appendix, p. 697.

[3] Rule 7.

to the use of the mark.[1] After seven years from the date of the original registration, or from the passing of the Act of 1905,[2] whichever shall last happen, the original registration is to be taken to be valid in all respects, subject to certain exceptions.[3]

of title by assignment, &c.;

Registration is *primâ facie* evidence of the validity of all assignments and transmissions of the trade mark,[4] but if the plaintiff claims, by devolution or assignment, through the registered proprietor, he must prove the devolution or assignment by giving the proper evidence of the facts which effect it, and must prove in the same way that the goodwill of the business concerned has also devolved upon or been assigned to him.[5]

of infringement;

The infringement must be proved by showing that the defendant, his servants, or agents, have dealt in, or threaten, or are about to deal in goods of the kind to which the plaintiff's trade mark rights extend, in such a manner as to infringe his trade mark.[6]

of probability of deception.

The nature of the evidence which should be adduced to satisfy the Court that the defendant's mark has such a resemblance to the plaintiff's as to be calculated to deceive has already been discussed.[7] It has been shown that the Court, in general, refuses to admit the mere statements of opinion by persons who are called as witnesses, to say that they think there is or there is not probability of deception.[8]

The Registrar's books are not evidence that a mark is *publici juris*.

In *Orr-Ewing* v. *Johnston*,[9] Fry, J., held that the books kept by the Registrar of Trade Marks were not evidence, in an action for infringement, to show that marks like the plaintiff's mark were in common use and had been refused registration, and that the plaintiff's mark was consequently *publici juris*. The books were only evidence, the learned judge held, that other persons had made claims. Certified copies of entries actually made on the Register are, however, evidence of such entries, and if they

[1] This is the combined effect of secs. 39 and 40, and is subject to certain limitations; see Chap. XII, Effect of Registration, above, p. 325.

[2] August 11th, 1905.

[3] Sec. 41. See above, p. 330.

[4] See. 39. above, p. 325.

[5] See. 22, Chap. XIII., p. 346. As to registration of the assignment, see p. 357.

[6] Above, p. 389.

[7] Above, p. 400, and Chap. X., p. 234. In many of the reports in the R. P. C. the nature of the evidence is very fully indicated; see, for instance, *Liebig's Co.* v. *Chemists' Society*, 13 R. P. C. 635, and the *Valentine* and *Payton* cases cited in the next chapter.

[8] *Turton* v. *Turton*, 42 C. D. 149 (1889), C. A., "Compurgators," Fry, L.J. See also *Cope* v. *Evans*, L. R. 18 Eq. 138 (1874), Hall, V.-C.; and per Jessel, M.R., in *Thorn* v. *Worthing Skating Rink Co.*, 6 C. D. 415, n.

[9] 13 C. D. at p. 442 (1879).

show that three or more marks other than, but similar to, the plaintiff's have been registered for the same goods, that would, it is submitted, be evidence that the mark is a common mark.[1]

A commission to America to take evidence as to goods ordered from an American firm, who were joined as plaintiffs, in consequence of their advertisements in this country and as to the extent of advertisements sent to this country was refused by the Court of Appeal on the ground of expense, and as not being really necessary for the plaintiffs.[2]

[1] See the "Three Marks Rule," Chap. X., p. 224.

[2] *Christy & Co.* v. *Tipper & Sons*, 21 R. P. C. 97 (1904), C. A., reversing Kekewich, J.

CHAPTER XVI.

THE ACTION FOR "PASSING-OFF."

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Definition

IT is an actionable wrong for the defendant to represent, for trading purposes, that his goods are those or that his business is that of the plaintiff, and it makes no difference whether the

representation is effected by direct statements, or by using some of the badges by which the goods of the plaintiff are known to be his, or any badges colourably resembling these, in connection with goods of the same kind, not being the goods of the plaintiff, in such manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff. But this rule does not extend to prevent the defendant honestly trading under his own name,[1] or under the names of the members of his firm, or honestly describing his goods, and their place of origin, manner of manufacture, and other characteristics, in the ordinary terms current in his trade.

The question whether the use of particular words or badges is calculated to pass off the defendant's goods as those of the plaintiff, or is merely honestly descriptive, is often one of difficulty, but it is, in substance, a question of fact.

"The principle of law may be very plainly stated, that nobody has any right to represent his goods as the goods of somebody else. How far the use of particular words, signs, or pictures, does or does not come up to the proposition enunciated in each particular case must always be a question of evidence, and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact, the legal consequence appears to follow."[2]

Comparison with the action for the infringement of a trade mark.

The action to restrain the defendant from passing off his goods as the goods of the plaintiff is obviously the generalised form of the action to restrain the infringement of a trade mark;[3] and the old principles from which the latter action grew up are still recognised and put into force by the Courts.[4] The action for

[1] Below, p. 532. Can the use be said to be honest, after it is shown that the result is to lead to the belief that the defendant's goods are the plaintiff's?

[2] Per Halsbury, L.C., in *Reddaway* v. *Banham*, [1896] A. C. at p. 204; 13 R. P. C. at p. 224. See generally on the subject of this Chapter the summaries of the law by Kay and Lindley, L.JJ., in *Powell* v. *Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235; and Ld. Davey in *Cellular Clothing Co.* v. *Maxton*, [1899] A. C. at p. 343; 16 R. P. C. at p. 408, the first of which is printed in a note at the end of this Chapter. See also an article entitled "Unfair Competition," by Mr. O. R. Mitchell, in the *Harvard Law Review* for January, 1897. Leading American authorities are the *Amoskeag Co.* v. *Spear*, 2 Sandf. S. C. 599 (1849); and *Lawrence Co.* v. *Tennessee Co.*, 138 U. S. 537 (1891).

[3] See Chap. I., pp. 1 and 13, and Chap. XV., p. 379.

[4] See Chapters I. and II., and the judgments of the C. A. in *Powell* v. *Birmingham Brewery Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235; *Lee* v. *Haley*, L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J.; *Somerville* v. *Schembri*, 12 App. Ca. 453; 4 R. P. C. 179 (1887), P. C.; *Montgomery* v. *Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ales*).

infringement has been specialised, and the proof of the plaintiff's case in it greatly facilitated and simplified by the registration of trade marks and the provisions of the Acts; but the plaintiff's trade mark, although the most important, is only one of the badges by which his trade or his goods are, or may be, identified with him; and it is equally a wrong, according to the principles laid down in the judgments quoted in the Introduction, and in the cases last cited, to imitate or copy any of the others,[1]—his trade name or the get-up of his goods, for instance,—so as to damage his trade by passing off other goods as his, or by leading his customers to suppose that there is a connection between such other goods and his business, which does not in fact exist.[2]

In a trade mark action the plaintiff must prove his title to the mark he claims, that it is registered as his mark or as the mark of his predecessor in business (unless the trade mark was in use before August 13th, 1875, and has been refused registration under the Act),[3] and that the defendant has infringed the mark.[4] And proof of the registration is, at least *primâ facie*, proof of title also. Further, if the mark has been actually or substantially copied, that constitutes an infringement, although it is not shown that the copy is calculated to deceive.[5] In a passing-off action the plaintiff's case is very similar to this, but registration forms no part of it, and the plaintiff must prove by direct evidence that the conduct of the defendant is calculated to pass off the defendant's goods as his. To do so, he must show either that the defendant has actually represented that his goods or business are those of the plaintiff, or,—and this is the common case,—that he has used certain symbols or badges in connection with his goods or business, which are reputed in the market to import that the goods or business in connection with which they are used are the plaintiff's goods or business.

Where trade mark action fails, passing-off action may succeed on the same evidence.

A plaintiff may, therefore, fail to make out a case of infringement of trade mark rights because he cannot prove his title to the trade mark, or its registration, or that its registration extends

1 "By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition" (*i.e.*, that his goods are those of the plaintiff) "but in different words and without using the name of the rival tradesman at all." Per Halsbury, L.C., in *Birmingham Brewery Co.* v. *Powell*, [1897] A. C. at p. 711; 14 R. P. C. at p. 728.

2 See *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., cited below, p. 506, and sec. 45, above, p. 338.

3 Sec. 42, above, p. 334.

4 See the last Chapter, p. 339.

5 See p 397.

to the goods,[1] or to all of the goods,[2] in question, or because the registration is ordered to be annulled,[3] and may yet show that by imitating the mark claimed as a trade mark, or otherwise, the defendant has done what is calculated to pass off his goods as those of the plaintiff. It follows that a case of "passing-off" is generally added as a second string to an action for infringement, and is frequently successful where the trade mark action proper breaks down.[4]

The two actions are frequently combined.

Nothing in the Trade Marks Act affects a trader's right against another in an action for passing-off. This is now expressly declared by sec. 45, but the law was the same under the earlier Acts.[5] It is therefore no bar to an action for passing-off that the trade name, get-up, or any other of the badges identified with the plaintiff's business, which are alleged to have been copied or imitated by the defendant, might have been, but are not, registered under the Acts as trade marks,[6] even though the evidence is wholly addressed to what may be a mark capable of registration.[7] Such unregistered marks are frequently referred to as "common law trade marks."[7]

The Act affords no bar to a passing-off action.

Common law trade marks.

But a plaintiff who has raised no issue upon his pleadings except in regard to the infringement of his trade mark has been refused leave to amend his claim at the trial so as to start a fresh case of "passing-off" in order to save his action.[8] In the

New case of passing-off or of fraud raised at the trial.

[1] *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

[2] *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

[3] *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Montgomery* v. *Thompson*, 41 C. D. 35; 6 R. P. C. 404; [1891] A. C. 217; 8 R. P. C. 361, C. A. and H. L.; *Powell* v. *Birmingham Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235; [1897] A. C. 710; 14 R. P. C. 720. The fact that a word which is *primâ facie* descriptive has been removed from the Register is an element to be considered when it is alleged in a case for passing-off to be distinctive. The Court may infer that the registration (alone) has prevented other traders from using the name: *Hommel* v. *Bauer*, 21 R. P. C. 576; 22 *ib.* 43 (1904), Warrington, J., and C. A.

[4] See the cases cited in the last three notes. *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; and the judgment of Lindley, L.J., in *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A. (*Camel Hair Belting*). See also *Compania Général de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), Kay, J., and *Curtis and Harvey* v. *Pape*, 5 R. P. C. 146 (1887), North, J., where the trade mark questions were let undecided.

[5] See pp. 450 and 451 of the 2nd ed., and *Faulder* v. *Rushton*, 20 R. P. C. 477 (1902), C. A. The question was argued in *Weingarten* v. *Bayer*, 20 R. P. C. 289, 649; 22 R. P. C. 341 (1905).

[6] See above, Chap. XII., p. 338, and *Great Tower Street Tea Co.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.

[7] *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, Lindley, L.J.; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.

[8] *Native Guano Co.* v. *Sewage Manure Co.*, 4 R. P. C. 478; 8 R. P. C. 125

case first cited in the note, however, leave was reserved to the plaintiffs to bring a fresh action to restrain the defendants from passing off their goods as the plaintiffs'. If a charge of fraud is to be made at the trial, it is essential that it should be put forward clearly and prominently on the pleadings.[1]

Proof of fraudulent intention is not essential.

Passing-off cases are usually cases of deliberate and intentional misrepresentation, and they have been treated in many reported judgments even in recent cases, in which the attention of the Court was not directed to the point, as though fraud were a necessary element of the right of action; but it is well settled that this is not the case.[2] In an action to restrain passing-off, proof that the defendant intended to deceive, if his conduct is shown to be calculated to pass off his goods as those of the plaintiff, or to cause them to be so passed off, is no more necessary than in an action for infringement.[3] And if it were necessary, it would be sufficient evidence of fraud to show that the defendant continued, or sought to continue, to use the deceptive badges or descriptions, after the danger of mistake arising from their use had been brought to his notice.[4] For it has never been held that innocent inception is a defence.[5]

(1887), Kay, J., C. A. and H. L. Leave was granted, the defendants not objecting, in *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.: and also in *Barber* v. *Manico*, supra, where the defendants raised the objection.

[1] *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.

[2] *Singer Manufacturing Co.* v. *Wilson*, 3 App. Ca. 376 (1877), Cairns, L.C., cited above, p. 14; *Johnston* v. *Orr-Ewing*, 7 App. Ca. 219 (1882); *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. 15 (1882); *Reddaway* v. *Bentham*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Saxlehner* v. *Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645, Kekewich, J.; and see the judgments of Cotton, L.J., in *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888); and *Turton* v. *Turton*, 42 C. D. 128 (1889), cited below, p. 540, and Halsbury, L.C., in *Cellular Clothing Co.* v. *Maxton*, [1899] A. C. at p. 334; 16 R. P. C. at p. 404; *Chivers & Sons* v. *Chivers & Co.*, *Ltd.*, 17 R. P. C. 420 (1900), Farwell, J.

[3] Chap. XV., p. 402. *Carr & Sons* v. *Crisp*, 19 R. P. C. 497 (1902), Byrne, J.; *Birmingham Small Arms Co.* v. *Webb*, 24 R. P. C. 27 (1907). This rule was too well settled to be disturbed by the judgments in *Derry* v. *Peek*, 14 App. Ca. 337 (1889), although it originally rested upon the extension of the action of deceit to cases where there was no intentional deception, which was reprobated in that case. Although in some judgments actions for passing-off have been referred to as actions for deceit, *e.g.*, as by Vaughan Williams, L.J., in *Jamieson* v. *Jamieson*, 15 R. P. C. at p. 191, and by the C. A. in *London General Omnibus Co.* v. *Lavell*, [1901] 1 Ch. 135, they are not actions for deceit in the ordinary sense, *i.e.*, actions brought to recover damages for a fraudulent misrepresentation made *to the plaintiff*. See also the judgment of Farwell, J., in *Bourne* v. *Swan and Edgar, Ltd.*, [1903] 1 Ch. 211, and 20 R. P. C. 105.

[4] See p. 403, above; and *Chivers* v. *Chivers*, note (2).

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

"Property" in trade names and get-up.

It is obvious, therefore, that a trader has much the same right in respect of his trade name, the get-up of his goods, and all the other distinctive badges and descriptions by which goods are known to be his, as he has in respect of his trade marks, although the latter right is called a right of property, and the former is commonly, but not invariably,[1] denied that title.[2] There are, however, important practical differences between the two rights. A trade mark being deliberately assumed or invented as a distinctive mark to identify the goods of its proprietor because of its supposed fitness for the purpose, could hardly be adopted by any other trader in the same market for similar goods without its use by him being calculated to deceive. But the other badges and descriptions referred to, although by use they may become more or less identified with the trader who used them first or most extensively, may have been adopted merely for purposes of convenience or of ornament, and may have been suggested by the circumstances of the trade in question, or of the trader himself; and the same considerations or circumstances may suggest the use of the same badges and descriptions to others also,[3] and their use of them will not necessarily be calculated to deceive. The cases in which a defendant can plead an independent right to the use of badges or descriptions which are not trade marks, —*for instance, to the use of the same trade name as the plaintiff*, —are much more important than the rare cases in which he can claim a right to use the trade mark of the plaintiff or a trade mark closely resembling it.[4]

Inferiority of the spurious goods need not be shown.

It is immaterial to the existence of the plaintiff's right of action that the goods passed off as his are as good as or better than his

[1] *Clements* v. *Maddick*, 1 Giff. 98 (1859), Stuart, V.-C.; *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1887), Kay, J., property in the name of a newspaper. Cf. p. 491, note (1), below.

[2] See per Ld. Blackburn in *Singer Manufacturing Co.* v. *Wilson*, 3 App. Ca. p. 400. In *Reddaway* v. *Banham*, [1896] A. C. at p. 209; 13 R. P. C. 228, Ld. Herschell said that he doubted whether it was accurate to speak of there being property in such a trade mark (*i.e.*, a common law trade mark), though no doubt some of the rights which are incident to property might attach to it, especially if it was such as to be capable of no conceivable legitimate use except by the proprietor. In *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. at p. 191, Vaughan Williams, L.J., said it was wrong to assume that a trader acquired some sort of property in his trade name or its use, and that the action is one of deceit.

[3] Or to customers of other traders, as for instance in the *Dolly Blue* case, *Edge* v. *Gallon*, 17 R. P. C. 557 (1901), H. of L.

[4] See per Cotton, L.J., in *Turton* v. *Turton*, 42 C. D. p. 142, and Chap. XV., p. 411; and the last note.

own;[1] but it would seem that if they are not inferior no case of damage by injury to the plaintiff's trade reputation could be made out.

Rules and practice of *infringement* action apply, in general, to passing-off action.

It will be seen from the definition placed at the beginning of the chapter, and the comparison of the two actions in the preceding pages, that the rules and principles relating to the action of infringement which are collected in the last chapter, in general apply also to the action for "passing-off," substituting proof of repute for evidence of title and registration. The defences available, the relief granted, and the practice and procedure in both actions are substantially the same.

1. Direct Misrepresentation as to Business or Goods.

Where there is a direct misrepresentation by the defendant that the goods he sells are the goods of the plaintiff, the case presents no difficulty.

No injunction if the defendant believed that his representation was true.

Thus, in *Ainsworth* v. *Walmsley*,[2] it was shown that the defendant had sold certain spools of thread wound and marked like the plaintiff's thread, with a representation that it was of the plaintiff's make. The defendant asserted that he had himself bought it on a like representation, which he believed, and that he had disclosed the source through which he himself obtained the goods, and his assertion was not disproved. The Vice-Chancellor accordingly dismissed the suit, for if the defendant in fact believed that the thread was the plaintiff's thread, he had committed no act of which the plaintiff could complain. Had he known it was not, or threatened to repeat the representation when he knew that it was untrue, there would have been a clear case for an injunction. "The use (by one manufacturer) of the name of another manufacturer," the Vice-Chancellor said, "whether *scienter* or not, is an interference with his business which this Court will interpose to prevent, on the ground that the defendant is endeavouring to pass off

[1] *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833); *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; per Ld. Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 4 App. Ca. p. 29. See last chapter, p. 389.

[2] L. R. 1 Eq. 518 (1866), Wood, V.-C. Upon the facts proved the plaintiff would probably succeed at the present day. The Vice-Chancellor treated the representation as practically equivalent to a warranty to the purchaser and no more. Cf. the defence of "acting innocently" under the Merchandise Marks Act, 1887, sec. 2 (2) (c). *Christie* v. *Cooper*, [1900] 2 Q. B. 522; *Thwaites* v. *M'Evilly*, 21 R. P. C. 397 (1904), C. A., Ireland.

the goods of his own, or somebody else's, manufacture, as the manufacture of the plaintiff." But he added, "taking the case most strongly against the defendant, it merely amounts to this, that Walmsley stated to the purchaser, 'I sell you thread which I have bought of Wreford, but which I know to be Ainsworth's.'"

"Similar to."

But *no* action lies for passing off the defendant's goods as "similar to" those of the plaintiff,[1] or with a representation that they are better than his,[2] even though the statements complained of are untrue and injurious to the plaintiff.[3]

Representation that the defendant's business is that of the plaintiff.

Cases in which the defendant directly represents that his business is the plaintiff's business, or a branch of it, or connected with it[4] are equally clear as soon as the false representation is made out.

False pretence of a business connection.

A partner or servant who has left a well-known firm and set up a similar business of his own, is entitled to advertise his former connection,[5] unless restrained from doing so by contract with his late partners or employers;[6] but he must take care to do it so as not to suggest that the connection is still existing between them and him,[7] or that they have ceased to carry on business and he is their successor.[8]

And the same rule holds good of a trader who,[9] or whose trustee in bankruptcy,[10] has sold the goodwill of his business.

False representation of succession to business.

Thus, where the son of the plaintiff quitted his father's employment, and described himself as "late of 107, Strand,"[7] an

[1] *Magnolia Metal Co.* v. *Tandem Smelting Syndicate*, 15 R. P. C. 701; 17 R. P. C. 477 (1900), C. A. and H. L. Cf. *Burberrys* v. *Raper*, 23 R. P. C. 170 (1906), Warrington, J., "identical with."

[2] *White* v. *Mellin*, [1895] A. C. 154.

[3] *Hubbuck* v. *Wilkinson*, [1899] 1 Q. B. 86, C. A., and see cases last cited.

[4] *Walter* v. *Ashton*, [1902] 2 Ch. 282.

[5] *Clark* v. *Leach*, 32 Beav. 14; 1 De G. J. & S. 409; 32 L. J. Ch. 290 (1862), Romilly, M.R., and Westbury, L.C.

[6] As in *Wolmershausen* v. *O'Connor*, 36 L. T. (N. S.) 921 (1877); and *Selby* v. *The Anchor Tube Co.*, W. N. (1877), 191 both Bacon, V.-C., where the style and goodwill passed, under the articles, to one partner on a dissolution. A servant must not use information acquired in his employment to enable him to solicit his master's customers to deal with him after he has left the employment: *Robb* v. *Green*, [1895] 2 Q. B. 1 315, Hawkins, J., and C. A. As to sales of goodwill, see below, p. 528.

[7] *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L.JJ.; *Van Oppen* v. *L. Van Oppen*, 20 R. P. C. 617 (1903), Eady, J., and see p. 409.

[8] See the cases next cited, and *Labouchere* v. *Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M.R.

[9] *Churton* v. *Douglas*, Johns. 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Fullwood* v. *Fullwood*, W. N. (1873), 93 and 185, Malins, V.-C., and L.JJ. See this further discussed below, p. 529.

[10] *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. See further, as to this, below, p. 530.

injunction was granted to restrain him from continuing to do so.

"Late."

So, in *Scott* v. *Scott*,[1] a doorplate, bearing the words "Scott and Nixon, late Robert and Walter Scott," was held to be a representation that Walter Scott had retired, and that Scott and Nixon were carrying on the business of his old firm.

And in a case where no such connection as those above referred to had ever existed between the defendants and the plaintiffs, but the defendants, having obtained a lease of clay mines formerly leased to the plaintiffs, described themselves in advertisements, referring not only to the mines, but to certain works also, where they carried on a trade similar to that of the plaintiffs, as *E. and J. Pearson* (*late Harpers and Moore*), the description was held to be a representation calculated to lead the public to believe that the plaintiffs, Harpers and Moore, had retired from business.[2] So where the plaintiff and defendant were carrying on business as rival dentists in the same street, and, on the expiration of his tenancy, the plaintiff was compelled to remove, and the defendant put up a board describing himself as the "old established dentist," this was held to be a representation that the plaintiff had removed to the defendant's place of business. An interim injunction would have been granted had the defendant not undertaken to put his name very conspicuously upon the board.[3]

Description of new comer as "the old established."

Pretence of agency.

Another description of false representation of a business connection which sometimes comes before the Courts, is where the defendant has pretended to be agent for the sale of the plaintiff's goods.[4]

Deceptive circulars.

The fraud is commonly effected by issuing misleading circulars or advertisements,[5] or by placing the deceptive name or title on

[1] 16 L. T. (N. S.) 143 (1866), Wood, V.-C.

[2] *Harpers* v. *Pearson*, 3 L. T. (N. S.) 547 (1860), cited p. 384; *Stevens* v. *Paine*, 18 L. T. (N. S.) 600 (1868), Giffard, V.-C., and cf. *Townsend* v. *Jarman*, 17 R. P. C. at 657 (1900), Farwell, J.

[3] *Mallam* v. *Davis*, 3 Times L. R. 221 (1887), Stirling, J.

[4] *Howe* v. *McKernan*, 30 Beav. 547 (1862), Romilly, M.R. (discovery ordered); *Wheeler and Wilson Co.* v. *Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C. (injunction granted).

[5] As in *Purser* v. *Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C.; *Burrows* v. *Foster*, 32 Beav. 18 (1862), L.J.J. *Graveley* v. *Winchester*, Seton, 5th ed. 591; Seb. Dig. p. 162 (1867), Wood, V.-C. (circulars ordered to be given up); *Stevens* v. *Paine*, 18 L. T. (N. S.) 600 (1868), Giffard, V.-C.; *Selby* v. *Anchor Tube Co.*, W. N. (1877), 191, Bacon, V.-C. (defendants restrained from soliciting or executing orders obtained by the misrepresentations); *Mogford* v. *Courtenay*, 45 L. T. (N. S.) 303; *Vernon* v. *Hallam*, 34 C. D. 748 (1886), Stirling, J.; and see *Townsend* v. *Jarman*, note (2).

the facia over the defendant's shop,[1] and by opening and replying to letters addressed to, or intended for, the plaintiff, and executing the orders contained in them;[2] or some one or more of these devices.

Names over shops.

Executing orders intended for the plaintiff.

As further examples of misrepresentation, not included in the classes considered below, may be mentioned claims to medals, prizes, &c., which, in fact, have been gained by the plaintiff,[3] or to patents under which he, and not the defendant, is working.[4] Such claims may enable a rival to pass his goods or business off as those of the person who is really entitled to the medals, prizes, or patents. Where they are not calculated to produce such a result no case can be made.[5]

Claim to the prizes, medals or patents of another.

In the old case of *Clark* v. *Freeman*,[6] Lord Langdale, M.R., refused to restrain the defendant from selling a quack medicine as "Sir J. Clarke's Consumption Pills," at the instance of the Sir J. Clark referred to, who was an eminent physician, on the ground that the plaintiff carried on no business in pill-making, and that the wrong done to him was a libel only, which the Court of Chancery had no jurisdiction to restrain.[7] It has always

Unauthorised use of the name of a non-trader.

[1] *Foot* v. *Lea*, 13 Ir. Eq. 484 (1850), Smith, M.R.; *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L.JJ.; *Scott* v. *Scott*, 16 L. T. (N. S.) 143 (1866), Wood, V.-C. (door plate); *Hookham* v. *Pottage*, L. R. 8 Ch. 91 (1872), Malins, V.-C., and L.JJ. As to the purchase of a building with the vendor's name built into it, see *Townsend* v. *Jarman*, p. 486, note (2), and *Boussod, Valadon & Co.* v. *Marchant*, 25 R. P. C. 42 (1908), C. A. As to names of places of business, see p. 504.

[2] *Schiele* v. *Brackell*, 11 W. R. 796 (1863); Seton, 5th ed. 584, Stuart, V.-C.; *Edgington* v. *Edgington*, 10 L. T. (N. S.) 299 (1864), Wood, V.-C. (a single instance proved, injunction refused); *Will* v. *Corcoran*, 2 C. D. 69 (1873), Bacon, V.-C.; *Townsend* v. *Jarman*, p. 486, note (2).

[3] *National Starch Co.* v. *Munn's Patent Maizena Co.*, [1894] A. C. at p. 284, P. C.; 11 R. P. C. 294; *Franks* v. *Weaver*, 10 Beav. 297; 8 L. T. (O. S.) 510 (1847), Ld. Langdale; see note (5), and below, p. 526. In *King* v. *Gillard*, 22 R. P. C. 327 (1905), C. A., the defendant's representations as to medals, &c., were held at the trial to be untrue, and they were for that reason deprived of costs. In the Court of Appeal, however, the decision on this point was reversed. The medals, &c., had been awarded to the defendants, but not for the goods in question.

[4] *Laurie* v. *Baker*, 2 R. P. C. 213 (1885), Day, J.: *Pneumatic Rubber Stamp Co.* v. *Lindner*, 15 R. P. C. 525 (1898): see also *Paine & Co.* v. *Daniells & Sons' Breweries*, cited above, p. 398.

[5] *Tallerman* v. *Dowsing Radiant Heat Co.*, [1900] 1 Ch. 1, Stirling, J. A medicine vendor published as his own testimonials sent to another. There was no probability of deception. Interlocutory injunction refused. An appeal in this case was compromised. See also *Batty* v. *Hill*, 1 H. & M. 264; 8 L. T. (N. S.) 791. As to medals and certificates at the Exhibitions of 1851 and 1862, see 26 & 27 Vict. c. 119, below, p. 817. Cf. also *Ajello* v. *Worsley*, [1898] 1 Ch. 274.

[6] 11 Beav. 112; 17 L. J. Ch. 142 (1848).

[7] As to this, see *Bonnard* v. *Perryman*, [1891] 2 Ch. 269; *Collard* v. *Marshall*, [1892] 1 Ch. 571; and *Monson* v. *Tussaud*, 10 Times L. R. 227 (1894).

been considered[1] that a narrow view was taken of the facts of this case, as the sale of pills under a well-known doctor's name is eminently calculated to suggest that the pills are prepared according to his directions, and to injure his practice if they do not meet with a favourable reception by purchasers who are, or who might become, his patients; but, in a similar recent case, Kay, J., refused to treat the older authority as no longer law, at least, upon an interlocutory application.[2]

System of advertising.

The mere adoption by one person of a system of advertising similar to that used by a rival trader will not support a passing-off action;[3] nor will the adoption of a similar system of window-dressing or decoration of a shop, if only used to attract custom and not to divert customers from the plaintiff's shop.[4]

Passing off one quality of goods for another.

Passing off one class of a manufacturer's goods for a superior class of his goods will be restrained by injunction.[5]

2. Imitations of Trade Name, Get-up, &c.

The name or get-up must be known as that of the plaintiff or his predecessors.

Actions based upon direct misrepresentation are comparatively rare. The plaintiff's case more commonly is that the defendant has copied or imitated the trade name, the unregistered trade mark, or the get-up, or some other badge or description by which the plaintiff's business and goods are known to be his. Where the charge is one of indirect misrepresentation of this sort, the onus is cast upon the plaintiff, in the first place, to show that the things copied or imitated are reputed in the market to denote a connection between himself or his predecessors in business, and the business or goods in, upon, or in reference to which they are used. And this is precisely the proof which the plaintiff had to adduce in trade mark actions before the Acts. So far as regards marks applied or attached to the goods them-

[1] Lord Selborne said the case had seldom been cited except to be disapproved: *De Rivière's Tm.*, 26 C. D. 48 (1884). See also *Maxwell* v. *Hogg*, L. R. 2 Ch. 307 (1867), Ld. Cairns; *Springhead Spinning Co.* v. *Riley*, L. R. 6 Eq. 551 (1868), Malins, V.-C. Cf. the case of the name of a private house, below, p. 505. As to authors' names, see p. 518, below.

[2] *Williams* v. *Hodge*, 4 Times L. R. 175 (1887). Kekewich, J., did so in *Lee* v. *Gibbings*, 67 L. T. 263 (1892). But see *Dockrell* v. *Dougall*, 80 L. T. 556 (1899), C. A.

[3] *Wertheimer* v. *Stewart, Cooper & Co.*, 23 R. P. C. 481 (1906), Kekewich, J.

[4] *Plotzker* v. *Lucas*, 24 R. P. C. 551 (1907), Mackenzie, L. O., Scotland.

[5] *Jameson & Son, Ltd.* v. *Clarke*, 19 R. P. C. 255 (1902), Ireland, Chatterton, V.-C.; *Teacher* v. *Levy*, 23 R. P. C. 117 (1906), Swinfen Eady, J.

selves, it has been considered, and the authorities relevant to it have been collected in a previous chapter.[1]

The plaintiff himself may be unknown.

It is not, however, necessary to show that the customers who knew the goods of the plaintiff's firm by a particular name or get-up knew anything whatever about the plaintiff. It is immaterial that they did not even know his name;[2] for it is sufficient to prove that purchasers of his goods recognised, by the use of the marks in question in connection with them, that they were goods of a particular class, and to show that such class is, in fact, constituted by his goods.

Thus, in the much contested *Yorkshire Relish* case,[3] the plaintiff's sauce was made according to a secret recipe, and was always bought and sold by the name alone. The defendants made a sauce described as a "wonderful match" of the plaintiff's, and their contention was that the public knew and cared nothing about the actual manufacturer, but wanted only the sauce known as *Yorkshire Relish*. The contention failed. Lord Herschell said of it in the House of Lords: "I think that the fallacy of the appellant's argument rests on this: that it is assumed that one trader cannot be passing off his goods as the manufacture of another unless it be shown that the persons purchasing the goods know of the manufacturer by name, and have in their mind when they purchase the goods that they are made by a particular individual. It seems to me that one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another, though they do not know that other by name at all. In the present case it seems to me that *Yorkshire Relish* meant the manufacture of a particular person."[4]

Evidence of repute essential.

Where the existence of such repute is not shown, the action cannot succeed.[5] Thus, in a case where the plaintiff claimed only as the mortgagee of a business and its trade name, and had never used, and did not intend to use, the trade name,[6] and

[1] Definition of a trade mark, Chap. II., p. 22; *Lawson* v. *The Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188 (1856).

[2] *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. (*Sunlight Self-washer Soap*); see next case.

[3] *Powell* v. *The Birmingham Brewery Co.*, [1896] 2 Ch. 54; 12 R. P. C. 496; [1897] A. C. 710; 14 R. P. C. 720, and p. 36, above.

[4] [1897] A. C. at p. 715.

[5] *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.; *Fels* v. *Christopher Thomas*, 21 R. P. C. 85 (1903), C. A. (*Naptha Soap*).

[6] *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J.; cf. *Clark* v. *Freeman*, above, p. 487.

in a case in which the plaintiffs were carrying on no business in England,[1] the actions were dismissed. But where the plaintiffs had no place of business in England, but their goods were imported by purchasers with the consent of the owners of the English patents, it was held that they had a reputation and market in England which the Court would protect.[2] No length of time during which the use of the badges in question by the plaintiff or his predecessors must have extended can be laid down,[3] although it seems safe to assume that an actual and practical knowledge of the connection between them and him by a number, apparently considerable, of probable dealers in, or purchasers of, the goods must be shown, and, accordingly, that a name, get-up, or other badge just adopted and brought into use would not now be protected, as a newly adopted trade mark would have been before the Registration Acts,[4] and would be now, if registered. On the other hand, it is not necessary that the association of the plaintiff's mark with his goods should be known all over the kingdom, or to every person in the area where it is known best.[5]

It has been held that three days' use of the name of a new weekly newspaper, of which fifteen copies had been sold (before the defendant's publication began), was not sufficient to give the owners any right to stop other persons using the same name for a rival paper.[6]

The reputed connection must be a connection of the trade or the goods, in or with which the name, get-up, or other badges are used, with the plaintiff himself, or else with his predecessors as owners of the business in which he is at the time of action,

[1] *Robineau* v. *Charbonnel*, W. N. (1876), 160, Malins, V.-C. The plaintiffs were confectioners (*quære* dressmakers) in Paris, having no agency in England. Held, no probability of injury.

[2] *Société Anonyme Panhard et Levassor* v. *Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

[3] This was stated to be a question for a jury in the old case of *Purser* v. *Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C. (*The London Manure Co.*).

[4] *Maxwell* v. *Hogg*, L. R. 2 Ch. 307 (1867), L.JJ.; *Hall* v. *Barrows*, 32 L. J. Ch. 548 (1863), Romilly, M.R.; *McAndrew* v. *Bassett*, 33 L. J. Ch. 561 (1864), Wood, V.-C., ante, p. 34.

[5] *Faulder* v. *Rushton*, 20 R. P. C. 477 (1902), C. A., (*Silverpan Jam*); *Weingarten* v. *Bayer*, 20 R. P. C. 289, 649; 22 *ib.* 341 (1905), H. of L.; *Warm* v. *Webster*, 21 R. P. C. 373 (1903), Kekewich, J. (*White Viennese Band*). And below, p. 509, area, and p. 508, secondary distinctive meaning.

[6] *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 C. D. 139 (1888). North, J., and C. A.; Cotton, L.J., said that the larger sale of the plaintiff's paper subsequently to the adoption of the defendant's name was immaterial: cf. *Maxwell* v. *Hogg*, supra, and p. 34, above.

using, or intending to use them. And trade names may be assigned and may devolve in connection with the goodwill of the business.[1] The rules in regard to assignment already discussed in relation to trade marks[2] apply, therefore, to trade names and similar matters, for if the things which the defendant has copied or imitated denote a connection, not with the plaintiff, but with someone else, he can have no claim to sue in respect of the deception which, as he alleges, the defendant's use of them is calculated to occasion. Thus, in *Pinto* v. *Badman*, the jury at the trial found, upon the same facts, that the defendant had both infringed the plaintiff's trade mark, and had passed off his goods as those of the plaintiff. On the appeal it appeared that the label and brand copied by the defendant had, not long before the commencement of the action, been assigned, without the business with which they were connected, by certain third parties to the plaintiff. Upon this ground the Court of Appeal set aside the verdict and entered judgment for the defendants, notwithstanding the finding as to "passing-off."[3] And neither a licence to use, nor an absolute assignment of a trade name without the goodwill of the business to which it was attached, entitles the licensee or assignee to sue in respect of the use of the name by another trader.[4]

Assignment and devolution of trade name, &c.

The question of repute is, however, rarely considered separately, for, as a right of property in respect of the exclusive use of marks or badges other than registered trade marks (and, to some extent, the trade name of the plaintiff) is not recognised, it is generally more convenient to deal directly with the general question: Is the defendant's conduct calculated to pass off his goods as those of the plaintiff?[5]

The question as to repute is not generally considered separately.

The imitation by the defendant of any of the badges by which the plaintiff's goods are known to be his, falls within the scope

[1] "I think it is settled by a series of cases, of which *Hall* v. *Barrows*" (p. 490, note (4)) "is, I think, the leading one, that both trade marks and trade names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed, so that they are no longer strictly correct": per Ld. Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 33 (1882). See above, p. 483, n. (2).

[2] Chap. XIII., p. 345.

[3] 8 R. P. C. 181 (1891). The case, so far as regards passing-off, was not expressly referred to in the judgments, but the principles stated were as applicable to that as to the case for infringement.

[4] *Thorneloe* v. *Hill*, W. N. (1894), 15; 11 R. P. C. 61, Romer, J. (*John Forrest*). It follows that the mere right to use a name cannot be sold; see below, p. 502.

[5] See *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1898), in the C. A.

of the action to restrain passing-off. The most important of these badges are the trade name of the plaintiff and the trade name and the get-up of his goods.

A. The Plaintiff's Trade or Firm Name.

A man's own name, or the name under which he trades, may be an ordinary trade mark, if used as such, that is, applied or attached to the goods in which he deals.[1] If it is represented in a special or particular manner, or in the form of the signature of the applicant or some predecessor in his business, it may be entered upon the Register.[2] But, although it is not so used or registered, and therefore does not become a trade mark, its use by the defendant for trading purposes in connection with goods which are not the plaintiff's is obviously calculated to mislead, unless it happens to be the name of the defendant also, or a name under which he is entitled to trade.[3]

Principle on which a trade name is protected.

The ground upon which the Court acts in protecting a trade name was stated by James, L.J., in *Levy* v. *Walker*[4] in the following passage: "It should never be forgotten that in these cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade mark, that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not, which is to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent [5] misstatement, deprive me of the profits of the business which would otherwise come to me.' An individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he has a right to restrain anyone else from injuring his business by using that name."[6]

[1] See Chap. II., p. 22.

[2] Sec. 9 (1) and (2). Chap. VIII., pp. 136 and 140.

[3] See per Wood, V.-C., *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), and p. 532, below.

[4] 10 C. D. p. 447 (1879). And see *Mrs. Pomeroy, Ltd.* v. *Scalé*, 24 R. P. C. 177 (1907).

[5] See above, pp. 14 and 482.

[6] Cf. Ld. Chelmsford's statement in *Du Boulay* v. *Du Boulay*, L. R. 2 P. C. p. 441 (1869): "The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name after a relative right of this description has been acquired by another is considered to have been guilty of a fraud, or, at least, of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction"; and *Clark* v. *Freeman*, cited ante, p. 487; see also the judgments of James, L.J., and Jessel, M.R., quoted above, pp. 1 and 13.

In the recent case of *Society of Accountants and Auditors* v. *Goodway*,[1] the question arose whether the plaintiff society could sue to restrain non-members from using a name which was calculated to represent them as being members of it, and it was held that it suffered a legal injury thereby inasmuch that it was a matter of pecuniary value to the society to have as many members as possible, and that the acts complained of by reducing its status might affect the number of its members.

It may belong to others beside the plaintiff.

The name taken or copied by the defendant need not be that under which the plaintiff alone, and no other person, is properly trading. Thus, in *Dent* v. *Turpin*,[2] Wood, V.-C., held that each of two firms carrying on business separately as watchmakers under the name *Dent* might sue a third person, who had set up a similar business under the same name, for an injunction, delivery up of the marked articles, and an account of profits.[3] But if the name in question is properly used by more than one person the difficulty of showing that its use by the defendant is calculated to cause his goods to be taken for those of the plaintiff may be greatly increased.[4]

It need not be the plaintiff's family name.

And as stated by James, L.J., in the judgment quoted above, the name need not be the personal name of the plaintiff.[5] It

[1] [1907] 1 Ch. 489; 24 R. P. C. 159, a similar decision was given in Scotland in *Society of Accountants in Edinburgh* v. *Corporation of Accountants, Ltd.*, 20 R. 750.

[2] 2 J. & H. 139; 30 L. J. Ch. 495 (1861): *Southorn* v. *Reynolds*, 12 L. T. (N. S.) 75 (1865), Wood, V.-C. See also per Ld. Watson during the argument in *Powell* v. *The Birmingham Brewery Co.*, 14 R. P. C. at p. 726. The action in *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1898), failed because the defendant had not used anything identified with the plaintiffs (p. 182), not because there were other Jamiesons in the trade at Aberdeen. See the *Whitstable Oyster* case, note (4). Cf. *Worcester Royal Porcelain Co., Ltd.* v. *Locke*, 19 R. P. C. 479 (1902), Byrne, J.

[3] As to the relief granted in such a case, see the last chapter, p. 457.

[4] See *Jamieson & Co.* v. *Jamieson*, note (2), in which Vaughan Williams, L.J., said (at p. 193): "The moment it is admitted that the goods of more traders than one are denoted by the same name you have gone a long way towards disposing of the assertion that the particular name is understood in the trade to denote the goods of the plaintiff." See also *Whitstable Oyster Co.* v. *Hayling Fisheries, Ltd.*, 17 R. P. C. 461 and 18 R. P. C. 434 (1901), Buckley, J., and C. A., and the judgments of Kekewich, J., in *Paine* v. *Daniells*, 10 R. P. C. at p. 80; and in *Findlater, Mackie, Todd & Co.* v. *Newman*, 19 R. P. C. 235, at p. 242; and *Mappin and Webb, Ltd.* v. *Leapman*, 22 R. P. C. 398 (1905), Farwell, J.

[5] P. 492; also *Mrs. Pomeroy, Ltd.* v. *Scalé*, 24 R. P. C. 177 (1907). In *Macmillan* v. *Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., the name in question, *Macfarlane Whiskey*, was adopted by both parties. The action failed because there was no probability of deception. In *Worm* v. *Webster*, 21 R. P. C. 373 (1904), Kekewich, J., the plaintiff failed to prove that "White Viennese Band" without the addition of his name meant his band exclusively. Cf. "Defences," below, p. 543.

need not even be that of a predecessor in business, for a trader may lawfully adopt and trade under any name which is unappropriated for businesses of the same kind, and when the name has become his by repute he is as well entitled to protection for it as if it were his own.[1] A modern case before North, J., is an illustration of this rule. There the plaintiffs made and sold a sauce which they called by the name of one of their servants, "Holbrook's Worcester Sauce." The servant left them and joined the defendants, who thereupon advertised that they had acquired the right to make "Holbrook's Worcester Sauce." It was shown that the sauce sold by the plaintiffs was well known as theirs by the name, and the learned judge held that they had a right to the name in question, and that Holbrook could not sell it to the defendants.[2] In that case the sauce was identified by the name with the plaintiffs, and not with Holbrook; an opposite result would have been reached if the name had been understood to indicate that the latter person was the actual maker of the goods, and that they were his goods of which plaintiffs happened to be vendors.[3] Thus, in *Franke* v. *Chappell*,[4] although the plaintiff had organised a series of concerts known as "Richter Concerts" for many years, when Herr Richter made arrangements to conduct the rival concerts of the defendants, it was held that the defendants might rightly advertise their series under the name, since it was understood to mean, not concerts got up by the plaintiff, but anybody's concerts conducted by Richter.

And a manufacturer has no right to use a name under which goods made by him for a trader have become known and identified with the trader alone, or to prevent him from using it for goods made for him by others.[5]

The trade name of a company.

Sec. 20 of the Companies Act, 1862.

In the case of a company registered under the Companies Act, 1862, it is enacted that[6]—

"No company shall be registered under a name identical

[1] In *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C., for instance, the plaintiff traded as *Mme. Elise*. See also *Mrs. Pomeroy, Ltd.* v. *Scalé*, p. 493, note (5).

[2] *Birmingham Vinegar Brewery Co.* v. *Liverpool Vinegar Co.*, W. N. (1888), 139, an interlocutory injunction was granted; cf. *Dence* v. *Mason*, W. N. (1877), 23; (1878), 42, Malins, V.-C. (*Brand's Essence of Beef*).

[3] As to joint trade marks, see p. 383, above.

[4] 57 L. T. (N. S.) 141 (1887), Chitty, J.

[5] *Defries* v. *Electric and Ordnance Accessories Co.*, 23 R. P. C. 341 (1906), Joyce, J. On the other hand, a merchant cannot continue to use a name identified with the place of origin of the goods, *e.g.*, a vineyard, after he has ceased to obtain his goods from it, *Van Zeller* v. *Mason, Catley & Co.*, 25 R. P. C. 37 (1907), Joyce, J.

[6] 25 & 26 Vict. c. 89, s. 20.

with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved,[1] and testifies its consent in such manner as the Registrar requires."

And the section further makes provision for a change of the name of any company which, through inadvertence or otherwise, is registered under a name which falls within the prohibition.

As Buckley, L.J., pointed out in his note to the section,[2] it is to be observed (1) that it only applies to the case of taking the name of a subsisting company already registered, and not to a case like *Hendriks* v. *Montagu*,[3] where a new company proposes to register in the name of, or in a name closely resembling, the name of an old-established company, which is not registered, or of a firm or individual trader;[4] (2) that so soon as the new company is registered, the section has ceased to be applicable, so that the old registered company cannot found upon the section any claim for an injunction to restrain the newly registered company from trading under the name;[5] (3) that the Act forbids registration in the same or a similar name, irrespective of the fact whether the business to be carried on under the name is the same or not.[6]

The section is supplementary to the common law.

But the provision of the section is merely in supplement of the ordinary rule upon which the Court acts in protecting trade names, and that rule is in no way limited by the registration of the name objected to as the name of the defendant company.[7] An injunction will therefore be granted to restrain the defendant from carrying on the same trade as that of the plaintiff under a name so nearly resembling his as to be calculated to deceive, whether it has been registered as the name of the defendant

[1] For example, upon a reconstruction.

[2] Buckley on the Companies Acts, see 8th ed. p. 27; see also Palmer's Company Precedents, 9th ed., Pt. I., p. 365.

[3] 17 C. D. 638 (1881), Jessel, M.R., and C. A.

[4] *Hoby* v. *Grosvenor Library Co., Ltd.*, 28 W. R. 386.

[5] But the section lays down the principle which ought to govern the Court in dealing with two companies, one of which is an old-established company, the other of which is an infant company. Per Cozens-Hardy, M.R., in *Daimler Motor Co.* (1904), *Ltd.* v. *London Daimler Co., Ltd.*, 24 R. P. C. 379, at p. 385.

[6] In considering similar names, however, a difference in the nature of the businesses may be material: *Aerators, Ltd.* v. *Tollit*, [1902] 2 Ch. 319; 18 R. P. C. 418, Farwell, J. See also the *Dunlop* case, cited below, p. 540.

[7] *Merchant Banking Co. of London* v. *Merchants Joint Stock Bank*, 9 C. D. 560 (1878), Jessel, M.R.; *Manchester Brewery Co., Ltd.* v. *North Cheshire and Manchester Brewery Co., Ltd.*, [1898] 1 Ch. 539; [1899] A. C. 83.

company or not, and, in the latter event, to restrain the defendants also from applying for registration of the name. In *Hendriks* v. *Montagu*,[1] the leading case on the point, the plaintiff, on behalf of the *Universal Life Assurance Society*, sued certain persons who were the promoters of an intended new company, to be called the *Universe Life Assurance Association*, and an injunction in the following form was granted:—

Hendriks v. *Montagu.*

The injunction granted.

"To restrain the defendants from applying to the Registrar of joint stock companies in England, for registration under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses representing that a company is to be incorporated pursuant to the Companies Act, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid."

The Master of the Rolls had refused the first branch of the injunction (as to the application to register), on the ground that no case could be made for granting it except under the section, and that the section did not apply, because the plaintiffs were not a registered company, and he had refused the second and third branches (as to advertising and carrying on business), on the ground that it was not shown that the defendants would carry on the same business as the plaintiffs, or that, if they did, the resemblance of the names must necessarily lead to the unfair appropriation by them of part of the plaintiffs' business; but the Court of Appeal overruled all these objections. The Lords Justices held that the defendants were shown to have threatened and intended to carry on the same business, and that it was morally certain that, if they did so under the name they had adopted, persons who had heard of the *Universal* would be misled into going to the *Universe*. And this, the Court said, according to the rules of equity, was sufficient, without reference to the Act, to entitle the plaintiffs to the injunction they claimed.

[1] 17 C. D. 638 (1881), Jessel, M.R., and C. A.

Injunction against signatories of Memorandum of Association.

In *Panhard et Levassor* v. *Panhard-Levassor Motor Co., Ltd.*,[1] the injunction was granted against the defendant company and also against the seven signatories of the Memorandum of Association forbidding them to use the names, and also forbidding the latter to allow the company to remain registered under its then present name.

The ground of the interference of the Court is, that the use of the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff to the defendant, or to occasion a confusion between the two businesses. If this is not made out there is no case.[2]

No monopoly allowed in names merely descriptive.

And the mere employment of a term which is descriptive of the business of both the parties will not of itself be accepted as sufficient to make out the plaintiff's case.[3] If it were it would give the first user a monopoly in the term. "If a company which does colonial business cannot call itself colonial, it is obvious that, under a species of assertion that the word colonial is symbolical, the plaintiffs might prevent every other person using it as descriptive of his trade."[4]

Cases of company trade names.

In *The Guardian Fire and Life Assurance Co.* v. *The Guardian Colonial Assurance Co., Ltd.*, 33 Beav. 548; 33 L. J. Ch. 741 (1864); see also *India and China Tea Co.* v. *Teede*, W. N. (1871), 241, Jessel. M.R.; and *The Australian Mortgage, Land, and Finance Co.* v. *The Australian and New Zealand Mortgage Co.*, W. N. (1880), 6, C. A., cited p. 500: *Daimler Motor Car Co.* v. *British Motor Traction Co.*, 18 R. P. C. 465 (1901), Buckley, J. (*Daimler Wagon Co.*). The application, which failed in the last case, succeeded six years later when *Daimler* was no longer merely descriptive: *Daimler, &c. Co.* v. *London Daimler Co.*, 24 R. P. C. 379, C. A. Also *Aerators, Ltd.* v. *Tollit*, [1902] 2 Ch. 319; 19 R. P. C. 418, Farwell, J.; *British Vacuum Cleaner Co., Ltd.* v. *New Vacuum Cleaner Co., Ltd.*, 24 R. P. C. 641 (1907). Parker, J.; *H. E. Randall, Ltd* v. *Bradley & Son, Ltd.*, 24 R. P. C. 657, 773 (1907), Warrington, J., and C. A.; *Electromobile Co., Ltd.* v *British Electromobile Co., Ltd.*, 24 R. P. C. 688; 25 R. P. C. 149 (1908). Warrington, J., and C. A.

[1] [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

[2] See *Daimler Motor Co.* (1904), *Ltd.* v. *London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A.; and *Electromobile Co., Ltd.* v. *British Electromobile Co., Ltd.*, 25 R. P. C. 149 (1908), C. A.; and the other cases collected below. And the principles to be applied are, at any rate, extremely analogous to those which are applicable in ordinary passing-off cases in which the Court has to consider whether a trade name, or trade description, or a description of a particular class of goods, or the get-up of a particular class of goods, is or is not likely to deceive: *British Vacuum Cleaner Co., Ltd.* v. *New Vacuum Cleaner Co., Ltd.*, [1907] 2 Ch. 312; 24 R. P. C. 641, Parker, J.

[3] Cf. the rule against descriptive trade marks, Chap. II., p. 37; Chap. VIII., p. 183; and as to infringement in similar cases, Chap. X., pp. 253 and 254, and below, p. 507.

[4] Per Ld. Romilly, in *The Colonial Fire Assurance Co.* v. *The Home and*

and General Insurance Co.,[1] the plaintiff company were a very old-established institution, and were commonly known as *The Guardian* or *The Guardian Assurance Co.*, and the defendant company had been lately formed by the reconstruction of the *Guardian Horse and Vehicle Insurance Association*. They had assumed powers to carry on general insurance business, and their offices were near those of the plaintiffs, in Lombard Street. It was shown that there were two other companies doing some insurance business in other parts of London, under names comprising the word *guardian*; but notwithstanding this, Jessel, M.R., held, that the defendants' new name was calculated and intended to deceive, and he would have granted an injunction had they not undertaken to call themselves the "Guardian Horse, Vehicle, and General Insurance Company."

Taking an existing name as a whole.

If a new company take the whole name of a subsisting company, even though that name is of a descriptive character, there is a high probability of deception.[2] Thus, where the Manchester Brewery Co., Ltd., had a brewery and a large business at Manchester, a new company which had acquired a brewery at Macclesfield with a business extending to Manchester, as well as other towns, attached to it, was restrained by the Court of Appeal from trading as the "North Cheshire and Manchester Brewery Co., Ltd." The decision was affirmed by the House of Lords on the ground that the use of the name would amount to a representation that the new company was an amalgamation comprising the business of the complainants.[3] But there is no rule of law that the use of a descriptive word in the name of a new company is deceptive and therefore unlawful, if it forms part or even the whole of the name of a previously existing company engaged in a similar trade.[3]

Name suggesting an amalgamation.

Name comprising plaintiffs' trade name.

In the *Eastman Co.* v. *The John Griffiths Cycle Corporation, Ltd.*, and the *Kodak Cycle Co., Ltd.*, the first-named defendants had promoted the Kodak Cycle Co., Ltd., to which they gave a name comprising as its distinctive element the trade name of the plaintiffs' goods, *Kodak*. Both defendants were restrained from carrying on

[1] 50 L. J. Ch. 253 (1880), Jessel, M.R.

[2] *Manchester Brewery Co., Ltd.* v. *North Cheshire, &c. Co., Ltd.*, [1898] 1 Ch. 539; [1899] A. C. 83.

[3] In *Aerators, Ltd.* v. *Tollit*, 19 R. P. C. 418 (1902), Farwell, J., a claim to stop *Automatic Aerator Patents, Ltd.*, failed; *British Vacuum Cleaner Co., Ltd* v. *New Vacuum Cleaner Co., Ltd.*, [1907] 2 Ch. 312; 24 R. P. C. 641, Parker, J.; *Randall* v. *Bradley*, 24 R. P. C. 657, 773 (1907), Warrington, J., and C. A. (*Anglo-American Shoe Co.*): *Electromobile Co., Ltd.* v. *British Electromobile Co., Ltd.*, 24 R. P. C. 688; 25 R. P. C. 140 (1908), Warrington, J., and C. A.

business under the name Kodak Cycle Co., Ltd., or under any name comprising the word *Kodak*.[1]

Assignments of trade name to or by a limited company.

A limited company, by the purchase of a business, often becomes entitled to a trade name which is different from its registered name, and, provided that sec. 41 of the Companies Act is not violated, there seems to be no objection to its continuing the use of such a name in connection with its own business, and it could, whether it had so used the name or not, if it had not abandoned it, prevent a person so using it as to represent that he was carrying on the business formerly carried on under the name; and, moreover, the company could sell the name with, of course, the goodwill.[2] Although a limited company could not, it is presumed, sell to a purchaser of its goodwill the whole of its registered name, yet a third person would not be permitted after the dissolution of the company to adopt its name (except the word "limited") so as to lead to the belief that his business was that formerly carried on by the company to the injury of the purchaser.[3]

Injunctions granted.

Injunctions were granted in *Hoby* v. *The Grosvenor Library Co., Ltd.*,[4] where the plaintiff's library was called the "Grosvenor Library," and in *The Accident Insurance Co., Ltd.* v. *The Accident, Disease, and General Insurance Co., Ltd.*,[5] where the plaintiff

[1] 15 R. P. C. 105 (1898), Romer, J. See the order below, p. 738. See also *Dunlop Pneumatic Tyre Co., Ltd.* v. *Dunlop Lubricant Co.*, 16 R. P. C. 12 (1899), Romer, J., and cf. the later *Dunlop* case cited p. 497, note (2).

[2] *Townsend* v. *Jarman*, 17 R. P. C. 649 (1900), Farwell, J.; *Macmillan* v. *Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A. Past contraventions of the section above referred to do not bar the plaintiffs: *Pearks, Gunston and Tee, Ltd.* v. *Thompson, Talmey & Co.*, 18 R. P. C. 185 (1901), Farwell, J.; *Randall, Ltd.* v. *British and American Shoe Co.*, 19 R. P. C. 393 (1902), Swinfen Eady, J. But where a plaintiff company in order to comply with the section has always used the special name in conjunction with its own registered name, it may be in a difficulty in showing that the name by itself indicates the company or its goods: see *Randall, Ltd.* v. *Bradley*, 24 R. P. C. 773 (1907), C. A.

[3] *Montreal Lithographing Company* v. *Sabiston*, [1899] A. C. 610, J. C., really supports this proposition, although the actual decision, which turned on the special facts of the case (see *Townsend* v. *Jarman*, 17 R. P. C. 649), was there in favour of the defendant, it being held that the mere use of the name was not, under the circumstances, calculated to deceive.

[4] 28 W. R. 386.

[5] 54 L. J. Ch. 104 (1884), Pearson, J.; see also *Wolmershausen* v. *G. S. Wolmershausen & Co., Ltd.*, W. N. (1892), 87, Chitty, J.; *Saunders* v. *The Sun Life Assurance Co. of Canada*, [1894] 1 Ch. 537; 10 Times L. R. 183, Stirling, J.; and *Premier Cycle Co., Ltd.* v. *Premier Tube Co., Ltd.*, 12 T. L. R. 481 (1896), Chitty, J., interlocutory injunction granted against the use of *Premier* as part of the title of the defendant company, whose works had before the formation of the company for six years been known as "Premier Mills."

company was popularly known as *The Accident Company* or *The Accident*; also in the cases specially mentioned above.[1]

Injunctions refused.

In the following cases injunctions were refused: *London and Provincial Law Assurance Society* v. *London and Provincial Joint Stock Life Assurance Co.*,[2] although there was evidence that the former company was usually called the *London and Provincial Insurance Co.*; *London Assurance* v. *London and Westminster Assurance Corporation*;[3] *Colonial Life Assurance Co.* v. *Home and Colonial Assurance Co., Ltd.*;[4] *London and County Banking Co.* v. *Capital and Counties Bank* (cited in the next case); *Merchant Banking Co. of London* v. *Merchants Joint Stock Bank*;[5] *The Army and Navy Co-operative Society, Ltd.* v. *The Junior Army and Navy Stores, Ltd.*;[6] *Australian Mortgage Land and Finance Co.* v. *Australian and New Zealand Mortgage Co.*;[7] *National Cash Register Co., Ltd.* v. *Theeman* (who was trading as the *Cash Register Co.*);[8] *Scottish Union and National Insurance Co.* v. *Scottish National Insurance Co., Ltd.*[9] In *Bumstead* v. *The General Reversionary Co., Ltd.*, an interlocutory injunction was refused, because, although the defendant company had adopted a name resembling that of the company of which the plaintiff was secretary, the General Reversionary and Investment Co., yet there was no probability of deception because the former was a small Liverpool concern, and the latter a very large London one.[10] See also the *Daimler*, *Dunlop*, *Electromobile*, *Vacuum Cleaner*, and *American Shoe* cases.[11]

The company may continue an established name.

A limited company formed to take over a business may adopt and use a name embodying a name under which the business has already been lawfully and properly carried on.[12] This was

[1] See the *Daimler* case, above, p. 497, note (4). In *Army and Navy Co-operative Society, Ltd.* v. *Army, Navy and Civil Service Co-operative Society of South Africa, Ltd.*, 19 R. P. C. 575 (1902), on appeal from an interlocutory injunction granted by Buckley, J., the defendants agreed to change their name to *Naval, Military and Civil Service Co-operative Society of South Africa, Ltd.*

[2] 17 L. J. Ch. 37 (1848), Shadwell, V.-C.

[3] 32 L. J. Ch. 664 (1863), Stuart, V.-C.

[4] 33 Beav. 548; 33 L. J. Ch. 741 (1864), Romilly, M.R.

[5] 9 C. D. 500 (1878), Jessel, M.R.

[6] Seb. Dig. p. 393 (1879), Jessel, M.R.

[7] W. N. (1880), 6, C. A. James, L.J., said: "The difficulty in these cases was, that while the business name of another could not be appropriated, a man could not, on the other hand, give himself any monopoly in a name which, as in this case, merely described the nature of the business or the locality of its operations"; see above, p. 497.

[8] 24 R. P. C. 211 (1907), Kekewich, J.

[9] 25 R. P. C. 560 (1908), Swinfen Eady, J. The classes of business [illegible]

[10] 4 Times L. R. [illegible] (1888), Stirling, J.

[11] Above, p. 497, notes (2) and (4).

[12] *Dunlop Pneumatic Tyre Co., Ltd.* v. *Dunlop Motor Co., Ltd.*, 23 R. P. C. 761

fully recognised by Stirling, J., in the case of *Tussaud* v. *Tussaud*,[1] where, however, the condition did not obtain. In that case an unsuccessful attempt was made by the defendant to shelter himself under the general exception from the principle stated at the head of this chapter, that anyone may honestly trade under his own name, which is discussed more fully below.[2] The plaintiffs, Madame Tussaud & Sons, Ltd., were the owners of a waxwork exhibition originally founded by a Madame Tussaud, and subsequently carried on by the father and uncles of the defendant. Their business was often referred to as *Madame Tussaud's*, and not infrequently as *Tussaud's* only. The defendant, who was a wax modeller by trade, was promoting a company to be called *Louis Tussaud, Ltd.*, to open and carry on a waxwork exhibition under that name in Shaftesbury Avenue, the plaintiffs' exhibition being situated in the Marylebone Road. He was to be engaged as manager of the exhibition and modeller of the exhibited figures. He had never carried on, and did not possess the goodwill of, any business in any such exhibition.

The judgment of Stirling, J.

It follows, said the learned judge, "from the decisions in *Burgess* v. *Burgess*[3] and *Turton* v. *Turton*,[4] that the defendant is at perfect liberty to open on his own account, and to carry on in his own name, an exhibition of waxworks. Further, he might take partners into his business, and carry it on under the name *Louis Tussaud & Co.* That seem me to have been expressly decided in *Turton* v. *Turton*. Ha ing commenced business on his own account, I apprehend that he might sell it with the benefit of the goodwill to third parties, and that the third parties might, if they thought fit, continue to carry on the business under the same name—that of the defendant; that is to say, they would be entitled to the full benefit of the goodwill which they had honestly and legitimately purchased from the defendant.

(Sc.); aff. in H. L. 24 R. P. C. 757. In *S. Chivers & Sons* v. *S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., said, at p. 426: "To my mind, no element of suspicion of fraud attaches to a man who has established a business under his own name if he turns that business into a limited company, and applies to that limited company his own name with the word "limited," because the reason for doing so is obvious, that he desires to retain the goodwill which he has gained for that name."

[1] 44 C. D. 678 (1890), Stirling, J.; followed and approved in *Fine Cotton Spinners, &c. Association, Ltd.* v. *Harwood, Cash & Co., Ltd.*, [1907] 2 Ch. 184; 24 R. P. C. 533, Joyce, J.; *Rendle* v. *Rendle & Co.*, 63 L. T. 94 (1890), Kay, J., is a somewhat similar case.

[2] Page 532.

[3] 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Knight Bruce and Turner, L.JJ., cited p. 533.

[4] 42 C. D. 128 (1889), C. A., reversing North, J., cited p. 540.

Again, the third parties might transfer the business and the goodwill to a joint stock company, and (without expressing a final opinion on the point) I am not prepared at present to say that that company might not be registered under the same name as had previously been used in connection with the business."[1]

Right to use a name not attached to any goodwill cannot be sold.

But the defendant could not, it was held, sell the right to use his name in connection with a business which he had never carried on, and in which he had no interest whatever, or in which he stood simply in the position of a paid servant.[2] And the proper inference to be drawn from the facts of the case *primâ facie* was, the learned judge concluded, that the object of the defendant in promoting the proposed company was to induce the world to believe that the business intended to be carried on was that of the plaintiff company or a branch of it, notwithstanding that the prospectus issued by the defendant plainly stated on the face of it that the new exhibition had no connection with the plaintiff company. An interim injunction in the terms of that in *Hendriks* v. *Montagu*,[3] set out above, was accordingly granted.

In three cases which subsequently came before the Courts attempts appear to have been made to carry through the series of operations indicated in the judgment just cited, but in each instance the defence which might have been founded upon them was displaced by evidence of deliberate fraud.

Brinsmead & Co. v. *T. E. Brinsmead, Ltd.*

In *The Brinsmead* case,[4] the plaintiffs were the well-known firm of pianoforte makers. T. E. Brinsmead and his sons, who were relatives of the partners, and had been in their employment, started a small independent business as "T. Brinsmead & Sons." They were restrained from trading under the name Brinsmead without using their full names, and they then promoted the defendant company under the name of "Thomas Edward Brinsmead & Sons, Ltd.," with the fraudulent intention of getting some of the plaintiffs' business. By the use of this name they induced the public to subscribe for shares in the belief that the company possessed the plaintiffs' business. The defendants were restrained from using the name Brinsmead in connection with

No connection.

[1] 44 C. D. p. 687. See p. 500, note (12).

[2] See also *Fine Cotton Spinners* v. *Harwood, Cash & Co., Ltd.*, p. 501, note (1). Cf. *The Birmingham Vinegar Brewery Co.* v. *The Liverpool Vinegar Co.*, supra, p. 494; and *Warner* v. *Warner*, 5 Times L. R. 327, 359 (1889), Stirling, J., and C. A. (*Warner's Case*); and see below, p. 543.

[3] Above, p. 496.

[4] *John Brinsmead & Co.* v. *Thomas Edward Brinsmead & Sons, Ltd.*, 12 Times L. R. 631; 13 *ibid.* 3 (1896), North. J., and C. A. The facts appear in *Re T. E. Brinsmead & Sons, Ltd.*, [1897] 1 Ch. 45, 406.

pianos without an express statement that they had no connection with the plaintiffs' firm.

Pinet et Cie. v. *Maison Pinet, Ltd.*

In *Pinet's* case,[1] a man who had carried on business in special boots for lame persons as "Maison Pinet," assigned his business to a company called "Maison Pinet, Ltd." The French firm of Pinet et Cie. complained of this, but the defendants contended that they intended only to trade in the special boots, and on that ground Kekewich, J., refused an interlocutory injunction. The Court of Appeal did not believe the defendants' story, and granted the injunction restraining them from carrying on their business in boots under the name Pinet without clearly distinguishing their boots from those of the plaintiffs. Subsequently it was discovered that the vendor to the defendant company had assumed the name Pinet for the purpose of defrauding the plaintiffs, and an injunction was then granted forbidding the use of the name by the defendants, and forbidding the liquidator of the company from selling the right to use the name in connection with boots.[2]

And in *Valentine's* case,[3] the Court of Appeal came to the conclusion that there had been an attempt to get the benefit of the plaintiffs' reputation, and in addition to relief in respect of passing-off, they restrained the defendant company from carrying on the business of manufacturers of extract of meat under any name of which *Valentine* formed part.

Purchase of a name.

In some cases of trade name, the defendant has sought to justify the use of the name by setting up the purchase of a business carried on under a name identical with or similar to that of the plaintiff, but the business so purchased has been one dealing in different goods. Whatever may be the legitimate rights of a *bonâ fide* purchaser of a business to extend it beyond its original scope, the use of the name to defraud the plaintiff by such means will not be allowed by the Courts.[4]

On the other hand, in *The Dunlop* case,[5] a company formed

[1] *Pinet et Cie.* v. *Maison Pinet, Ltd.*, 14 R. P. C. 933 (1897), C. A.

[2] *Pinet et Cie.* v. *Maison Louis Pinet, Ltd.*, 15 R. P. C. 65 (1898), North, J.

[3] *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ltd.*, 17 R. P. C. 673; 83 L. T. 259 (1900), C. A. The facts will be found more fully set out below, p. 537.

[4] *Holloway* v. *Clent*, 20 R. P. C. 525 (1903), Swinfen Eady, J.; *Rodgers* v. *Hearnshaw*, 23 R. P. C. 349 (1906), Buckley, J.; *Morrall* v. *Hessin*, 19 R. P. C. 557; 20 R. P. C. 429 (1903), Swinfen Eady, J., and C. A. Cf. *Mappin and Webb* v. *Leapman*, 22 R. P. C. 398 (1905), Farwell, J.

[5] *Dunlop Pneumatic Tyre Co., Ltd.* v. *Dunlop Motor Co., Ltd.*, 23 R. P. C. 761 (Sc.); aff. 24 R. P. C. 572 (1907), H. L. Cf. *Same* v. *Dunlop Lubricant Co.*, 16 R. P. C. 12 (1899), Romer, J.

under the name Dunlop Motor Co., Ltd., by R. and J. F. Dunlop to purchase and carry on the motor branch of a motor and cycle repairing business in Edinburgh, which they had previously carried on in partnership, maintained its right to use the name against the well-known Dunlop Pneumatic Tyre Company. There was no proof of fraud and there was no great similarity in the objects of the companies, and, in the view of the Court, there was no probability of deception.

Name of business, house, or factory.

A trader has the same rights in respect of the name of the house, shop,[1] or factory,[2] where he carries on his trade or business, as he has in respect of his trade name. He can, therefore, support an action for passing-off, and obtain an injunction by showing that the name of the house, &c., has a reputed connection with his trade or business or goods, and that the defendant, without having any independent right to do so,[3] is using for

[1] *Boussod, Valadon & Co.* v. *Marchant*, 24 R. P. C. 665; 25 *ib.* 42 (1907), Parker, J., and C. A. (*Goupil Gallery*); *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. (*Osborne House*); *Boulnois* v. *Peake*, 13 C. D. 512, n. (1868), Gifford, V.-C. (*The Carriage Bazaar*); *Bodega Co.* v. *Owens*, 6 R. P. C. 236; 7 *ib.* 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C. (*Bodega Wine Shop*). *Great North of Scotland Rail. Co.* v. *Mann*, 19 R. 10, 35 (*Palace Hotel*); *Cowan* v. *Miller*, 22 R. 833 (*San Foundry*); both Scotch cases. A number of American decisions are cited by Mr. Sebastian, 3rd ed., p. 294, 4th ed., p. 270. In *Charleston* v. *Campbell*, 4 Sess. Cas. 4th ser. 149 (1876), an injunction to restrain the use of the "Royal Station Hotel," at the instance of the proprietor of the "Station Hotel," was refused, because the title was merely descriptive.

[2] *Braham* v. *Beachim*, 7 C. D. 848 (1878), Fry, J. (*Radstock Colliery*); *Montgomery* v. *Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361, Chitty, J., C. A., and H. L. (*Stone Brewery*).

[3] In *Mason* v. *Queen*, 23 Scot. L. R. 641 (1886), the Lord Ordinary held that the goodwill and trade name of an hotel could not be transferred so as to entitle the transferee to stop a new occupier of the building from using the old name. The "Waverley Hotel," Glasgow, was taken by a railway company under compulsory powers in May, 1884, compensation being paid for loss of business. The proprietor, who had other "Waverley Hotels" in London and Edinburgh, transferred the goodwill and the right to use the name to the plaintiff, who thereupon changed the name of her own house to "Waverley," and put up a notice of removal upon the old building. In January, 1885, the railway company let the old building to the defendant, who opened it as the "Old Waverley." Held: (1) the plaintiff had no exclusive right to the name, and (2) (but *quære* on the special facts) there was no case of passing-off. See also *Nicholson* v. *Buchanan*, 19 R. P. C. 321 (1900), Stirling, J., where a firm who were the owners of a business and distillery, sometimes known as "the Black Swan Distillery," which had had a figure of a black swan outside, and who also had a black swan for a trade mark, sold first the premises to the defendants, and subsequently the goodwill and trade mark to the plaintiffs. The vendors had been known chiefly for gin, whereas the defendants carried on business on the premises in Scotch whisky, no distilling being done there. On the evidence it was held that there was no probability of deception, and the action in which

business purposes a name which is calculated to cause his trade, business, or goods to be taken for, or to be confounded with, the plaintiff's.[1] There is no right to the exclusive use of the name of a mere private house,[2] and no cause of action arises where, although the defendant has adopted, for business purposes, an address likely to be confused with that of the plaintiff, yet the businesses of the parties are so different that no damage can result to the plaintiff's trade.[3]

If the goodwill of a business, including the right to a name derived from the house where the business is carried on, be sold, the purchaser is generally entitled to continue to use the name even though he does not acquire, or ceases to possess, the house itself.[4]

If the name in question is taken from a building where a firm carries on business, it may be that on the removal of the firm the name still attaches to the building and may properly be used by the next tenant. The question appears to be one of fact.[5]

B. The Trade name of the Plaintiff's Goods.

A name which is used upon or in connection with goods for the purpose of indicating that they are the goods of a trader by virtue of manufacture, selection, certification dealing with or offering for sale, is a trade mark.[6] And if it is within any of the classes enumerated in sec. 9, it may be registered as a trade mark. But whether or not the name is used upon or in connection with the goods, so as to conform to the definition just stated, or registered

the plaintiffs complained of the use of the words "Black Swan" and the device was dismissed. In *Cooper and M'Leod* v. *Maclachlan*, 18 R. P. C. 380; 19 R. P. C. 27 (1902), the defendant was held entitled to use "Castle Brewery" which the plaintiffs also used, there being no probability of deception. Cf. *Findlater, Mackie, Todd & Co.* v. *Newman*, 19 R. P. C. 235 (1902), Kekewich, J., where "Findlater's Corner" was held to be associated with the place where the defendant carried on business. As to the assignment of marks having a local connotation, see above, p. 349.

[1] See note (1), p. 504, above.

[2] *Day* v. *Brownrigg*, 10 C. D. 294 (1878), C. A.

[3] *Street* v. *Union Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J.; the plaintiffs were advertising agents (telegraphic cypher).

[4] *Rickerby* v. *Reay*, 20 R. P. C. 38 (1903), Byrne, J. See also the *Goupil Gallery* case, above, p. 504, note (1).

[5] See *Mason* v. *Queen*, *Nicholson* v. *Buchanan*, supra, note (3), p. 504, *Charleston* v. *Campbell*, supra, p. 504, note (1), and *Rickerby* v. *Reay*, note (4); *Booth* v. *Jarrett*, 52 How. Pr. 169 (1876), New York ("Booth's Theatre"); and Sebastian, 4th ed., p. 272.

[6] Trade Marks Act, 1905, sec. 3, Chap. II., p. 24.

as a trade mark, if it is in fact known in the market as the distinctive name of the goods of a particular trader, no one else may use it for dealings in other goods of the same description as those in connection with which it has acquired its distinctive signification.

The acquisition of a trade name by the use of it in connection with the sale of, or with dealings in, goods has already been considered, and the authorities bearing on the subject have been collected in the chapter on the definition of a trade mark. It will be sufficient, therefore, to summarise shortly the results deduced from the reported cases.

Right restricted to particular goods or business.

The qualified right in the trade name,—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it,—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business suggested by the use of the name extends.[1] So, where

The Evening Post case.

the proprietors of *The Morning Post* sought to restrain the publishers of a new evening newspaper from calling their paper *The Evening Post*, the Court of Appeal, holding, as an inference of fact, that there was no probability of the defendant's paper being taken for the plaintiff's, or being taken to have any connection with it so as to cause damage to the plaintiffs, dismissed the action.[2] But if the name, although not actually used by the plaintiff for the particular kind of goods to which the defendant has applied it, is so identified with the plaintiff that the defendant's use of it will induce the belief that his goods are those of the plaintiff, or that his business is an extension of,[3] or an amalgamation with,[4] or is otherwise connected with the plaintiff's

[1] Page 31; and cf. the rule in respect of the infringement of trade marks, Chap. XV., p. 392.

[2] *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A., overruling Kay, J.; but see *Re The Australian Wine Importers, Ltd.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A., where a mark for wine was refused registration, as too closely resembling a mark for spirits, and the Court left open the question whether its use would amount to infringement or passing-off; and other cases, cited above, in connection with secs. 19, 20 and 21, p. 227. Injunctions were granted in *Walter* v. *Emmott*, 54 L. J. Ch. 1059 (1885), C. A. (*The Morning Mail*), and *Reed* v. *O'Meara*, 21 L. R. Ir. 216, V.-C. (*The Grocer*).

[3] *Eastman, &c. Materials Co.* v. *John Griffiths' Cycle Corp., Ltd.*, 15 R. P. C. 105 (1898), Romer, J. The plaintiff company dealt in photographic materials, and sold *Bicycle Kodak* cameras. *Kodak* was their trade name. The defendants were restrained from selling *Kodak Cycles*. Romer, J., said it would lead to confusion and to deception, and would be injurious to the plaintiff company. See further as to this case, above, pp. 228, 269, and 498.

[4] See *Manchester Brewery Co.* v. *North Cheshire, &c. Co.*, above, p. 498, and cf. *Joseph Lucas, Ltd.* v. *Fabry Automobile*

business, and will thereby cause substantial damage to the plaintiff, an injunction may be granted,[1] and possibly a prospective interference with the natural and probable extension of the plaintiff's business would be sufficient[2] ground to entitle the plaintiff to relief.

The name may be used on the right goods.

Anyone may use the name in connection with goods which are in fact the goods of the plaintiff.[3]

It must be distinctive of the plaintiff's goods;

It is the essence of the plaintiff's case that the use of the name should be understood in the market to imply that the goods sold or dealt in under it are his goods.[4]

In *The Two D.* case,[5] Herschell, L.C., said, the foundation of a passing-off case "is that the party alleging it should prove, in the first instance, that any name which he claims as his trade name has been so extensively used in connection with his manufacture or with the goods which he sells, that his goods have come to be known in the market by that name; that anyone using that name would intend to refer to his goods; and that anyone to whom the name was used would understand that his goods were referred to."

not the mere name of the goods.

Hence the critical question of fact in cases under this head is often whether a word or term is the distinctive name of the plaintiff's goods, or is the name of anybody's goods of the kind,[6] like *Liebig's Extract*,[7] *Chlorodyne*,[8] *Linoleum*,[9] *Wellington Boots*,

Co., Ltd., 23 R. P. C. 33 (1906), Warrington, J., where the plaintiffs had a reputation in cycle accessories, principally metal, under the name "Lucas," and the defendants commenced to sell "Lucas" motor tyres, which were well-known on the Continent, it was found that the tyre trade was a distinct branch of the motor industry, and the action for passing-off was dismissed.

[1] See note (3), previous page.

[2] See the cases last cited, per Ld. Watson in *Eno* v. *Dunn*, 15 App. Ca. at p. 258, and per Cotton, L.J., in *The Morning Mail* case, p. 506, note (2). In an American case, *Celluloid Co.* v. *Reed*, 47 Fed. Rep. 712; Cox, p. 509, the judge said the prospect that the complainant will in future want to manufacture starch, is too shadowy to base an injunction upon. But the suggested extension was there improbable in fact.

[3] Pages 33 and 394; and *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C., cited p. 484.

[4] Page 35. *Fels* v. *Christopher Thomas Brothers, Ltd.*, 21 R. P. C. 85 (1903), C. A. (*Naptha soap*)

[5] *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. p. 155 (1893), H. L.

[6] See pp. 37 and 252 *et seq.*

[7] *Liebig's Extract of Meat Co., Ltd.* v. *Hanbury*, 17 L. T. (N. S.) 298 (1867), Wood, V.-C.; *Liebig Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.; and cf. *Same* v. *Chemists' Co-operative Society, Ltd.*, 13 R. P. C. 736.

[8] *Browne* v. *Freeman*, (1) 12 W. R. 305 (1864), Wood, V.-C.; (2) W. N. (1873), 178, L.J.J.

[9] *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J. Cf. *Chesebrough Co.'s Tms.*, 18 R. P. C. 191; 19 *ib.* 342 (1901), C. A., reversing Buckley, J. (*Vaseline* not descriptive).

Gladstone Bag, and *Hansom Cab*, or a mere description of the goods, denoting only their pattern,[1] mode of manufacture,[2] or sale,[3] ingredients,[4] or place of origin,[5] or the use for which they are intended.[6] In *The Kodak* case it was alleged for the defendants that certain names were descriptive of photographic films suitable for use in cameras of the same names; but it was held, in fact, that they indicated the plaintiffs' goods only.[7]

Descriptive names may have a secondary distinctive meaning.

Words and terms which *primâ facie* are merely descriptive in the sense just explained may, however, acquire by use and reputation a secondary distinctive meaning,[8] so that they may be practically monopolised for use in connection with certain classes of goods by a particular trader, since their employment by anyone else would be calculated to deceive.[9] "I take it to be

[1] *Ford* v. *Foster*, L. R. 7 Ch. 616 (1872), L.JJ. (*Eureka Shirts*); *Hirst* v. *Denham*, L. R. 14 Eq. 542 (1872), Bacon, V.-C.; *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J. (*Albion Mowers*); *Winser* v. *Armstrong*, 16 R. P. C. 167 (1899), Byrne, J. (*Winser Interceptors*). In *Burberry* v. *Raper and Pulleyn*, 23 R. P. C. 170 (1906), Warrington, J., the defence, that the name "Burberry" meant a coat of a particular shape made of a particular cloth, failed.

[2] *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875); *Id.* v. *Looy*, 18 C. D. 395; 8 App. Ca. 15 (1877); *Id.* v. *Spence & Co.*, 10 R. P. C. 297 (1893), Romer, J.; *Id.* v. *British Empire Co.*, 20 R. P. C. 313 (1903), Kekewich, J. (*Singer System, Singer Sewing Machines*), cited ante, p. 39. In the last two cases and in *Daimler Motor Co.* (1904), *Ltd.* v. *London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A. (*Daimler*), the plaintiffs after failing in previous actions established that the name had become distinctive.

[3] *Symington* v. *Footman*, 56 L. T. 696 (1885), Kay, J. (*Guaranteed Corset*).

[4] *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A.

[5] *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; 33 L. J. Ch. 561 (*Anatolia Liquorice*); *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (*Seixo Wine*); *Wotherspoon* v. *Currie*, 5 L. R. H. L. 508 (*Glenfield Starch*), all cited pp. 19 to 51; see also *The Reading Biscuit* case, *Huntley and Palmer* v. *The Reading Biscuit Co., Ltd.*, 10 R. P. C. 277 (1893), Chitty, J.; and *The Rugby Portland Cement* case, *Rugby Portland Cement Co., Ltd.* v. *The Rugby and Newbold Portland Cement Co.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A., and *Bewlay* v. *Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*); *Whitstable Oyster Co.* v. *Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 *ib.* 434, Buckley, J., and C. A. (*Whitstable Oysters*).

[6] *Talbot* v. *Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Baffle Safes*); *Christy* v. *Tipper*, 21 R. P. C. 97, 755 (1903), Kekewich, J., and C. A. (*Absorbine Lotion*).

[7] *Kodak, Ltd.* v. *London Stereoscopic, &c. Co.*, 20 R. P. C. 337 (1903), Swinfen Eady, J. Cf. *Neostyle Manufacturing Co., Ltd.* v. *Ellam's Duplicator Co.*, 21 R. P. C. 185, 869 (1904), Byrne, J., and C. A., where it was held on the facts that, although "Neostyle" in England denoted the name of the plaintiffs' duplicating machine, the plaintiffs had no exclusive right to it for accessories.

[8] Chap. II., p. 37.

[9] See the cases cited in note (5), and *Montgomery* v. *Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ales*); followed in *Worcester Royal Porcelain Co., Ltd.* v. *Locke*, 19 R. P. C. 479 (1902), Byrne, J. (*Worcester China*).

clear from the evidence," Lord Westbury said, in *The Glenfield Starch* case,[1] "that long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants."

And in *The Camel Hair Belting* case[2] Lord Herschell said: "The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."[3]

Descriptive meaning must be lost.

It follows that where a word, which is not a "fancy word,"[3] but is *primâ facie* descriptive, is claimed as his trade name by the plaintiff, he must show that its original or apparent meaning has been wholly lost, or does not exist, "amongst those who are purchasers of the goods" in question[4] within a definite area. Such area must extend to a large part of England and Wales and

Area.

[1] See above, p. 508, note (5).

[2] *Reddaway* v. *Banham*, [1896] A. C. 199, at p. 210; 13 R. P. C. at p. 228.

[3] Cf. the decisions on the expression "fancy word not in common use" in the Act of 1883, above, p. 144. The current use of the term "fancy word" is as an antithesis to "descriptive," or *primâ facie* descriptive, word. See *Faulder* v. *Rushton*, 20 R. P. C. 477 (1902), C. A. (*Silverpan Jam*), and the judgments in the *Cellular Clothing* case cited below. *Yorkshire Relish* was referred to as a "fancy word," although it could not have been registered under the Act: see [1896] 2 Ch. p. 92; 13 R. P. C. 235. The expression is also made use of in regard to trading names, see the judgment of Kennedy, L.J., in *Daimler Motor Co.* (1904), *Ltd.* v. *London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), and the judgment of Parker, J., in *British Vacuum Cleaner Co., Ltd.* v. *New Vacuum Cleaner Co., Ltd.*, 24 R. P. C. 641 (1907).

[4] This was Ld. Herschell's phrase in *Reddaway* v. *Banham*, [1896] A. C. at p. 208; 13 R. P. C. at p. 227.

include the district in which the defendant trades or proposes to trade.[1] If the word still continues to be used and understood with its original descriptive meaning by any considerable section of such persons, it cannot be monopolised.[2] And the more appropriate the words claimed are as a description of the goods or of some characteristic of the goods, the greater is the burden of proof required from the plaintiff.[3] If the plaintiff has had a monopoly in fact of the goods his difficulty is increased.[4]

The question for the jury.

The question of fact which has to be answered in the cases

[1] In *S. Chivers & Sons* v. *S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., expressed the rule by saying that the secondary meaning must be "locally universal." He did not think that the area need necessarily comprise Scotland in order to establish a case in the English Courts. This goes too far. *Faulder* v. *Rushton*, p. 509, note (3), and the judgment of Moulton, L.J., in *Star Cycle Co.* v. *Frankenburgs*, 24 R. P. C. 405 at p. 414 (1907), where the learned Lord Justice said that small local *bonâ fide* users, which had been proved, did not affect his mind much with regard to the issue (the general reputation of the plaintiffs under the name *Star Cycle*). See also the judgment of Ld. Shand in the *Cellular Clothing* case cited below, note (3).

[2] *Parsons* v. *Gillespie*, [1898] A. C. 239; 15 R. P. C. 57, P. C. (*Flaked Oatmeal*); *Cellular Clothing Co., Ltd.* v. *Maxton*, [1899] A. C. 326; 16 R. P. C. 397, H. L. See also the judgments in the Court of Session in the last case, 15 R. P. C. 581.

[3] "I desire to say, speaking for myself, at all events, that where a person for his own purposes, for his own business, adopts such a title" (*American Shoe Co.*) "a title descriptive of the goods which he is selling, and another person is minded to adopt a title descriptive of the goods which he is going to sell, the very heavy burden lies upon the plaintiffs of proving that the adoption of this new title will cause deception, and, again, speaking for myself at all events, I think the Courts ought to be extremely careful to prevent the acquisition by persons who adopt a descriptive name, of a monopoly not only in that name, but in a name descriptive of another class of goods": per Warrington, J., in *H. E. Randall, Ltd.* v. *E. Bradley & Son*, 24 R. P. C. 657, affirmed p. 773. The action of the plaintiffs (*The American Shoe Co.*) to restrain the defendants trading as *The Anglo-American Shoe Co.* was dismissed. "In all these cases if the primary meaning of a word is a simple and easy primary meaning, known to everybody, it is extremely difficult to establish that in any particular trade this word has lost its well-known and original meaning, and in that trade acquired a secondary meaning to the exclusion of the natural and original meaning of the word": per Vaughan Williams, L.J., in *Hommel* v. *Bauer & Co.*, 22 R. P. C. 43 (1905); *Hæmatogen* for a medicine held not to be distinctive. "The *Camel Hair Belting* case may be an example of what, under ordinary circumstances, it would be very difficult to establish": per Halsbury, L.C., in the *Cellular Clothing* case, [1899] A. C. at p. 336; 16 R. P. C. at p. 405.

[4] See Ld. Davey's judgment in the *Cellular Clothing* case, note (3), and Farwell, J., in *Ripley* v. *Griffiths*, 19 R. P. C. 590 (1902), where the plaintiffs had been the only manufacturers of laundry blue in an oval shape, but they failed to establish a secondary meaning of the words "Oval Blue"; also the *Naptha Soap* cases, *Fels* v. *Christopher Thomas*, *Fels* v. *Stephenson*, *Fels* v. *Hedley*, 21 R. P. C. 85, 89 and 91, C. A.

under consideration has, accordingly, a negative as well as an affirmative part.[1]

The possibility of proving that a word which is *primâ facie* descriptive is in reality a trade name is not an exception to the well-settled rule that no case of passing-off can be made out merely by showing that the defendant has adopted and used a descriptive or other "open" word previously used by the plaintiff.[2] Any trader is entitled to affix a true description to his goods in ordinary language; but if words are used which have lost their ordinary descriptive meaning and have acquired a new meaning which is not descriptive, they no longer constitute a true description.[3]

Literally true description may mislead.

[1] In his direction to the jury in *A. W. Gamage, Ltd.* v. *H. E. Randall, Ltd.*, 16 R. P. C. 185 (1899), at p. 196, Russell, L.C.J., said: "The first point is, have Gamages made out to your satisfaction that *Shorland* means a buckle and strap shoe sold by Gamage & Co. *exclusively*, so that the person who sold the shoe under the name of *Shorland* would be passing off as Gamages' what was not Gamages', but his own, and so that a person buying it would believe that he was getting Gamages' and not the shoe of the man who sold it to him." This was approved by the C. A. In *Reddaway* v. *Banham*, [1895] 1 Q. B. 280; [1896] A. C. 199; 12 R. P. C. 83; 13 R. P. C. 218, the questions put to the jury were:—1. Does *Camel Hair Belting* mean belting made by the plaintiffs as distinguished from belting made by other manufacturers? (*Answer*, Yes.) 2. Or does it mean belting of a particular kind without reference to any particular maker. (*Answer*, No.) 3. Do the defendants so describe their belting (*i.e.*, by using the term) as to be likely to mislead purchasers, and to lead them to buy the defendants' belting as and for the belting of the plaintiffs? (*Answer*, Yes.) 4. Did the defendants endeavour to pass off their goods as and for the goods of the plaintiffs, so as to be likely to deceive purchasers? (*Answer*, Yes.) Upon these findings, Collins, J., gave judgment for the plaintiffs; the Court of Appeal reversed the judgment on the ground that the term was descriptive; but the House of Lords restored it. It appears from all the judgments that the fourth question was superfluous.

[2] *Kelly* v. *Byles*, 13 C. D. 682 (1880), Bacon, V.-C., and C. A. (*Post Office Directory*); *Schove* v. *Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Great Tower Tea Co.* v. *Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J. (*Tower Tea*); *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889) Chitty, J. (*Washerine*); *Rugby Portland Cement Co., Ltd.* v. *Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), Vaughan Williams, J., and C. A. (*Rugby Portland Cement*); *The Colonial Fire Assurance Co.* v. *The Home and Colonial Assurance Co., Ltd.*, above, p. 500; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389, Collins, J., and C. A. (1897) (*Magnolia Metal*); *Parsons* v. *Gillespie* and *Cellular Clothing Co., Ltd.* v. *Maxton*, above, p. 510, note (3).

[3] "Even a description of goods which is literally true may be so framed as to deceive": per Ld. Davey in *Grand Hotel Co. of Caledonia Springs, Ltd.* v. *Wilson*, 21 R. P. C. at p. 134. In *Reddaway* v. *Banham*, [1896] A. C. at p. 212; 13 R. P. C. at p. 229, Ld. Herschell said: "I rather demur, however, to the statement of James, L.J., that the defendant in *Wotherspoon* v. *Currie* (above, p. 51) was not telling a lie in calling his starch

A descriptive word must not, moreover, be used as a mere blind. Where an ingredient, oxide of iron, was used in making medicinal tablets merely to justify the use of the name "Compound Iron Oxide Tablets," and the name was chosen because it would lead to confusion with the plaintiffs' "Iron-Ox Tablets," and not because it could be said to correctly describe the article, an injunction was granted against the use of the term iron oxide without better distinguishing the defendants' goods from those of the plaintiffs. The plaintiffs' goods did not contain oxide of iron, which was practically useless as a drug, and the name "Iron-Ox Tablets" was held to indicate their tablets and was not associated by the public with any particular drug.[1]

Evidence.

It will be useful to contrast the evidence in some of the recent cases in which the plaintiffs succeeded with that in others in which they failed. In *Reddaway* v. *Banham*,[2] although it was admitted that the yarn of which the belting was made consisted for the most part of camel hair,[3] it was shown that the name camel-hair belting had never been current as a description in the trade, a number of other names being used, and there was evidence that the defendant had adopted the name in order to deceive purchasers, and that he was likely to succeed in deceiving them by its use. In *Powell* v. *The Birmingham Vinegar Brewery Co.*,[4] numerous wholesale and retail grocers, export agents, travellers, saucemakers and purchasers, and scientific witnesses were called, and the effect of their evidence, stated shortly, was

Glenfield Starch, as I do to the view that the defendants in this case were telling the simple truth when they sold their belting as camel-hair belting. I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary meaning differing from its primary one, and that if it is used to persons in the trade who will understand it in its secondary sense, it will be none the less a falsehood that in its primary sense it may be true." Ld. Macnaghten said (at p. 219; 13 R. P. C. at p. 233): "At Banham's works, where it cannot mean Reddaway's belting, it may be construed to mean belting made of camel's hair; abroad, to the German manufacturer, to the Bombay mill-owner, to the up-country native, it must mean Reddaway's; it can mean nothing else. I venture to think that a statement which is literally true, but which is intended to convey a false impression, has something of a faulty ring about it; it is not sterling coin; it has no right to the genuine stamp and impress of truth."

[1] *Iron Ox Remedy Co., Ltd.* v. *Co-operative Wholesale Society, Ltd.*, 24 R. P. C. 425 (1907), Parker, J.

[2] Above, p. 509. See the findings of the jury, p. 511, note (1). And other "camel hair" cases below, p. 549, note (2).

[3] Cf. the earlier case, *Reddaway* v. *Bentham Hemp Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A., where there was no such admission.

[4] [1894] 3 Ch. 449; 11 R. P. C. 563, interlocutory injunction; [1896] 2 Ch. 54; [1897] A. C. 710; 13 R. P. C. 235; 14 R. P. C. 710, Stirling J., C. A. and H. L.

that if a purchaser asked for Yorkshire Relish he would expect to get the plaintiffs' sauce. There was also evidence of actual deception.[1] In this case, as there was no other maker of the sauce but the plaintiffs themselves, the defendants'[2] sauce being a clever imitation, but not the same thing, it was inevitable that the name should indicate the plaintiffs' goods. This circumstance might have gone some way to displace the plaintiffs' evidence, as in the cases next cited, if the defendants had been prepared to sell the goods which, according to their own contention, were described by the name.

On the other hand, in *Parsons* v. *Gillespie*,[3] a number of grocers proved that when asked by their customers for "Flaked Oatmeal" they supplied the plaintiff's goods; but there was no evidence of actual deception or confusion, and the value of the evidence first mentioned was discounted by the fact that it wholly or chiefly referred to a period when there were no other goods of the kind in question in the market besides the plaintiff's goods. In *The Cellular Clothing Co., Ltd.* v. *Maxton*,[4] the plaintiffs' evidence consisted of (a) their own advertisements, in which they used the word "cellular" to describe their cloth, but did not suggest that its use distinguished their cloth from cloth of a similar description made by others;[5] (b) statements of witnesses who said that they understood "cellular goods" to mean the goods of the plaintiffs, but who did not say that they knew of any other manufacturers making similar classes of goods; and (c) consent orders for injunctions obtained against other persons who had used the name. In both of these cases the plaintiffs failed.

Secondary meaning not acquired while no competition.

In *A. W. Gamage, Ltd.* v. *H. E. Randall, Ltd.*,[6] where the plaintiffs were retail shopkeepers, a mass of evidence was called on both sides. The plaintiffs relied principally on the evidence of purchasers, of retail dealers, and of writers in trade news-

[1] [1896] 2 Ch. p. 57.

[2] Above, p. 489.

[3] See [1898] A. C. p. 254; 15 R. P. C., p. 62.

[4] See [1899] A. C. at p. 345; 16 R. P. C. at p. 410. The cases are reviewed in *British Vacuum Cleaner Co.* v. *New Vacuum Cleaner Co.*, 24 R. P. C. 641 (1907), Parker, J.

[5] It is not sufficient to show extensive advertising apart from the effect of the advertisement. "To make an advertisement relevant you must show that it had an effect." Per Vaughan Williams, L.J., in *Christy* v. *Tipper*, 21 R. P. C. 97 (1904), at p. 101. See also *Chivers & Sons* v. *Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., at p. 431.

[6] 16 R. P. C. 185 (1899), Russell, L.C.J., and C. A. (*The Shorland Cycling Shoe*). See above, p. 511, note (1).

Word qualified by plaintiff's name.

papers; the defendants principally on that of wholesale dealers. It was admitted that there were in the market shoes of the same pattern as the shoes in question made by other makers, but it was proved that the plaintiffs invariably used, besides their alleged trade name, a stamp bearing the name of the company. Some of the plaintiffs' witnesses admitted that if they saw the name without the stamp they would not think the goods were the plaintiffs'. The jury found for the defendants, being possibly influenced by the admission just mentioned, and the Court of Appeal refused to disturb their verdict.[1]

Name of introducer or patentee.

The name of the inventor or first introducer of goods which are new to the market, or the name which he gives to those he manufactures or sells, is very readily adopted as the name of goods by whomsoever they are made; and in the case of goods made under a patent, the Court is careful not to extend the patentee's monopoly by forbidding other manufacturers, after the patent has expired, to sell goods lawfully made by them according to its specification under the only name by which they are known.[2]

In *James* v. *James*,[3] Romilly, M.R., said that anyone who was possessed of the secret of an invention might make the goods according to it, and might sell them under the name of the inventor after his death, but might not sell them in his lifetime, so as to suggest that they were made by him. But the distinction here suggested was questioned by James, L.J.,[4] in a later case, for the death of the inventor would not necessarily prevent the use of his name being calculated to pass off the goods of others as goods manufactured in the business lately carried on by him, if his successors were continuing the business; and, on the other hand, during his lifetime, if there was no monopoly in the manufacture, anyone might state that the goods were made according to his system. It is material also to remember that the name of the first maker or inventor is often understood to imply the good quality of work or materials which has brought the new goods into favour rather than the mode of manufacture or the nature of the ingredients employed.[5] Where this is the

[1] So in *Hommel* v. *Bauer*, 22 R. P. C. 43 (1905), the plaintiff had called his goods "Dr. Hommel's Haematogen." See the judgment of Vaughan Williams, L.J. Further illustrations will be found under the heading, "Right to use a man's own name," below, p. 532.

[2] See Chap. II., p. 43.

[3] L. R. 13 Eq. 421 (1872) (*Lieutenant James' Horse Blister*).

[4] *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. p. 754 (1880).

[5] See the last case: and cf. the use of "original," above, p. 49.

case the use of the name by traders who have no connection with him must almost always be calculated to deceive.

Names may become *publici juris*

On the other hand, names which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such,[1] or for other reasons, lose it and fall into common use and become *publici juris*,[2] in the same way as trade marks may be lost or abandoned. Accordingly, evidence is admissible to show that a word which was once distinctive of a particular trader's goods has become common in the trade. But, where the distinctive meaning alleged is proved to hold generally for the trade and public, cases of small local user for the goods of other traders will not have much effect to displace the evidence.[3]

or become associated with another trader.

The question is, What is the meaning of the name for the time being? it is possible therefore for a word which has at one time been the trade name of one trader to become so identified with the goods of a rival trader as afterwards to become the trade name of the latter,[4] who may thereby acquire an exclusive right to its use,[4] or, if its association with the original owner has continued, a right concurrent with his right.[5]

Similarly a word which has, at one time, been in common use in a trade with a mere descriptive meaning may subsequently come to have special reference to the goods of a particular trader, who will then be entitled to prevent others using it without sufficiently distinguishing their goods.[6]

The fact that the plaintiff has for some of his goods a special name does not necessarily negative his right to a more general

[1] *Wood* v. *Butler*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton Cigarettes*). See also *Wolff* v. *Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J.; 18 R. P. C. 27 (1901), C. A.

[2] Chap. II., p. 38; and Chap. XIV., p. 362.

[3] *Star Cycle Co.* v. *Frankenburgs*, 24 R. P. C. 405 (1907), see the judgment of Moulton, L.J.; *Board* v. *Thom*, 24 R. P. C. 697 (1907), Sc., and cf. "area." above, p. 509. For the converse, see note (6).

[4] *Daniel and Arter* v. *Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*); cf. next case.

[5] *Edge & Sons, Ltd.* v. *Gallon & Son*, 16 R. P. C. 509 (1899), C. A. (*Dolly Blue*).

[6] *Daimler Motor Co.* (1904), *Ltd.* v. *London Daimler Co., Ltd.*, 23 R. P. C. 718; 24 *ib.* 379 (1906), Buckley, J., and C. A. A word which has denoted the goods of two or three separate firms may come to denote the goods of one only, *Worcester Royal Porcelain Co., Ltd.* v. *Locke*, 19 R. P. C. 479 (1902), Byrne, J., where, however, the plaintiffs were the successors of all the three firms who had previously used the term "Worcester" to denote their goods, and see above.

name; for instance, in *The Worcester China* case,[1] the plaintiffs had used the terms "Royal Worcester" and "Grainger's Worcester China" for some of their goods, and it was contended that by their conduct they had abandoned or lost their rights in "Worcester China" *simpliciter*, but this defence failed.

Disclaimed word.

Under the old Act it was decided that a word, or other particular, forming part of a registered label or other trade mark, which the plaintiff had disclaimed as a condition of registration, was necessarily open, and that the plaintiff could not be heard to allege that by itself it formed a distinctive mark.[2] It is now expressly provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration.[3]

Expunged trade mark.

In the case of a word or mark which has been expunged from the Register, even though it was expunged without the plaintiff's assent, the removal of the mark does not and never did prevent the plaintiff from showing that the mark is, nevertheless, distinctive of his goods,[4] but the Court may infer that other traders have refrained from using the word not because they knew it to mean the plaintiff's goods, but merely because of the registration.[5] It has already been shown that a trade mark which has never been registered, or which has been removed from the Register, may be the basis of a passing-off case.[6]

[1] See p. 515, note (6). But the use of a special name is a matter to be considered, cf. *Whitstable Oyster Fishery Co.* v. *Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 R. P. C. 434, Buckley, J., and C. A.

[2] *Rosenthal* v. *Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. Corsets*), interim injunction refused. This was not followed by the Scotch Court in *Bayer* v. *Baird*, 15 R. P. C. 615 (1898) (*C. B. Corsets*). Might not the plaintiff show, at any rate, that the word has acquired a distinctive meaning after the registration?

[3] Sec. 15.

[4] See *The Yorkshire Relish* (above, pp. 489 and 512), and *Stone Ale* (above, p. 339) cases.

[5] *Hommel* v. *Bauer*, 21 R. P. C. 576 (1904), Warrington, J., at p. 587; affirmed on appeal, 22 R. P. C. 43.

[6] Above, p. 481; Chap. XII., p. 338. In *Paine & Co.* v. *Daniells & Sons' Breweries Co., Ltd.*, [1893] 2 Ch. 567; 10 R. P. C. 217 (*John Bull Beer*), the C. A. assumed that the plaintiffs must fail if their trade mark were expunged from the Register, although the action was brought, not only in respect of infringement, but also in respect of passing-off. But the case was a peculiar one, for the only matter which led the Court to think the defendants' conduct was calculated to pass off their goods as those of the plaintiffs, was the use by the defendants of a label, bearing the words *Registered* and *John Bull*, whereas, in fact, the only *registered* John Bull mark was that of the plaintiffs. The use of the word "registered" in connection with the label complained of was an element also in *Board & Son* v. *Huddart*, 21 R. P. C. 140 (1904), at p. 158, Swinfen Eady, J.

Use of common word by defendant may be an element in a get-up case.

But an open word, that is to say, a non-distinctive word, or open words, may be an important element in the plaintiff's labels, and the use of the same word or words by the defendant in the same manner, especially if coupled with the use of other details of "get-up" which are similar to those which the plaintiff uses, may be strong evidence to support a passing-off case based upon imitation of get-up.[1]

This was pointed out by Wood, V.-C., in *Woollam* v. *Ratcliff*,[2] where, in commenting upon *The Omnibus* case,[3] he said: "The words *Conveyance Company*, the green omnibus, &c., were held sufficient together to entitle the plaintiffs to an injunction. The defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone."

Geographical names.

In the case of trade names which are *primâ facie* geographically descriptive, a special order has sometimes been made in order to avoid any interference with the honest and proper use of them by persons other than the owner of the trade name. Thus, in *Braham* v. *Beachim*,[4] the plaintiff, being owner of all the collieries in Radstock, except a very small one, traded as the "Radstock Coal Co.," and the defendants began to sell coal under the same name, and also as "The Radstock Colliery Proprietors." An injunction was granted, "to restrain the defendants, unless and until they shall acquire a colliery or coal mine within the parish of Radstock, from trading under, or using, the name or style of 'The Radstock Colliery Proprietors,' or any other name or style signifying that the defendants or either of them are proprietors of any colliery or collieries at Radstock." Subsequently the defendants acquired a colliery, but not in Radstock, and began to trade as "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset," and a motion to commit for breach of the injunction was refused on the ground that the terms used by them did no more than imply that they were proprietors of collieries, and that their place of business was at Radstock, and this was true.[5] So, in *The Whit-*

[1] As in *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. (*Sunlight Self-Washer*, and *Goodwin's Self-Washing Soap*); and see the report of Ld. Herschell's Committee on disclaimed additions.

[2] 1 H. & M. 259 (1863).

[3] *Knott* v. *Morgan*, 2 Keen, 213 (1836), Ld. Langdale, M.R., and Cottenham, L.C.

[4] 7 C. D. 848 (1878), Fry, J.

[5] Seb. Dig. p. 633 (1878), Fry, J.

stable Oyster case,[1] where it was held that the name "Whitstable Native Oysters" meant the plaintiffs' oysters, and could not be fairly used of French oysters relaid and brought to maturity at Whitstable; the learned judge said, the plaintiffs' right in respect of the name was subject to the inconvenience that the name might honestly be used by anyone to describe real Whitstable natives, whether the plaintiffs' oysters or not.[2]

It may be doubted whether the decision in *The Radstock Colliery* case, and the dicta just referred to, are consistent with the judgments delivered in the House of Lords, in *The Stone Ales* case,[3] where, although the right of the appellant to state that his beer was brewed at Stone was recognised, it was held to be subject to an obligation not to do so in any manner calculated to cause the appellant's beer to be passed off as that of the respondents, which was commonly known as *Stone Ale*, and the learned Lords were clearly of opinion that the obligation would prevent the appellant from using the last-mentioned term at all. And if, as required by the rule laid down in the recent authorities, the plaintiff proves that an apparently descriptive word which he claims to appropriate has wholly lost its descriptive meaning, it is difficult to imagine how the defendant can be truthfully using the word with that meaning.[4]

Author's name

An author can restrain the publication under his name of books which are not written by him, on the same principles as a trader can obtain an injunction to protect his trade name or that of his goods.[5] And, further, it has been held that the writer of a work can maintain an action against the owner of the copyright

[1] *Free Fishers of Whitstable* v. *Elliot*, 4 Times L. R. 273; W. N. (1888), 27, Stirling, J., interlocutory injunction to restrain the use of *native*: no order as to *Whitstable*. In the later case of *The Whitstable Oyster Fisheries Co.* v. *The Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 *ib.* 434 (1900), Buckley, J., and C. A., it was decided that "Whitstable," as applied to oysters, was descriptive of the place where the oysters reach maturity.

[2] Cf. also *Bewlay* v. *Hughes* and *Wolff* v. *Nopitsch*, above, p. 51, notes (4) (5). In *Grand Hotel of Caledonia Springs, Ltd.* v. *Wilson*, [1904] A. C. 103; 21 R. P. C. 117, P. C., it was held that the defendants were entitled to indicate that their mineral waters came from the Caledonia Springs. Cf. *Apollinaris Co., Ltd.* v. *Duckworth*, 23 R. P. C. 540 (*Apollinaris Salts*) (1906), Warrington, J., and C. A., and *Rey* v. *Lecouturier*, 25 R. P. C. 265 (1908), C. A. (*Chartreuse*).

[3] *Montgomery* v. *Thompson*, [1891] A. C. 217; 8 R. P. C. 361; *Worcester Royal Porcelain Co., Ltd.* v. *Locke & Co.*, 19 R. P. C. 479 (1902), Byrne, J. See also *The Yorkshire Relish* case, above, p. 489.

[4] Above, p. 511.

[5] *Lord Byron* v. *Johnson*, 2 Mer. 29 (1816), Eldon, L.C.; cf. *Barnard* v. *Pillow*, W. N. (1868), 94, Romilly, M.R. (music); and *Martin* v. *Wright*, 6 Sim. 297 (1833), Shadwell, V.-C., copy of work of diorama painter.

for the damage occasioned to his reputation by the publication of a new edition of the book, purporting to be prepared by him, but in fact not so prepared.[1] But in the case of a serial publication, the purchaser of the goodwill of the business of conducting it—sometimes, but erroneously, called the copyright in the publication—is at liberty to publish subsequent numbers under the old name after determining his business relations with the author or editor of earlier numbers, and notwithstanding that the name is that of the first editor or author.[2]

The author's right to prevent the work of another being passed off as his is, of course, quite distinct from the copyright which he may have in his own work. Upon the principle already stated,[3] the right here under consideration will not enable him to stop the republication under his name of his own, non-copyright, work.[4]

Titles of books, newspapers, or other publications, are also protected on the same principles, that is, as trade names, and no cause of action arises, therefore, unless it is shown that the title is known to indicate the plaintiff's book or paper, so that its use by the defendant would be calculated to lead to deception.[5] There is no copyright in such titles.[6] Title of book.

C. Imitation of Get-up.

The general appearance of a trader's goods as they are presented to purchasers is often the most important of the signs by which the goods are recognised as his, and an imitation of it frequently affords the readiest means by which a fraudulent

[1] *Archbold* v. *Sweet*, 1 M. & R. 162; 5 C. & P. 219 (1832), Ld. Tenterden, C.J. In *Lee* v. *Gibbings*, 67 L. T. 263 (1892), Kekewich, J., said the question was one of libel. He refused an interim injunction. See Chap. XVIII.

[2] *Ward* v. *Beeton*, L. R. 19 Eq. 207 (1874), Malins, V.-C. (*Beeton's Christmas Annual*); cf. *Condy* v. *Mitchell*, 37 L. T. N. S. 766 (1877), C. A. (*Condy's Fluid*). A late editor would be restrained from advertising that a serial is discontinued; *Bradbury* v. *Dickens*, 27 Beav. 53; 28 L. J. Ch. 667 (1859), Romilly, M.R. (*Household Words*).

[3] Above, and pp. 478, 505.

[4] *Clemens* v. *Belford*, 14 Fed. Rep. 728 (1883), Amer. (*Mark Twain*).

[5] *Schove* v. *Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A.; *Walter* v. *Emmott*, 54 L. J. Ch. 1059 (1885), C. A. (*The Morning Mail*); and cases in the next note. A list of these cases is collected in Sebastian on Trade Marks, 4th ed., p. 294.

[6] *Dicks* v. *Yates*, 18 C. D. 76 (1880), Bacon, V.-C., and C. A. (*Splendid Misery*); *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 C. D. 139 (1888), North, J., and C. A. (*Licensed Victuallers' Mirror*).

rival, and fraudulent retail dealers in collusion with him, can pass off his goods as the goods of the other. The cases falling under this head are almost necessarily cases of deliberate fraud, for such similarity of "get-up" as is calculated to deceive is, as a rule, the result of a resemblance, more or less close, in a number of corresponding details, and this can hardly happen by accident or coincidence. In effect, if the get-up of the defendant's goods appears, on first inspection, closely to resemble that of the plaintiff's, and it is shown that it has recently been adopted by him, the only explanation, consistent with honest conduct, that can ordinarily be given is, that the leading features of the get-up are common to the trade in question. A familiar example of such common features is the square tin box covered with yellow paper, bearing red and black letters, of the mustard trade.[1]

Get-up common to the trade.

What is compendiously called the "get-up" of goods—the dress in which they are presented to the buyer[2]—comprises, in particular, the size and shape of the packages,[3] where the goods have no definite outline, or none which is shown to the buyer, the material, colour, and decoration of their wrappers, and the lettering and arrangement of their labels.[4] Thus, in *Lever* v. *Goodwin*,[5] the plaintiffs sold their soap in packets wrapped up in a peculiar parchment paper, with *Sunlight Self-washer* printed in spaced type upon the wrapper; the defendants began to use

[1] See *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J. Other examples will be found in *Jamieson & Co.* v. *Jamieson*, 15 R. P. C. 169 (1898), C. A., overruling Byrne, J.; *Packham & Co.* v. *Sturgess & Co.*, 15 R. P. C. 669 (1898), North, J., and C. A.; *Payton & Co.* v. *Snelling, Lampard & Co.*, 17 R. P. C. 48 and 628, C. A. and H. of L., enamelled tins for French coffee, reversing Byrne, J., 16 R. P. C. 283. *King* v. *Gillard*, 22 R. P. C. 327 (1905), C. A. (*desiccated soup in steel boxes*).

[2] In *Knott* v. *Morgan*, 2 Keen, 213 (1836), Langdale, M.R., and Cottenham, L.C., the fraud consisted in the imitation of the painting of the plaintiff's omnibuses, the uniforms of their servants, and the use of their descriptive title—the London Conveyance Co. The facts in *The London General Omnibus Co.* v. *Felton*, 12 T. L. R. 213, Chitty, J., and *London Road Car Co.* v. *Era Omnibus Assn.*, (1898) *Times*, June 23: (1899) *Times*, April 28, were similar.

[3] In *Ripley* v. *Bandey*, 14 R. P. C. 591, Kekewich, J., the blue was done up in oval packets, and thence called *Oval Blue*; the case was settled on appeal, 14 R. P. C. 944. In *Jones* v. *Hallworth*, 14 R. P. C. 225 (1897), Kekewich, J., the colours, patterns, shape, and sizes of the plaintiff's *Selvyt* dusters were imitated. In *Elliott* v. *Hodgson*, 19 R. P. C. 518 (1902), Buckley, J., flat ended cigars were imitated.

[4] A curiously shaped stick on which the plaintiffs' carpets were rolled has been protected in America: *Lowell Manufacturing Co.* v. *Larned*, Cox, 2nd ed., p. 241. In *Parker and Smith* v. *Satchwell*, 18 R. P. C. 299 (1901), Farwell, J., the show cards on which the defendant's goods were sold closely resembled those used by the plaintiffs.

[5] 36 C. D. 1; 4 R. P. C. 492 (1887) Chitty, J., and C. A. Cf. *Lever* v. *Bedingfield*, 16 R. P. C. 3 (1899), C. A.

similar packets and paper, with the words *Goodwin's Self-washing Soap* printed upon it in similar type. It was treated as an obvious case of fraud.[1]

No monopoly in the constituent elements.

"Looking at the two tablets," Cotton, L.J., said, "one cannot but see that there is a strong general resemblance between them, and especially in the eyes of people who cannot read. But (the defendants') contention was this: there is no trade mark in *Self-washer* or *Self-washing*;[2] there is no monopoly in this parchment paper; there is no monopoly in the spaced printing; then why should we be restrained, in carrying on business, from using those things as to which the plaintiffs cannot claim any monopoly? That is an obvious fallacy. There may be no monopoly at all in the individual things, but, if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction to restrain the defendants from passing off their goods as those of the plaintiffs."[3]

Get-up common to the trade, or newly introduced.

No case can be made merely by showing an imitation of the parts of the get-up of goods which are common to the trade.[4] And even where a trader introduces a new feature into the get-up of his goods he does not thereby acquire any proprietary interest in it, so as to be able to prevent its use by competitors without proving that it has become so identified with his goods that its use by others is calculated to deceive.[5] The fact that the

[1] Imitations of the descriptive and commendatory inscriptions, and of the directions for use printed on the covers of patent medicines and proprietary articles are very common: *Franks* v. *Weaver*, 10 Beav. 297 (1847), Langdale, M.R.; and *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A., are instances. As to prizes, medals, and testimonials, see above, p. 487, and below, p. 526, note (5).

[2] It had been struck off the Register on the defendants' application.

[3] *Blofeld* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833), imitation of envelope; *Great Tower Street Tea Co.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J., of packets; *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), Chitty, J., of label; *Stephens* v. *Peel*, 16 L. T. N. S. 145 (1867), Wood, V.-C., of bottle, and Steel-pens for *Stephens*.

[4] Page 520, n. (1). *Imperial Tobacco Co.* v. *Purnell*, 21 R. P. C. 368, 598 (1904), Joyce, J., and C. A., narrow red bands for cigars.

[5] In *Payton* v. *Snelling, Lampard & Co.* (above, p. 520, n. (1)), the plaintiffs had been the first to put up coffee in tins enamelled in bright colours. The practice was soon followed, and it was held that the plaintiffs had no monopoly in such tins. See also the remarks of Kekewich, J., in *Hubbuck* v. *Brown*, 17 R. P. C. at p. 154 (1900), and in *Alaska Packers' Association* v. *Crooks*, 18 R. P. C. 129 (1901), as to the fashion of the market.

peculiarities of get-up which are relied on by the plaintiff have become identified with and distinctive of his trade must be proved as in any other case of passing-off.[1] But very little evidence of user may be sufficient where the get-up is not only novel but striking.[2] The case is then analogous to that of a "fancy word."

Imitation of part of get-up.

It is not, however, necessary that every part of the get-up should be imitated, for, though no exclusive right to the use of any single feature of it which is not a registered trade mark is recognised, yet a part of the get-up, a picture, for instance, which is used on the label or wrapper, may be shown to be so identified with the plaintiff's goods that its use for similar goods is calculated to pass them off as his. The picture, in effect, may become —as the trade name of the plaintiff's goods may— a "common law trade mark."[3]

Thus, in *Jay* v. *Ladler*,[4] the plaintiff used the device of a lady and a bear, in his trade as a furrier, by attaching it to the wrappers and boxes in which he sent out his goods, but he had registered it only as a trade mark for sealskin mantles and coats. The defendant began to issue a circular, bearing a similar mark, in connection with his trade, which was also that of a furrier. Two injunctions were granted, one, restricted to the mantles and coats, to restrain infringement of the trade mark, the other, not so restricted, to restrain the defendant from using the device so as to deceive the public.

And, on the other hand, the imitation of a number of things, each of which is in itself not distinctive of the plaintiff's goods, may make a strong case on account of the cumulative effect of the detailed resemblances.[5]

Only things which are put prominently forward so as to be likely to catch the eye of a purchaser and remain in his memory need generally be considered. Thus, the printing on the back or sides of a box may usually be disregarded in considering whether the get-up of goods is likely to deceive.[6]

[1] See note (5), previous page.

[2] *Weingarten* v. *Bayer*, 22 R. P. C. 341 (1905), H. L. (*Erect Form* with *corsets* written in a flourish of the F).

[3] Above, p. 481, and *Weingarten* v. *Bayer*, supra.

[4] 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; see also *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.; and *Great Tower Street Tea Co.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.; and see p. 516, above.

[5] See the judgment, in *Lever* v. *Goodwin*, quoted above, and compare it with those in *Lever* v. *Bedingfield*, 16 R. P. C. 3 (1899), C. A. See also per Wood, V.-C., in *Woollam* v. *Radcliff*, 1 H. & M. 259, cited ante, p. 517.

[6] "I attribute very little importance indeed in a case of this kind to the sides

It is no answer to a case founded on passing-off by "get-up" that the plaintiff's trade mark which appears on his goods or the special name of his goods is not taken or infringed. But if a plaintiff by his cautions and advertisements shows that he relies wholly or mainly on his trade mark or trade name, he makes his case on general get-up, apart from trade mark or trade name, more difficult to establish.[1]

3. Use in Connection with the Defendant's Goods.

Name, &c., need not be attached to the goods.

The spurious badges must be used in connection with goods which are not the plaintiff's, but they need not be stamped or printed upon them or their envelopes. The fraudulent trade names, for instance, in most of the cases where injunctions have been granted, were used as descriptions of the defendants for general purposes, and in their advertisements and circulars,[2] or were placed over their shop doors.[3] In *Jay* v. *Ladler*,[4] the deceptive representation was effected by sending to the defendant's customers a circular inclosing a print of a design resembling the plaintiff's distinctive design. The action extends to every kind of representation which is calculated to pass off the defendant's goods as the plaintiff's.

4. Probability of Deception.

Where deception is intended.

The Court must be satisfied that the defendant's conduct is calculated to pass off other goods as those of the plaintiff, or, at least, to produce such confusion in the minds of probable customers or purchasers as would be likely to lead to the other goods being bought and sold for his.[5] This is the foundation of the action.

If it is shown to have been intended by the defendant to deceive in this way, the Court will not generally push the inquiry further.[6]

and luck." Per Kekewich, J., in *Lever* v. *Bedingfield*, 15 R. P. C. at p. 462 (a box of tablets of soap). 14 R. P. C. 645; Appendix, pp. 732, 737.

[1] See *Hennessy* v. *Keating*, 25 R. P. C. 125 and 361 (1908), H. of L., and also *Imperial Tobacco Co.* v. *Parnell*, 21 R. P. C. 368, 598 (1904), Joyce, J., and C. A.

[2] See the injunctions in *Hendriks* v. *Montagu*, 17 C. D. 638; *Massam* v. *Thorley*, 14 C. D. 748; and see *Saxlehner* v. *Apollinaris Co.*, [1897] 1 Ch. 893;

[3] *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675.

[4] 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

[5] *Hendriks* v. *Montagu*, 17 C. D. 638 (1881); see per James, V.-C., p. 646, and *Schweppes* v. *Gibbens*, p. 824, note (3), per Romer, L.J.

[6] "Why should we be astute to say that (the defendant) cannot succeed in

But the intention is only evidence of the actual deception or probability of deception which may be inferred from it. And if the Court does not believe that there is any probability of deception, the action must fail.[1] "The law does not take notice of a fraudulent intention in a man's mind if he does nothing to carry out the fraud." [2]

Deception by the deliberate fraud of a third party, *e.g.*, a retailer, where the defendant's mark when fairly used is not calculated to deceive, is not imputable to the defendant.[3]

Badges of fraud: unexplained similarities; colourable differences;

The existence of unexpected and unexplained similarities[4] between the goods of the defendant and those of the plaintiff, or of similarities which have been modified by colourable differences[5] or by differences and distinctions so arranged as to escape notice;[6] the use by the defendant of descriptions, which, as applied to himself or his own trade, are inaccurate, and by reason

doing what he is straining every nerve to do?" Lindley, L.J., asked, in *Slazenger* v. *Feltham*, 6 R. P. C. p. 538 (1889). Cf. per Ld. Macclesfield, in *Mitchell* v. *Reynolds*, 1 Smith L. C., 10th ed., p. 391. "He only can suffer by his knavery, and surely Courts of Justice are not concerned lest a man should pay too dear for being a knave." And see *Lambert and Butler, Ltd.* v. *Goodhaly*, 19 R. P. C. 377 (1902), Farwell, J., at p. 381; *Iron Ox Remedy Co.* v. *Co-operative Wholesale Society*, 21 R. P. C. 425 (1907), Parker, J., at p. 430; *Hennessy* v. *Keating*, 24 R. P. C. 125, Fitzgibbon, L.J., at p. 136.

[1] *Leer* v. *Bolingfield*, 16 R. P. C. 3 (1898), C. A., overruling 15 R. P. C. 453, Kekewich, J.

[2] Per Ld. Esher, M.R., in *Reddaway* v. *Banham*, 12 R. P. C. at p. 89. "If intent to deceive be once established, it is a short step, though it is a step, and not an inevitable one, to the conclusion that the intention has been fulfilled, and that the goods are calculated to deceive," per Kekewich, J., in *Saelehner* v. *Apollinaris Co.*, 14 R. P. C. at p. 654.

[3] *Payton* v. *Snelling*, [1901] A. C. 308; 17 R. P. C. 635; *Scherpps, Ltd.* v. *Gibbens*, 22 R. P. C. 113, 601 (1905, C. A. and H. of L.; *Hennessy* v. *Keating*, 25 R. P. C. 361 (1908), H. of L.

[4] *Taylor* v. *Taylor*, 2 Eq. Rep. 290; 23 L. J. Ch. 255 (1854), Wood, V.-C.

[5] *Slazenger & Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889), C. A. (*Demon, Demotic*). Obvious differences between the goods themselves are very material to the question: *Coleman* v. *Brown*, 16 R. P. C. 619 (1899), North, J., and C. A. on an interlocutory application (*Vincarnis, Vincalis*). *Fairbank Co.* v. *Cocoa Butter Manufacturing Co.*, 21 R. P. C. 23 (1904), Swinfen Eady, J. (*Cottolene, Cocosoline*), an action for infringement; *Apollinaris Co., Ltd.* v. *Duckworth*, 23 R. P. C. 540 (1906), Warrington, J. (*Apollinaris Salts*); *Reddaway & Co., Ltd.* v. *Irwell and Eastern Rubber Co., Ltd.*, 23 R. P. C. 621; 24 R. P. C. 203 (1907), Neville, J., and C. A. (*Lancashire* for hair belting, *Lanco* for balata belting); *Pianolist Co.'s Application*, 23 R. P. C. 774 (1906), Parker, J., *Pianola* and *Nola* for different instruments; *Turner's Motor Manufacturing Co., Ltd.* v. *Miesse Petrol Car Syndicate, Ltd.*, 24 R. P. C. 531 (1907), Warrington, J., steam motor cars and petrol motor cars. Cf. application of *Compagnie Industrielle des Petroles*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J., *motorine* for lubricating oils, *motricine* for petrol; and the cases cited above, p. 228.

[6] *E.g.*, "*late of*," &c., in small letters, Chap. XV., p. 409.

of their inaccuracy approach more nearly to the proper description of the plaintiff,[1] and the gradual approximation of the defendants' names, get-up, or description to those of the plaintiff,[2] are all obvious badges of fraudulent intention frequently recurring in the cases which come before the Court.[3]

gradual approximation.

Instances of actual deception need not be proved if the Court is otherwise satisfied of the probability of deception;[4] and on the other hand, they are not necessarily conclusive where they have occurred, in cases, for example, where their number is comparatively insignificant.[5] And, of course, proof of deception is not sufficient to enable the plaintiff to succeed if the defendant has done nothing but what he was entitled to do, as where he has only used marks common to the trade.[6]

Proof of actual deception.

The question what resemblance is calculated to deceive, and the modes of comparison adopted, have been sufficiently considered in the preceding chapters.[7]

Proof of probability of deception.

All the circumstances of the case must be considered. Thus where the mark in question is not attached to the goods themselves so as to reach the ultimate purchasers, it may be clear that

[1] *Holloway* v. *Holloway*, 13 Beav. 209 (1850), Langdale, M.R.

[2] *Boulnois* v. *Peake*, 13 C. D. 513, n. (1868), Giffard, V.-C., *Carriage Repository* changed to *New Carriage Bazaar*; *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), C. A. (*Apollinis*); *Sanitas Co., Ltd.* v. *Condy*, 4 R. P. C. 195, 530; 56 L. T. 621 (1886), Kay, J. (*Condi-Sanitas*). "When a manufacturer's goods are a drug on the market so long as they bear his own name or proclaim their true origin, and yet are saleable at once if marked with nothing but some common English words, and when that manufacturer holds himself out as ready and willing so to mark his goods, and does so mark them *at the 'instigation,'* as he says, of a purchaser, a Lancashire jury may perhaps be trusted to solve the riddle." Per Ld. Macnaghten in *The Camel Hair Belting* case, 13 R. P. C. at p. 233. See also *Colman* v. *Farrow*, 15 R. P. C. 198 (1898), Stirling, J.

[3] See further, p. 409.

[4] See the last chapter, p. 401, and Parker, J., in *Iron Ox Remedy Co., Ltd.* v. *Co-operative Wholesale Society*, 24 R. P. C. 125, at p. 430 (1907).

[5] *Civil Service Supply Association* v. *Dean*, 13 C. D. 512 (1879), Malins, V.-C.; *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A.; *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.; *Rutter* v. *Smith*, 18 R. P. C. 4 (1901), Kekewich, J.

[6] See below, *Defences*, and above, p. 520, note (1). In *Jamieson* v. *Jamieson*, 15 R. P. C. 169 (1898), the C. A. dismissed the action, although Byrne, J., had found both actual deception and intention to deceive. In *King* v. *Gillard*, 22 R. P. C. 327, the defendant copied some common elements from the plaintiff's box.

[7] *Chap.* XV., p. 400; *Chap.* X., p. 234; see also *Goulfellow* v. *Prince*, 35 C. D. 9 (1887), C. A. (plaintiff and defendant both mere importers); *Bodega Co.* v. *Owens*, 6 R. P. C. 236; 7 R. P. C. 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C. (defendant called his wine shop in Belfast *Bodega*; plaintiff had no Bodega shop in Ireland outside Dublin).

the trade purchasers to whom the defendant's business is confined are not in danger of being deceived.[1]

5. Proof of Damage.

Proof of damage is not in every case essential to enable the plaintiff to maintain his action, for if he shows that the defendant is acting so as to pass off goods as those of the plaintiff which are not the plaintiff's, it will generally be assumed that the plaintiff is thereby prevented from selling as many of the goods as he otherwise would. But if this assumption is negatived by the circumstances of the case, proof of actual or probable damage is necessary.[2] For the assumption of a name,[3] or an address,[4] similar to the name or address of the plaintiff, without malicious intent, although it may cause annoyance and inconvenience to him,—for instance, by delaying his letters,—is not actionable, unless it is shown to be calculated to injure him in his trade. And no action lies at the suit of any private person for deception practised upon the public, unless it incidentally causes, or is calculated to cause, damage to him as an individual; if this is not the case, the wrongdoer can only be punished through the criminal law, or in a civil action on information brought in the name of the Attorney-General.[5]

Probability or proof of damage is essential.

The questions how far the inconvenience caused to a trader by the use of his trade name, or the trade name of his goods, in a business which is not in competition with his own, and how far the interference with a possible extension of his existing business entitle him to sue, have already been considered.[6]

[1] *Star Cycle Co.* v. *Frankenburgs*, 24 R. P. C. 46, 105 (1907), Eady, J., and C. A. (use in trade price lists); *Fairbank Co.* v. *Cocos Butter Co.*, 21 R. P. C. 23 (1903), Eady, J.

[2] So that a non-trader has no action, ante, p. 392; *Delondre* v. *Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.; *Levy* v. *Walker*, 10 C. D. 436 (1879). See also cases in p. 525, note (7)

[3] *Borthwick* v. *The Evening Post*, above, p. 506; *Du Boulay* v. *Du Boulay*, L. R. 2 P. C. 430.

[4] *Day* v. *Brownrigg*, 10 C. D. 294 (1878), C. A.; *Street* v. *Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J., adoption by the defendants (bankers) of the same cypher telegraphic address as that of the plaintiff.

[5] Per Cotton, L.J., in *The Native Guano Co.* v. *The Sewage Manure Co.*, 8 R. P. C. p. 128 (1891); see also *Clark* v. *Freeman* and *Williams* v. *Hodge*, cited above, pp. 487, 488; *Batty* v. *Hill*, 1 H. & M. 264 (1863), Wood, V.-C., false pretence of award of gold medal. In *The Maizena* case (above, p. 364), the Privy Council thought that the defendants had made an objectionable reference to a medal really gained by the plaintiffs, but that it was a mere advertising trick. The defendants gave an undertaking to discontinue the reference, and the action was dismissed: [1894] A. C. 275; 11 R. P. C. 281.

[6] Above, p. 507, and note (4).

6. Defences.

The defences, other than a simple denial of the acts alleged, which are commonly set up, may be tabulated as follows: that—

(1) The name, or other badge, which the plaintiff charges the defendant with having imitated, carries no distinctive reference to the plaintiff's goods.

(2) The defendant has an independent or a concurrent right to use it.[1]

(3) The name or other badge which the defendant is using, is not such, or is not so used, as to be calculated to pass off other goods for those of the plaintiff.[2]

(4) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (a) an agreement, or some personal estoppel[3] (other than those next alluded to); (b) acquiescence;[4] (c) delay;[5] or (d) deceptive use of the name or badges he relies on, or because his trade is fraudulent.[6]

Denial of repute.

(1) This is a traverse of part of the plaintiff's case. It may take the form of an allegation that the name or other badge is merely descriptive.[7] If so, the defence falls under the second head also.

Concurrent right.

(2) This defence is discussed below. The most important case is the right of any man, apart from restriction by contract, to trade honestly under his own name.[1] That right is, of course, an answer only to a case which rests wholly upon an alleged imitation or adoption of the trade name which the plaintiff is using.

Denial of deception.

(3) This defence also is a mere traverse. It has been considered already.[8]

Estoppel.

(4) The defences collected under the fourth head are precisely analogous to those discussed in the last chapter; they depend on the same considerations and are governed by the same rules.[9]

[1] See, as to the right to use a man's own name, p. 532; and as to the right to describe honestly the place of origin, &c. of his goods, p. 517; and further, the last chapter, "Infringement," pp. 411 *et seq.*

[2] Above, p. 523; and Chap. XV., p. 400.

[3] Page 419.

[4] Page 421.

[5] Page 423.

[6] Page 439.

[7] Above, pp. 507 *et seq.*

[8] Note (2), above.

[9] See *Read* v. *Richardson*, 45 L. T. N. S. 54 (1881), C. A. (*Dog's Head Beer*).

Concurrent Right.

The defendant may have as good a title to use the name or other things in question as the plaintiff has to use the name or things with which it or they are, as he alleges, likely to be confused.

Registered trade mark.

The defence of concurrent right with regard to a registered trade mark is discussed in the last chapter.[1] Registration of a mark which is deceptive confers no right to use it so as to pass off the defendant's goods as those of the plaintiff.[2]

Partners after dissolution.

On the dissolution of a partnership, in the absence of special agreement, and unless the firm name is sold or assigned with the goodwill, as it may be,[3] each partner has an equal right to use it, if he continues to carry on a similar business to that of the late firm,[4] provided that he does not by so doing expose his former partners to any risk of liability.[4] Whether there will be any such risk is a matter to be determined under the circumstances of the particular case.[5]

Purchaser of goodwill.

It is convenient to note here, in passing, that the purchaser of the goodwill of a business, or a partner succeeding to it under agreement upon dissolution of partnership, has a right to use the trade name and trade marks under which it was conducted.[6] And this even though it comprise the personal name of a late partner,[7] or of any other late owner of the goodwill, but not so as to cast any risk of liability upon the late partner or owner[8]

[1] Above, p. 411. *Lyle and Kinahan's Application*, 24 R. P. C. 249 (1907), C. A., see p. 256; *Van Zeller* v. *Mason*, 25 R. P. C. 37 (1907), Joyce, J.

[2] See the judgment of Buckley, L.J., quoted above, p. 415.

[3] *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; and see Lindley on Partnership, 6th ed., pp. 445 and 449; and *In re David and Matthews*, below, p. 529.

[4] *Burchell* v. *Wilde*, [1900] 1 Ch. 551 Byrne, J., and C. A. (*Burchell & Co.*); *Banks* v. *Gibson*, 34 Beav. 566; 34 L. J. Ch. 591 (1865), Romilly, M.R.; *Levy* v. *Walker*, and *Chappell* v. *Griffiths*, infra; and see further on this subject, Sebastian, 3rd ed., p. 289; 4th ed., p. 299.

[5] *Burchell* v. *Wilde*, supra; and see next paragraph.

[6] *Levy* v. *Walker*, 10 C. D. 436 (1879), C. A.; *Currie* v. *Currie*, 15 R. P. C. 339 (1897), Ct. of Sess. (*Prince Charlie*). For a case where the purchase of goodwill and right to use a trade name was inferred upon a sale of stock-in-trade and patterns, see *Rickerby* v. *Reay*, 20 R. P. C. 380 (1903), Byrne, J. For cases of colourable purchase of a goodwill, see above, pp. 502, 503.

[7] *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766 (1887), Bacon, V.-C., and C. A. (*Condy's Fluid Co.*); *Chappell* v. *Griffith*, 53 L. T. N. S. 459 (1885), Kay, J.

[8] *Chatteris* v. *Isaacson*, 57 L. T. N. S. 177 (1887), Kekewich, J. The vendor of the business of "Mme. Elise" agreed that the purchaser should have the exclusive right to use the name "Mme. Elise & Co." Mme. Elise was his wife's name. Held, the purchaser must use the addition "& Co." In *Burchell* v. *Wilde*, [1900] 1 Ch. 551, it was held that, upon the division of a solicitor's business between the partners on dissolution, the

by using his personal name in such manner as to represent that he is still a member of the firm, or carrying on the business.[1]

Trader may use his own name after the sale of his business, where no contrary agreement.

But where the goodwill of a business is sold, or is taken over on the dissolution of a partnership by agreement, without any restrictive condition being imposed upon the late owner or the retiring partner which restrains him from exercising his ordinary right, he is at liberty to start in the same trade again at once under his own name, so long as he uses it honestly, even though it be the same as, or be similar to, the name under which the old business was, and continues to be, carried on.[2]

In such a case the vendor or retiring partner could not trade under the old name if it differed from his own personal name.[3] And he would not be allowed to solicit his old customers in the business which he has sold, because to do so would be to derogate from his grant.[4]

Vendor must not solicit his old customers.

In *Re David and Matthews*,[5] there was a provision in a deed of partnership between two partners, that on the death of either a

partner whose name was Burchell would run no risk by reason of the use by the other of the old name. *Burchell & Co.* Notice of the change had been given to all the clients. The defendant, in fact, undertook to carry on business under a different name, viz., *Burchell, Wilde & Co.* In *Townsend* v. *Jarman*, [1900] 2 Ch. 698; 17 R. P. C. 649, Farwell, J., the plaintiff bought the business of Jarman & Co., Ltd., seedsmen, from a company to whom he and the defendant had, on the dissolution of their partnership, transferred it. He carried on business as *Jarman & Co.*, and it was held that the defendant could not complain of this. The defendant had sold business premises on which his name, *E. J. Jarman*, was cut to the company, who had transferred them to the plaintiff. It was held that the defendant could not compel the plaintiff to remove the name. See also *Routh* v. *Webster*, 10 Beav. 561 (1847); and *Prudential Assurance Co.* v. *Knott*, L. R. 10 Ch. 142 (1875); also *Rosher* v. *Young*, Sol. Jo., Vol. 45, p. 344.

[1] *Dickson* v. *McMaster & Co.*, 18 Ir. Jur. 202 (1866), Brady, C.: *Scott* v. *Rowland*, 26 L. T. N. S. 391 (1872), Wickens, V.-C.; *Gray* v. *Smith*, 43 C. D. 208 (1889), C. A.; *Thynne* v. *Shove*, 45 C. D. 577 (1890), Stirling, J. There can be no risk where the late partner is dead, *Webster* v. *Webster*, 3 Swan. 490 (1791). Thurlow, L.C.; see Lindley on Partnership, 7th ed., p. 483.

[2] *Churton* v. *Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; see page 531; *Johnson* v. *Helleley*, 34 Beav. 63; 34 L. J. Ch. 32, 179; 2 De G. J. & S. 446 (1864), Romilly, M.R., and L.JJ.; *Labouchere* v. *Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M.R.

[3] The grant would then pass the exclusive right to the name. *Mrs. Pomeroy, Ltd.* v. *Scalé*. 24 R. P. C. 177 (1907). See judgment of Parker, J. See also cases cited in last note.

[4] So finally decided in *Trego* v. *Hunt*, [1896] A. C. 7, overruling *Pearson* v. *Pearson*, 27 C. D. 145, on this point. See also *Gillingham* v. *Beddow*, [1900] 2 Ch. 242. The order made by the H. L. in the first case restrained the defendant from applying privately by letter, personally, or by a traveller, to any person who was, prior to the dissolution, a customer of the old firm, asking such customer to deal with him (the defendant) or not to deal with the plaintiffs.

[5] [1899] 1 Ch. 378.

general account should be taken for the purpose of determining the value of the share of the deceased partner which was to be paid by the survivor, who, under other provisions, took over the assets of the firm. A question arose whether the goodwill should be included in the account or not, and, if it were, upon what basis it should be valued. Romer, J., after reviewing all the authorities on the subject, decided that the goodwill must be included as part of the assets, and must be valued as on a sale upon the footing that, if it were sold, the surviving partner would be at liberty to carry on a rival business, but not to solicit any person who was a customer of the firm before the death of the partner, or to carry on business under the firm name, which was made up of the names of both partners.

Questions between the purchaser of a business and its former owners, or some of them, respecting the use of the firm name seldom arise except upon a dissolution of partnership, or after the sale of the goodwill of a debtor's business by his trustee in bankruptcy; for no careful purchaser would agree to buy the goodwill of a business without stipulating for the exclusive use of the trade name, and probably stipulating also that the vendor should not carry on a new competitive business.[1]

Sale in bankruptcy.

A trustee in bankruptcy has no power to contract on behalf of the bankrupt, and the bankrupt is not a grantor so as to be bound by the rule applied in *Trego* v. *Hunt*. The sale of the goodwill of his business in the bankruptcy, accordingly, throws no obligation upon the bankrupt trader other than the obligation of the general law, not to represent that the business is still carried on by him.[2] The purchaser can, however, restrain the bankrupt from using a firm name, but not from using his own name.[3]

The vendor must not represent that his business is the old business, or its successor.

But the late owner or partner must do nothing, other than make an honest use of his own name, which is calculated to suggest that he is carrying on the old business.[4]

[1] As to the registered trade marks on a dissolution, see sec. 23, and above, p. 352.

[2] *Walker* v. *Mottram*, 19 C. D. 355 (1881), C. A. In *Trego* v. *Hunt*, above, p. 529, note (4), Ld. Macnaghten said: "There is all the difference in the world between the case of a man who sells what belongs to himself and receives the consideration, and a man whose property is sold without his consent by his trustee in bankruptcy, and who comes under no obligation, express or implied, to the purchaser from the trustee."

[3] *Melrose Dricer, Ltd.* v. *Heddle*, 4 Fraser (Ct. of Sess., 5th series), 1120 (1902).

[4] As to the use of the word "late," see above, pp. 409, 485.

"It has been settled," James, V.-C., said, in *Hudson* v. *Osborne*,[1] "that there is no implied covenant of any kind in the sale by an individual himself of the goodwill of his business; but it seems to be settled that a trader, whose business, and the goodwill of whose business, have been sold by himself, or by any person deriving title under him, has no right to represent himself as carrying on that identical business; he has no right to use the trade marks which were the marks of that business, or, by the use of the name, or of a title of the firm, to represent himself as being the continuer of that identical business which has been sold."

And, in *Churton* v. *Douglas*,[2] a partner, who, after he had sold his share in the business of "John Douglas & Co." to his co-partners, continued to trade as "Churton, Bankart, and Hirst, late John Douglas & Co.," was restrained from trading as "John Douglas & Co.," or representing that his new business was a continuation of the old business.

The question whether a late partner, or other late owner of a business which has passed into the hands of the plaintiff, is representing that he is still carrying it on, or that his present business is its successor, or is only fairly working and advertising the latter business as his own, is often one of great nicety.[3] The case of *Moqford* v. *Courtenay*[3] is an illustration of this. There the partnership between the parties having expired by efflux of time, and the goodwill passing under the partnership articles to the plaintiff, but without any restrictive covenant binding the defendant not to use the firm name or any similar name, the defendant was restrained from issuing a circular to the old customers stating the fact of dissolution, and that he had joined a new firm, and asking the customers for a "continuance" of their custom. This was held to be a suggestion that he was about to carry on, not merely a similar business, as he lawfully might, but the identical business which had passed to the plaintiff. It appears by the more recent authorities[4] that he

[1] 39 L. J. Ch. 79 (1869). This was, of course, before the decision in *Trego* v. *Hunt*.

[2] Page 529, note (2); *Witt* v. *Corcoran*, 2 C. D. 69 (1873), Bacon, V.-C., is a similar case; *Benbow* v. *Low*, 44 L. T. 875: 29 W. R. 837 (1881), Bacon, V.-C.

[3] 45 L. T. N. S. 303 (1881). Fry, J. The decision that the defendant might not solicit the old customers has since been approved by the House of Lords, above, p. 529.

[4] *In re David and Matthews*, above, p. 529.

ought to have been restrained from privately soliciting the old customers to deal with him in any terms whatsoever.

The right to Trade under one's own Name.

The general rule.

It is frequently stated, as a general rule, that any man may, so long as he acts honestly, trade under or describe his goods by his own name, or the names of himself and his partners, even though the similarity of such name or names to the name under which another person has previously been trading, or to the trade name of that other's goods, may occasionally lead to confusion or lead to the business or goods of the new-comer being mistaken for the business or goods of the earlier trader.[1]

Thus, Knight-Bruce, L.J., said, in a suit between father and son,[2] "all the Queen's subjects have a right to sell (their goods) in their own names, and not the less that they bear the same name as their father"; "but," he added, "if any circumstances of fraud had accompanied, and were continuing to accompany, the case, it would stand very differently." And in a recent Scotch case[3] Lord Kyllachy said, "Far as the law may have gone in its justifiable anxiety to prevent imposition upon the unwary purchaser, and content as it has sometimes been to pursue that object at the expense of encouraging the acquisition of virtual monopolies by traders and companies prepared to spend largely in systematic advertising and litigation, it has never as yet, at least so far as I know, gone the length of debarring any merchant or manufacturer from selling his own goods under his own name, unless there has been, in addition to the use of that name, some overt act or course of conduct plainly indicative of

[1] See the 5th and 6th rules stated by Kay, L.J., in *The Yorkshire Relish* case, printed in a note to this chapter (p. 550), and the judgment of Lindley, L.J., in the same case: [1896] 2 Ch. at p. 70; 13 R. P. C. at p. 270; the judgments of the C. A. in *Turton* v. *Turton*, 42 C. D. 128 (1889), and *Warner* v. *Warner*, 5 T. L. R. 327, 359. In *Reddaway* v. *Banham* (below, p. 534), however, Ld. Macnaghten said he was at a loss to know why *Turton* v. *Turton* was ever reported, and that the plaintiff's case was extravagant and absurd: [1896] A. C. at p. 220: 13 R. P. C. at p. 234.

[2] *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853); see below, p. 533, note (4).

[3] *Dunlop Pneumatic Tyre Co., Ltd.* v. *Dunlop Motor Co., Ltd.*, 23 R. P. C. 761 (1907), aff. in the H. L., [1907] A. C. 430; 24 R. P. C. 572, where the question was dealt with merely as one of fact. In *Abel Morrall, Ltd.* v. *Hessin*, 20 R. P. C. at p. 433, Romer, L.J., said: "The law is settled and it is merely a question of fact. If fairly and honestly done, it cannot be stopped."

fraud—that is to say, of dishonest effort to pass off his own goods as the goods of another."

Present state of authorities.

It is doubtful, however, whether any rule can now be laid down as an absolute rule of law. The inclination of the Courts is to treat the question whether the use of the name in question by a defendant is calculated to pass off his business or goods as that or those of the plaintiffs as one of fact in each particular case, as though there were no difference in principle between a man's own name and any other apparently descriptive word.[1] There is, as already stated, no reported instance, where, apart from fraud, a defendant has been absolutely restrained from using his own name, but in one case[2] an order was made restraining him from using it without taking reasonable precautions to distinguish his business and goods from those of the plaintiff, and orders have occasionally been made restraining the use of the name descriptively, *e.g.*, as *Cash's Frillings*[2] or *Powne's Gloves*.[3] But such orders will only be made in the rare and highly exceptional cases where it can be proved that a personal name has become *so identified by use in a wide-spread and well-known business* with a particular trader as to be necessarily deceptive when used without qualification by anyone else in the same trade.

In the *Anchory Sauce* case cited above,[4] Turner, L.J., said that "it is a mere question of evidence in each case whether there is a false representation or not," and in the *Camel-hair Belting*

[1] *The Valentine Meat Juice Co.* v. *The Valentine Extract Co., Ltd.*, 17 R. P. C. 673 : 83 L. T. 259 (1900), C. A. As to the conditions under which a descriptive word can be monopolised, see above, pp. 508 *et seq.*

[2] *J. & J. Cash, Ltd.* v. *Cash*, 18 R. P. C. 213 (1901) ; 19 R. P. C. 181, Kekewich, J., and C. A. An absolute injunction restraining the use of *Cash* was granted in the first instance. The C. A. altered this by adding "without taking reasonable precautions to distinguish, &c." It is said, as stated in the text, that the same rules are to apply to a personal name and any other *prima facie* descriptive word. One such rule is that the word must have wholly lost its ordinary descriptive meaning for the trade purposes under consideration (see above, p. 509). How can this be the case while it remains the name and the only proper description of a person who is lawfully engaged in the trade?

[3] *Rigden* v. *Jones*, 22 R. P. C. 417 (1905), Eady, J.

[4] *Burgess* v. *Burgess*, 3 D. M. & G. 896 : 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and Knight-Bruce and Turner, L.JJ., on an interlocutory application. The defendant, who had recently left the employment of his father, the plaintiff, and set up a rival business in King William Street, was restrained from describing his business as "late of 107, Strand." his father's address; but the Court refused to restrain him from trading under his own name or describing his goods as "Burgess' Essence of Anchovies."

case,[1] in which the matter was placed upon its modern footing by the opinions of the learned Law Lords, this statement was adopted and approved. Lord Halsbury, L.C., said[2] that no principle of law was laid down in the earlier cases which would have prevented an injunction, although the defendant's name was Burgess and although the article was described by a descriptive name, but that, in the view of the Lords Justices, the descriptive name there in question, *Burgess' Essence of Anchories*, had not, as a matter of fact, acquired the technical signification of being only made by Burgess the father.

Lord Herschell said:[3] "the name of a person or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word or device, which he had adopted to distinguish his goods, would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."

These passages, and the passage from the judgment of Vaughan Williams, L.J., in *Jamieson* v. *Jamieson*, quoted below,[4] were cited by Lord Alverstone, M.R., in *The Valentine Meat Extract* case,[5] as establishing that the supposed exception to the general rule stated at the head of this chapter in the case of a man's own name does not exist.

It follows that it is no more essential, in theory, to prove a fraudulent intent in a passing-off case which depends upon the use by the defendant of his own name than in any other case.[6]

While, however, the possibility of such a monopoly of a personal

[1] *Reddaway* v. *Banham*, cited above, pp. 42 and 512.

[2] [1896] A. C. at p. 204; 13 R. P. C. at p. 225.

[3] [1896] A. C. at p. 210; 13 R. P. C. at p. 228.

[4] Page 536.

[5] Above, p. 533, note (1), and below, p. 537.

[6] *S. Chivers & Sons* v. *S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J. The learned judge said that in order to make out that a personal name has acquired a secondary meaning, its use in the secondary sense must be shown to have become universal, and that, if this were so, the defendant must necessarily have known that his use of it for his own goods was deceptive and dishonest.

name being established as to prevent the honest use of his own name, without qualification, by the defendant is recognised, the degree of proof exacted is very high, and only one case has been reported in which this has been done.[1] There are, no doubt, many instances in which the deliberately fraudulent attempt of a defendant to make use of his own name, or, more commonly, an assumed name, in order to pass off his goods as another's, has been restrained,[2] or where a company constituted for the purpose of competing with an established business under a name chosen because of its resemblance to the firm name of such business has been compelled to take steps to prevent deception or to change its name.[3]

Jamieson & Co. v. *Jamieson*.

In *Jamieson & Co.* v. *Jamieson*,[4] the plaintiff failed because the Court of Appeal decided that the defendant was not bound to use extra precautions to avoid confusion between his goods and those of other persons in the trade, if such confusion arose solely from the similarity of his own name with theirs,[5] and from the use of

[1] *J. J. Cash, Ltd.* v. *Cash*, cited above, p. 533, and more fully below, p. 539, and see App., p. 738. In *Dewar, Ltd.* v. *Dewar*, 17 R. P. C. 341 (1900), Ct. of Sess at p. 358, Ld. Kyllachy said: "I do not myself know of any case in which the use by a man of his own name has been successfully challenged except in circumstances which plainly involved fraud on the part of the user." In the *Dunlop* case he dealt more fully with the matter, see below, p. 540. In *Cellular Clothing Co.* v. *Maxton*, cited above at p. 513. Ld. Shand ([1899] A. C. at p. 341: 16 R. P. C., at p. 407) said the same thing of descriptive names in general. *The Valentine* case was similar to the *Tussaud* and *Pinet* cases, cited below, where a company was formed with a deceptive name for the purposes of competition.

[2] As *Morrall* v. *Hessin*, 19 R. P. C. 557; 20 *ib.* 429 (1902), Swinfen Eady, J., and C. A. (*Morrall's needles*); and see *Van Oppen & Co., Ltd.* v. *Leonard Van Oppen*, 20 R. P. C. 617 (1903), Swinfen Eady, J. *Holloway* v. *Holloway*, 13 Beav. 209 (1850), Langdale, M.R., was a case of fraudulent imitation of "get-up." The M.R. said: "The defendant's name being Holloway, he has a right to constitute himself a vendor of Holloway's pills and ointment. I do not intend to say anything to abridge any such right."

[3] Above, p. 494.

[4] 15 R. P. C. 169 (1897), C. A., overruling Byrne, J. It should be noted that there were other Jamiesons engaged in the trade at Aberdeen besides the parties. It was a "get-up" case, but, in the view of the C. A., the only resemblance between the boxes of the plaintiff and defendant was due to the name and to features common to the trade.

[5] In *J. H. Brooks & Co., Ltd.* v. *Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, the plaintiffs were makers of the well-known "Brooks" saddle. The defendant Brookes was a saddle maker who had newly entered the trade, but his father had sold saddles under his own name, and had been restrained at the instance of the plaintiffs from doing so. Stirling, J., said that knowing the facts and the probability of confusion, it was the defendant's duty to mark his goods so as to avoid all possibility of mistake between them and those of the plaintiffs. Instead of doing this he had imitated the plaintiff's manner of marking. An injunc-

features common to the trade.[1] But the Court, as will be seen from the quotations following, carefully distinguished from the case before them the case where the name of a particular trader has come to denote his goods in the market.

Lindley, L.J., after referring to *The Holloway Pill* case,[2] said, "When we are asked to restrain a man from carrying on business in his own name, we must take very great care what we are about. The principle applicable to the case, I take it, is this: the Court ought not to restrain a man from carrying on business in his own name simply because there are other people who are doing the same and who will be injured by what he is doing. It would be intolerable if the Court were to interfere, and to prevent people from carrying on business in their own names in rivalry to others of the same name. There must be something far more than that, viz. (there must be), that the person who is carrying on business in his own name is doing it in such a way as to pass off his goods as the goods of somebody else."[3] "It is said, because yours may be mistaken for ours you are bound to take extra precautions to prevent yours being mistaken for ours. I am not aware of any case that goes so far as that." "In all cases in which a person has been restrained from carrying on business in his own name he has done something more than use his name: he has copied something from somebody else in the trade, or he has gone out of his way to make his things look like those of a rival in the trade."[4]

Mere similarity of firm name does not impose duty to take precautions.

Vaughan Williams, L.J., said: "I do not understand that there is any case, or ever has been any case, in which it has been laid down that a man who happens to bear a particular name is debarred from entering into any trade which he chooses to enter into merely because there is somebody else of the same name who has acquired a great reputation in the manufacture of the particular goods dealt with in the trade." Then, after referring to such well-known trade names as *Bass' Beer*,[5] *Colman's Mustard*, and *Pears' Soap*, the Lord Justice continued: "A plaintiff never can complain of the user by the defendant of

tion restraining him from marking a trade name of the goods.

[1] Above, p. 242.
[2] Page 535, note (2).
[3] 15 R. P. C. at p. 181.
[4] At p. 183.
[5] See below, p. 545.

saddles "J. Brookes" *without distinguishing*, &c. was granted. *Jamieson & Co. v. Jamieson* does not appear to have been cited, but the case was obviously one of fraud, and possibly also one in which the name had become

either the plaintiff's personal name, or of any other name that he chooses to use for the purpose of denoting his goods, unless he first establishes that in the market his goods have come to be known by that name. The right and duty of the Court always is to restrain a man from using a name that has come to be recognised as the name of a particular trader's goods for his, the defendant's, goods so as to suggest that the defendant's goods are the plaintiff's goods, and to pass them off as such."[1]

The question has since come before the English Courts on several occasions.[2]

The Valentine case.

In *The Valentine Meat Juice Co.* v. *The Valentine Extract Co., Ltd.*,[3] the plaintiffs in the Court of Appeal obtained an injunction[4] to restrain the defendant company from carrying on business as manufacturers or vendors of extract of meat, and from selling any extract of meat, under a name of which *Valentine* formed part, and also an injunction to restrain the defendant, C. K. Valentine, from carrying on business, in such goods, under his name without distinguishing such business from that of the plaintiffs. The plaintiffs' business, although chiefly American, was well known in England, and their goods, a medicinal fluid extract of meat, were always described by a name comprising *Valentine*, and sometimes as *Valentine* simply. The defendant, C. K. Valentine, who had obtained a patent for putting up quite a different extract of meat, which was solid and was intended to be used as a food, promoted the defendant company as a purchaser of his invention, and became its managing director. He never had any business, although he purported to sell to the company "the goodwill of the business which is now being created by the vendor." There was evidence of actual deception, and the Court of Appeal came to the conclusion that C. K. Valentine adopted the name in dispute for his company for the

[1] At pp. 192, 193. This passage was cited with approval by Ld. Alverstone, M.R., in *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ltd.*, 17 R. P. C., at p. 680 (1900), as an exposition of the law on the point.

[2] It has also come before the Court of Session in Scotland in *Dewar, Ltd.* v. *Dewar*, above, p. 535, note (1), and in *The Dunlop Motor* case, below, p. 540, which went to the H. L.

[3] 17 R. P. C. 1, Stirling, J.; 17 R. P. C. 673; 83 L. T. 259 (1901), C. A. Stirling, J., refused the injunction partly because of the difference between the trades, but also on the ground that the defendant, C. K. Valentine, was entitled to promote a company to work his invention under his name, unless fraud were shown, and the learned judge did not find fraud.

[4] Appendix, p. 738. The form of the injunction was followed in *International Plasmon, Ltd.* v. *Plasmonade, Ltd.*, 22 R. P. C. 543.

purpose of getting the benefit of the plaintiffs' reputation.[1] The decision might therefore have been put upon the ground of fraud, and might have been arrived at without going beyond the earlier cases[2] cited below. The decision was, however, placed on the broad ground that the supposed distinction in law between personal names and other descriptive words does not exist.[3]

Chivers v. *Chivers.*

Chivers & Sons v. *Chivers & Co., Ltd.*,[4] is an example of the difficulties which may occur where the extension of a large business brings it into competition with one which is already established in a particular locality. In that case the plaintiffs carried on the business of jam and jelly makers at Histon, Cambridgeshire, and by very extensive advertising[5] for some years before the action they had developed a large trade in a particular class of their goods known as "table jellies," especially in the Eastern and Midland counties of England. It was not shown that they had any large or extensive trade in Wales. The goods in question were always described by the plaintiffs on the boxes in which all such goods were sold as *Chivers' Table Jellies.* The defendant company had been formed in the year 1895 by a firm of S. Chivers & Co., in which the senior partner, who became the principal managing director of the company, was Samuel Chivers. The firm, and after its incorporation the company, had carried on a substantial business at Cardiff and in South Wales as jam makers, and were locally well known. In the year 1898 the company commenced to make table jellies, the manufacture of which was, as the learned judge found, a bye-product of the jam trade. Their boxes were quite different in appearance[6] from those of the plaintiffs, but they placed upon them their name, S. Chivers & Co., Ltd., and it was this of which complaint was made. They did not themselves use the phrase *Chivers' Table Jellies*, but a number of witnesses, most of whom had never heard of the defendant company, were called to prove that in different parts of the country that phrase or *Chivers'*

[1] Per Ld. Alverstone, M.R.

[2] *E.g.*, *Tussaud's* case and *Pinet's* case, above, pp. 501, 503.

[3] The defendants were also restrained from using the word *Valtine* which they had registered as a trade mark. It was subsequently removed from the Register, *Valentine's Tm.*, 18 R. P. C. 175 (1901), Farwell, J.

[4] 17 R. P. C. 420 (1900), Farwell, J.

[5] The learned judge said (at p. 431): "Advertising distinguished from trade is nothing."

[6] They at first adopted a box which, in some particulars, closely resembled that of the plaintiffs. It had directions copied from the latter. In a previous action they had consented to an injunction in respect of this box.

Jellies was understood to mean the plaintiffs' goods, and that by the use of the defendant company's name their goods might and probably would be passed off as those of the plaintiffs. No case of fraud or of actual deception was made out. It was held that, as the plaintiffs had not established that the secondary meaning of the name *Chivers* for which they contended was universal in Wales as well as in England, or that its original meaning had been lost, they could not succeed. The learned judge said that if they could do so they could also prevent the use of the defendant's name for their old-established jam trade.

Cash v. Cash.

The subject was next discussed in the case of *J. and J. Cash, Ltd.* v. *Cash*.[1] The plaintiffs and their predecessors in business had been for some years carrying on business under the name of Cash, in Coventry, and it was established that "Cash's Frillings," and "Cash's Woven Names," and "Cash's Initials" meant the plaintiffs' goods. The defendant, whose proper name was Joseph Cash, commenced to carry on business, also at Coventry, in goods which included frillings, woven names, and initials. He did not claim the right to describe these as "Cash's Frillings," etc., but to trade in such goods under the name of *Joseph Cash & Company* or *Joseph Cash*. Kekewich, J., said: "Is it possible for Joseph Cash to have a shop in Coventry, and there to sell frillings without those frillings being sold and known as 'Cash's Frillings'? It seems to me, speaking as a jury, and simply applying such knowledge of the world as I can to the subject, that it is impossible that that can be done." And the learned judge granted an injunction restraining the defendant from carrying on the business of manufacturer or seller of the three kinds of article under the name of Cash, or any other name so as to mislead. The defendant appealed against this order, asking that it might be varied so far as it absolutely restrained him from trading in the article in question in his own name, and he succeeded. The order, as modified by the Court of Appeal, restrained the defendant from carrying on business in the three kinds of articles under the name "Cash" without taking reasonable precautions to clearly distinguish the business and articles of the defendant from those of the plaintiffs.[2]

[1] 18 R. P. C. 213; 19 *ib.* 181 (1902). Kekewich, J., and C. A.

[2] The order is printed at length in the Appendix, p. 738. In *B. Warsop & Sons, Ltd.* v. *Warsop*, 21 R. P. C. 481 (1904), the defendant traded as "*A. Warsop*," and this was held to be sufficiently distinguished from the plaintiffs' name, and from the plaintiffs' use of "*B. Warsop*" on the goods

The Dunlop case.

In *Dunlop Pneumatic Tyre Co., Ltd.* v. *Dunlop Motor Company, Ltd.*,[1] the plaintiffs, manufacturers of tyres and motor accessories, but not of motors, sought to restrain the defendants from carrying on business under their registered name. The defendants had purchased a small retail business carried on at Kilmarnock by R. Dunlop and F. D. Dunlop, who became directors of the defendant company. They had sold and repaired motors and cycles. The defendant company was formed to acquire it and to manufacture and sell motors. The main objects of the businesses were different, the defendant company being mainly a motor company and the plaintiffs a tyre company, although in minor articles there was or might be a common production. The plaintiffs succeeded at the trial, but on appeal the Court of Session dissolved the interdict granted, and the House of Lords upheld their decision, holding that on the facts there was no probability of confusion. In the Court of Session Lord Kyllachy, in his judgment in the passage quoted above, expressed the view that as a matter of law a person could not be restrained from the use of his own name except in a case of fraud,[2] and said that if *The Valentine* case affirmed or implied any broader proposition, he did not agree with it.

The Earlier cases.

As the earlier cases on the subject are useful as illustrations of circumstances under which the Court has restrained or limited, or refused to restrain or limit, the use by a defendant of his own name, although they cannot now be relied on as laying down a general principle, the summary of them contained in the former edition of this book has been retained.

Turton v. *Turton.*

The subject had been previously discussed by the Court of Appeal in *Turton* v. *Turton*.[3] In that case the plaintiffs, Thomas Turton and Sons, Limited, were carrying on a widely known and extensive business acquired by the company in 1886, but established many years previously, under the name of *Thomas Turton and Sons*, in Sheffield, and one of the trade marks of the company

(cricket bats); both the plaintiffs' and defendant's bats bore the word "Marylebone," but they bore different devices.

[1] 22 R. P. C. 533; 23 R. P. C. 761; [1907] A. C. 430; 21 R. P. C. 572, Lord Ordinary, Ct. of Sess. and H. of L.

[2] See also Romer, L.J., in *Abel Morrall* v. *Hessin*, 20 R. P. C. at p. 433: "The law is settled, it is merely a question of fact. If fairly and honestly done, it cannot be stopped; and the judgment of Kennedy, L.J., in *The Daimler* case, 24 R. P. C. at p. 390.

[3] 42 C. D. 128 (1889), C. A., reversing North, J. In *Reddaway* v. *Banham*, Ld. Macnaghten said he was at a loss to know why this case was ever reported. The plaintiff's case was extravagant and absurd: [1896] A. C. at p. 220.

bore that name upon it. The defendants, John Turton and his two sons, were carrying on a business of a similar description in the same town. Their business had also been established for many years, although not for so long as that of the plaintiffs. For ten years before June, 1888, its style had been *John Turton & Co.*, but John Turton then took his sons into partnership, and changed the style to *John Turton and Sons*, the name the plaintiffs complained of. There was evidence that the plaintiff company were often referred to as *Turton and Sons*, and *Thomas*, or *T. Turton and Sons*, and there were conflicting affidavits by persons engaged in the trade as to whether the distinction between the trade names was sufficient to prevent mistakes being made. It was also shown that letters intended for the plaintiffs had, in some instances, been delivered to the defendants, but, apart from the adoption of the addition *and Sons*, in place of *and Co.*, there was no evidence that the defendants' conduct was intended or calculated to pass off their goods as those of the plaintiffs.

Mr. Justice North, at the trial, granted an injunction in the terms of that in *Hendriks* v. *Montagu*;[1] but the Court of Appeal reversed this order, and dismissed the action.

In the view of the facts taken by the Court of Appeal, the defendant, John Turton, was not shown to have done anything to give to the name objected to any other meaning than that he was carrying on business in partnership with his sons; he had not done anything with the intent or for the purpose of making the use of his simple name look as if his name were the name of the plaintiffs. "In some cases," Lord Esher said, "besides using the names, parties have, to use what, I think, is a happy phrase of my brother Cotton's, 'garnished that use'—that is, they have done things besides using the name, in order that the use of that name might look as if it were being used by the old firm. There is nothing of that kind here." Lord Esher's judgment.

Notwithstanding the possibility of mistakes between the two firms being made by careless people, therefore, the Court held that the defendants were justified in adopting the name complained of, and in continuing its use after the possibility of mistake had been brought to their knowledge, and the action was accordingly dismissed. One may venture to regret that the Court did not adopt the slight extension of the principles appealed

[1] Ante, p. 496.

to which would have been necessary to forbid the defendants from choosing out of several alternative styles, all equally accurate as descriptions, and equally convenient according to business usage, the only one which was calculated to lead to mistake. If *Turton & Co.* did not suit the defendants, they might have been satisfied with *Turton, Turton and Turton* or, *Turton* preceded by the initials of the partners.

A man may describe his firm in the ordinary mercantile way;

The foundation of the judgments of all the Lords Justices was that the statement comprised in the defendant's name was nothing other than a statement of the actual fact that their business was the business of Joseph Turton and his sons, expressed in the "ordinary mercantile way,"[1] and made "truly, honestly, and in the usual manner in which such statements are made in the course of business."[2] The case is, therefore, readily distinguishable from cases where a "fancy name" which is not descriptive of actual facts in ordinary language is appropriated,[3] such as, for instance, the name—the "Universal Life Assurance Association"—in *Hendriks* v. *Montagu*.[3] There is no justification for the adoption and use of any such name if it is calculated to deceive.

not necessarily by any "fancy" name.

Massam v. *Thorley.*

Massam v. *J. W. Thorley's Cattle Food Co., Ltd.*,[4] closely resembled the case of *Tussaud* v. *Tussaud* already referred to.[5] There the plaintiffs, as executors of one Joseph Thorley, were carrying on a well-known business in a special food for cattle established by their testator. The defendant company had engaged as their manager J. W. Thorley, who was a brother of Joseph Thorley, and having been in his employment some ten years previously, had become possessed of the recipe according to which the cattle food was made by the plaintiff's testator. J. W. Thorley was also the holder of a one-shilling share in the company. The defendants endeavoured to defend their use of the name which they had adopted on the ground of their relations with J. W. Thorley, but unsuccessfully, and the Court of Appeal were further of opinion that the defendants had imitated the get-up of the plaintiff's goods, and had intentionally acted so as to induce buyers to take their goods for them.

The injunction granted left the defendants at liberty to use

[1] Cotton, L.J., p. 142.
[2] Fry, L.J., p. 147.
[3] Ante, p. 496; and see the latter part of the judgment of Cotton, L.J., 42 C. D. 145.
[4] 14 C. D. 748 (1880), C. A., reversing Malins, V.-C.
[5] Ante, p. 501.

their name, and to use the word *Thorley* in connection with their goods (if they could) in any way not calculated to mislead the public.[1]

The injunction in this case might, in the view which the Lords Justices took of the facts, have been granted on the fraudulent intention of the defendants alone, for, as appears from the judgments quoted above, it is only the honest use of a man's own name which is ever a defence.[2]

Name must be the defendant's own name;

And the justification only extends, in any case where it applies, to the use of a man's own name,[3] or that of his predecessor who founded his business and established it under the name which the defendant is using;[4] not to the use of that of his servant,[5] or of an alleged partner who has really no interest in his business, and has been brought into it only in aid of an attempt to cover the employment of a deceptive name.[6] Still less to the use of the name of a stranger,[7] even though it is alleged that he has authorised the defendant to use it.[8] Where a name has been

not a bought name.

[1] See the form of injunction, 14 C. D. 762: and Appendix, p. 732.

[2] See also *Warner* v. *Warner*, 5 Times L. R. 327, 359; *Huntley and Palmer* v. *The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J.: and *Clayton* v. *Day*, where one Day joined one Martin in a fraudulent attempt to carry on business as "Day and Martin," in unfair competition with the well-known firm, 26 Sol. J. 43 (1881). Chitty, J.

[3] In *Mrs. Pomeroy, Ltd.* v. *Scale*, 24 R. P. C. 177 (1907), the defendant contended that the name "Mrs Pomeroy," which had been adopted by her in her business had become for all practical purposes her own name, and that the plaintiffs who had purchased the business formerly carried on by her, could not restrain her from using it. It was held, however, that she had by express agreement precluded herself from using it in a similar business. In *Macmillan* v. *Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., the defendants were using a Scotch firm name, which they had adopted for their whisky business, it never having been the name of an actual firm; but, although disapproval was expressed of such a practice, it was held that nothing that the defendants had done had tended to intercept the plaintiffs' trade.

[4] See *Pinet* v. *Maison Pinet, Ltd.*, ante, p. 503; *Turton* v. *Turton*, ante, p. 540: *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; *Truefitt* v. *Edney*, 20 R. P. C. 321 (1903), Byrne, J.

[5] *Southorn* v. *Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C. (*Southorn's Broseley Pipes*); *Birmingham Vinegar Brewery Co.* v. *Liverpool Vinegar Co.*, W. N. (1888), 139, North, J., cited p. 494; *Tussaud* v. *Tussaud*, ante, p. 501.

[6] See *Croft* v. *Day*, infra; *Schweitzer* v. *Atkins*, 37 L. J. Ch. 847 (1868); *Dence* v. *Mason*, W. N. (1877), 23; (1878) 42 (*Brand's Essence of Beef*), both Malins, V.-C.

[7] *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871). Bacon, V.-C. (*Madame Elise*), defendant used his daughter's name, *E. Louise*; interim injunction refused on account of delay. *Pearks, Gunston and Tee, Ltd.* v. *Thompson, Talmey & Co., Ltd.*, 18 R. P. C. 185 (1901), Farwell, J.

[8] *Croft* v. *Day*, 7 Beav. 84 (1843), Langdale, M.R. (*Day and Martin*): *Shrimpton* v. *Laight*, 18 Beav. 164 (1854), Romilly, M.R.; *Melachrino & Co* v. *The Melachrino Egyptian Cigarette Co.*

acquired with a goodwill in one business, the purchaser will not be permitted to use it unfairly in another business, in which the use of it would be deceptive.[1]

or a name altered to resemble the plaintiff's;

Such practices are badges of fraud rather than grounds of defence. So, where the defendant has altered his name in such a way as to make it more nearly resemble the plaintiff's, the inference is almost inevitable that fraud is intended,[2] and whether it is or not, the rule in question only applies to the use of the defendant's name in its ordinary form.

but may be the defendant's name of repute.

But it is submitted that the name need not be that which the defendant received from his parents. A name which he has adopted and used until it has come to be his name by repute is as much his name as that by which his parents were known.[3] Of course, a new name adopted at the time of, or shortly before, the alleged deceptive user of it would generally be taken to have been adopted for fraudulent purposes, even if it could be shown by the date of the trial to have become the defendant's name by repute.

Addition of "limited" to a firm name.

The name of a company formed by the addition of "limited" to the firm name of a business which the company takes over stands in the same position as the firm name itself.[4]

It must be used *simpliciter*, not garnished to look like the plaintiff's.

In most of the reported cases in which a defendant has been restrained from passing off his goods as those of the plaintiff under cover of a similar name, the defendant has added the "circumstances of fraud," to which Knight-Bruce, L.J., referred, in *Burgess* v. *Burgess*,[5] or, in the phrase of Cotton, L.J., in

4 R. P. C. 215 (1887), Chitty, J. See also *Tussaud* v. *Tussaud* and *Rendle* v. *Rendle & Co.*, above, p. 501, note (1), and *The Talmey* case, p. 543, note (7).

[1] See the cases cited above, p. 503, note (4).

[2] *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.; *James* v. *James*, L. R. 13 Eq. 421 (1872), Romilly, M.R. (*Robert Joseph James* called himself *Robert James*); and see *Slazenger* v. *Feltham*, 6 R. P. C. 531 (1889), C. A.

[3] See per James, L.J., and Bramwell, L.J., in *Massam* v. *Thorley, &c.*, 14 C. D. 757, 760. See also per North, J., in *Pinet* v. *Pinet*, 15 R. P. C. at p. 72. It has already been shown that a name of repute is protected as a trade name: above, p. 493. See also p. 543, note (3).

[4] *Chivers* v. *Chivers*, above, p. 538. See also *Townsend* v. *Jarman*, above, p. 528, note (7). In *Fine Cotton Spinners &c. Association, Ltd.* v. *Harwood, Cash & Co., Ltd.*, 24 R. P. C. 533 (1907), Joyce, J., said that a company with a title of which the name "A" forms part has none of the natural rights that an individual born with the name "A" would have. In that case the defendant company had taken the name of a mere promoter. Cf. in *The Daimler* case, 24 R. P. C. at p. 390, the judgment of Kennedy, L.J.

[5] Ante, p. 532; *e.g.*, by adding *& Co.*; *Graveley* v. *Winchester*, Seb. Dig. p. 162 (1867), Giffard, V.-C.; *Churton* v. *Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Witt* v. *Corcoran*, 2 C. D. 69 (1873), Bacon, V.-C.

Turton v. *Turton*,[1] has "garnished the use of his name" by imitating the get-up of the plaintiff's goods,[2] or his labels and show-cards,[3] or has issued circulars or advertisements[4] calculated to foster the error which the resemblance of his name and that of the plaintiff's was calculated to produce.[5]

Thus, in *Moët* v. *Clyboun*,[6] the defendant claimed to be entitled to use the names *Meadows* and *Clyboun*, and, by virtue of such right, to brand upon the corks of his champagne bottles the letters *M. & C.* in a circle on the bottom, and the word *England* at the side, in obvious imitation of the plaintiff's practice. And in *Holt* v. *Smith*,[7] the defendant bought the business of H. Newman and changed its name to Newman & Co., in imitation of the plaintiff's trade name. In *Joseph Rodgers & Sons, Ltd.* v. *Joseph Rodgers Simpson*,[8] the defendant was trading as "Joseph Rodgers Simpson & Son," having in fact no son as partner, and he was held in this and other ways to have used his name in a manner calculated to pass off his cutlery as that of the plaintiffs, and an injunction was granted against such unfair use.

Proximity may be a badge of fraud.

The proximity of the place where the defendant sets up his business to that where a well-known firm is already trading may be evidence to show that, although trading under his own name, the defendant is seeking to take fraudulent advantage of its similarity to the plaintiff's name. The case of somebody finding a man named *Bass* and setting up a brewery at Burton as Bass & Co.,[9] and the case of a man starting business as a banker in the Strand under the name of Coutts,[10] have been cited as instances in which it is scarcely conceivable that the use of the

[1] Ante, p. 540.

[2] *Holloway* v. *Holloway*, 13 Beav. 209 (1850), Langdale, M.R., above, p. 536, *Taylor* v. *Taylor*, p. 544, n. (2); *Schweitzer* v. *Atkins*, p. 543, n. (6); *Fullwood* v. *Fullwood* (1), W. N. (1873), 93, 185, Malins, V.-C., and L.JJ.; *J. H. Brooks & Co., Ltd.* v. *Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, Stirling, J., above, p. 535, n. (5).

[3] *Croft* v. *Day*; *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, p. 543, n. (8).

[4] *Massam* v. *J. W. Thorley's Cattle Food Co.*, above, p. 544, n. (3).

[5] In *Rigden* v. *Jones*, 22 R. P. C. 417, the defendant who had purchased a retail business of glovers carried on as "F. & A. Fownes" was restrained from using the words "Fownes, Manchester" without prefixing "F. & A.," the plaintiffs being known as manufacturers of "Fownes' Gloves."

[6] Seb. Dig. p. 316 (1877), Jessel, M.R. (*Moët and Chandon*).

[7] 4 Times L. R. 329 (1888), Kay, J. Action stayed on the defendant undertaking to use *H.* and drop *Co.*; defendant to pay costs.

[8] 23 R. P. C. 297 and 348 (1906).

[9] James, L.J., in *Massam* v. *Thorley, &c.*, 14 C. D. p. 757; see above, p. 536.

[10] Chitty, J., in *Melachrino* v. *The Melachrino &c. Co.*, 4 R. P. C. p. 221.

name could be honest.[1] In *Turton* v. *Turton*,[2] the defendants were trading in the same town, Sheffield, as the plaintiff, but their presence there was reasonably accounted for, because their business had been established in the town long before the circumstances which led them to adopt the name complained of arose.

7. The Relief Granted.

The relief granted to the plaintiff, if he succeeds in a passing-off action, corresponds to that granted in the action for infringement of a registered trade mark to which the first-mentioned action is so closely allied. It comprises, therefore—(i.) an injunction;[3] (ii.) an order for the delivery up for destruction, or for the erasure of the names or other badges, of any goods already marked with the deceptive names or badges, and in the possession or under the control of the defendant;[4] and (iii.) damages in respect of the past interferences with the plaintiff's rights;[5] or (iv.) an account of the profits made by the defendant by the sale of goods under the deceptive names or badges,[6] or some one or more of these.

Injunction.

The general principles governing the grant of an injunction have been sufficiently considered in the last chapter.

Form of the injunction.

The form of the injunction granted varies considerably, according to the nature of the deceptive representation which the defendant is shown to have made use of, or threatened to make use of.

Where he has imitated or adopted the plaintiff's trade name, the order may be an absolute injunction that he shall not carry on business under that name.[7]

Injunction in *Massam* v. *Thorley*.

A very full form of order was adopted in *Massam* v. *Thorley's Cattle Food Co.*[8] It restrained the defendant company and their servants from selling, or procuring to be sold, and from in any manner representing any goods manufactured by them as

[1] *Lee* v. *Haley* is another illustration. There the plaintiff's late manager set up in business as the "Pall Mall Guinea Coal Co.," in the Strand, and afterwards removed to 46, Pall Mall. The plaintiffs traded, at 22, Pall Mall, as "The Guinea Coal Co." An injunction was granted; 21 L. T. N. S. 546; 22 *ib.* 251: L. R. 5 Ch. 155, Malins, V.-C., and Giffard, L.J.

[2] Page 540.

[3] Last chapter, p. 441. See below, and the orders collected in the Appendix, pp. 730, *et seq.*

[4] Page 450.

[5] Page 452.

[6] Page 454.

[7] As in *Hendriks* v. *Montagu*, 17 C. D. 638, set out above, p. 496.

[8] 14 C. D. p. 762, set out in the Appendix, p. 732.

the goods of the late Joseph Thorley or the plaintiffs, his successors; from in any manner representing, or doing anything which should lead to the belief that the defendant company were carrying on the business of the late Joseph Thorley; from affixing to their goods, or otherwise employing, any labels, wrappers, or marks used by him or the plaintiffs, or so contrived as to represent, or lead to the belief, that the goods manufactured or sold by the defendant company were his goods or those of the plaintiffs; and from using or circulating any circulars or advertisements, used or circulated by him or the plaintiffs, or which should in any manner represent or lead to the belief that the defendant company had been or were carrying on the business of the late Joseph Thorley, or were his successors.

Only deceptive use of open word, &c. restrained.

But a device or name, which is not a trade mark or the trade name of the plaintiff, may always be used by the defendant in any way which is not calculated to deceive, if such way can be found; and the injunction in passing-off cases is usually drawn so as to preserve this right, the order not to use a particular device or word being qualified by the addition "so as to represent, or lead to the belief," that the defendant's goods are the plaintiff's.[1]

Thus, in *Massam* v. *Thorley's Cattle Food Co.*, the Lords Justices refused to prohibit the defendants from using the word Thorley in connection with cattle food altogether.[2] And in *Slazenger* v. *Feltham*, the Court of Appeal modified the order of Kekewich, J., forbidding the defendants to stamp *Demotic* on their lawn-tennis bats, by adding the words "so as to represent that (they) are manufactured by the plaintiffs, or in any other way from passing off their lawn-tennis bats as the goods of the plaintiffs."

Where what is complained of is the deceptive use of an open word, which has come to be associated with the plaintiff's trade or goods, the form of injunction is now generally directed to prevent the defendant from using it "without clearly distinguishing his goods from the plaintiffs." This was the form adopted in the

[1] *Slazenger & Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889); *Jay* v. *Ladler*, 40 C. D. p. 656; 6 R. P. C. 136 (1888), Kekewich, J.; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 R. P. C. 389 (1897), Collins, J., and C. A. For a form of injunction in a trade name case in which the plaintiffs had not an exclusive but only a qualified right in a particular word, see *Daimler Motor Co.* (1904), *Ltd.* v. *London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A.

[2] 14 C. D. 763.

infringement cases *Seixo* v. *Provezende*,[1] and *Johnston* v. *Orr-Ewing*,[2] and in *The Yorkshire Relish*,[3] and *The Stone Ales* cases.

"Without distinguishing, &c."

In the last-mentioned case several of the Lords of Appeal referred to it as the proper form to adopt unless the plaintiff had a claim to the exclusive use of the word, name, or other mark in question.[4]

The Stone Ales case.

In the last-mentioned case, however, the injunction to restrain the defendant (*inter alia*) from selling beer not of the plaintiff's manufacture, under the term *Stone Ales* or *Stone Ale*, or in any way so as to induce the belief that such ale was of the plaintiff's manufacture, was, under the circumstances, maintained, the Lords of Appeal holding that the *Seixo* v. *Provezende* form of injunction would be more stringent, as it would, in effect, prevent the defendant using the term *Stone Ale* at all.[5]

Temporary or contingent prohibition.

And the defendant has, in some instances, been restrained from using a word or words which could not be used by him at all, except deceptively, so long as this should continue to be the case; for instance, from calling his bitters *Angostura Bitters* until he should find out how to make the real *Angostura Bitters*;[6] or from using the name *Radstock Colliery Proprietors* until he should be able to sell coal from Radstock.[7]

The *Pinet* cases[8] illustrate the different cases to which the absolute and the limited forms of injunction are respectively applicable. In the first case it was supposed that the assignor to the defendant company had traded under his own name, "Pinet," and a limited injunction was granted. Subsequently it was discovered that this was not his own name, but a name adopted for the purpose of the fraud, and thereupon an absolute injunction was decreed.

[1] L. R. 1 Ch. 194 (1865), Wood, V.-C., and Cranworth, L. C.

[2] 13 C. D. 434; 7 App. Ca. 219, Fry, J., C.A., and H. L.

[3] Above, p. 489. *Bewlay & Co., Ltd.* v. *Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*); and *Grezier and Doyle* v. *Autran*, 13 R. P. C. 1 (1895), Chitty, J., and C. A. and *Rey* v. *Lecouturier*, 25 R. P. C. 265 (1908), C. A. (both *Chartreuse*), are other examples. See also Ld. Macnaghten's judgment in *Reddaway* v. *Banham*, [1896] A. C. at p. 221; 13 R. P. C. at p. 234.

[4] Ld. Watson and Ld. Macnaghten: *Montgomery* v. *Thompson*, [1891] A. C. 217; 8 R. P. C. 361; see also *Thompson* v. *Bent's Brewery Co., Ltd.*, 8 R. P. C. 479 (1891), Chitty, J. In *The Magnolia* case, p. 547, n. (1), Collins, J., granted an injunction in this form, and the plaintiffs unsuccessfully appealed, asking for an absolute prohibition.

[5] See above, p. 517; and *Braham* v. *Beachim*, there cited.

[6] *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J.

[7] See ante, p. 517.

[8] *Pinet* v. *Maison Pinet, Ltd.*, 14 R. P. C. 933 (1897), C. A.; *Same* v. *Maison Louis Pinet, Ltd.*, 15 R. P. C. 65, North, J.

No general rule can be laid down as to what additions to the objectionable matter will be sufficient to effect the requisite distinction.[1] It must depend upon the circumstances of each case.[2] Where the order is in respect of a word which has, in fact, become the trade name of the plaintiff's goods, the most careful differentiation of the get-up of the goods,[3] and the greatest possible prominence of the defendant's own name[4] upon his labels may not be enough. In such cases the limitation of the order is more likely to mislead the defendant than to protect him in his assumed right to use the word.

No rule as to what distinction is sufficient.

The injunction may be limited with reference to the use of the mark in a particular country or market.[5]

Limited to particular market

[1] "No Court has ever said how the distinction is to be made": per Stirling, J., in *Powell* v. *Birmingham Vinegar Co.*, [1896] 2 Ch. at p. 64. Also *Kerfoot* v. *Cooper*, 25 R. P. C. 508 (1908). But see the last chapter, p. 449. In France the Court sometimes settles what may be used: see *Grezier and Doyle* v. *Autran*, 13 R. P. C. 1.

[2] Since the decision in *Reddaway* v. *Banham*, cited above, p. 512, there have been three cases as to "camel-hair" belting in which the question has arisen whether the defendant sufficiently distinguished, namely, *Reddaway* v. *Ahlers*, 19 R. P. C. 14 (1902), *Reddaway* v. *Frictionless Engine Packing Co.*, 19 R. P. C. 505, and *Reddaway* v. *Stevenson*, 20 R. P. C. 276 (1903). In the second of these cases it was held that the prefixing of the defendants' name was sufficient, although they were not manufacturers, but the result was different in the last case, where it was pointed out that each case must rest on its own facts. It is no answer to say that the custom of the trade is not to distinguish, see the first of the three cases. In *Grand Hotel Co. of Caledonia Springs* v. *Wilson*, [1904] A. C. 103; 21 R. P. C. 117, P. C., the plaintiffs being the owners of natural springs at Caledonia, Ontario, sold the water as "Caledonia Water" or "Caledonia Spiings Water." They had, however, no exclusive right to the word "Caledonia," and the defendants who owned springs in the same neighbourhood and sold "Natural Saline Water from the New Springs at Caledonia" were held to have sufficiently distinguished. See also *Warsop* v. *Warsop*, cited supra, p. 539, n. (2), where A. Warsop was held to be sufficiently distinguished from *B. Warsop & Sons, Ltd.*

[3] In the last case the bottles and labels of the defendants' *Yorkshire Relish* were totally different from those of the plaintiffs. They are shown in 13 R. P. C. pp. 237, 238, and 240.

[4] In *Daniel and Arter* v. *Whitehouse*, 16 R. P. C. 71 (1898), North, J., *F. Whitehouse's Brazilian Silver* was held to be an infringement of an order not to use *Brazilian Silver* without distinguishing, &c.

[5] *Carver* v. *Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C., a trade mark case before the Acts; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; the action succeeded only as to passing-off; the injunction was limited to Ireland. In *Société, &c. de l'Etoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436, a registered trade mark case, Stirling, J., said that he did not think limiting the registration would give the applicants, under the circumstances of the case, complete relief. See above, pp. 232 and 444. In *Weingarten* v. *Bayer*, 20 R. P. C. 289 (1903), Joyce, J., refused to limit the injunction which he granted to England or the account of profits to sales in England. The case went to the Court of Appeal, 20 R. P. C. 649, and the House of Lords, 22 R. P. C. 341 (see the text, p. 550).

Interim injunctions.

Interim injunctions are granted in passing-off actions on the same terms and according to the same principles as in infringement actions.[1]

Damages or profits.

In *Weingarten* v. *Bayer & Co.*,[2] Vaughan Williams and Cozens-Hardy, L.JJ., expressed the opinion that, had the plaintiffs succeeded, it would have been a case for damages and not profits, but in the House of Lords, where it was held that the defendant had sold his goods as and for the plaintiffs' by the use of the descriptive name "Erect Form Corsets" in a special type and with a special scroll used by the plaintiffs and an injunction was granted limited to the use of the special form, an account of profits derived from the sale of corsets so distinguished was ordered. Lord Macnaghten stated that ever since the case of *Edelsten* v. *Edelsten*,[3] it had been the established rule that a plaintiff succeeding in a case of that sort might at his option take an inquiry as to damages or an account of profits.

8. Costs, Appeals, and Practice.

And the rules and principles in regard to costs,[4] appeals,[5] and practice,[6] are also the same in both actions, except in so far as they depend upon registration and the Registration Acts, which do not extend to or affect passing-off actions.

NOTE.

Rule.

In *Powell* v. *Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. at p. 79; 13 R. P. C. at p. 256, Kay, L.J., said: "The law relating to this subject may be stated in a few propositions: (1) It is unlawful for a trader to pass off his goods as the goods of another. (2) Even if this is done innocently it will be restrained (*Millington* v. *Fox*, 3 My. & Cr. 338). (3) *A fortiori* if done designedly, for that is a fraud. (4) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal (*Sykes* v. *Sykes*, 3 B. & C. 541). (5) One apparent exception is that where a man has been describing his goods by his own name, another man having the same name cannot be prevented from using it, though this may have the effect of deceiving purchasers (*Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Turton* v. *Turton*, 42 C. D. 128). (6) But this exception does not go far. A man may so use his own name as to infringe the rule of law. 'It is a question of evidence in each case whether there is false representation or not' (per Turner, L.J., *Burgess* v. *Burgess*, 3 De G. M. & G. 905). So he may be restrained if he associates another man with him, so that under their joint names he may pass off goods as the goods of another person (*Croft* v. *Day*, 7 Beav. 84; *Clayton* v. *Day*, 26 Sol. Jour. 43; *Melachrino* v. *The Melachrino Egyptian Cigarette*

First exception.

[1] Chap. XV., p. 445.
[2] See note, p. 549 (5).
[3] 1 H. L. J. & S. 185.
[4] Page 458.
[5] Page 463.
[6] Page 469; forms of pleadings, p. 724.

Co., 4 R. P. C. 215). (7) Another apparent exception is where a man trading under a patent had a monopoly for fourteen years, and has given the article a descriptive name, he cannot, when the patent has expired, prevent another from selling it under that name (*Young* v. *Macrae*, 9 Jur. N. S. 322; *Linoleum Co.* v. *Nairn*, L. R. 7 C. D. 834). (8) I am not sure that this would be so if the name so used were the name of the patentee, or even a purely fanciful name not descriptive. (9) Certainly where there has not been a patent, and an article has been made and sold under a fanciful name not descriptive, so that the article as made by one person has acquired reputation under that name, another trader will not be permitted to use the name for a similar article made by him (*Braham* v. *Bustard*, 1 H. & M. 417; *Cochrane* v. *MacNish*, 13 R. P. C. 100). (10) In this last proposition there is again a limitation. If the first maker has slept upon his rights or allowed the name to be used by others until it has become *publici juris*, this Court will not interfere."

Second exception.

Third exception.

CHAPTER XVII.

WARRANTY OF TRADE MARKS AND TRADE DESCRIPTIONS.[1]

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It is provided by sec. 17 of the Merchandise Marks Act, 1887, that:—

"On the sale or in the contract for the sale of any goods to which a trade mark,[2] or mark, or trade description[3] has been applied,[4] the vendor shall be deemed to warrant that the mark is a genuine[5] trade mark and not forged[6] or falsely applied,[7] or that the trade description is not a false trade description[8] within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee."

This section corresponds to sec. 19 of the Merchandise Marks Act, 1862, but the older section applied only to trade marks which were applied to goods sold, and the implied warranty was that the trade marks were "genuine and true, and not forged or counterfeit, and not wrongfully used."

Trade mark.

Trade mark[9] here means registered trade mark or trade mark protected by law in any British possession or foreign state to

[1] The references in this chapter are to the Merchandise Marks Act, 1887, which is set out in the Appendix, p. 805. It is fully dealt with and commented on in the 2nd ed., Book II., p. 554.

[2] "Trade mark," sec. 3 (1), see the text, *infra*.

[3] "Trade description," sec. 3 (1). Page 570 of the 2nd edition.

[4] "Applied," sec. 3 (2), and sec. 5 (1). Page 567 of the 2nd edition.

[5] "Genuine," cf. sect. 2 (2) (a). Page 608 of the 2nd edition.

[6] "Forged," sec. 4. Page 563 of the 2nd edition.

[7] "Falsely applied," sec. 5 (3). Page 569 of the 2nd edition.

[8] "False trade description," sect. 3 (1). Pages 570, 584, of the 2nd edition.

[9] "Trade mark," sect. 3 (1). Page 560 of the 2nd edition.

which sec. 91 of the Patents and Designs Act, 1907, is applicable.[1] Section 17, however, imports a warranty of the genuineness of unregistered English trade marks, at any rate when the application of them to the goods is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of the proprietor of the trade mark, and also of any trade mark, whether registered or not, which the mark applied to the goods purports to be, for in such cases the mark is a false trade description applied to the goods.[2] "Mark," where it first occurs in the section, can hardly include an unregistered trade mark, for the warranty implied is that the mark is a genuine trade mark, that is, a genuine registered trade mark, and that it does not purport to be. "Mark," where it occurs the second time, should be trade mark or mark.

The several terms occurring in the section have the meanings given to them respectively by the sections of the Merchandise Marks Act, 1887, which are referred to in the notes.[3] The general effect of the implied warranty is that the trade marks, or marks purporting to be trade marks, applied to the goods, are used with the assent of the proprietor of the trade marks which they purport to be, and that the statements made or implied by the trade descriptions are true.

Statement in writing to the contrary.

The saving at the end of the section is, it will be observed, very carefully expressed. The statement required to prevent the implication of a warranty must be in writing, signed, delivered at the time of sale, and accepted by the vendee.[4] What

[1] The reference is to sec. 103 of the Ac of 1883, but by virtue of sec. 38 (1) of the Interpretation Act, 1889, see p. 654, the reference is now to the re-enactment. As to the trade marks so protected, see Chap. XX., p. 576, and the list in the Appendix, p. 741.

[2] See. 3 (2).

[3] See also Appendix and 2nd edition, Book II., Chap. I., p. 554.

[4] The Food and Drugs Act, 1875 (38 & 39 Viet. c. 63), s. 25, enables the vendor to set up as a defence that he purchased the adulterated goods under a written warranty and resold them unaltered. See *Laidlaw* v. *Wilson*, [1894] 1 Q. B. 74; *Robertson* v. *Harris*, [1900] 2 Q. B. 117; *Elliott* v. *Pilcher*, [1901] 2 K. B. 817; *Watts* v. *Stevens*, [1906] 2 K. B. 323; *Evans* v. *Weatherill*, [1907] 2 K. B. 80, on the question where the warranty is not given in express reference to a particular consignment, what evidence is necessary to connect any particular consignment with the warranty. Sec. 20 of the Sale of Food and Drugs Act, 1899 (62 & 63 Viet. c. 51), requires notices of the intention to rely on the warranty as a defence to be given to the purchaser and to the person who has given the warranty. Giving a false warranty is an offence, sec. 27 of the Act of 1875, unless the person giving it had reason to believe the statements or descriptions to be true, sect. 20 of the Act of 1899. Sec. 9 makes *any alteration in the article* without disclosure to the purchaser an

"accepted by the vendee" means is not clear. It would probably be construed to import at least that the vendee understood that he was to get no warranty, and that he completed the purchase on that footing.

Implied warranty at common law.

Apart from the statutory warranties implied by the Merchandise Marks Act, it is held, at common law,[1] that when a purchaser orders goods from a firm who are manufacturers only of such goods, and not dealers in them, then, unless it is shown that in the particular trade, or as regards the particular goods, there is a custom for the manufacturer to supply the goods of other makers, the purchaser must be assumed to have contracted with the particular manufacturers in reliance on the general excellence of the work of their firm, and he is entitled (in the absence of any express stipulation to the contrary) to have goods of the manufacturer's own make delivered in performance of the contract.[2]

Warranty where goods are described by a trade mark.

It is a question of fact, or, if there is a written contract, of construction, whether a manufacturer or vendor has agreed to deliver the goods which are referred to by a trade mark in the contract, stamped with the mark, and being, therefore, goods of the kind properly denoted by it, or whether he has agreed only to deliver goods of the same quality as those which are denoted by the mark. Thus, in *Hopkins* v. *Hitchcock*,[3] where the contract was for iron described as "S. and H. (crown) bars," and the vendors were Hopkins & Co., the successors of Snowden and Hopkins, iron marked "H. & Co." with a crown was delivered, and the jury found that the mark was not a material

offence. A notice exhibited in the shop may be such a disclosure: *Spiers and Pond* v. *Bennett*, [1896] 2 Q. B. 65. Cf. *Pearks, Gunston and Tee, Ltd.* v. *Houghton*, [1902] 1 K. B. 889, and *Dawes* v. *Wilkinson*, [1907] 1 K. B. 279. Knowledge of the adulteration on the purchaser's part is not a defence: *Heywood* v. *Whitehead*, 76 L. T. 781 (1897). Under sec. 17 of the Merchandise Marks Act, such questions can hardly arise. The statement in writing must, if the construction in the text is adopted, be a term of the contract. Disclosure that, for example, a trade mark is not genuine without the statement in writing would not prevent a warranty being implied. Under the Food and Drugs Act proof of scienter is necessary to a conviction for giving a false warranty, *Derbyshire* v. *Houliston*, [1897] 1 Q. B. 772.

[1] Warranties of the genuineness of marks are implied, in respect of *anchors and chain cables*, by 37 & 38 Vict. c. 51, s. 4, and in respect of *hops*, by 29 & 30 Vict. c. 37, s. 8.

[2] Per Cotton, L.J., in *Johnson* v. *Raylton*, 7 Q. B. D. 438 (1881). Cotton and Brett, L.JJ., Bramwell, L.J., dissenting; *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889), Div. Court.

[3] 14 C. B. (N. S.) 65; 32 L. J. C. P. 154 (1863).

part of the bargain. Judgment was given for the vendors in an action for the price of the iron, and the Court of Queen's Bench upheld the judgment, on the ground that the contract was for iron of a particular quality, not for iron bearing a particular mark.

Pictures ascribed to particular artists.

A somewhat similar question has arisen upon sales of pictures under the names of the supposed painters of them, and in such cases the matter to be decided is whether the use of the artist's name amounts to a warranty by the vendor that the picture in question is his, or merely to an expression of the vendor's opinion.

In the case where pictures had been sold as "Views in Venice, Canaletto," and they were not by Canaletto,[1] the question was left to the jury; but where the supposed artist was an old master, Lord Kenyon, at *Nisi Prius*, held that it was impossible to make the case one of warranty. The pictures, he said, were the work of artists of some centuries back, and there being no way of tracing the picture itself, it could only be matter of opinion whether the picture in question was the work of the artist whose name it bore or not; the catalogue only expressed the opinion of the vendor, but left the determination to the buyer's own judgment.[2]

Remedy for breach of the warranty.

The remedy for breach of warranty, whether implied under the section set out above, or at common law,[3] or imported by express agreement in any contract in regard to goods sold or agreed to be sold, is an action for damages, reduction of the agreed price, or rescission of the contract. The rules determining the nature and extent of the remedy are now contained in the Sale of Goods Act, 1893,[4] from which the following sections are quoted :—

"**53.**—(1.) Where there is a breach of warranty by the seller, or where the buyer elects, or is compelled, to treat any breach of a condition on the part of the seller as a breach of warranty, the buyer is not by reason only of such breach of warranty entitled to reject the goods; but he may—

"(a.) Set up against the seller the breach of warranty in diminution or extinction of the price; or

"(b.) Maintain an action against the seller for damages for the breach of warranty.

[1] *Power* v. *Barham*, 7 C. & P. 356; 4 Ad. & E. 472; 5 L. J. K. B. (N. S.) 88 (1835) (Canaletto died in 1768). The jury found there was a warranty.

[2] *Jeaffreson* v. *Slade*, 2 Esp. N. P. C. 572 (1797) (Teniers and Claud Lorraine, who died in 1694 and in 1682 respectively).

[3] See Benjamin on Sale, Book IV., Part II., Chap. I.

[4] 56 & 57 Vict. c. 71.

"(2.) The measure of damages for breach of warranty is the estimated loss directly and naturally resulting, in the ordinary course of events, from the breach of warranty.

"(3.) In the case of a breach of warranty of quality such loss is *primâ facie* the difference between the value of the goods at the time of delivery to the buyer and the value they would have had if they had answered to the warranty.

"(4.) The fact that the buyer has set up the breach of warranty in diminution or extinction of the price, does not prevent him from maintaining an action for the same breach of warranty if he has sustained further damage.

"(5.) Nothing in this section shall prejudice or affect the buyer's right of rejection in Scotland as declared by this Act."

"**54.** Nothing in this Act shall affect the right of the buyer or seller to recover interest or any special damages in any case where by law interest or special damages may be recoverable, or to recover money paid where the consideration has failed."

Rescission of the contract for breach of warranty.

The right to rescind the contract and return the goods is dealt with by an earlier section of the same Act.

When condition is to be treated as warranty.

11.—(1) In England or Ireland—

"(a.) Where a contract of sale is subject to any condition to be fulfilled by the seller, the buyer may waive the condition, or may elect to treat the breach of such condition as a breach of warranty, and not as a ground for treating the contract as repudiated.

"(b.) Whether a stipulation in a contract of sale is a condition the breach of which may give rise to a right to treat the contract as repudiated, or a warranty the breach of which may give rise to a claim for damages, but not to a right to reject the goods and treat the contract as repudiated, depends in each case upon the construction of the contract. A stipulation may be a condition, though called a warranty in the contract.[1]

[1] See *Behn* v. *Burness*, 3 B. & S. 756; 32 L. J. Q. B. 204 (1863). Blackburn on Sale. 2nd ed., p. 198. Also *Nadel* v. *Martin*, 20 R. P. C. 129 and 723; 23 R. P. C. 41 (1906), H. of L.; *Burchem* v. *Wren*, 21 R. P. C. 683 (1904), Darling, J.; *Henderson* v. *Shic's*. 24 R. P. C. 109 (1907), Parker, J.; in which questions arose whether on the construction of agreements for sale and licence of patents a guarantee of validity was a condition or a mere warranty.

"(c.) Where a contract is not severable, and the buyer has accepted the goods, or part thereof, or where the contract is for specific goods, the property in which has passed to the buyer, the breach of any condition to be fulfilled by the seller can only be treated as a breach of warranty, and not as a ground for rejecting the goods and treating the contract as repudiated,[1] unless there be a term of the contract, express or implied, to that effect.

"(2.) In Scotland, failure by the seller to perform any material part of a contract of sale is a breach of contract, which entitles the buyer either within a reasonable time to reject the goods and treat the contract as repudiated, or to retain the goods and treat the failure to perform such material part as a breach which may give rise to a claim for compensation or damages.

The Scotch rule.

"(3.) Nothing in this section shall affect the case of any condition or warranty, fulfilment of which is excused by law by reason of impossibility or otherwise."

Damages for breach of warranty of trade mark.

The warranty implied by the Merchandise Marks Act will accordingly operate to enable an innocent purchaser of goods which have been forfeited under that Act, or which have led to a prosecution, entailing expenses upon him, to recover damages in respect of the loss or expenses from the vendor, for such damages directly and naturally result in the ordinary course of events from the breach of warranty. It will also enable the purchaser to recover from the vendor any damages which may have been recovered from the purchaser by a sub-purchaser upon a resale by him, at any rate where the goods were known by the vendor to have been bought for the purpose of resale.[2]

Indemnity to manufacturer infringing a trade mark at his customer's request.

A manufacturer has at common law, and apart from any question of implied warranty, a right of indemnity by his customer, if, in compliance with the customer's orders, he innocently places a mark upon goods made for him, and the mark turns out to be an infringement of some third person's

[1] *Street* v. *Blay*, 2 B. & Ad. 460 (1831); *Heyworth* v. *Hutchinson*, L. R. 2 Q. B. 447 (1867); *Hooper* v. *Balfour*, 62 L. T. 646 (1890); *Re Green and Balfour*, 63 L. T. 97, 325 (1890).

[2] *Hammond* v. *Bussey*, 20 Q. B. D. 79 (1887), C. A.; *Agius* v. *Great Western Colliery Co.*, [1899] 1 Q. B. 413. See further, as to consequential damages, *The Argentino*, L. R. 13 P. D. 191 (1888), C. A.

trade mark, so that the manufacturer is rendered liable to an action by the owner of the trade mark.[1]

Third party notice.

In an action for infringement of trade mark the defendant served a third party notice on his vendor, claiming to be indemnified by him against liability on the ground that the goods were innocently purchased by him in good faith from the third party in the ordinary way of trade, and that the third party supplied the same to him without notification of any such infringement or wrong as in the claim alleged in the action; and an order was made that the third party notice should be tried immediately after the action, and that the third party should have liberty to take such part in the action as the judge at the trial should think fit.[2]

[1] *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137 (1861). As to the defence of the manufacturer in any such case upon proceedings under the Merchandise Marks Act, see sec. 2 (2), sec. 6, and sec. 19 (3) of that Act, Appendix, pp. 806, 808, and 813, and 2nd edition, Book II., Chap. I.

[2] *Hennessy* v. *Dompé*, 19 R. P. C. 338 (1903). At the trial, however, the third party was treated as a defendant, so that the action was tried as between the original plaintiff and both defendants, and, the plaintiff failing, he was ordered to pay the costs of both. On appeal, both defendants submitted to an order on terms, 20 R. P. C. 175 (1903).

CHAPTER XVIII.

TRADE LIBEL.

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There is no threats action in respect of a trade mark;

Under sec. 36 of the Patents and Designs Act, 1907,[1] an action for damages or an injunction lies against any person claiming to be a patentee, who by circulars, advertisements, or otherwise, threatens any other person with legal proceedings or liability, at the instance of anyone who is aggrieved by the threats.[2] The section does not extend to threats in respect of the use of a trade mark or trade name, and there is no precisely corresponding right apart from it. So that the publication in good faith of a statement that the plaintiff is infringing the defendant's trade mark, and that the defendant intends to take proceedings against all persons dealing in the infringing goods, is not actionable, and cannot be restrained by injunction.[3] In

[1] Replacing sec. 32 of the Patents, &c. Act, 1883. The provisions are now extended to designs, Patents and Designs Act, 1907, sec. 61.

[2] Frost, Vol. I., p. 309, and Frost on Patents and Designs Act, 1907, Terrell, and Roberts and Moulton, on that Act. *Challender* v. *Royle*, 36 C. D. 425; 4 R. P. C. 363 (1887), C. A.; *Johnson* v. *Edge*, [1892] 2 Ch. 1; 9 R. P. C. 142, C. A.; and *Skinner* v. *Shew*, [1893] 1 Ch. 413; and as to damages, *S. C.*, [1894] 2 Ch. 581; and *Skinner* v. *Perry*, 11 R. P. C. 406 (1894).

[3] *Colley* v. *Hart*, 44 C. D. 179; 6 R. P. C. 17 (1888), North, J. (interim injunction refused as to the trade mark). Also at the trial, 7 R. P. C. 101, at p. 113.

a passing-off case,[1] a counterclaim which alleged threats merely without malice was ordered to be struck out as disclosing no reasonable cause of action.

but the threats may amount to libel or slander of title.

But disparaging statements calculated to injure the plaintiff's trade or to diminish the value of his goods, if they are not made in good faith, are actionable; and the continued publication of them after they have been shown, or have been held by the Court,[2] to be untrue may be restrained.[3] For they amount to libels on the plaintiff in the way of his trade, or to slander of title.[4]

A warning against infringements, &c., may be issued in good faith.

A fair warning to the public, or to probable purchasers of the goods, or to customers of the businesses concerned, by a trader that he regards the conduct of another as an infringement of his rights, if published in good faith, and in the belief that it is well founded, is not libellous,[3] although it may turn out to be mistaken.[5] So, anyone who thinks his trade name is likely to be confused with that of another business may publish a warning that there is no connection between his business and the other.[6] And this, notwithstanding the pendency of proceedings in which the right of the proprietor of the other to use the name or marks

[1] *Ripley* v. *Arthur & Co.*, 18 R. P. C. 82 (1901), Farwell, J.

[2] *Burnett* v. *Tak*, 45 L. T. 743 (1882), Kay, J.

[3] *Wren* v. *Weild*, L. R. 4 Q. B. 730 (1869), a patent threats action before the Act of 1883. In *Halsey* v. *Brotherhood*, 19 C. D. p. 392 (1881), a similar action, Lindley, L.J., said: "*Wren* v. *Weild* comes to this: that if I am a patentee, so long as I act honestly, I am entitled to say, without running the risk of having an action for damages brought against me, that somebody is infringing my patent, or that somebody 'else's manufacture is an infringement of my patent. . . . If I say it dishonestly, I am so liable; and if I know that what I say is untrue, it would not take much to persuade a jury that I was acting dishonestly."

[4] A false and malicious statement in writing, printing, or by word of mouth, injurious to any person's title to property, and causing special damage, is an actionable slander of title. Tindal, C.J., in *Malachy* v. *Soper*, 3 Bing. N. C. 371 (1835).

[5] In *Dicks* v. *Brooks*, 15 C. D. p. 40 (1880), Bramwell, L.J., said: "Although, according to our opinion, they would have been wrong in their law with respect to its being a piracy, I think their saying so would not have been actionable, because a man is not bound to be correct in his statement of law, though he is bound to be correct in his statement of facts." "To support such an action it is necessary for the plaintiffs to prove (1), that the statements complained of were untrue; (2), that they were made maliciously, *i.e.*, without just cause or excuse; (3), that the plaintiffs have suffered special damage thereby": per Ld. Davey, in *Royal Baking Powder Co.* v. *Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. See also the passage as to *bona fides*, below, p. 563.

[6] *Thorley's Cattle Food Co.* v. *Massam*, 14 C. D. 763 (1880), C. A.; *William Coulson & Sons* v. *James Coulson & Sons*, 3 Times L. R. 740 (1887), Div. Court. In the last case the defendants added to their warning a statement that the plaintiff firm was lately bankrupt.

he has adopted comes into question.[1] But under pretence of the honest publication of a fair warning there is no excuse for an allegation that the goods of the other party are spurious,[2] or that he is foisting a fictitious article upon the public,[3] or is fraudulently endeavouring to pass off his goods as those of the person who issues the advertisement or circular complained of.[4]

Suggestion that the plaintiff's goods are spurious.

Thus, in *Thorley's Cattle Food Co.* v. *Massam*,[5] the defendants had published an advertisement warning the public that any goods purporting to be Thorley's Cattle Food, and not signed by their trade name "Joseph Thorley," were not of their manufacture, and alleging that they were the only persons possessed of the secret recipe according to which the food was compounded, and had published also a circular stating that the plaintiffs were seeking to "foist upon the public an article which they pretend is the same as that manufactured by the late Joseph Thorley." The defendants were the executors of the late Joseph Thorley, the inventor of the cattle food, and they were carrying on his business; but the statement that they alone possessed the secret recipe, and the suggestion that the goods of the plaintiffs were not prepared according to it, were both false, for one Josiah Thorley, a brother of Joseph Thorley, who had obtained the recipe from him, was manager of the plaintiff company.[6] An injunction was granted at the trial to restrain the defendants from advertising, or representing, or suggesting in their advertisements or circulars, that they, or the proprietors of their testator's business, were alone possessed of the secret recipe, and from representing or suggesting, or doing anything calculated to represent or suggest, that the cattle food manufactured or sold by the plaintiffs was spurious or not genuine.

And in *Thomas* v. *Williams*,[7] the publication of circulars suggesting that the goods of the plaintiff were not genuine, but were imitations of goods sold by the defendants, was restrained.

[1] *Coats* v. *Chadwick*, [1894] 1 Ch. 347, Chitty, J.; see p. 565, below; *Anderson* v. *Liebig, &c. Co.*, 45 L. T. 757 (1881), Chitty, J.

[2] *Thorley's* case, supra.

[3] See note (6), previous page.

[4] *Coats* v. *Chadwick*, supra.

[5] Supra; *Liebig, &c. Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.

[6] A suit for an injunction by the executors to restrain the use of the name *Thorley's Cattle Food* by the company had been abandoned, after an application in it for an interim injunction had failed; 6 C. D. 583, Malins, V.-C. But, subsequently, the executors succeeded in a trade name and passing-off action against the company, ante, p. 542.

[7] 14 C. D. 864 (1880), Fry, J.; *Liebig, &c. Co.* v. *Anderson*, note (1) "only genuine brand."

But a mere puff of the defendant's own goods, or a statement that they are superior to those of a rival trader, even if untrue and the cause of damage to the latter, is not actionable.[1] And it cannot be made actionable by proof of malice.[1]

Special damage must be proved.

In an action for a trade libel, as distinguished from an ordinary personal libel, proof of special damage—*i.e.*, that the publication of the libel has actually injured the business or property of the plaintiff—is essential.[2] If the libel is "in its very nature intended, or reasonably likely to produce," and "in the ordinary course of business does produce, a general loss of business, as distinct from the loss of this or that known customer, evidence of such general decline of business is admissible" to prove special damage.[3]

If the injury proved is trifling and no threat to repeat the publication is proved, the action should be dismissed.[4]

The interruption of an illegal trade cannot be legal damage.[5]

[1] *Hubbuck* v. *Wilkinson*, [1899] 1 Q. B. 86, C. A., adopting the opinion expressed by Herschell, L.C., in *White* v. *Mellin*. In the latter case ([1894] 3 Ch. 276; [1895] A. C 154), the defendant, a chemist, had placed upon the goods of the plaintiff, Mellin, which he sold, an advertisement of *Vance's Food*, a rival food for infants. The advertisement stated that *Vance's Food* was "far more nutritious and healthful" for infants and invalids "than any yet offered." The plaintiff complained of this as a trade libel. Romer, J., dismissed the action at the close of his case. The C. A. ordered a new trial, but this order was reversed by the H. L. on the ground that neither the untruth of the statement complained of, nor that it had caused special damage to the plaintiff, had been proved. Both points were essential to the plaintiff's case. Ld. Watson also held that, notwithstanding the manner in which the statement had been affixed to and sold with the plaintiff's goods, it was not, in any legal sense, published of and concerning them. Ld. Herschell said (at p. 164): "I entertain very grave doubts whether any action can be maintained for an alleged disparagement of another's goods merely on the allegation that the goods sold by the party who is alleged to have disparaged his competitor's goods are better either generally or in this or that particular respect than his competitor's are." His lordship put aside the question of malice. The other learned lords concurred in this view. See also *Magnolia Metal Co.* v. *Tandem Smelting Syndicate*, 17 R. P. C. 477 (1900), H. of L.

[2] *White* v. *Mellin*, supra, approving *Evans* v. *Harlow*, 5 Q. B. 624 (1844); *British Empire Type Co.* v. *Linotype Co.*, 79 L. T. 8 (1898), C. A. *Royal Baking Powder Co.* v. *Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. The contrary had formerly been held: see cases cited in *White* v. *Mellin* and *Hayward* v. *Hayward*, infra.

[3] *Ratcliffe* v. *Evans*, [1892] 2 Q. B. 524, C. A.

[4] *Dicks* v. *Brooks*, 15 C. D. 22 (1879), C. A. There the defendants, who owned the copyright in an engraving of Millais' "Huguenots," had threatened proceedings against persons who bought copies of the plaintiff's paper containing a wool-work pattern, wrongly alleged to be an infringement of the copyright. Only two or three numbers were shown to have been returned or not sold in consequence of the threats.

[5] Per Ld. Robertson, in *Royal Baking Powder Co.'s* case, note (2).

And in a case where the only evidence of damage to the plaintiff, by the publication of a libellous circular misstating the result of an action for passing off the plaintiff's goods as those of the defendant, was the plaintiff's own affidavit alleging that his business had fallen off, and the plaintiff had delayed bringing his action for three months after he first knew of the publication, North, J., assessed the damages at £5, but granted an injunction, and gave the plaintiff the costs of the action.[1]

Statement may be a personal libel.

But a disparaging statement with regard to a trader's goods may be an ordinary libel upon the trader personally and, accordingly, be actionable without proof of special damage. Such, for instance, would be the case if the goods were described as worthless[2] or spurious.[3] To write of a trader that he sells such goods is clearly defamatory.

Libel on inventor.

In an action brought for falsely and maliciously publishing passages in a book depriving the plaintiff of the credit of being the first inventor of a machine, the statement of claim was struck out on the ground that the passages complained of were not libellous, and that no reasonable cause of action was shown. But Vaughan Williams, L.J., said that he must not be supposed in any way to be affirming such a proposition as that you cannot libel anyone by denying his title to a reputation which he may have obtained as an inventor or as a man of science.[4]

A threat or warning may be made, if *bonâ fide*.

It is essential, in order to entitle the plaintiff to redress in respect of the publication of a threat or warning, that he should make out that the statements complained of are not published in good faith. He must show that the defendant was not saying what he did in defence of his own right, or, as he believed, in defence of his own right—for the defendant might make a mistake.[5] Upon an application, therefore, for an interim injunction to restrain the publication of threats by the defendant, *it is not sufficient proof, if it is any evidence at all, of* want of good faith, to show that he has commenced an action

[1] *Hayward & Co.* v. *Hayward & Sons*, 34 C. D. 198 (1886).

[2] *British Empire Type Co.* v. *Linotype Co.*, 79 L. T. 8 (1898). The defendants published a statement that the plaintiffs' machines had been removed, after a very short time, from several newspaper offices. The plaintiffs got a verdict at the trial, and the C. A. refused a new trial on the ground stated in the text.

[3] See *The Liebig* case, above, p. 561.

[4] *Wilde* v. *Thompson*, 20 R. P. C. 861, 775 (1903), Buckley, J., and C. A.

[5] Per Lindley, M.R., in *Royal Baking Powder Co.* v. *Wright, Crossley & Co.*, 16 R. P. C. 217 (1899), C. A. In the House of Lords the decision was unanimously affirmed, the majority of the learned lords holding that special damage was not proved, 18 R. P. C. 95.

for infringement of trade mark, or for passing off goods against the plaintiff, but has neglected to apply in it for an interlocutory injunction ;[1] nor to show even a long delay in bringing an action for infringement, if the delay is reasonably explained.[2]

Misleading report of a trade mark action.

The publication of a misleading report of a trade mark action, or of an order obtained by the successful party therein either at the trial or on an interlocutory application, may be a trade libel falling within the principles of the cases referred to in this chapter. Thus, where an action for passing-off had failed and been dismissed without costs, because the evidence showed only a few instances of representations that the defendant's goods were those of the plaintiffs, and also that these representations were made by the defendant's agents without his knowledge or authority, the defendant offered an undertaking that he would never make such representations, and this undertaking was inserted in the order at the desire of the judge. The plaintiffs then published a circular headed "Caution," which, referring to the action, alleged that :—

"By the judgment the defendant was ordered to undertake not to represent that his firm is, or that the plaintiff's firm is not, the original firm of Richard Hayward & Co.," and added that the plaintiffs, "finding that serious misrepresentations were in circulation to their prejudice, felt themselves compelled to bring the above action." In a subsequent action,[3] brought by the former defendants against the former plaintiffs, the circular was held to be untrue and libellous, and to have been published maliciously, and an injunction was granted to restrain its further publication.

True statements are not libellous.

So far as the case against an advertisement or other publication rests upon its being a libel, proof that the statements complained of in it are, in fact, true, is an answer to any action for damages, or an injunction in respect of its publication.[4] It makes no difference that ignorant readers might misunderstand it.[2]

Accordingly, an action for publishing a statement that certain persons, meaning the plaintiff company, had wrongfully used the word *Singer* to designate machines not manufactured by the

[1] *Anderson* v. *Liebig's Extract of Meat Co.*, 45 L. T. N. S. 757 (1881), Chitty, J.

[2] *Incandescent Gas Light Co.* v. *Sunlight Incandescent Co.*, 14 R. P. C. 180 (1897), Stirling, J.

[3] *Hayward & Co.* v. *Hayward & Sons*, 34 C. D. 198 (1886), North, J. ; *Liebig's, &c. Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.

[4] *Nähmaschinen Fabrik, &c.* v. *Singer Manufacturing Co.*, 10 R. P. C. 310 (1893), Romer, J. ; and the *Baking Powder* case, p. 563, note (5).

Singer company, which came on for trial after the *Singer* company had established, in a passing-off action against the plaintiff company, that the use of the word by the the latter was actually wrongful, was dismissed with costs.[1]

Evidence to construe the libel.

The meaning of the statements complained of is determined by the Court itself, and unless circumstances are proved tending to show that their actual meaning, in the particular case, is different from the natural meaning, evidence cannot be adduced to prove that they were not understood according to it.[2]

Solicitor.

A solicitor who has made the publication merely as agent for the real defendants should not be joined as a defendant.[3] So the publication of an apology actually made by the plaintiffs to the defendants is justifiable, though it may have been extracted from the plaintiffs under duress of civil or criminal proceedings in respect of the false marking of their goods.[4]

Publication of an apology.

But a statement pending proceedings, whether true or not, may be a contempt of Court.

But the publication of a statement which turns out to be true may be improper pending legal proceedings in which the matters it refers to are in issue, not as being libellous, but as contempt of Court, if it tends to interfere with the fair trial of the action, or to embarrass one of the parties in the preparation or conduct of his case. And such contempt may be punished by imprisonment,[5] fine, or sequestration of goods, or the publication may be restrained by injunction, upon a summary application by motion in the action.[6] The reluctance of the Court to interfere by interlocutory injunction to restrain the further publication of an alleged libel which the defendant justifies, does not extend to such cases as these. As already stated, the parties are at liberty to warn the trade as much as they like, notwithstanding the pendency of the action; but they are bound to refrain during its pendency from public discussion on the merits or demerits of

[1] Note (4), above, p. 564.

[2] Note (2), above, p. 563.

[3] Note (2), above, p. 564.

[4] *Fisher* v. *Apollinaris Co.*, L. R. 10 Ch. 297 (1875), L.JJ.

[5] *Roach* v. *Hall*, 2 Atk. 469 (1742), Hardwicke, L.C. The respondents were imprisoned for publishing statements calling some of the witnesses "affidavit men." *Kitcat* v. *Sharp*, 31 W. R. 227 (1883), Fry, J. (defendant restrained from publishing the statement of claim and correspondence).

[6] *Coats* v. *Chadwick*, [1894] 1 Ch. 347, Chitty, J. The plaintiffs, in an action for passing-off, were restrained from publishing a circular charging the defendants with fraudulent imitation of their goods. In some subsequent cases the Court has expressed the opinion that the actual decision went too far, *R.* v. *Payne*, [1896] 1 Q. B. 577, Ld. Russell and Wright, J.; *In re New Gold Coast Exploration Co.*, [1901] 1 Ch. 860, Cozens-Hardy, J. See also *Goulard* v. *Lindsay*, 4 R. P. C. 189 (1887), Kay, J. (a patent case).

the case.[1] "You can warn as much as you like," Kay, J., said, in *Goulard* v. *Lindsay*, "but can you advertise: 'I have brought an action against A. B. which is certain to succeed'?"[2] And the learned judge added that to advertise a positive statement that the defendants had infringed the plaintiff's patent was wrong.

Moreover a misrepresentation by one party to the prejudice of other parties of the result of proceedings is a contempt of Court, whether the action or proceedings have come to an end or not. Where a motion for an interlocutory injunction had been refused on the ground of the plaintiff's delay, and the defendants thereupon put up a notice in their shop window which would in the opinion of the Court have led an ordinary customer to the conclusion that the defendants had been held to be entitled to do what was complained of, it was held that there had been an attempt to represent to the prejudice of the plaintiffs what had taken place in Court, and that therefore a contempt of Court had been committed.[3]

Statement in reply to one published by the other side.

It is no answer to an application for an injunction in respect of a publication alleged to be a contempt of Court, to say that it was made in reply to a statement published by the applicant himself with reference to the same matter, although this circumstance may influence the Court in dealing with the costs of the application.[4]

But every publication bearing upon the matters in question *pendente lite* is not a contempt. A fair and accurate report of interlocutory proceedings, for instance, is allowable.[5] And the Court may refuse to restrain a report which it thinks unfair or discreditable to the persons responsible for it, if not convinced that the report is calculated to obstruct the course of justice, or to prejudice the public mind.[6]

[1] Per Chitty, J., [1894] 1 Ch. 350.

[2] 4 R. P. C. 189 (1887). But see *British Vacuum Cleaner Co., Ltd.* v. *Suction Cleaners, Ltd.*, 21 R. P. C. 300 (1904), Swinfen Eady, J.; *Haskell Golf Ball Co.* v. *Hutchison*, 21 R. P. C. 497 (1904), Buckley, J. These were all patent cases.

[3] *Gillette Safety Razor Co.* v. *A. W. Gamage, Ltd.*, 24 R. P. C. 1 (1907), Warrington, J.

[4] *Coleman* v. *West Hartlepool Ry. Co.*, 8 W. R. 734 (1860), Wood, V.-C.

[5] A newspaper report published contemporaneously, if otherwise libellous, would be privileged under the Law of Libel Amendment Act, 1888.

[6] *Brook* v. *Evans*, 29 L. J. Ch. 616 (1860), Stuart, V.-C., and L.JJ. The plaintiffs advertised that they had established that they first used the word *Glacé*, but that the defendants relied on the lapse of time as an answer to the motion, although the plaintiffs had constantly protested against the defendants' use of the word. The defendants, in fact, had not been called upon on the motion.

Undertaking as to damages

Where the publication of a statement *pendente lite* is restrained as being a contempt of Court, the applicant is not required to give an undertaking to be answerable in damages to the respondent for any loss occasioned by the injunction if it turns out that the respondent was in the right,[1] as is usual upon the grant of an interlocutory injunction, for the publication is wrong in any event, whether the statements are found in the end to be false or to be well-founded.

Contempts by newspaper editors.

The rule under which the publication of biassed comments reflecting on matters in issue in pending litigation and calculated to interfere with the fair trial of the action, is restrained, is of general application, and it is not confined to publications made by, or at the instance of, interested parties. Applications under it to commit the editors of newspapers were very frequent a few years ago, and, in spite of the constantly expressed reluctance of the judges to interfere where it is not necessary to protect the fair prosecution of the action,[2] the applications generally result in the costs incurred, or part of them,[3] and sometimes a substantial fine,[4] being thrown upon the respondents if they have ventured at all beyond a mere accurate report, or a colourless account of the proceeding.

Injunction to restrain trade libels.

Before the Judicature Act the Courts had no jurisdiction to restrain the publication of a libel, even though it affected the plaintiff's trade or property;[5] but the jurisdiction is conferred by that Act upon all the divisions of the High Court, and it has been exercised in many cases.[6]

Interlocutory injunction.

The Court has also jurisdiction to interfere by interlocutory

[1] *Fenner v. Wilson*, [1893] 2 Ch. 656, Kekewich, J.

[2] In *Re Clements*, 46 L. J. Ch. 383 (1877), Jessel, M.R., said: "I say that a judge should be most careful to see that the cause cannot be fairly prosecuted to a hearing unless this extreme mode of dealing with persons brought before him on accusations of contempt should be adopted." And see *R. v. Jayne*, [1896] 1 Q. B. 577, Ld. Russell and Wright, J. In *The Plating Co. v. Farquharson*, 17 C. D. 49 (1881), the C. A. dismissed an application to commit the editor of a paper in respect of an advertisement asking for subscriptions and evidence to assist the appeal in a patent case. In *Re Martindale*, [1894] 3 Ch. 193, North, J., refused with costs motions to commit the editors of several papers who had innocently copied from another paper.

[3] See *Duncan v. Sparling*, The Times, 9th March, 1894.

[4] *Re The Crown Bank*, 44 C. D. 649 (1890) (a bad case of contempt).

[5] *Prudential Assurance Association v. Knott*, L. R. 10 Ch. 142 (1875), Cairns, L. C. and L.JJ.

[6] *Thorley's Cattle Food Co. v. Massam*, 6 C. D. 582 (1877), Malins, V.-C.; 14 C. D. 763 (1880), Malins, V.-C., and C. A.; *Thomas v. Williams*, 14 C. D. 864 (1880), Fry, J.; *Saxby v. Easterbrook*, 3 C. P. D. 339 (1878), Div. Court, and the cases cited below.

injunction to restrain the further publication of an alleged trade libel, which is the subject of an action, until the hearing.[1] But it will only do so if it is satisfied, upon the facts and evidence before it, that the statements complained of are false,[2] however much the balance of convenience may be in favour of staying the publication,[3] and only in the clearest cases[4]—where, as it has been put, the plaintiff's case is so strong that if the jury at the trial found for the defendant, their verdict would be set aside as unreasonable.[5]

For the question, libel or no libel, is peculiarly a question for a jury; and in order to interfere before the hearing the Court must determine that question in advance, without the jury's assistance.[5] The reluctance to interfere by interlocutory injunction is so strong, that the cases cited of *Bonnard* v. *Perryman*,[6] and *Monson* v. *Tussaud*,[7] seem to show that, where the defendant alleges justification and reserves the particulars of his case and the evidence in support of it, the injunction ought never to be granted. In any case, the probability of very serious injury to the plaintiff if the libellous statements are allowed to continue must be made out.[8]

Action survives to executors.

An action in respect of a trade mark for slander of title, unlike a mere personal libel, survives to the executors since it occasions an injury to the estate of the testator.[9]

[1] *Lee* v. *Gibbings*, 67 L. T. 263 (1892), Kekewich, J., and the cases next cited.

[2] *Collard* v. *Marshall*, [1892] 1 Ch. 571, Chitty, J. The libel was that the plaintiffs were "sweaters," and that their work was not properly executed. The defendants said the statements were, in substance, true, but did not suggest that they had any further evidence not before the Court. They were willing to treat the motion as the trial. An interim injunction was granted. *Punch* v. *Boyd*, 16 L. R. Ir. 476 (1885).

[3] *Société des Manufactures des Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 C. D. 1 (1883), C. A.

[4] *Monson* v. *Tussaud*, [1894] 1 Q. B. D. 671, C. A., per Davey, L.J. (case of a personal libel).

[5] Per Ld. Esher, M.R., in *Coulson* v. *Coulson*, 3 Times L. R. 846, adopted in *Bonnard* v. *Perryman*, [1891] 2 Ch. 269. C. A.; *Lee* v. *Gibbings*, supra.

[6] See note (5).

[7] Note (4). These were not, however, trade libels, but the rule was applied in *Champion & Co.* v. *The Birmingham Vinegar Brewery Co.*, 10 Times L. R. 163 (1893), Div. Court, which was a trade case.

[8] *Salomons* v. *Knight*, [1891] 2 Ch. 294, North, J., and C. A.; *Mogul Steamship Co.* v. *McGregor, Gow & Co.*, 15 Q. B. D. 476 (1885), Coleridge, L.C.J., and Fry, L.J.

[9] *Hatchard* v. *Mege*, 18 Q. B. D. 771 (1887), Div. Court.

CHAPTER XIX.

TRADE SECRET AND TRADE NAME.

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Use of the trade name of a secret preparation.

It has been shown that anyone is entitled to use a name or mark for the goods to which that name or mark is properly applied.[1] Thus, anyone who is in possession of goods made or sold by the owner of a trade mark or trade name, may apply the proper trade name or trade mark to them,[2] and may, for instance, replace the old labels upon the goods by new ones.[3] So, the name of a secret preparation may be used by anyone for goods actually prepared according to the recipe,[4] for they are the goods

[1] See Chap. II., p. 33, and Chap. XV., p. 394.

[2] *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J. But he must not apply a mark denoting a superior quality of goods of the owner of the mark to an inferior quality, see above, p. 394.

[3] *Farina* v. *Silverlock*, 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1856), Cranworth, L.C., cited, p. 33. See also p. 394.

[4] *Canham* v. *Jones*, 2 V. & B. 218; 13 R. R. 70 (1813), Plumer, V.-C. (*Velno's Vegetable Syrup*) The case was decided on demurrer, although the bill alleged facts which would now be held sufficient to support a passing-off case like that of *The Yorkshire Relish*, p. 570, note (1). *James* v. *James*, L. R. 13 Eq. 421 (1872), Romilly, M.R. (*Lieutenant James' Horse Blister*); *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766 (1877), Bacon, V.-C., and C. A. (*Condy's Fluid*); and see the injunction in *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J., cited p. 394 (*Angostura Bitters*). In *Benbow* v. *Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C., held that an outgoing partner who retained the receipt could use the name of a secret preparation. The question whether the defendant could have used the name in *The Yorkshire Relish* case (next note), if he had discovered the secret, was left open by the H. L. Ld. Davey ([1897] A. C. at p. 717; 14 R. P. C. at p. 732) said he saw no reason to differ from the opinion of Fry, J., in *The Angostura Bitters* case, and of Lindley, L.J., in the case in question, that he could have done so. See also *Rey* v. *Lecouturier*, 25 R. P. C. 265 (1908), C. A. (*Chartreuse*), where in the Court of Appeal, all the members of the Court adverted in their judgments

indicated by the name, whether prepared by the original inventor of the recipe, or his successors in business, or not. Until the secret is discovered or betrayed the goods of the original inventor or his successors can be the only goods to which the name is applicable, or which are denoted by it;[1] but when other people can make them, the difficult question of fact, discussed in previous chapters of this book[2] arises, whether the name is merely that of the goods themselves, or that of goods of the kind prepared or sold by the original inventor or his successors in business. This was clearly put by Fry, J., in *The Angostura Bitters* case.[3] "I cannot say," the learned judge said, "that Meinhard[4] may not, if he can, make a bitter identical with the plaintiffs', and, if he does, I cannot prevent him from selling it as *Angostura Bitters*. It is to be observed that the person who produces a new article, and is the sole[5] maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from. No distinction can arise from using the name of the class so long as the class consists of only one species, for then the name of the species and the name of the class will be the same."

The use of the name or secret may be a breach of contract or of confidence.

But, as regards any particular person, the use of a mark or name which is open to the world at large may be restrained by reason of a contract which he has entered into, or of circumstances which make it contrary to conscience for him to avail himself of the general right. Putting aside cases of express contract,—as where, for instance, a partner or servant has covenanted not to use the firm name, or any particular name or marks, or not to engage in any particular business, after the determination of the partnership or employment,—the most important cases of this kind are cases of trade secrets. The

to the fact that the process of the monks (plaintiffs) was a secret one. See also the form of the injunction, judgment of Buckley, L.J.

[1] Thus, in *Birmingham Vinegar Brewery Co.* v. *Powell*, [1897] A. C. 710; 14 R. P. C. 720, the defendants were restrained from describing their sauce as *Yorkshire Relish* without clearly distinguishing it from the plaintiff's sauce. They had not succeeded in discovering the recipe, but only in making a wonderful match. See above, p. 489.

[2] Above, pp. 37 *et seq.*, and p. 507.

[3] *Siegert* v. *Findlater*, 7 C. D. 801, at p. 813.

[4] The maker of the defendant's bitters.

[5] On the principle of *Dent* v. *Turpin* (above, p. 385), if there were two or three makers only, each of them might claim to restrain an outsider from using the name. See observations of Ld. Watson during the argument in *The Yorkshire Relish* case, 14 R. P. C. at p. 726. Cf. sec. 39 of the Trade Marks Act, 1905.

law relating to trade secrets does not properly fall within the scope of this book, but as it touches upon the limitation of trade mark and trade name rights referred to above, it is convenient shortly to refer to the leading cases on the subject.

Wherever secret information has been obtained under circumstances which import a contract not to disclose or make use of it, or by breach of confidence, or under other circumstances which make the disclosure, or the use of the information, contrary to conscience, the Court will restrain the person who has obtained it, or anyone to whom it has been communicated by him, from using or disclosing it.[1]

Information obtained by breach of contract or of confidence.

Thus, in *Prince Albert* v. *Strange*,[2] the publication of a catalogue of a number of etchings made by the late Queen and Prince Albert for their private use and amusement, and never published or authorised to be published by them, and the exhibition of the etchings, was restrained, the copies of the etchings which had passed into the defendant's possession having been obtained surreptitiously and in breach of confidence from or through a printer employed to print them. And in *Morison* v. *Moat*[3] the defendant, who had obtained the secret of manufacturing *Morison's Universal Medicine* from his father, was restrained from using it. Both the defendant and his father had formerly been in partnership with the plaintiff, but the father of the defendant, to whom alone the original inventor had disclosed the secret, had entered into a bond not to divulge it to any other person. The injunction restrained the defendant, his agents, &c., from selling, under the title of *Morison's Universal Medicine*, any medicine made by him or under his directions, and also from making any medicines according to the secret, or in any manner using the secret of compounding the medicines, or any part thereof.

Information obtained by a clerk;

Injunctions have been granted on the same principles to

[1] For a case in which the Court enforced the trusts of a settlement of a trade secret, see *Green* v. *Folgham*, 1 S. & S. 398; 1 L. J. (O. S.) Ch. 203 (1822).

[2] 2 De G. & Sm. 652; 1 Mac. & G. 25; 18 L. J. Ch. 120 (1849), Knight-Bruce, V.-C., and Cottenham, L.C.

[3] 9 Hare, 241; 20 L. J. Ch. 513; 21 *ib.* 248 (1851), Turner, V.-C., and Knight-Bruce and Ld. Cranworth, L.JJ., App., p. 730. The case of *Canham* v. *Jones*, 2 Ves. & B. 219; 13 R. R. 70, was distinguished by Turner, V.-C., on the ground that it was not put forward as one of breach of confidence or contract; but the report shows that the bill stated the employment of the defendant, and that the plaintiff's counsel, on the demurrer, to some extent rested their case on breach of confidence. The case would now be differently decided on the alleged facts.

restrain the use or publication of secret information obtained by a clerk or servant in the course of his employment[1]—and it is said that "every clerk employed in a merchant's counting-house is under an implied contract that he will not make public that which he learns in the execution of his duty as a clerk"[2]—of a list of the names and addresses of the plaintiff's customers copied by the defendant from his books when employed as his manager;[3] of a table of details of the dimensions of machinery designed by, or for the plaintiffs, collected from their plans by one of their draftsmen, although the details could all have been gathered from the machines made according to the designs and sold, if access could have been obtained to them;[4] of materials for the construction of a book of advertisements collected by the plaintiff's advertising canvassers;[5] of lectures delivered to a class of students, and not published or authorised to be published by the lecturer;[6] of private letters written by the plaintiff, or by a person whose estate the plaintiff represents;[7] of copies of the plaintiffs' pictures, delivered to the defendants for the making of copies, in excess of the number made for and delivered to the plaintiffs;[8] and of prints from a photographic negative likeness of the plaintiff, which the defendants had been employed by the plaintiff to take.[9]

table of dimensions by engineer's draftsman;

book of advertisements by canvasser; lectures;

private letters; copies of pictures by lithographer;

photographs of the plaintiff.

"Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the Court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of

The jurisdiction rests on implied contract.

[1] *Vouatt* v. *Winyard*, 1 Jac. & W. 394 (1820), Eldon, L.C.

[2] Per Wigram, V.-C., in *Tipping* v. *Clarke*, 2 Hare, 383 (1842); and per North, J., in *Pollard* v. *Photographic Co.*, 40 C. D. 345 (1888). See next case.

[3] *Robb* v. *Green*, [1895] 2 Q. B. 1, 315, Hawkins, J., and C. A.; damages for breach of the implied contract to observe good faith were also recovered.

[4] *Merryweather* v. *Moore*, [1892] 2 Ch. 518, Kekewich, J. The defendant had been apprenticed to the plaintiffs, and had remained in their employment after his articles expired; cf. *Reuter's Telegram Co.* v. *Byron*, cited below, p. 373, note (2).

[5] *Lamb* v. *Evans*, [1892] 3 Ch. 462: [1893] 1 Ch. 218, Chitty, J., and C. A.

[6] *Abernethy* v. *Hutchinson*, 3 L. J. Ch. (O. S.) 214 (1824), Eldon, L.C.; *Caird* v. *Sime*, 12 App. Ca. 326 (1887).

[7] *Perceval* v. *Phipps*, 2 Ves. & B. 19 (1813), Plumer, V.-C.; *Earl of Lytton* v. *Devey*, 54 L. J. Ch. 293 (1884), Bacon, V.-C.

[8] *Tuck & Sons* v. *Priester*, 19 Q. B. D. 629 (1887), C. A.

[9] *Pollard* v. *Photographic Co.*, note (2).

performing a promise, on the faith of which the benefit has been conferred."[1] But it is submitted that the true ground is always implied contract,[2] for if information, which both parties understand the present possessor intends to be kept, and to remain secret, is communicated by him to another, or the means of obtaining it are placed by him within the reach of another, for particular purposes, for instance, in the course of an employment, an undertaking not to use or disclose the information ought almost necessarily to be inferred.

As already stated, the jurisdiction extends to enable the Court to restrain a third party from using secret information which has been, to his knowledge, obtained or communicated in breach of faith[3] or contract. On similar grounds the right of a person, who has collected information and supplied it for the sole use of his customers, to restrain them from disclosing it to others,[4] and to restrain others from surreptitiously obtaining it from the subscribers, has been protected.[5]

Patents taken out by agent in breach of confidential relation towards principal.

The mere existence of a contract for service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service, even although the invention may relate to subject-matter germane to and useful for his employers in their business; and that, even although the servant may have made use of his employers' time and servants and materials in bringing his invention to completion, and may have allowed his employers to use the invention while in their employment, but all the circumstances must be considered in each case. Thus it was held by Byrne, J., in a case in which he summed up the principle established by the authorities in the above words, that the confidential agent and manager in this country of an American corporation, who had taken out two patents in this country, could not, having regard to the nature and scope of his employment, to the obligations and duties arising therefrom, to the trust imposed in him, and to his own conduct in endeavouring to establish a trade for them in the

[1] Per Turner, V.-C., in *Morison* v. *Moat*, 20 L. J. Ch. p. 522. So, per Kekewich, J., in *Merryweather* v. *Moore*, [1892] 2 Ch. p. 522.

[2] *Merryweather* v. *Moore*, supra; *Reuter's Telegram Co.* v. *Byron*, 43 L. J. Ch. 661 (1874), Jessel, M.R.; *Robb* v. *Green*, p. 572, note (3), was decided on the ground that there is an implied contract to keep good faith on the part of a servant.

[3] Page 571, notes (2) and (3).

[4] *Exchange Telegraph Co.* v. *Gregory*, [1896] 1 Q. B. 147, C. A.

[5] *Exchange Telegraph Co.* v. *Central News*, [1897] 2 Ch. 48, Stirling, J.

articles in question, hold the patents as against the corporation, and he was declared to be a trustee for them of the two patents.[1]

Use of agent's information where no breach of contract or confidence.

Reuter's Co. v. Byron.

The mere fact that the defendant obtained information as and while he was the agent of the plaintiff, is not a sufficient ground for restraining him from using it, provided there is nothing of a secret character in the information itself, or confidential or surreptitious in the manner in which it was communicated or obtained, so that a contract not to communicate or use it can be implied. "The plaintiffs here do not seek to restrain the defendant from publishing anything," Jessel, M.R., said, in *Reuter's Telegram Co.* v. *Byron*,[2] "but from making use of knowledge acquired while the relation of principal and agent subsisted, after that relation had terminated. Now I am not aware of any authority in which this has been done in the absence of a contract, expressed or implied." And he added, "the jurisdiction of the Court cannot be stretched on an interlocutory application. I do not mean to say it cannot be done at all." The circumstances of the case just cited were, that the plaintiffs had invented a large number of telegraphic cyphers indicating the names of their customers, which were communicated to the defendant while he was the plaintiffs' agent, and after he had left their employment, and started a rival business, he sent circulars to the customers, stating that he had their cyphers, and soliciting their custom. It was said that the defendant had committed no breach of confidence with regard to the cyphers, because these were known to the customers, and could have been obtained by the defendant from such of them as chose to do business through him. It may be doubted whether the importance of having access to the large number of cyphers invented or collected by the plaintiffs was fully appreciated in this case, and whether the decision is consistent with the reasoning accepted in the later cases of *Lamb* v. *Evans*, and *Merryweather* v. *Moore*, cited above.[3] It was, however, as appears from the judgment of the learned Master of the Rolls, a decision on an interlocutory application only. The principle stated in the judgment, and quoted above, is undoubtedly sound, whatever may be thought of its application to the facts of the case.

[1] *Worthington Pumping Engine Co.* v. *Moore*, 20 R. P. C. 41 (1902). A claim as to a third patent was dropped. See also *Richmond & Co., Ltd.* v. *Wrightson*, 22 R. P. C. 25 (1905), Buckley, J., and *Edisonia, Ltd.* v. *Forse*, 25 R. P. C. 546 (1908), Warrington, J.

[2] See n. (2), ante, p. 573.

[3] Page 572, notes (4), (5).

No injunction unless there is danger of the secret being communicated.

Following the ordinary rule in regard to injunctions, no injunction to restrain the communication of a secret will be granted unless by reason of a threat or otherwise the Court is satisfied that there is a danger of the communication being made.[1]

Section 15 of the Patents and Designs Act, 1907, contains provisions protecting a true and first inventor against applications for patents in fraud of his rights and from the consequences of use or publication subsequent to a fraudulent application during the period of provisional protection.

[1] *Morison* v. *Moat*, 20 L. J. Ch. p. 529.

CHAPTER XX.

REGISTRATION OF FOREIGN AND COLONIAL TRADE MARKS.

BEFORE the introduction of the Register of trade marks a foreigner, not being an alien enemy, was allowed to sue for the infringement of his trade mark in the English Courts,[1] provided that the trade mark had become his trade mark in England by user, or to prevent or obtain damages for the passing off the goods of others as his goods, in the same way and on the same terms as an English subject. And many treaties existed by which this country agreed to give to the subjects of other countries the same right of protection, in respect of their trade marks, as it gave to its own subjects.[2] The prohibition contained in sec. 42 of the present Act, and the corresponding sections of the Acts of 1883 and 1875, restraining actions in respect of the infringement of unregistered trade marks,[3] however, apply to the trade marks of foreigners,[4] and therefore actions for infringement could not, since 1875 (in general),[5] be brought by a foreigner without his trade mark being registered in England; actions for passing-off, to which the prohibitory sections of the former or the present Acts do not apply,[5] remaining as before.

A foreigner, or any resident in a British possession, may apply for and obtain registration under sec. 12; but if he does not reside or carry on business in the United Kingdom at the time of making the application, he must, if so required, give an address for service in the United Kingdom;[6] and under sec. 91 of the Patents and Designs Act, 1907, replacing secs. 103 and 104 of the Act of

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

[2] See a paper presented to Parliament, 1872, C. 633. For later instances of similar treaties, see the Convention between Great Britain and Guatemala, July 20, 1898 (1899, C. 9504), which withdrew from the International Convention during 1895, and the Convention between Great Britain and Luxemburg, Jan. 25, 1900 (1900, C. 31).

[3] For the precise effect of the section, see its terms, and Chap. XII., p. 334.

[4] *Goodfellow* v. *Prince*, 35 C. D. 9 (1887). C. A.; decided under he Act of 1883, sec. 77, see above, pp. 337, 344.

[5] Sect. 45.

[6] Rule 9, corresponding to Act of 1888, s. 8.

1883,[1] further provisions are made in his favour if he is a subject of a State in respect of which, or a British subject resident in a British possession to which the provisions of the section have been, by Order in Council, declared to be applicable.

Section 91, so far as it relates to trade marks,[2] provides that—

International and colonial arrangements.

"(1.) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of trade marks, then any person who has applied for protection for any trade mark in that state, shall be entitled to registration of his trade mark under the Trade Marks Act, 1905, in priority to other applicants; and the registration shall have the same date as the date of the application in the foreign state.

Provided that—(a) the application is made, in the case of a trade mark, within four months from the application for protection in the foreign state; and

(b) Nothing in this section shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the actual date on which his trade mark is registered in this country.[3]

(2.) The registration of . . . a trade mark shall not be invalidated (c) . . . in the case of a trade mark, by reason only of the use of the trade mark in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3.) The application for the registration of a trade mark under this section must be made in the same manner as an ordinary application under the Trade Marks Act, 1905:[4] Provided that (b), 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 the Trade Marks Act, 1905.[5]

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which His

[1] Sec. 65 of the Trade Marks Act of 1905 made those sections applicable to trade marks registrable under the Act of 1905. And see p. 578, note (3).

[2] The words referring only to patents or designs are here omitted.

[3] The ordinary rule is, that where trade mark rights exist, damages for infringements before the registration may be recovered: *Barlow* v. *Johnson*, 7 R. P. C., p. 411 (1890), Chitty, J., ante, p. 337. Cf. with this sub-section the International Copyright Act. See *Moul* v. *Groenings*, [1891] 2 Q. B. 443; and *Schauer* v. *Field*, [1893] 1 Ch. 35; *Sarpy* v. *Holland*, [1908] 1 Ch. 443.

[4] Sec. 12, Chap. IV., p. 78.

[5] See p. 583.

Majesty by Order in Council declares 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.[1]

(5.) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of (inventions, designs, and) trade marks, (patented or[2]) registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession with such variations or additions, if any, as may be stated in the Order."

Section 88 of the same Act provides that "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 may be revoked or varied by a subsequent order."[3]

The provisions of sec. 103 and 104 of the Act of 1883, as amended by sec. 6 of the Act of 1888 were to the like effect, although the wording and arrangement have been altered in the later sections.[3]

The International Convention.

At the time when the section of the Act of 1883 was passed into law, the International Convention for the Protection of Industrial Property, as it was originally settled at Paris, had been drawn up and agreed to by several of the countries which are parties to it, and in the following year[4] this country acceded to the Convention. Practically all civilised States, except Austria and Russia, have now acceded to the original Convention.[5]

International registration of trade marks.

At a subsequent conference at Madrid, in 1891, besides an agreement to endow the International Bureau at Berne, two Conventions were signed by most of the States of the Union. Of these, one, which was signed by Great Britain,[6] related to false indications of origin; the other, signed by Belgium, Brazil, France, Italy, the Netherlands, Portugal, Spain, Switzerland, and Tunis, but not by Great Britain, established a system for the international registration of trade marks.[7] The principles of

[1] For list of States and Possessions to which the section applies see Appendix, p. 741.

[2] The brackets are not part of the Act: see note (2), above, p. 577.

[3] Section 98 of the Act of 1907, which repeals the Acts of 1883 and 1888, provides that the repeal shall not affect any convention or Order in Council having effect under any enactment so repealed, but any such convention or Order in Council in force at the commencement of the Act shall continue in force, and may be repealed, altered or amended, as if it had been made under that Act.

[4] March 20th, 1883.

[5] Germany adhered to it in 1903.

[6] See post, p. 749.

[7] The text of this arrangement will be found in the Appendix, p. 751.

this system are admirably explained by M. Frey-Godet, Secretary to the International Bureau at Berne, in a paper read by him before the London Congress of the International Association for the Protection of Industrial Property, in 1898.[1] "The proprietor of the trade mark makes an application for international registration to the Government of his native country, which then forwards his request to the International Office at Berne. The latter registers the trade mark, and notifies this registration to all the States which have become parties to the Arrangement of Madrid, and afterwards publishes a description of the trade mark, with all the data in connection with it, in a publication entitled *Les Marques Internationales*, which forms an appendix to *La Propriété Industrielle*, the official organ of the Office.

"The registration of the trade mark at the International Office produces absolutely the same effect as if the trade mark had been registered on the same day in all the contract States. . . . The trade marks judged inadmissible must be refused at latest during the year following the notification by which the Berne Office has made known the registration of the trade mark to the contract States. When a State refuses legal protection to a trade mark registered internationally, the proprietor enjoys the same means of appeal as if he had made the application to the national registration department of the State concerned.

"The effect of international registration lasts for twenty years; but it can only be invoked so long as the trade mark remains protected in the country of origin. Nevertheless, if a trade mark has been temporarily deprived of protection in that country owing to delay in renewing the application, it is sufficient to make a fresh application in order again to set in operation the international protection which had remained in abeyance. This is, then, only an expansion of the protection which the trade mark enjoys in the country of origin. Consequently every modification relating to the property of an international trade mark (annulment, erasure, renunciation, transfer, &c.) must be notified by the national Government to the International Office, which makes a memorandum of this and forwards the information to the various contract States.

"Whoever wishes to effect the international registration of a trade mark must pay a fee of 100 francs, which goes to the

[1] Trans. Inter. Assoc. for the Protection of Ind. Prop., Vol. II. (1898), p. 102.

International Office, and a national fee, which goes to the country of origin. Each country fixes at its pleasure the amount of this fee, which is supposed to be an equivalent for the labour furnished by the Government of the country on the occasion of the international registration of the trade mark to which it refers. France, for instance, imposes a fee of 25 francs; Switzerland a fee of 5 francs only, whilst Belgium exacts none at all.

"The international and national fees together are always inferior in amount to the total of national fees which it would be necessary to discharge in the different contract countries in order to obtain in each of them the national registration of the trade mark (165 francs). But the amount of the official fee is insignificant in comparison with the expenses which would be entailed by translations, authentications, agent's fees, &c., if the application for registration of a trade mark were contemplated in each of the States adhering to the arrangement."

Obstacles to Great Britain's accession.

The objection of Great Britain to accede to this arrangement is based on several grounds with which M. Frey-Godet deals in succession. It does not appear that the point has ever been taken on behalf of this country that international registration, by diminishing the number of national applications for registration of foreign trade marks, would at the same time reduce the registration fees collected by the British Government. But if such an argument were advanced, M. Frey-Godet's answer is twofold. In the first place, Great Britain would not grudge the expenditure of a few thousand francs in order to be assured of a valuable advantage to her commerce. In the second place, it is by no means certain that the fee collected by Great Britain on international applications effected by British subjects, added to that derived from the surplus receipts of the service of registration, would not make up for the diminution in the number of ordinary registrations. A second objection, and one which has greater weight, may be put in this way: British trade mark law is based on a registration effected by a national government. To a system of this kind it is impossible to assimilate one of registration carried out in a foreign country. M. Frey-Godets' answer is that our internal legislation by which copyright is only granted to literary works if they have been entered at Stationers' Hall, does not apply to works produced in the countries forming part of the Literary and Artistic Union. It may be noted in passing, that Article V. of the Madrid Arrangement preserves

the right of the contracting States to reject any trade mark presented for registration under the international scheme to which it could object if an application were made for its registration in the ordinary course. The Patent Office would, therefore, be free to examine trade marks for which international registration was desired, and to reject those which were inadmissible on the ground of internal legislation. Our internal legislation, however, gives rise to several difficulties of its own. Under sec. 15 of the Act of 1905 an applicant may be required to make a disclaimer for the purpose of defining his rights under the registration. This difficulty, however, is now less than it was under sec. 64, sub-sec. (2) of the Act of 1883, which required every applicant in his application for registration to indicate the essential elements of his trade mark, and to disclaim what is non-essential. Disclaimers are now the exception and not the rule. Again, sec. 8 of the Act of 1905[1] provides that "a trade mark must be registered in respect of particular goods or classes of goods"; and in this country trade marks must be published in the official journal of the Patent Office. How are these provisions to be severally adjusted to the system of international registration? As regards disclaimers, M. Frey-Godet's suggestion was that the applicant might be required expressly to disclaim the non-essential parts of his trade mark before embarking on a law suit. A similar procedure is, no doubt, in force in this country in regard to patents. But this solution of the problem does not deal with the inconvenience that would be caused to applicants for national (or even international) registration by the uncertainty as to what were the essential parts of marks already on the Register of Trade Marks.[2] The difficulty as to publication might be met, as M. Frey-Godet points out, by the annexation to the national publication of a trade mark either of the publication of the Berne Office or, preferably, of an authenticated translation of it.

The International Convention.

The text of the International Convention of Paris to which, as already stated, this country is a party, and a list of the countries and British possessions to which the above sections have been made applicable by Orders in Council, are set out in the Appendix.[3]

The Convention and the accession thereto of this country may

[1] Corresponding to sec. 65 of the Act of 1883.

[2] The uncertainty exists to some extent as to trade marks registered under the Act of 1905.

[3] Pages 741, 743.

be referred to by the Court as a matter of history, in order to enable it to understand under what circumstances the sections of the Act were passed;[1] but the terms of the Convention cannot be employed as a guide to interpret the sections,[2] for a treaty with a foreign State binds the subjects of the Crown only in so far as it has been embodied in legislation passed into law in the ordinary way.[3]

Foreign trade mark may be refused registration.

The provisions of the section, in fact, do not carry out the international agreements constituted by the Convention, for, by Art. VI. of the Convention, it is agreed that "every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the forms originally registered in all other countries of the Union"[4]; and by clause 4 of the final protocol, it is explained that this article "is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of the State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin"; but it was, nevertheless, decided under the Act of 1883 that, in order to be qualified for registration, a mark tendered under sec. 103, just as any other mark sought to be registered, must fall within the descriptions of sec. 64 of that Act. So that the words *Syrup of Figs*,[5] and the words *Carter's Little Liver Pills*,[1] were refused registration as trade marks, although registration of them respectively had been duly applied for and actually obtained in the United States, one of the States to which sec. 103 had been applied. No alteration in this respect is made by the Act of 1905, although that Act enlarges the classes of registrable trade marks.

The effect of the decisions just referred to is to reduce the operation of the Convention, in regard to trade marks[6] in this country, to very narrow limits. As between applicants for the

[1] *Carter Medicine Co.'s Tm.*, [1892] 3 Ch. 472; 9 R. P. C. 401, North, J.

[2] *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

[3] See last case, and *Walker* v. *Baird*, [1892] A. C. 491.

[4] *I.c.*, the union of the contracting States for the protection of industrial property.

[5] *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

[6] Another part of the convention, relating to false marking and false trade description and the seizure on importation of falsely marked goods, has been carried into effect by the Merchandise Marks Act, see p. 811, below.

registration of new marks, or marks acquired as trade marks since the application for protection in a foreign State within the Union, the applicant in the foreign State is to have priority, provided that he makes his application in this country within four months from the date of the foreign application on which he relies. And this priority is not affected by the success or failure of the foreign application.

Publication of foreign trade mark.

The proviso that use of the trade mark in this country during the period of four months shall not invalidate the registration, is surplusage, if it is directed to use by the applicant himself, as it seems intended to be, for the publication or use of a mark by the applicant before registration in no case prejudices a right to registration. The proviso might have some useful meaning and operation, if it were construed to prevent an opponent, who had first used the trade mark in question in this country after the application in a foreign State by the applicant for registration, from relying on his use of the mark, or the title acquired by him in consequence of that use, as an objection to the registration of the applicant.[1] But so long as the Convention is not embodied in legislation, as already stated, it can have no operation upon the right to registration at all. It might, however, it is submitted, properly affect the Registrar's discretion.

The last clause of sub-sec. (3), providing that "any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act," does not give an independent or new right of registration under the Act,[2] and it seems to bear no other construction than that suggested on behalf of the Comptroller in *The Carter Medicine Co.* case,[2] namely, that "may be registered" is to be read as "may be the subject of application for registration," although this construction reduces it also to surplusage.

The application of the sections to any foreign State can, under no circumstances, afford any answer to a motion under sec. 35 to remove from the Register a mark which was originally registered without sufficient cause.[3]

[1] The first user might acquire a right under the proviso to sec. 41, see above, p. 331.

[2] *Californian Fig Syrup Co.'s Tm.*, and *Carter Medicine Co.'s Tm.*, supra. In *Vidal's Patent*, 15 R. P. C. 721 (1898), Sir R. Webster, A.-G., said:—"I am clearly of opinion that, when a person claims under those articles, he cannot claim greater privileges than a national applicant, and that he is liable to the same restrictions as a subject or citizen of the country in which he is making the application."

[3] *Vignier's Tm.*, 6 R. P. C. 490 (1889), Kay, J. (*Monobrut Champagne*).

CHAPTER XXI.

MISCELLANEOUS MATTERS.

False Representation as to Registration of Trade Mark.

Penalty on falsely representing a trade mark as registered.

By sec. 67 of the Trade Marks Act, 1905:—

"(1.) Any person who represents a trade mark as registered which is not so, shall be liable for every offence on summary conviction[1] 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."[2]

The offences here dealt with are applications of false trade descriptions,[3] but the liability to punishment under the M. M. A. would afford no answer to a prosecution under the above section.[4]

And an infringement of the section is not necessarily a bar to an application for the registration of the trade mark which has been wrongly described as registered.[5] The use of the word "Registered" has been held to indicate registration in the United Kingdom.[6]

False Representation as to Patent or Design.

By sub-sec. (2) of sec. 89 of the Patents and Designs Act 1907, it is an offence for any person falsely to represent that any

[1] As to the Isle of Man, see sec. 70; and as to Scotland, sec. 72.

[2] This corresponds to and substantially re-enacts, so far as relates to trade marks, sec. 105 of the Patents, &c. Act, 1883.

[3] See M. M. A. 1887, s. 3 (n), Appendix, p. 807.

[4] M. M. A. s. 19 (1), Appendix, p. 812.

[5] *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.; "registered shape"; and *Altman's Application*, 21 R. P. C. 753 (1904), Kekewich, J., and *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A., in both of which cases the use of the word "registered" before registration was proved to have been by a *bonâ fide* mistake; see also above, pp. 72, 437.

[6] *Wright, Crossley & Co.* v. *William Dobbin & Co.*, 15 R. P. C. 21 (1898), in Ireland. *MacSymons' Stores, Ltd.* v. *Shuttleworth*, 15 R. P. C. 748 (1898), in England. The use of the words "Trade Mark," in relation to an unregistered trade mark, is not necessarily an offence under the section: *Sen Sen Co.* v. *Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137.

article sold by him is a patented article, or falsely to describe any design applied to any article sold by him as registered; and by sub-sec. (3), if any person sells an article having stamped, engraved, or impressed thereon, or otherwise applied thereto, the word "patent," "patented," or "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of the section to represent that the article is a patented article or that the design applied thereto is a registered design.[1] The introduction in sub-sec. (2) of the word "falsely" probably prevents the sub-section applying to a case in which no patent has ever existed but the word "patent" has become part of the trade name of the goods and has been used by the manufacturer in his description of them.[2] It also saves the use of such ordinary names of commerce as "patent leather" and "patent medicine."[3] It is submitted that a limitation must be placed upon the literal meaning of the enactment which will exclude these cases from the section.[4]

Falsification of the Register of Trade Marks.

By sec. 66 of the above-mentioned Act of 1905:—

Falsification of entries in Register.

"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 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.[5]

False Representation as to Royal Warrant.

By sec. 20 of the M. M. A. of 1887:—

False representation as to Royal warrant.

"Any person who falsely represents that any goods are made

[1] These provisions replace sec. 105 of the Act of 1883, which section was not qualified by the word "falsely."

[2] *Edelsten* v. *Vick*, 11 Hare, 78 (1858), Wood, V.-C. (*Taylor & Co.'s Patent Solid-headed Pins*); see further, Chap. XV., p. 401; *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Div. Court, *Swinborne's Patent Refined Isinglass*, held not to be a false trade description.

[3] See above, p. 431.

[4] Application for a patent, or provisional protection, does not authorise the use of the word patent; but, it is submitted, the acceptance of the complete specification of a patent does. See *R.* v. *Townsend*, 13 R. P. C. 265 (1896). Cf. *Grueber's* case, Times, Nov. 22, 1894.

[5] Replacing, as to the Trade Mark Register, sec. 93 of the Patents, &c. Act, 1883. As to the Registers of Patents and Designs, see now sec. 89 (1) of the Patents and Designs Act, 1907.

by a person holding a Royal warrant, or for the service of Her Majesty, or any of the Royal Family, or any Government department, shall be liable, on summary conviction,[1] to a penalty not exceeding £20."

Unauthorised Assumption of Royal Arms.

By sec. 90 of the Patents and Designs Act of 1907:—

"(1.) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

Unauthorised assumption of Royal Arms.

(2.) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling, or profession, the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such a manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction, under the Summary Jurisdiction Acts,[2] to a fine not exceeding £20.

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark."

Sub-sec. (1) is new. Sub-sec. (2) corresponds to sec. 106 of the Patents, &c. Act, 1883, but it requires the authority to be that of His Majesty, omitting the former words "or of any of the Royal Family, or of any Government department." Its provisions are now supplemented by those of sec. 68 of the Trade Marks Act, 1905, which were introduced into that Act at the suggestion of the Association of Royal Warrant Holders. The section is as follows:—

"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

[1] In Scotland, in the Sheriff Court (sec. 21); and in the Dublin police district, the Courts of the justices under the Petty Sessions Act, 1851 (sec. 22).

[2] As to the Isle of Man, see sec. 96, and as to Scotland, see sec. 94 of the same Act.

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."

This section adds to the remedy by summary prosecution now provided by sec. 90 of the Patents and Designs Act, 1907, 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.[1]

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.[2]

In a prosecution under sec. 106 of the Patents, &c. Act, 1883, the defendant unsuccessfully contended that he was entitled to use the Royal Arms as he held a patent for an invention which he was using in his business, and the Patent Office was a Government department.[3] A defence in another case that the defendants were contractors to Government departments, also failed.[4]

[1] An injunction was granted by consent under the section in *Royal Warrant Holders' Association* v. *Slade & Co., Ltd.*, 25 R. P. C. 245 (1908).

[2] Rules 11 and 12, p. 657.

[3] *Webber & Co.'s* case, Times, February 2, 1897.

[4] *Wood's* case, Times, May 14th, 1903.

Cutlery Marks.

The Cutlers' Marks Act, 1819.

By the Act 59 Geo. 3, c. 7, it is forbidden to mark cutlery and the other goods mentioned in the Act with the figure of a hammer, unless the goods have been wrought or forged, or to place false marks of quality upon such goods, or to falsely mark them as London made; and the offences created by the Act extend to selling, or having in possession for the purposes of sale, such goods marked in breach of the Act. The material provisions of the Act [1] may be summarised as follows:—

Hammer marks.

1. Where any knives, knife-blades, forks, razors, razor-blades, scissors, shears, and other articles of cutlery, edge tools and hardware requiring a cutting edge, of wrought steel, or of iron and steel, are made by means of the hammer, the maker may mark the figure of a hammer upon them before they are ground.

3. No one may mark such figure on any of the goods enumerated not so made, before the *bonâ fide* sale of the goods to the user, or have in his possession for the purpose of sale, or sell any such goods not so made, and being marked with such figure, under penalty of forfeiture of the goods and a fine of £5 for every dozen.

Quality marks.

4. No one may mark on any of the goods enumerated, whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, "any word or words which shall or may denote or indicate the quality of such articles to be otherwise than the real and true quality thereof," or have in his possession for the purpose of sale, or sell any such goods so marked, under penalties as aforesaid.

London made.

5. No one may mark on any of the goods enumerated whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, the word or words *London* or *London made*, or any word or words having any similitude thereto, unless the goods were made in the City of London, or within twenty miles distance therefrom, or have in his possession, &c., or sell (as before) under a penalty of forfeiture and fine of £10 a dozen articles.

Innocent purchasers.

7. Any one having in his possession for the purposes of sale, or selling any of the goods aforesaid contrary to the Act, who shall, before information or complaint laid against him, prove

[1] Sec. 17 has been repealed by the Stat. Law Rev. Act, 1873, and sect. 2 by the Stat. Law Rev. Act, 1874, secs. 8–10 in part, and secs. 11–13 and 15 wholly, repealed by 47 & 48 Vict. c. 43, s. 4.

satisfactorily by oath before one or more justice or justices that he purchased the goods with the marks thereon without knowing they were marked contrary to the Act, and shall discover to two or more justices the name of the person from whom he bought, so that the latter shall be prosecuted to conviction, shall not be liable to penalties himself,[1] but shall be entitled to two-thirds of the penalty recovered from his vendor, as any other informer.

Counterfeiting Sheffield corporate marks.

The Cutlers' Co. Act of 1814 contains a provision inflicting penalties upon any person who counterfeits or imitates assigned corporate marks; and by sec. 81 (13) of the Patents, &c. Act of 1883, this provision was extended to any mark entered in the Sheffield Register,[2] but the Trade Marks Act of 1905 contains no such provision, no doubt because it was considered that sufficient protection is now given by the Merchandise Marks Act, 1887. The section of the first-mentioned Act is as follows[3]:—

"If any member or members of the Cutlers' Company, or any other person or persons using, exercising, or carrying on any of such arts or trades as aforesaid within the said lordship or liberty, or six miles compass of the same, shall at any time after the passing of this Act strike, engrave, impress or use, or cause or procure to be stricken, engraved, impressed or used upon his or their goods, wares, or manufactures, any mark, device, stamp, or impression, with intent to counterfeit or imitate any mark or device assigned, or which may hereafter be assigned, by the said master, wardens or searchers and assistants of the said company, to be used by any other person, the person or persons so offending shall, for every such offence, forfeit and pay (in lieu of the penalty imposed by the said last recited Act)[4] any sum not exceeding £20, one moiety whereof shall be paid to the person whose mark shall have been so counterfeited or imitated, and the other moiety to the said master and wardens of the said company; and the provisions in the said last recited Act[4] contained for the recovery and application of the penalty thereby imposed shall be used, applied, and put in force for the recovery and application of the penalty hereby made payable, as fully and effectually as if the same provisions were in this Act severally and separately repeated and re-enacted."

[1] Cf. M. M. A. sec. 2 (2), "unless he proves," p. 806.

[2] Above, p. 626.

[3] 54 Geo. 3, c. 119, s. 5 (local).

[4] The Cutlers' Co. Act of 1791, see above, p. 113.

The sections of the Cutlers' Co. Act of 1791,[1] which are referred to and incorporated by the last-mentioned section, provide (sec. 26) that the penalties may be sued for by the company, or (sec. 27) recovered summarily before a justice or justices of the West Riding of York, or of the county of Derby, who shall have power to award costs, and to issue a distress warrant, or, if the goods of the offender are insufficient, to commit him to the House of Correction for one month to enforce payment of the penalty. Section 28 contains a form of conviction, and sec. 29 gives an appeal to quarter sessions.

Statutes relating to particular goods.

A number of statutes of little general importance, requiring special marks to be placed upon particular classes of goods, are summarised in the Appendix, p. 816.

[1] 31 Geo. 3, c. 58 (local).

APPENDICES.

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APPENDIX I.

TRADE MARKS ACT, 1905.

[5 EDW. VII. CHAP. 15.]

TABLE SHOWING THE ARRANGEMENT OF SECTIONS WITH THE CORRESPONDING SECTIONS OF THE ACT OF 1883, AS AMENDED BY THE ACT OF 1888.

Section.		Corresponding Sections of Acts of 1883-8.
1.	Short title	
2.	Commencement of Act	
	PART I.	
	Definitions.	
3.	Definitions	New. The Court, 117 (1).
	Register of Trade Marks.	
4.	Register of trade marks	§ 78, § 82 (3), is not repealed by the Act of 1905.[1]
5.	Trust not to be entered on register	§ 85.
6.	Incorporation of existing register	§ 114 and cf. § 113; last para. new.
7.	Inspection of and extract from register	§ 88.
	Registrable Trade Marks.	
8.	Trade mark must be for particular goods	§ 65.
9.	Registrable trade marks	§ 64; last two paras new.
10.	Coloured trade marks	New, cf. § 67.
11.	Restriction on registration	§§ 73, 86.
	Registration of Trade Marks.	
12.	Application for registration	§ 62, (5), new; (6), § 91 (a), (d).
13.	Advertisement of application	§ 68.
14.	Opposition to registration	§ 69, costs, new, cf. § 69 (5).
15.	Disclaimers	§§ 64 (2), (3), 74 (2); end new.
16.	Date of registration	§ 75.
17.	Certificate of registration	New, cf. § 88.
18.	Non-completion of registration	§ 63.

[1] Sec. 82 is repealed by the Patents and Designs Act, 1907, and is replaced by sec. 62 of that Act.

Identical Trade Marks.

Section.		Corresponding Sections of Acts of 1883-8.
19.	Identical marks	§ 72.
20.	Rival claims to identical marks	§ 71.
21.	Concurrent user	New, cf. § 72 (1).

Assignment.

22.	Assignment and transmission of trade marks	§ 70; end new.
23.	Apportionment of marks on dissolution of partnership	New.

Associated Trade Marks.

24.	Associated trade marks	New.
25.	Combined trade marks	New.
26.	Series of trade marks	§ 66.
27.	Assignment and user of associated trade marks	New. § 66.

Renewal of Registration.

28.	Duration of registration	§ 79.
29.	Renewal of registration	§ 79.
30.	Procedure on expiry of period of registration	§ 79.
31.	Status of unrenewed trade mark	§ 79 (5).

Correction and Rectification of the Register.

32.	Correction of register	§ 91 (b) (c); end new.
33.	Registration of assignments, &c.	§ 87, end new, cf. § 90.
34.	Alteration of registered trade mark	§ 92.
35.	Rectification of register	§ 90, part new.
36.	Trade marks registered under previous Acts	New.
37.	Non-user of trade mark	New, cf. § 90.

Effect of Registration.

38.	Powers of registered proprietor	§ 87.
39.	Rights of proprietor of trade mark	§ 76; end new.
40.	Registration to be *prima facie* evidence of validity	§ 76.
41.	Registration to be conclusive after seven years	§ 76; proviso new.
42.	Unregistered trade mark	§ 77.
43.	Infringement	New.
44.	User of name, address, or description of goods	New, cf. § 64.
45.	"Passing-off" action	New.

Legal Proceedings.

46.	Certificate of validity	§ 77 (a).
47.	Registrar to have notice of proceeding for rectification	New, cf. old rule, 49.

Costs.

48.	Costs of proceedings before the Court	New

Evidence.

49.	Mode of giving evidence	New.
50.	Sealed copies to be evidence	§§ 84, 89.
51.	Certificate of Registrar to be evidence	§ 101.
52.	Certificate of Board of Trade to be evidence	§ 102a.

PART II.

Powers and Duties of Registrar of Trade Marks.

Section.		Corresponding Sections of Acts of 1883-8.
53.	Exercise of discretionary power by Registrar	§ 94.
54.	Appeal from Registrar	New.
55.	Recognition of agents	Old rule 9.
56.	Registrar may take directions of law officers	§ 95.
57.	Annual reports from Comptroller	§ 102.

Powers and Duties of the Board of Trade.

58.	Proceedings before Board of Trade	§ 102a (1).
59.	Appeals to Board of Trade	Cf. §§ 62 (5), 69 (4).
60.	Power of Board of Trade to make rules	§ 101.

Fees.

61.	Fees	§ 80.

Special Trade Marks.

62.	Standardisation, &c., trade marks	New.

Sheffield Marks.

63.	Sheffield marks	§ 81.

Cotton Marks.

64.	Cotton marks	New, cf. old rules, 8, 13.

International and Colonial Arrangements.

65.	International and Colonial arrangements	§§ 103, 104, not repealed by Act of 1905. [1]

Offences.

66.	Falsification of entries in register	§ 93.
67.	Penalty on falsely representing a trade mark as registered	§ 105.

Royal Arms.

68	Unauthorised assumption of Royal Arms	§ 106, not repealed by Act of 1905. [2]

Courts.

69.	General saving for jurisdiction of courts	§ 111.
70.	Isle of Man	§ 112.
71.	Jurisdiction of Lancashire Palatine Court	§ 112 (a).
72.	Offences in Scotland	§ 108.

Repeal; Savings.

73.	Repeal and saving for rules, &c.	Cf. § 113, § 27, of 1888.
74.	Application of 46 & 47 Vict. c. 57, ss. 82—84	§§ 82—84. [3]

SCHEDULE.

[1] Sections 103 and 104 have since been repealed by the Patents and Designs Act, 1907; see now sec. 91 of that Act.

[2] Since repealed by the Patents and Designs Act, 1907; see now sec. 90 of that Act.

[3] Since repealed by the Patents and Designs Act, 1907; see now sec. 62—64 of that Act.

APPENDIX II.

TABLE SHOWING THE CORRESPONDING SECTIONS OF THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883, AS AMENDED BY THE ACT OF 1888, WITH THE TRADE MARKS ACT, 1905.

PART IV.—TRADE MARKS.

Registration of Trade Marks.

Sections of the Acts 1883-8 relating to Trade Marks.	Corresponding Sections in Trade Marks Act, 1905.
62. Application for registration	§§ 12, 16.
63. Limit of time for proceeding with application	§ 18.
64. Conditions of registration of trade mark	§ 9 (2), cf. § 15; as to sub-sec. 3 (i), cf. § 44.
65. Connexion of trade mark with goods	§ 8.
66. Registration of a series of marks	§ 26, also part 27.
67. Trade marks may be registered in any colour	Cf. § 10.
68. Advertisement of application	§ 13.
69. Opposition to registration	§§ 14 (4), 59.
70. Assignment and transmission of trade mark	§ 22.
71. Conflicting claims to registration	§ 20.
72. Restrictions on registration	§§ 19, 20, 21.
73. Further restriction on registration	§ 11.
74. Saving for power to provide for entry on Register of common marks as additions to trade marks	Cf. § 15.

Effect of Registration.

75. Registration equivalent to public use	Omitted.
76. Right of first proprietor to exclusive use of trade mark	§§ 39, 40, 41.
77. Restrictions on actions for infringement, and on defence to action in certain cases	§ 42, cf. § 45.
77a Certificate as to exclusive use and costs thereon	§ 46.

Register of Trade Marks.

78. Register of trade marks	§ 4.
79. Removal of trade mark after fourteen years unless fee paid	§§ 28—31.

Fees.

80. Fees for registration, &c.	§ 61.

Sheffield Marks.

81. Registration by Cutler's Company of Sheffield marks	§ 63.

PART V.—General.

Patent Office and Proceedings thereat.

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[1] Sections 82 and 83 are now replaced by secs. 62 and 63 of the Patents and Designs Act, 1907.

[2] But now replaced by sec. 64 of the Patents and Designs Act, 1907.

[3] Sections 103 and 104 have now been repealed by the Patents and Designs Act, 1907, and are replaced by sec. 91 of that Act.

[4] Section 106 has now been repealed by the Patents and Designs Act, 1907, and is replaced by sec. 90 of that Act.

[5] And see Interpretation Act, 1889, sec. 38, post, p. 654

APPENDIX III.

TRADE MARKS ACT, 1905.

[5 EDW. VII. CHAP. 15.]

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SCHEDULE.

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.

"Save as otherwise expressly provided." See sec. 64, sub-sec. (10). Repeals and savings, sec. 73. See also Interpretation Act, 1889, sec. 38, below, p. 654.

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

Definition of a Trade Mark, Chap. II., p. 22.
Mark, p. 24.
Device, p. 184.
Brand, p. 189.
Heading, p. 191.
Label, p. 192.
Ticket, p. 197.
Name, p. 136.
Signature, p. 140.
Word marks, p. 142.
Letter, p. 198.
Numeral, p. 198.

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 :

Trade mark, p. 24.
Proposed to be used, p. 25.
In connection with goods, pp. 30 and 328.
Indication of origin, p. 35.
Certification, p. 53. See sec. 62.
Offered for sale in the market, p. 33.

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

"Registrable trade mark," p. 26. Sec. 9.
What marks may be registered as trade marks, Chap. VIII., p. 127.

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

The Register, Chap. III., p. 57.
Sheffield Register, p. 112.
Manchester Register, p. 121.
Entries to be made in the Register, sec. 4, pp. 57, 59.
Trusts not to be entered in the Register, sec. 5, p. 59.
Incorporation of existing Register, sec. 6, p. 57.
Inspection of Register, sec. 7, p. 61.
Registration of assignments, sec. 33, p. 357.
Rectification of the Register, Chap. XI., p. 278.

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 :

"Prescribed," p. 94, n. Rules of Court, *ibid.*
Rules under the Act, Trade Mark Rules, 1906, Appendix, p. 655.

"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.

The Court, pp. 94 and 303.
Scotland, sec. 69 and sec. 72, p. 303.
Ireland, sec. 69, p. 303.
Lancashire Palatine Court, sec. 71, p. 126.
Isle of Man, sec. 70, p. 624.

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.

The Register, Chap. III., p. 57.
Assignments and devolution, Chap. XIII., p. 345. Sec. 33.
Disclaimers, Chap. IX., p. 212. Sec. 15, rule 34.
Conditions, secs. 12, 13, 14, pp. 76 and 98, and secs. 21 and 23, pp. 264 and 352.
Limitations, sec. 10, colour, p. 209; sec. 21, concurrent user, p. 264, and see above "Conditions."
As to the Sheffield Register, sec. 63, see Sheffield Marks, Chap. VI., p. 112.
As to the Manchester Register, sec. 64, see Cotton Marks. Chap. VII., p. 121.
Registration is as of the date of application, sec. 16, p. 81.
"Prescribed," date of registration, goods, trade, &c., of proprietor and such other particulars as the Registrar shall think necessary, Rule 64, pp. 59 and 664.
Removal from the Register and cause to be entered, Rule 74, p. 374.
Patent office, secs. 62 and 63 of the Patents and Designs Act, 1907,
The Registrar, p. 58. Acts under the Board of Trade, p. 58. Sec. 62 of the Patents and Designs Act, 1907.

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.

The registered proprietor can make a good title to a purchaser without notice, sec. 38, p. 353.
A purchaser with notice of an equitable title in a third person takes subject to his rights, p. 356.
As to notices in the nature of caveats, see *Viola* v. *Sharpe*, 22 R. P. C. 23 (1905), a patent case.
This section does not prevent the entry on the Register of conditions and limitations, which are recognised by the Act, see notes to sec. 4.

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.

"Original Date." A trade mark is registered as of the date of application, Sec. 75 of the Act of 1883, as amended by sec. 17 of the Act of 1888. See also under this Act, sec. 16, pp. 81 and 324.
Sec. 36 gives a trade mark already on the Register the benefit of this Act without re-registration, p. 132.
Sec. 41 saves the original registration from attack on the ground of its invalidity after seven years from its date or from the passing of the Act, whichever shall last happen, and subject to certain exceptions, p. 330.

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.

Inspection, searches and indexes, pp. 61 and 62.
Hours of inspection, Rule 96. Searches, Rule 95. Form of request for official search, TM No. 28, p. 691.
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.* See list of fees, p. 673.

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.

Classification of goods, Chap. V., p. 103. List of classes, p. 697.
A trade mark is assignable only in connection with the goodwill of the business concerned in the goods for which it has been registered, sec. 22, p. 346.
Registration for part of a class, pp. 104 and 229.
Associated trade marks, secs. 24 to 27, p. 107.

Registrable trade marks.

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

A registrable trade mark is one capable of registration under the provisions of the Act, sec. 3.
As to what marks may be registered as trade marks, see Chap. VIII., p. 127.
For comparison with repealed sections, see p. 131.
Essential particulars, p. 134.

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

Name marks, p. 136. Trade name, p. 492.
Name of *imaginary* person not included, p. 137.
Special or particular manner, p. 140.

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

Signature, p. 140.

(3) An invented word or invented words ;

Word marks, p. 142. Paragraph (3) not qualified by (4), p. 159.
Invented word, p. 158. List of decisions, pp. 164 and 165.
Under the Act of 1883, before amendment by the Act of 1888, a fancy word not in common use might be registered, as to these, see pp. 144 to 157.

(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 ;

Page 165. List of decisions, pp. 168 and 169.
Descriptive words, pp. 37 and 150 *et seq.*, pp. 183 *et seq.*
Secondary meaning of word *primâ facie* descriptive, pp. 37, 152, 183 and 508.
Geographical names, p. 170. Decisions, p. 172.
Surname, p. 172.

(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 :

"Mark," sec. 3, p. 24 and 173.
Distinctive, pp. 174 to 184. Loss of distinctiveness, p. 363.
Special applications under paragraph (5) pp. 82 and 172, Rules 35 to 41, pp. 660 and 661.
Instances of words allowed by the Board of Trade under paragraph (5) *below* p. 820.

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.

Old marks, p. 198.
August 13th, 1875, the date of the commencement of the first Registration Act.
Special or distinctive, p. 198.
Used as a trade mark, p. 203, and Chap. II., p. 22.
Statutory declaration as to user, Rule 20, p. 658.
Additions or alterations not substantially affecting the identity of the trade mark, cf. sec. 26, sec. 27 and sec. 34.
Alteration of old registered mark, p. 317.

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.

Distinctive, pp. 35 and 174.
As to descriptive marks, see generally, pp. 37, 152, 165, 183 and 507.
Colour, sec. 10.

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.

Colour, p. 209.
Limitations, pp. 76, 264.

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.

Deceptive marks, Chap. X., p. 266.
The prohibition is not limited to marks inherently deceptive, &c., p. 267.
Marks otherwise disentitled to protection, p. 274.

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.

Registration of trade marks, Chap. IV., p. 65.
Who may apply to register, pp. 67 and 658.
Application by firm, partnership or body corporate, p. 67.
Prescribed manner, ordinary application, Rules 17 to 34, p. 658, Form TM No. 2, p. 678; application under sec. 9 (5), Rules 35 to 41, p. 660. Form TM No. 5, p. 680; application under sec. 62, Rules 42 to 46, p. 661, Form TM. No. 6, p. 681; application for a cotton mark, Rules 113 to 120, p. 670, Form Cotton No. 1, p. 692; applications to Cutlers' Co., Rules 107 to 112, p. 669; application to enter corporate mark on Sheffield Register, Form Sheffield No. 1, p. 691.
List of fees, p. 673; fees also marked on Forms.
Applications by agents, pp. 63 and 70.

(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.

The Registrar's discretion, p. 70.
Applicant entitled to be heard before refusal, sec. 53, p. 76.
Conditions, amendments or modifications, p. 76.

(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.

Request for statement of grounds of decision, Form TM No. 4, p. 679.

(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.

Appeal from the Registrar, p. 92.
Appeal to the Court, p. 94.
Appeal from Registrar to Board of Trade, Rules 122 to 127, p. 671. Form TM No. 29, p. 698.
Conditions, amendments or modifications, p. 76.

(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.

Appeal from the Registrar, p. 92.
Costs, p. 99.

(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.

Amendments, pp. 84 and 97.

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.

Advertisement, p. 80.
Rules 47 to 49, p. 661.
Date of registration, sec. 16, pp. 81 and 324.
Certificate of registration, sec. 17, p. 81.

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.

Opposition to registration, p. 85.
Prescribed time, one month, Rule 51, p. 662. Enlargement of time, Rule 99, p. 688.
Summary of procedure on an opposed application, p. 89.

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

Notice of opposition, p. 88. Form TM No. 7, p. 681.
If registration is opposed on the ground of resemblance to registered marks, the numbers of such marks and of the journals in which they have been advertised are to be set out, Rule 52, p. 662.
Precedent of notice of opposition, p. 718.

(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.

Counter-statement, p. 85. Form TM No. 8, p. 682. Precedent, p. 718.
"Prescribed time," one month from the date of receipt of the duplicate notice of opposition, Rule 53, p. 662.
The applicant should set out what facts, if any, alleged in the notice of opposition he admits, *ibid.*
Abandonment of application, p. 80.

(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.

Evidence, p. 87. Rules 54 to 58, p. 662.
Hearing by Registrar, p. 87. Rule 59, p. 663.
Conditions, p. 76.

(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.

Appeal from the Registrar, p. 92.
Appeal to the Court, p. 94. "Prescribed manner," by motion within one month from the date of decision, Rule 121.
Appeal to the Board of Trade, p. 92. Rules 122 to 127, p. 671. Form TM No. 29, p. 695. Time, within one month from the date of decision, Rule 122, p. 671. Precedent of appellant's case, p. 719.
Reference by Board of Trade to Court, sec. 59, p. 92.
Directions by Board of Trade, p. 721. Rule 125, p. 672.
Notice of hearing of appeal by Board of Trade, Rule 126, p. 672.

(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.

Prescribed manner, directions by Board of Trade, Rule 125, p. 672.
Costs, p. 99.

(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.

Modification of trade mark, p. 97, cf. sec. 12 (2) and (4). "Not substantially affecting the identity of such trade mark," cf. sec. 9, old marks, sec. 26, sec. 27 and sec. 34.
Advertisement, p. 80.

(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.

Costs before the Registrar, p. 89.
Costs on appeal to the Board of Trade, p. 101.

(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.

Security for costs, p. 102. Rule 61, p. 663.

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.

Disclaimers, Chap. IX., p. 212.
Effect of disclaimer, p. 219.
Essential particulars, p. 134.
Parts of a trade mark may be separately registered, see Associated Trade Marks pp. 109 and 214, and sec. 25.
Matter common to the trade, p. 215.
The three mark rule, p. 215.
A disclaimer may be required in rectification proceedings under sec. 35 as a condition of the trade mark remaining on the register, p. 297.
The proviso renders obsolete the decision in *Rosenthal* v. *Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, which was to the contrary effect, see p. 219.
A disclaimer is not to be required, unless some special reason for it is made out, p. 214.

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.

Where a trade mark has been accepted by error the Registrar may withdraw his acceptance subject to appeal, Rule 63, p. 663.

Date of registration, p. 81. Cf. as to marks registered under prior Acts, secs. 6 and 36, and see p. 132.

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. Certificate of registration.

Prescribed form. Rule 67, p. 664. Form O., No. 2, p. 683. No fee. As to other certificates, see secs. 50 and 51, and Rules 102 and 104, and table of forms, p. 676. There is a general right to have a certified copy of any entry in the register on payment of the prescribed fee, sec. 7.

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. Non-completion of registration.

Abandonment of application, p. 80. It is no bar to a fresh application, *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. 145 (1886), Stirling, J.

The ordinary length of notice is fourteen days, but the Registrar may give a further time where the applicant lives at a distance, Rule 62, p. 663.

Identical Trade 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. Identical marks.

Duplicate marks, p. 221.

Mark resembling a registered mark, p. 234.

"Except, &c." See also secs. 20 and 21. Old marks, p. 198. Three mark rule, p. 224.

An application to the Court must be served on the Registrar and an office copy of an order under the section must be left at the Patent Office, rule 129, p. 672.

For procedure, see p. 225.

Belonging to a different proprietor, cf. sec. 24.

Same goods or description of goods, p. 228.

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 Rival claims to identical marks.

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.

Duplicate registration, pp. 225 and 264.
Concurrent claims, p. 225.
Same goods or description of goods, p. 228.
"Determined by the Court," procedure, p. 225.
"Settled by agreement," p. 226.

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.

Duplicate registration, pp. 228 and 264.
Concurrent user, p. 264.
Same goods or description of goods, p. 228.
Conditions and limitations, pp. 76, 265.
As to rights of proprietors of duplicate marks, sec. 39, p. 325.

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.

Assignment and devolution, Chap. XIII., p. 345.
Registration of assignments, &c., sec. 33. See notes to that section. Rules 76 to 81, p. 665.
A trade mark must be registered in respect of particular goods or classes of goods, sec. 8; and the exclusive right to the use of it conferred by registration is confined to the goods in respect of which it is registered, sec. 39, p. 327.
The registered proprietor has power to assign a trade mark and give receipts for any consideration, sec. 38, p. 353.
Determination of trade mark rights, Chap. XIV., p. 362.
Goodwill, pp. 359 and 367.
As to the proviso, see p. 351.

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.

Rights on dissolution of partnership, Chap. XIII., p. 352.
Rules 87 to 89, p. 666. A note of the apportionment and the date of the decision is to be entered on the register.
Appeal to the Board of Trade, rules 122 to 127, p. 671.
The Board of Trade may refer an appeal to the Court, sec. 59, p. 618.
Associated trade marks, secs. 24 to 27.

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.

Associated trade marks, p. 107. They comprise (1) a set of marks associated under this section; (2) series of trade marks, sec. 26; and (3) a set of trade marks constituted by the registration of a trade mark and of one or more parts of it, sec. 25.

The section has nothing to do with the registration of identical marks belonging to the same proprietor, per Kekewich, J., in *Birmingham Small Arms Application*, [1907] 2 Ch. 396; 24 R. P. C. 563. Cf. secs. 19 and 20, as to marks belonging to different proprietors. This section was inserted to meet the difficulty caused by the decision in *Players & Sons' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65.

The fact of association is to be noted on the register against each mark, rule 65, p. 664.

Associated trade marks are only assignable or transmissible as a whole, sect. 27.

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.

See notes to sec. 24.

A trade mark, *e.g.*, a label, often contains distinctive parts, which under this section may be registered subject to the condition of association. A part separately registered cannot be required to be disclaimed under sec. 15.

The proviso was inserted in view of sec. 37, enabling a trade mark to be removed from the register on the ground of non-user, see p. 109.

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.

Series of trade marks, p. 110.
Application for a series of trade marks, rule 27, p. 659.
Fee, 1a, List of Fees, p. 673.
Advertisement of a series, rule 49, p. 662.
See also notes to sec. 24, as to associated trade marks generally.

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.

Assignment of trade marks, Chap. XIII., p. 345.
Associated trade marks, p. 107. See notes to sec. 24.
Rules as to assignment, rules 76 to 81, p. 665.
As to the proviso, see sec. 37, non-user of trade mark.
"Not substantially affecting the identity," cf. sec. 9, old marks, secs. 14 (9), 26 and 34.

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, p. 372. Rules 68 to 75, pp. 664, 665.
And see notes to secs. 29 and 30.

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."

"Prescribed period," not less than two months nor more than three months before expiration, rule 68, p. 664.
Renewal is to be advertised in the Journal, rule 75, p. 665.

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. 372.
Renewal of registration, p. 372.
The rules provide for two notices by the Registrar and an advertisement in the Journal before removal, rules 70 to 74, pp. 664, 665. See also the summary of prescribed procedure, p. 374. The forms are there referred to.
What conditions may be required, p. 375.
The cause of removal is to be entered on the register, rule 74, p. 665.

Status of unrenewed trade mark.

31. Where a trade mark has been removed from the register for non-payment 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.

Under this section a trade mark, though removed from the register, may be a ground of refusal of registration for an identical or similar mark, see secs. 19 and 20 and p. 375.

"No *bonâ fide* trade user, &c." Cf. sec. 37.

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.

Correction and cancellation of entries at the proprietor's request, p. 313.

As to changes of proprietorship, see sec. 33. As to alteration of a trade mark, see sec. 34.

"Goods or classes of goods," sec. 8.

Disclaimers, Chap. IX., p. 212.

Rules 82, and 90 to 92. Form for alteration of address, TM No. 20. p. 688. Form for entry of change of name, TM No. 23. p. 689. Form for cancellation of entry, TM No. 24. p. 689. Form of request to strike out particular goods, TM No. 25, p. 690. Form of request to enter a disclaimer or memorandum, TM No. 26. p. 690.

An appeal may be referred by the Board of Trade to the Court, sec. 59, p. 618.

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.

Assignment and devolution of trade marks, Chap. XIII., p. 345.

Registration of assignment, p. 357.

"Subject to the provisions of this Act," secs. 22 and 27.

As to the power of the registered proprietor to assign, and as to notice of equities, see notes to sec. 38.

As to changes of name and address, see sec. 32.

"Prescribed manner," rules 76 to 81, p. 665. Form of joint request by registered proprietor and assignee to register assignee, TM No. 16. p. 686. Declaration in support, TM No. 17. Request by subsequent proprietor only to register him, Form TM No. 18. A case is to accompany the request, rule 78, p. 665. Declaration in support, TM No. 19, p. 687.

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.

Alteration of registered trade mark, p. 316.
"Prescribed manner," rules 93 and 94, p. 667. Form TM No. 27, p. 690.
Advertisement. Cf. sec. 13.
The Board of Trade may refer an appeal to the Court, sec. 59.

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.

Rectification of the Register, Chap. XI., p. 276.
As a defence, p. 410.
"Subject to the provisions of this Act," see especially secs. 40 and 41.
"The Court," p. 303.
"Person aggrieved," p. 279.
Costs, p. 311. Security for costs by a foreigner, p. 312.
Procedure, p. 303.
The Registrar must be served, rule 129, and see sec. 47. An office copy of any order made must be left at the Office, Form TM 30, rule 129.
Form, p. 723.

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.

Page 132.
"Registrable trade mark," see sec. 3, p. 26.
The facts at the date of the decision are to be considered with reference to the law at that date, *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513: 24 R. P. C. 545; 25 R. P. C. 156. See, however, the judgment of Parker, J., in *Philippart* v. *Whiteley, Ltd.*, [1908] 2 Ch. 274: 28 R. P. C. 565.
The trade mark, if upheld, retains its original date, sec. 6, p. 601.

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.

Removal on the ground of non-user, p. 292.
"Person aggrieved." p. 279.
Abandonment, p. 370.
User of trade marks associated with that in question may under some circumstances be accepted as equivalent to user of the trade mark, secs. 25 and 27.

Effect of Registration.

38. Subject to the provisions of this Act—

Powers of registered proprietor.

(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.

Assignment and devolution of trade marks, Chap. XIII., p. 345.
Registration of assignments, &c., sec. 33, p. 357.
"Subject to the provisions of this Act," sec. 22. trade marks are only assignable with goodwill, p. 345. and sec. 27, associated trade marks are not separately assignable. p. 108.
Equities, p. 356.
Notice of trusts is not to be entered on the register. p. 59.

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.

Effect of registration. Chap. XII., p. 321.
Registration. evidence of validity, *primâ facie*, sec. 40, p. 329, and after seven years conclusive, sec. 41. p. 330.
Limitations and conditions. see secs. 10, 12, 14, 21, and the notes thereto.
Test of infringement where the registered trade mark is actually copied, p. 397. For deceptive resemblance, see pp. 234 *et seq.*, and pp. 400 *et seq.*
Concurrent registration. pp. 225 and 400.
Definition of rights by the Court, see secs. 20 and 21.
The exclusive right conferred by this section is subject to the savings contained in sec. 44, as to the *bonâ fide* use by a person of his own name or place of business and *bonâ fide* descriptions of goods.

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.

Effect of registration, Chap. XII., p. 321.
See notes to secs. 39 and 41.
Sec. 35, Rectification, Chap. XI., p. 276.

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.

Registration conclusive evidence of validity, p. 330.
The first part of the section cannot come into operation until August 11th, 1912.
Fraud, p. 332. Sec. 11, p. 266.
As to the proviso, see concurrent user, pp. 264, 411, and concurrent registration, pp. 225, 264.

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.

Registration as a condition precedent to an action for infringement, pp. 334, 386.
The prohibition does not affect actions for passing-off, sec. 45, p. 338. It applies to foreigners, p. 337.
August 13th, 1875, is the date of the commencement of the first Registration Act. Old marks, p. 198.
Form of request for certificate of refusal, TM No. 32. p. 696.

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.

Infringement, Chap. XV., p 377.
Evidence as to get-up, &c., p. 405.

User of name, address, or

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. description of goods.

Page 419.
Right to honest use of one's own name, pp. 419, 532.
Descriptive words, pp. 37, 183, 252, 507.

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. "Passing-off" action.

Passing-off, Chap. XVI., p. 477.
Non-registration not a bar to an action for passing-off, pp. 338, 481.
Cf. sec. 42.

Legal Proceedings.

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. Certificate of validity.

Certificate of validity, pp. 309, 466. May be given in rectification proceedings, p. 310.

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. Registrar to have notice of proceeding for rectification.

Notice of every application to the Court under the Act is to be served on the Registrar, rule 129, p. 672.
Rectification, Chap. XI., p. 277.
Alteration of trade marks, p. 316.
Evidence, p. 307.
In cases under secs. 23, 32, 33 or 34, the matter would come before the Registrar in the first instance. The words "the grounds of any decision" appear, however, not to be confined to the decision (if any) under appeal, but would include, *e.g.*, a decision when the mark was registered.
The Court may review any decision of the Registrar relating to the entry in question, sec. 54, p. 617.

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 in applications to register, p. 99.
Costs in rectification proceedings, p. 311.
The Registrar is entitled as a general rule to have his costs, p. 99.

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.

Evidence in applications to register, pp. 87, 93, 94.

As to the powers of an official referee to require the attendance of witnesses and to take evidence on oath, see Order XXXVI., r. 49, and the Arbitration Act, 1889.

As to the Registrar's power to dispense with evidence, see Rule 97, p. 668.

"On oath" and "affidavit," see Interpretation Act, 1889, sec. 3, p. 652.

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.

Pages 62, 63. Cf. sec. 51.

The Register, sec. 4, p. 57. Inspection and extracts, sec. 7, p. 61.

Seal of the Patent Office, Patents and Designs Act, 1907, sec. 64, replacing sec. 84 of the Act of 1883.

Fees, see sec. 7.

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.

Pages 62, 63. Cf. sec. 50.

See also rule 102, and certificate of registration under sec. 17 (on registration), Form O., No. 2, p. 683.

Request for general certificate. Form TM No. 31, p. 696. Request for certificate of refusal to register, Form TM No. 32, p. 696. Request for certificate of registration for use in obtaining registration abroad, Form TM No. 33, p. 697. Request for certificate of registration to be used in legal proceedings, Form TM No. 34, p. 697. Request for certificate under sec. 64 (12) (deposit of cotton mark), Form Cotton No. 3, p. 693. Certificate under same Form. MB No. 1, p. 694. Request for certificate of Keeper of Cotton Marks of registration. Form Cotton No. 4, p. 694. General certificate of Keeper of Cotton Marks, Form MB No. 2, p. 695.

Fees marked on Forms, or see List of Fees, p. 673.

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 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.

"Prescribed time," one month from the date when the matter has arisen, 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 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.

As to appeal to the Court direct, see secs. 12. 14. 33, 63 (9) (Sheffield Marks), and 64 (5) (Cotton Marks).

The Board of Trade may refer an appeal to the Court, sec. 59.

Rectification of the Register, sec. 35, p. 276; and in appeals direct from the Registrar under sec. 33, p. 357; and in referred appeals under sec. 32 (p. 313) or sec. 34 (p. 316).

By rule 63 (p. 663) an appeal is given where registration is refused on the direction of the Board of Trade after acceptance.

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 by special leave of the Board of Trade be done by or to an agent of such party duly authorised in the prescribed manner.

Agents, p. 63.

Authorisation of agents, rule 2. p. 655.

As to agents generally, rule 10. p. 656. Form of authorisation, TM No. 1. p. 677.

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.

Pages 58, 77.

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.

The Comptroller, p. 58.

The official reports of Patents, Designs and Trade Marks are published under sec. 46 of the Patents and Designs Act, 1907.

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.

Rights of appeal to the Board of Trade are given by secs. 12, 14 (by consent), 20, 23, 32, 33 and 34. In some of these cases, there is an alternative appeal to the Court.

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.

The Rules of 1906, which came into force after March 31st, 1906, that is to say, with the commencement of the Act, are printed below, p. 655. Table of Fees, p. 673. Forms, pp. 676 *et seq.* Classification of goods, pp. 697 *et seq.*

"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, sec. 3.

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.

Table of Fees, p. 673.

Special Trade Marks.

Standardisation, &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.

Standardisation Marks, pp. 83, 208.
Procedure, p. 84; rules 42 to 46, p. 661.
"Person" includes any body of persons corporate or incorporate. Interpretation Act, 1889, sec. 19, p. 652.

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.

Sheffield marks, Chap. VI , p. 112.
Procedure, p. 118 ; rules 107 to 112, pp. 669.
"The Court" means in England the High Court of Justice, sec. 3.
"Person aggrieved, cf. sec. 35, and see p. 279.
Certificate of the Registrar, sec. 51.

Cotton Marks.

Cotton marks.

64. (1) The Manchester Branch of the Trade Marks Registry of the Patent Office (hereinafter 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 (hereinafter 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 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.

Cotton Marks, Chap. VII., p. 121.

Classes 23, 24 and 25, under the former classification included the same goods as the present Classes 23, 24 and 25, see p. 121; but Class 23 was differently subdivided, see p. 121.

Procedure, p. 122; Rules 113 to 120, p. 670.

"Person aggrieved," cf. sec. 35, and see p. 279.

"Passing of the Act," August 11th, 1905. The Act generally only came into force on April 1st, 1906.

"The Court" means in England the High Court of Justice, sec. 3, but as regards cotton marks, the Court of Chancery of the County Palatine of Lancaster has a co-ordinate jurisdiction, sec. 71.

Request for certificate under sub-sec. (12), Form Cotton No. 3, p. 693; certificate, Form MB No. 1, p. 694. Request for general certificate, Form Cotton No. 4, p. 694; certificate, Form MB No. 2, p. 695.

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. 576.

Secs. 103 and 104 of the Patents, &c. Act, 1883, and the amending section are

repealed by the Patents and Designs Act, 1907, and replaced by sec. 91 of that Act which so far as relates to trade marks is set out above, p. 577.

The International Conventions of 1883 (signed at Paris, March 20th, 1883, ratified June 6th, 1884) and 1891 (signed at Madrid, April 14th, 1891, ratified June 15th, 1892) are printed at p. 743, and the list of foreign States and British Possessions to which sec. 91 is applicable at p. 741.

Definition of "British Possession," Patents and Designs Act, 1907, sec. 93.

Great Britain did not sign the arrangement relating to the International Registration of trade marks of 1891.

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 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.

Page 585.

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.

Page 584. Cf. Rule 11, p. 657.

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.

Pages 386 and 585.

Courts.

General saving for jurisdiction of Court.

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.

"The Court" is by sec. 3 defined to mean (subject to the provisions for Scotland, Ireland and the Isle of Man) the High Court of Justice in England.

As to rectification of the Register in or under proceedings in Scotland or Ireland, see p. 303.

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.

Pages 94, 303.

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.

"The Manchester Branch," Chap. VII., p. 121.

"Other proceeding" includes the special jurisdiction on rectification under sec. 35, and also jurisdiction upon appeals under sec. 64 (5).

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.

The repeal is of all parts of the Acts of 1883 and 1888, which relate to trade marks, except secs. 103 and 104 (International and Colonial Arrangements) which are now repealed and are replaced by sec. 91 of the Patents and Designs Act, 1907, sec. 106 (penalty on unauthorised use of Royal Arms, replaced by sec. 90 of the Patents

and Designs Act, 1907 (see also sec. 68 of the Act of 1905), and secs. 82, 83 and 84, which related to the constitution and seal of the Patent Office, which are now replaced by secs. 62, 63 and 64 of the Patents and Designs Act, 1907.

The former rules of 1890, and the amending rules of 1897 and 1898, and the forms, table of fees, and classification of goods thereunder, were from March 31st, 1906, superseded by the Trade Mark Rules, 1906, with new forms, table of fees and classification; these are printed below, pp. 655 to 701.

The commencement of the Act, except where otherwise provided, was April 1st, 1906.

The general saving provisions of sec. 38 of the Interpretation Act, 1889, apply, see p. 654.

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 sec. 73.

SCHEDULE.

Section 73.

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 IV.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.[1]

AS AMENDED BY THE ACT OF 1888.

ARRANGEMENT OF SECTIONS.

PART I.—PRELIMINARY.

SECTION
1. Short title.
2. Division of Act into parts.
3. Commencement of [the Acts].

PART IV.—TRADE MARKS.

Registration of Trade Marks.

62. Application for registration.
63. Limit of time for proceeding with application.
64. Conditions of registration of trade mark.
65. Connexion of trade mark with goods.
66. Registration of a series of marks.
67. Trade marks may be registered in any colour.
68. Advertisement of application.
69. Opposition to registration.
70. Assignment and transmission of trade mark.
71. Conflicting claims to registration.
72. Restrictions on registration.
73. Further restriction on registration.
74. Saving for power to provide for entry on Register of common marks as additions to trade marks.

Effect of Registration.

75. Registration equivalent to public use.
76. Right of first proprietor to exclusive use of trade mark.
77. Restrictions on actions for infringement, and on defence to action in certain cases.

[77a. Certificate as to exclusive use and costs thereon.]

Register of Trade Marks.

78. Register of trade marks.
79. Removal of trade mark after fourteen years unless fee paid.

Fees.

80. Fees for registration, &c.

Sheffield Marks.

81. Registration by Cutlers' Company of Sheffield marks.

[1] Now repealed by the Act of 1905, or, as to sections not so repealed, namely, sections 82 to 84, 103, 104, and 106, by the Patents and Designs Act, 1907. For tables of corresponding sections see above, pp. 592 *et seq.*

PART V.—General.

Patent Office and Proceedings hereat.

SECTION
82. Patent Office.
83. Officers and clerks.
84. Seal of Patent Office.
85. Trust not to be entered in Registers.
86. Refusal to grant patent, &c. in certain cases.
87. Entry of assignments and transmissions in Registers.
88. Inspection of and extracts from Registers.
89. Sealed copies to be received in evidence.
90. Rectification of Registers by court.
91. Power for Comptroller to correct clerical errors.
92. Alteration of registered mark.
93. Falsification of entries in Registers.
94. Exercise of discretionary power by Comptroller.
95. Power of Comptroller to take directions of law officers.
96. Certificate of Comptroller to be evidence.
97. Applications and notices by post.
98. Provision as to days for leaving documents at office.
99. Declaration by infant, lunatic, &c.
100. Transmission of certified printed copies of specifications, &c.
101. Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.
102. Annual reports of Comptroller.
[102a. Proceedings of Board of Trade.]

International and Colonial Arrangements.

103. International arrangements for protection of inventions, designs, and trade marks.
104. Provision for colonies and India.

Offences.

105. Penalty on falsely representing articles to be patented.
106. Penalty on unauthorised assumption of Royal arms.

Scotland; Ireland; &c.

107. Saving for courts in Scotland.
108. Summary proceedings in Scotland.
109. Proceedings for revocation of patent in Scotland.
110. Reservation of remedies in Ireland.
111. General saving for jurisdiction of courts.
112. Isle of Man.
[112a. Jurisdiction of Lancashire Palatine Court.]

Repeal; Transitional Provisions; Savings.

113. Repeal and saving for past operation of repealed enactments, &c.
114. Former Registers to be deemed continued.
115. Saving for existing rules.
116. Saving for prerogative.

General Definitions.

117. General definitions.

The First Schedule.—Forms of application, &c.

The Third Schedule.—Enactments repealed.

46 & 47 Vict. c. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

[25th August, 1883.]

51 & 52 Vict. c. 50.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[24th December, 1888.]

*** The general text of the Act of 1883 is adhered to. The parts repealed by the Act of 1888 are printed in italics, and the additions in square brackets. The amending Act and section are quoted in the margin. The whole Act is now repealed, see above, p. 626, n. (1); for tables of corresponding sections of the Act of 1905 and of the repealed Acts, see above, pp. 592 and 595.

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

PART I.—Preliminary.

Short title.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

Division of Act into parts.

2. This Act is divided into parts, as follows:—

Part I.—Preliminary.
II.—Patents.
III.—Designs.
IV.—Trade Marks.
V.—General.

Commencement of Act.

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.

Act, 1888, s. 28.

[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.]

PART IV.—Trade Marks.

Registration of Trade Marks.

Application for registration.

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

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

Act, 1888, s. 8.

(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.

[(6.) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.] Act, 1888, s. 8.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned* [the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned]. Limit of time for proceeding with application. Act, 1888, s. 9.

64. (1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:—* Conditions of registration of trade mark. Repealed. Act, 1888, s. 10.

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

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

(*c*) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

(2.) *There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade mark under this part of this Act.*

64. [(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:— Conditions of registration of trade mark. Act, 1888, s. 10.

(a) A name of an individual or firm printed, impressed, or woven in some particular or 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 *two months* [one month or such further time, not exceeding three months, as the Comptroller may allow] of the *first* advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the Comptroller shall send one copy of such notice to the applicant.

Act, 1888, s. 13, sub-s. 3.

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

Repealed.

(3.) *If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and*

shall require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn. Act, 1888, s. 13, sub-s. 4.

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*

[(3.) If the applicant sends such counter statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.] Act, 1888, s. 13, sub-s. 4.

[(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.

(2.) [Except as aforesaid] the Comptroller shall not register with respect to the same goods or description of goods a trade mark *so nearly resembling* [having such resemblance to] a trade mark already on the Register with respect to such goods or description of goods as to be calculated to deceive. Act, 1888, s. 14.

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 pro-

74. (1.) Nothing in this Act shall be construed to prevent the Comptroller entering on the Register, in the prescribed manner, and

vide for entry on Register of common marks as additions to trade marks.

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 the application is made;

(b) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

Repealed. Act, 1888, s. 16.

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the Register.*

Act, 1888, s. 16.

[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.]

(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. Act, 1888, s. 17.

75. *Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*

[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.]

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,

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.

and on defence to action in certain cases.

[**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.]

Certificate as to exclusive use and costs thereon.

Act, 1888, s. 18.

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.

Register of trade marks.

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.

Removal of trade mark after fourteen years, unless fee paid.

(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

Act, 1888, s. 19, sub-s. 1.

Act, 1888, s. 19, sub-s. 2.

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].

Fees.

Fees for registration, &c.

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.

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

(1.) The Cutlers' Company shall establish and keep at Sheffield a new Register of trade marks (in this Act called the Sheffield Register):

Act, 1888, s. 20. subs. 1.

(2.) *The Cutlers' Company shall enter in the Sheffield Register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the Register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such Register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the Register established under the Trade Marks Registration Act, 1875:*

Act, 1888. s. 20. subs. 1.

38 & 39 Vict. c. 91.

[(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 there[illegible] 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:]

(3.) An application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel*

and iron combined, whether with or without a cutting edge [on metal goods] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company : Act, 1888, s. 20, sub-s. 2.

(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 :

(7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield Register ; and notice of every entry made in the Sheffield Register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register :* 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. 3.

(8.) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel*

Act, 1888, s. 20, sub-s. 2.

and iron combined, whether with or without a cutting edge [on metal goods], he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(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:

Act, 1888, s. 20, sub-s. 4.

[(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.]

[(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield Register a certificate under the hand of the master of the 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.

Trust not to be entered in Registers.

85. There shall not be entered in any Register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied, or constructive.

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.

Act, 1888, s. 24.

[(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered.]

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.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the patent office after the commencement of this Act, printed for and sealed with the seal of the patent office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the patent office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying

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:

goods and regulating business of patent office.

(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.

[**102a.** (1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.]

Act, 1888, s. 25.

[(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in

evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.]

[(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.]

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 unauthorised 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.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

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.

Jurisdiction of Lancashire Palatine Court.

Act, 1888, s. 26.

[**112a.** The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.]

Repeal, Transitional Provisions, Savings.

Repeal and saving for past operation of repealed enactments, &c

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(a) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Former Registers to be deemed continued.

114. (1.) The Registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of patents kept under this Act.

(2.) The Registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of designs and the Register of trade marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

"Law officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller General of Patents, Designs, and Trade Marks.

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

Section 62.

FORM F.

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

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 V.

THE TRADE MARKS REGISTRATION ACTS, 1875—77.

THE TRADE MARKS REGISTRATION ACT, 1875.

38 & 39 Vict. c. 91.

An Act to establish a Register of Trade Marks.

[13th August, 1875.]

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

Registration of trade marks.

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

Characteristics of registered trade mark.

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

Title of first proprietor of a trade mark.

3. *The registration of a person as first proprietor of a trade mark shall be primâ facie evidence of his right to the exclusive use of such trade mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence of his right to the exclusive use of such trade mark, subject to the provisions of this Act as to its connection with the goodwill of a business.*

Title of proprietor claiming by transmitted proprietorship.

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

Rectification of Register.

5. *If the name of any person who is not for the time being entitled to the exclusive use of a trade mark in accordance with this Act, or otherwise in accordance with law, is entered on the Register of trade marks as a proprietor of such trade mark, or if the Registrar refuses to enter on the Register as proprietor of a trade mark the name of any person who is for*

the time being entitled to the exclusive use of such trade mark in accordance with this Act, or otherwise in accordance with law, or if any mark is registered as a trade mark which is not authorised to be so registered under this Act, any person aggrieved may apply in the prescribed manner for an order of the Court that the Register may be rectified; and the Court may either refuse such application, or it may, if satisfied of the justice of the case, make an order for the rectification of the Register, and may award damages to the party aggrieved.

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

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

The Court may direct an issue to be tried for the decision of any question of fact which may require to be decided for the purposes of this section.

Whenever any order has been made rectifying the Register the Court shall by its order direct that due notice of such rectification be given to the Registrar.

Restrictions on registry of trade marks.

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

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

Establishment of registry and general rules.

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

any matter in which the judgment or leave of the Court is required to be obtained under this Act, and generally for the purpose of carrying into effect this Act, as he may deem expedient.

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

Certificate of Registrar to be evidence.

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

Provision as to Cutlers' Company and Sheffield corporate marks.

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

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

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

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

(4.) *The Registrar under this Act, without the special leave of the Court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with*

respect to which a Sheffield corporate mark shall have been assigned and actually used, and of which mark a copy or description or notice of the assigning whereof shall have been delivered or given to the Registrar as aforesaid, register a trade mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive:

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

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

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

Definitions.

10. *For the purposes of this Act—*

A trade mark consists of one or more of the following essential particulars; that is to say,

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

A written signature or copy of a written signature of an individual or firm; or

A distinctive device, mark, heading, label, or ticket;

and there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures; also

Any special and distinctive word or words or combination of figures or letters used as a trade mark before the passing of this Act may be registered as such under this Act.

"Prescribed" means prescribed by general rules made in pursuance of this Act; and

"Court" means any of Her Majesty's superior Courts of law or equity at Westminster, or any Court to which the jurisdiction of such Courts may be transferred, or any one or more of such Courts which may be declared to be the Court for the purposes of this Act by such general rules as aforesaid; but the provisions of this Act conferring a special jurisdiction on the Court as above defined shall not, excepting so far as such jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in causes, actions, suits, or proceedings relating to trade marks; and if the Register requires to be rectified in consequence of any proceedings in any such Court in Scotland or Ireland, due notice of such requirements shall be given to the Registrar, and he shall rectify the Register accordingly.

Short title of Act.

11. *This Act may be cited for all purposes as the Trade Marks Registration Act,* 1875.

THE TRADE MARKS REGISTRATION AMENDMENT ACT, 1876.

39 & 40 VICT. c. 33.

An Act for the Amendment of the Trade Marks Registration Act, 1875. [24th July, 1876.]

38 & 39 Vict. c. 91.

Whereas by the Trade Marks Registration Act, 1875, *in this Act referred to as the principal Act, it is provided that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by the principal Act until and unless such trade mark is registered in pursuance of that Act:*

And whereas by reason of the number of trade marks, and especially by reason of the difficulties attending the registration of trade marks in relation to textile fabrics, it has been found impossible to complete the registration of existing trade marks within the time specified by the said section; and it is therefore expedient to prolong the time for the completion of such registration as aforesaid, and otherwise to amend the principal Act:

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

Amendment of s. 1 of the principal Act.

1. *There shall be repealed so much of section one of the principal Act as provides that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by that Act until and unless such trade mark is registered in pursuance of that Act, and in place thereof be it enacted that—*

From and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade mark as defined by the principal Act until and unless such trade mark is registered in pursuance of that Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused as hereinafter is mentioned.

Saving of marks and devices not capable of being registered under Act.

2. *When an application by any person to register as a trade mark a device, mark, name, word, combination of words, or other matter or thing proposed for registration as a trade mark, which has been in use as a trade mark before the passing of the recited Act, has been refused, it shall be the duty of the Registrar, on request, and on payment of the prescribed fee, to give to the applicant a certificate of such refusal, and a certificate so granted shall be conclusive evidence of such refusal.*

Short title.

3. *This Act may be cited for all purposes as the Trade Marks Registration Amendment Act*, 1876.

THE TRADE MARKS REGISTRATION EXTENSION ACT, 1877.

40 & 41 Vict. c. 37.

An Act for extending the Time for the Registration of Trade Marks, in so far as relates to Trade Marks used in Textile Industries.

[6th August, 1877.]

Whereas by section one of the Trade Marks Registration Amendment Act, 1876, *it is provided that from and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade mark as defined by the Trade Marks Registration Act*, 1875 (*referred to in such Amendment Act and in this Act as the principal Act*), *until and unless such trade mark is registered in pursuance of the principal Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused, as is in the said Act hereafter mentioned:* 39 & 40 Vict. c. 33. 38 & 39 Vict. c. 91.

And whereas by reason of the difficulties attending the registration of trade marks used in the textile industries it has been found impossible to complete the registration of such trade marks within the time specified by the said section, and it is therefore expedient to prolong such time as aforesaid:

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

Extension of time for registration of trade marks used in textile industries.

1. *In so far as relates to the registration of trade marks used in the textile industries, but not further or otherwise, section one of the Trade Marks Registration Amendment Act*, 1876, *shall be construed as if for the words "from and after the first day of July one thousand eight hundred and seventy-seven" there were substituted the words "from and after the first day of January one thousand eight hundred and seventy-eight, or such further time as Her Majesty may by Order in Council determine."*

Definition of "trade marks used in the textile industries."

2. *The expression in this Act "Trade Marks used in the textile industries" means the trade marks relating to goods comprised in Classes 23 to 35, both inclusive, of the First Schedule to the Rules under the Trade Marks Registration Acts*, 1875–76, *dated September*, 1876.

Short title of Act.

3. *This Act may be cited for all purposes as "The Trade Marks Registration Extension Act*, 1877," *and this Act and the Trade Marks Registration Amendment Act*, 1876, *and the Trade Marks Registration Act*, 1875, *may be cited together as "The Trade Marks Registration Acts*, 1875–77."

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.

APPENDIX VII.

TRADE MARKS RULES, 1906.[1]

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.

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,[2] shall have the meanings thereby assigned to them respectively. Interpretation.

"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.

3. The fees to be paid in pursuance of the said Act shall be the fees specified in the First Schedule to these Rules. Fees.

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. Forms.

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. Classification of goods.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Registrar.

[1] Statutory Rules and Orders, 1906, No. 233.

[2] A selection of extracts from this Act is printed above, p. 652.

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,[1] 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.

Royal 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 authorisation, 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

[1] See now sec. 84 of the Patents and Designs Act, 1907.

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 sec. 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 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 sec. 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 indorsed 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 indorsed and signed as aforesaid.

Procedure on Receipt of Application.

Search.

29. Subject to the provisions for special applications under paragraph 5 of sec. 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 Sec. 9.

Special applications under sec. 9, paragraph 5.

35. An application to register a name, signature, or word or words under paragraph 5 of sec. 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.

Result of search.

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.

Appeal by applicant.

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.

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.

Hearing.

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.

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 Sec. 62.

42. Where an association or person desires to register a mark under sec. 62 of the said Act they shall apply to the Registrar in writing upon the Form TM No. 6. Application under sec. 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 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. Report by Registrar.

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. Hearing.

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 sec. 12 of the said Act. Advertisement, &c.

Advertisement of Application.

47. Every application when accepted shall be advertised by the Registrar in the Journal during such time and in such manner as the Registrar may direct. Advertisement of application.

If no representation of the trade mark be inserted in connection 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.

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. Wood block or electrotype.

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 sec. 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.

Advertisement under sec. 14 (9).

50. Advertisements under sec. 14 (9) of the said Act shall *mutatis mutandis* be made in the same manner as advertisements relating to an application for registration.

Opposition to Registration.

Opposition.

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.

Notice of 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 Journals 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.

Counter-statement.

53. Within one month from the receipt of such duplicate the applicant shall send to the Registrar a counter-statement (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 counter-statement shall be accompanied by a duplicate in writing.

Evidence in support of opposition.

54. Upon receipt of such counter-statement 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 application.

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 reply by opponent.

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.

Further evidence.

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.

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 sec. 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-sec. 2 of sec. 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 sec. 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 sec. 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

71. At a time not less than 14 days and not more than 28 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.

Removal of trade mark from register.

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.

Advertisement of non-payment.

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 trade 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.

Removal of mark from register.

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.

Notice and advertisement of renewal.

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.

Joint request for entry of assignment.

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.

Request for entry of assignment by subsequent proprietor.

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.

Case accompanying 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.

Signature of request.

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 Sec. 23.

Application under sec. 23.

87. All applications to the Registrar under sec. 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 Sec. 32.

Application under sec. 32.

90. Applications under sec. 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 Sec. 34.

Alteration of trade mark.

93. Where a person desires to apply under sec. 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 sec. 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 genuinenessof 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 sec. 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 sec. 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-sec. 8 of sec. 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 sec. 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 sec. 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.

Directions by Board.

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.

Hearing of appeal.

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.

No appeal unless notice duly given.

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.

Withdrawal of Appeals.

Withdrawal of appeal.

128. Where under sec. 12 (5) or sec. 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.

Applications to and Orders of the Court.

Order of 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.

Every application to the Court under the said Act shall be served on the Registrar.

Publication of order of Court.

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.

Dated this 24th day of March, 1906.

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.	Corresponding 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 section 63, sub-section (2)	5 0 0	Sheffield No. 1
1*c*. On application to the Board of Trade under section 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 section 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 section 12, sub-section 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 section 9, paragraph (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 section 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 in no case to exceed £20 for any number of classes.		

		Corresponding Form.
	£ s. d.	
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	—
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 section 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—		
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 section 12 (6) or under section 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

		Corresponding Form.
	£ s. d.	
18a. 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 section 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
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 section 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
23a. 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 section 66 of the Patents, Designs and Trade Marks Act, 1883, or section 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.

Second Schedule.

FORMS.

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[1] The pages here inserted are those of this book, and not those actually inserted in the published Rules. The indicating letters and numbers of the forms are not in the Table of Forms as issued by the Patent Office.

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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*c* 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, (*a*) hereby give notice of my intention to oppose the Registration of the Trade Mark advertised under the above number for Class in the Trade Marks Journal of the day of , 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.

(*a*) 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 unstamped duplicate.)

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.

(a) ——

Dated this day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,
25, Southampton Buildings, Chancery Lane, London, W.C.

(a) Signature.

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.

Declared at this day of 19 .

(*f*) ——

Before me (*g*) ——

(*h*) ——

(*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.

(*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 .

(*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 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 Nos. .

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 8a.)

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).

( ) ——.

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 23a.)

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. 10s.)

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.

APPENDIX VII.

(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 5*s*.) 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 5*s*.)

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.

(Sd.) D. LLOYD-GEORGE,
President of the Board of Trade.

THIRD SCHEDULE.

CLASSIFICATION OF GOODS.

Illustrations.

Note.—Goods within the brackets are mentioned 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.)

APPENDIX VII.

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; threshing 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.)

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 metals; Sheffield and other plated goods; gilt and ormolu work.)

Class 15.

Glass. (Such as window and plate glass; painted glass; glass mosaic; glass beads.)

Class 16.

Porcelain and earthenware. (Such as china; stoneware; terra cotta; statuary porcelain; tiles; bricks.)

Class 17.

Manufactures from mineral and other substances for building or decoration. (Such as cement; plaster; imitation marble; asphalt.)

Class 18.

Engineering, architectural, and building contrivances. (Such as diving apparatus; warming apparatus; ventilating apparatus; filtering apparatus; lighting contrivances; drainage contrivances; electric and pneumatic bells.)

Class 19.

Arms, ammunition, and stores not included in Class 20. (Such as cannon; small-arms; fowling pieces; swords; shot and other projectiles; camp equipage; equipments.)

Class 20.

Explosive substances. (Such as gunpowder; gun-cotton; dynamite; fog-signals; percussion caps; fireworks; cartridges.)

Class 21.

Naval architectural contrivances and naval equipments not included in Classes 19 and 20. (Such as boats; anchors; chain cables; rigging.)

Class 22.

Carriages. (Such as railway carriages; waggons; railway trucks; bicycles; bath chairs.)

Class 23.

(*a*) Cotton yarn.
(*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.

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.

D. LLOYD-GEORGE,
President of the Board of Trade.

APPENDIX VIII.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE MARKS.

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1.—General.

It is advisable in the first instance for a person who desires to register a Trade Mark to buy a copy of the Trade Marks Rules, 1906, and of the Trade Marks Act of 1905 now governing the registration of Trade Marks. For information as to obtaining copies of the Rules and Act, *see* paragraph 26.

[1] The pages here inserted are those of this book, and not those actually inserted in the Instructions as issued from the Patent Office.

2.—Who may Apply for Registration of a Trade Mark.

Any person claiming to be the proprietor of a Trade Mark, whether a British subject or not, may make an application for the Registration of a Trade Mark in the United Kingdom.

The term "person" includes firm, partnership, and body corporate.

Any person who has made a previous application for Registration of a Trade Mark, which is registrable under the Trade Marks Act, 1905, either in any of the Foreign States or in any of the British Possessions (*see* paragraph 24) with which certain arrangements for mutual protection of Trade Marks have been made, may obtain priority of date in the United Kingdom, provided that the application is made within four months from the date of the application in such Foreign State or British Possession.

3.—What may be Registered as a Trade Mark.

Section 9 of the Trade Marks Act, 1905, provides as follows:—

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.

4.—Manner of Applying for Registration of a Trade Mark.

All applications and communications must be made in the English language.

Applications relating to marks not being cotton marks or Sheffield marks must be left at the Patent Office by hand or sent by post addressed to the Registrar, The Patent Office, Trade Marks Branch, 25, Southampton Buildings, London, W.C.

In the case of cotton marks, applications should be addressed to the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry, 48, Royal Exchange, Manchester (*see* paragraph 19).

In the case of Sheffield marks, applications should be addressed to the Law Clerk to the Cutlers' Company, The Cutlers' Hall, Sheffield (*see* paragraph 18).

Applicants must use the appropriate Stamped Forms (*see* paragraph 5), as fees cannot be received by cheque or money order or in cash at the Patent Office.

5.—Trade Mark Forms and Fees.

The following is a List of the Forms[1] under the Trade Marks Act, 1905, and of the principal fees:—

Number of Form.	Title of Form.	Fee. £	s.	d.
TM No. 1	Form of authorisation of Agent		—	
TM No. 2	Application for registration of Trade Mark	0	10	0
TM No. 3	Additional Representation of Trade Mark	No stamp.		
TM No. 4	Request for statement of grounds of decision under section 12 (3)	0	10	0
TM No. 5	Application for registration of Special Trade Mark under section 9 (5)	0	10	0
TM No. 6	Application for registration of Special Trade Mark under section 62	0	10	0
TM No. 7	Notice of Opposition to application for registration ...	1	0	0
TM No. 8	Counter-statement to opposition to application for registration	0	10	0
TM No. 9	Application for hearing in cases of opposition	1	0	0
TM No. 10	Application to the Board of Trade for hearing under Rule 38	1	0	0
TM No. 11	Fee for Registration of a Trade Mark	1	0	0
TM No. 12	Renewal of Registration before notice has been given by Registrar	1	0	0
TM No. 13	Renewal of Registration after notice has been given by Registrar	1	0	0
TM No. 14	Additional fee to accompany renewal fee within one month after advertisement of non-payment of renewal fee	0	10	0
TM No. 15	Restoration of Trade Mark where removed for non-payment of fee	1	0	0
TM No. 16	Joint request by registered proprietor and assignee to register assignee as subsequent proprietor	1	0	0
TM No. 17	Form of Declaration (only to be furnished when requested by Registrar) by assignee in support of Form TM No. 16		—	
TM No. 18	Request to enter name of subsequent proprietor upon register	1	0	0
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		—	
TM No. 20	Application for alteration of address on Register ...	0	5	0

[1] For the Forms, see above, pp. 677 *et seq.*; for Table of Fees, p. 673.

Number of Form.	Title of Form.	Fee. £ s. d.
TM No. 21	Application to permit an apportionment of Trade Marks	5 0 0
TM No. 22	Request for correction of clerical error or amendment of application...	0 5 0
TM No. 23	Request to enter change of name of registered proprietor	0 5 0
TM No. 24	Application to cancel entry on register	0 5 0
TM No. 25	Request to strike out goods from those for which a mark is registered	0 5 0
TM No. 26	Request to enter disclaimer or memorandum	0 5 0
TM No. 27	Application to add to or alter a Trade Mark	1 0 0
TM No. 28	Request for search under Rule 95	0 10 0
TM No. 29	Appeal from Registrar to Board of Trade...	1 0 0
TM No. 30	Notice of Order of Court for alteration of Register ...	0 10 0
TM No. 31	Request for general certificate	1 0 0
TM No. 32	Request for certificate of refusal to register	1 0 0
TM No. 33	Request for certificate of registration for use in obtaining registration abroad	0 5 0
TM No. 34	Request for certificate of registration for use in legal proceedings	1 0 0
	For office copies every 100 words, but never less than one shilling	0 0 4
	For certifying office copies MS. or printed matter ...	0 10 0
	An additional stamp duty of one shilling is also charged under the Stamp Act upon certified copies of certain documents.	

Stamped Forms are supplied on personal application at the Inland Revenue Office, in the Patent Office, Room 32, or, at a few days' notice and upon pre-payment of the value of the stamp, at any Money Order Office in the United Kingdom.

If it should not be convenient to apply in either of the ways above specified, the Stamped Forms can be ordered by post from the Controller of Stamps (Room No. 5), Inland Revenue Office, Somerset House, London, W.C. In this case a bankers' draft or a Money or Postal Order payable to the Commissioners of Inland Revenue and crossed Bank of England, to cover the value of the stamp and the cost of transmitting the form in a registered envelope by post, must be forwarded to Somerset House with the application for the form. Cheques will not be accepted.

Forms bearing the numbers TM No. 2, TM No. 3, and TM No. 11 are kept in stock at the following Post Offices in London :—

The General Post Office, E.C.
District Post Office, Lombard Street, E.C.
" 195, Whitechapel Road, E.
" 239, Borough High Street, S.E.
" Charing Cross, W.C.
" 28, Eversholt Street, Camden Town, N.W.
Post Office, 44, Parliament Street, S.W., and
The Chief Post Office of the undermentioned cities and towns :—

IN ENGLAND AND WALES.

Accrington.	Ashton-under-Lyne.	Barnsley.	Bedford.
Altrincham.	Bacup.	Bath.	Birkenhead.

IN ENGLAND AND WALES—*continued*.

Birmingham.	Driffield.	Manchester.	Sheffield.
Blackburn.	Droitwich.	Middlesbrough.	Southampton.
Bolton.	Dudley.	Newcastle.	Stafford.
Bournemouth.	Durham.	Newport (Mon.).	Stalybridge.
Bradford.	Exeter.	Northallerton.	Stockport.
Brighton.	Gloucester.	Northampton.	Stockton-on-Tees.
Bristol.	Goole.	Norwich.	Stoke-on-Trent.
Burnley.	Greenwich.	Nottingham.	Stourbridge.
Burslem.	Halifax.	Nuneaton.	Stroud.
Bury.	Hanley.	Oldbury.	Sunderland.
Cambridge.	Hartlepool.	Oldham.	Swansea.
Cardiff.	Huddersfield.	Plymouth.	Tamworth.
Carlisle.	Hull.	Pontypridd.	Truro.
Chatham.	Ipswich.	Portsmouth.	Tunstall.
Cheltenham.	Keighley.	Preston.	Wakefield.
Chester.	Kidderminster.	Reading.	Walsall.
Coventry.	Leamington.	Redditch.	Warrington.
Croydon.	Leeds.	Rochdale.	West Bromwich.
Darwen.	Leicester.	Rotherham.	Widnes.
Derby.	Lichfield.	Rugby.	Wigan.
Devizes.	Lincoln.	Salford.	Wolverhampton.
Dewsbury.	Liverpool.	St. Helen's.	Woolwich.
Doncaster.	Macclesfield.	Scarborough.	York.
Dorchester.			

IN SCOTLAND.

Aberdeen.	Greenock.
Dundee.	Inverness.
Edinburgh.	Leith.
Glasgow.	Perth.

IN IRELAND.

Belfast.	Limerick.
Dublin.	Waterford.
Galway.	Wexford.

6.—DOCUMENTS, &c., REQUIRED ON APPLICATION FOR REGISTRATION OF A TRADE MARK.

An application for the registration of a Trade Mark, under Section 9 (*see* paragraph 3), must be made on an application form (Form TM No. 2) bearing an impressed stamp of 10*s*. (*see* paragraph 5), but in the case of an application under the special provisions of Section 9 (5) in regard to names, signatures or words, Form TM No. 5 must be used.

(The applicant should, before filling up the form, carefully read the marginal notes.)

Four additional representations of the Trade Mark, each mounted on Form TM No. 3, should accompany every application on TM No. 2 or TM No. 5 (*see* paragraph 5).

A *separate* application form is required for *each* class in cases where the same trade mark is claimed in more than one class of goods.

If the mark be the property of a firm or partnership, the Form TM No. 2 should be signed by some one or more members of such firm or partnership, who should add, after his or their signature, "a member of the firm" or "members of the firm" (as the case may be); if of a body corporate, by a director or by the secretary or other principal officer, who should add, after his signature and designation, "for the company."

Applications may be made by agents in the names of and on behalf of the owners of trade marks. The agent must be duly authorised in writing, in the Form TM No. 1, by the owner or owners; the authority

to an agent should be signed by the owner or owners; in the case of a firm, partnership, or body corporate, the authority should be signed in the same manner as indicated in the paragraph next above.

Each application made by an agent should have, after the signature of the agent, the description "Agent."

When an applicant, or his authorised agent, for the registration of a trade mark, otherwise than under an International Convention, resides out of the United Kingdom at the time of making the application, an address for service in the United Kingdom must be given in the application.

When the mark consists of or includes words printed in other than Roman characters, there should be given upon the forms a translation and a transliteration of such words, signed by the applicant or his agent.

In the case of marks claimed in the Cotton Classes and Class 34, the applicant should state by what name the particular mark claimed would be referred to in the invoices of his house.

The representations of the mark on the Form TM No. 3 must agree *in every respect* with each other, and with that on the Form TM No. 2.

Representations of a mark of a large size may be folded. In that case they must, however, be backed with linen, tracing cloth, or other suitable material and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners. Photographs are not, as a rule, therefore, acceptable.

7.—Word Marks.

In most of the Classes, except the Cotton Classes, word marks are very popular. Speaking broadly, the Act debars from registration three kinds of words: (1) Geographical names; (2) surnames; (3) descriptive words; and it is frequently difficult to decide whether any given word falls under any of these heads. Cases often happen in which a person thinks he has invented a word, and yet on investigation it is found that such a word already exists, and falls under one of the heads above mentioned.

Again, though a given word may, after argument, be decided not to fall under one of the forbidden heads, yet the matter is so much on the border-line that much discussion can be raised before a final decision is reached.

It is very greatly to the advantage of a person adopting a new word mark—it being immaterial to him what word he adopts—to choose a word open to little or no discussion, and which clearly falls within paragraphs 3 or 4 of the ninth section of the Act. The Registrar will give what assistance he can on this subject, and it is suggested that an applicant desirous of adopting a new word mark should, before doing so, submit by letter a word, such as he thinks will suit his purpose, for the Registrar's consideration. The Registrar will of course only express an opinion as to how far a word submitted is within the section, and will make no search for the purpose of ascertaining whether any other person has a similar registered mark, unless a search fee is paid.

8.—Search.

A person wishing to adopt a trade mark may make application to the Registrar in writing upon a Form TM No. 28, to cause a search to be made to ascertain whether any marks are on record at the date of such search which may resemble the proposed mark, and the applicant will be informed of the result of such search. The request on Form TM No. 28 should be accompanied by two representations of the proposed mark, each mounted on a half-sheet of foolscap.

A person may, however, search amongst the classified representations of trade marks at the Trade Marks Branch of the Patent Office, if he so desire. The index includes a general collection of marks, a divisional index of devices, and an alphabetically arranged index of words appearing as parts of trade marks or alone. It must not be assumed, however, that all words contained in this index are protected by registration.

The fee payable by a person making a search is 1s. for every quarter of an hour.

Complete searches amongst classified collections of marks in the *Cotton Classes* (Classes 23, 24 and 25) can only be made at the Manchester Branch Office, 48, Royal Exchange, Manchester. *See* paragraph 19.

9.—Series of Trade Marks.

By section 26 of the Act, 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.

When an application is made for a series, a representation of each of the marks of the series must be affixed to Form TM No. 2, and also to each of the Forms TM No. 3.

10.—Old Marks.

In order that an application for an "Old Mark" may be treated as such, there must have been continuous user since before the date mentioned in paragraph 3, in the United Kingdom and in connection with the goods stated in the application. An applicant for such a mark should state how, *i.e.*, whether as a label, by branding or embossing or in any other manner, the mark has been so used. The Registrar may require a declaration verifying the statements made in such an application.

11.—Procedure on Receipt of Application.

As soon as may be following the receipt of an application and after due consideration and search, the Registrar will communicate the result to the applicant in writing.

12.—Non-completion of Registration of a Trade Mark.

When Registration is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the application may, after notice duly given, be treated as abandoned, unless it be completed within the time specified in such notice.

13.—Duration of Registration and Payment of Renewal Fees.

Registration of a trade mark is for a period of 14 years from the date of the original application, but may be renewed from time to time on payment of the prescribed fee.

Each renewal is for 14 years.

The fee for renewal should be paid in due time by lodging the proper form as directed by the rules.

If the renewal fee is not paid in due time, extra cost is incurred, and, possibly, the registration may entirely lapse.

14.—Classification of Goods.

A guide to the classification of goods under the Trade Marks Rules can be obtained on application at the Patent Office, Trade Marks Branch, and should be asked for if the applicant feels any difficulty in determining to which of the classes set out in the Third Schedule to the rules the goods for which he uses his mark belong.

15.—Advertisement in the Trade Marks Journal.

A trade mark cannot in any case be entered upon the Register until after the expiration of one month from the date of its advertisement in the Journal.

A wood-block or electrotype must be furnished for each mark (even though the mark consists only of a word or words) in each Class claimed, except in the case of the Cotton Classes, for which no blocks are required.

No block or electrotype should be forwarded until a formal demand for it is sent by the Registrar.

In the case of a "series" of trade marks differing only in respect of the particulars mentioned in sec. 26 of the Act, a wood-block or electrotype must, if the Registrar so require, be furnished for each mark in the series.

The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be

accepted. It is found in practice that zincotypes or process blocks do not, as a rule, yield impressions distinct enough for the purposes of this Journal, and a great number of such blocks have to be returned as unsuitable. It is generally found that the most suitable blocks are wood-blocks or electrotypes.

In the case of word marks the words on the block should be in plain block type.

The largest space available for the insertion of any single block or electrotype is five and a half inches broad by seven and a half inches deep.

When a block or electrotype *exceeds two inches in breadth or depth, or in breadth and depth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch over two inches in breadth, and for every inch or part of an inch over two inches in depth.

The official number given by the Registrar to a mark should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure identification.

All blocks or electrotypes should be sent to the Patent Office, Trade Marks Branch, together with the paper marked "Form R. Adv. 3," and with the representation of the mark sent for the guidance of the applicant in preparing the block or electrotype.

After the advertisement of a trade mark the block or electrotype supplied for such advertisement cannot in any case be returned to applicants, even for temporary use.

16.—Restrictions on Registration.

Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork be included within the mark by some border or lines.

Applications may be refused in cases where the following appear upon the representations of trade marks forming part of an application :—

(*a.*) The words "Patent," "Patented," "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.

The following also may not appear on trade marks, the registration of which is applied for, unless the marks have been used since before 13th August, 1875 :—

(*a.*) The Royal Arms or Royal crests, or arms or crests so nearly resembling them as to lead to mistake.

(*b.*) British Royal crowns.

(*c.*) British National flags.

(*d.*) The word "Royal" or any other words, letters or devices calculated to lead persons to think that the applicant has Royal patronage or authorisation.

In cases where the following appear on a mark, the Registrar may call for such justification as he may deem necessary for their use :—

Representation of the arms of a foreign State or place.

In cases where the following appear on a mark, the Registrar may

require to be furnished with consents from such officials, persons, or their legal representatives as he may consider necessary :—

(*a.*) Representations of the arms or emblems of any city, borough, town, place, society, body corporate, or institution.

(*b.*) Names or representations of living persons or persons recently dead.

Where there appears on the face of a trade mark the name or a description of the goods to which the mark is applied, 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 applicant should state in his application that the name or description varies.

17.—Oppositions.

Notice of opposition to the registration of a trade mark (*see* Rules, Form TM No. 7) must be filed within one month from the date of advertisement of the mark in the Journal, accompanied by an unstamped duplicate.

The applicant's counter-statement, Form TM No. 8, accompanied by an unstamped duplicate, must be filed within one month from the date of receipt by him of the duplicate notice of opposition.

The opponent's evidence, in support of the opposition, must be filed within one month from the date of receipt by him of the duplicate counter-statement, and copy of such evidence must be forthwith sent to the applicant.

The applicant's evidence must be filed within one month from the receipt of the copies of the opponent's evidence, and a copy of such evidence must be forthwith sent to the opponent.

The opponent's evidence in reply must be filed within fourteen days from the receipt of the copies of the applicant's evidence, and a copy of such evidence must be forthwith sent to the applicant.

On the completion of the evidence, a hearing is appointed by the Registrar. Each party attending the hearing must lodge the hearing fee form (Form TM No. 9, with £1 stamp).

18.—Cutlers' Company.

By sec. 63 of the Act, application for the registration of trade marks used on metal goods shall, if made by a person carrying on business in Hallamshire or within six miles thereof, be made to the Cutlers' Company of Sheffield. *See* Rules 107 to 112.

Applications made to the Cutlers' Company in pursuance of sec. 63 of the Act should be made on Form TM No. 2, the address in the left-hand corner to be "To the Cutlers' Company, Sheffield," instead of "To the Registrar," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on an Application Form TM No. 2. *See* Rule 107.

Requests to enter old corporate marks on the Sheffield register, under sec. 63 (2) should be made on Form Sheffield No. 1.

Applications sent by post should be addressed—

The Law Clerk to the Cutlers' Company,
The Cutlers' Hall,
Sheffield.

19.—Manchester Branch.

By sec. 64 of the Act, application for the registration of cotton marks should be made to the Manchester branch on Form Cotton No. 1. It should be accompanied by an unstamped duplicate of the Form, and also by four additional representations on Form Cotton No. 2.

These forms can be obtained at the chief post office, Manchester, and on personal application at the Inland Revenue Office, in the Patent Office, Room 32.

Applications sent by post should be addressed:—

The Keeper of Cotton Marks,
Manchester Branch of the Trade Marks Registry,
48, Royal Exchange, Manchester.

Searches can be made at the Manchester Branch on payment of 1*s.* for each quarter of an hour for marks in the cotton classes.

20.—Certificates.

The Registrar's certificate in relation to a trade mark is of four kinds, viz.:—

(i.) Of registration for use in legal proceedings.
(ii.) Of registration for use in obtaining registration abroad.
(iii.) Of any application made and of proceedings thereon.
(iv.) Of refusal to register a mark in use since before 13th August, 1875, and not registrable.

A person desirous of obtaining any of the above certificates should forward Form TM No. 34, Form TM No. 33, Form TM No. 31, or Form TM No. 32 (*see* paragraph 5), as the case may be, to the Registrar, giving the Registrar's official number of the mark and the class, and stating whether the certificate is required for use in legal proceedings, or for use in applying for the registration of the mark abroad, or for what other purpose.

In every case where a certificate is required in respect of a cotton mark, or in respect of any trade mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the mark should be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as otherwise considerable delay may be caused before the certificate can be issued.

21.—Inspection of Register and Copies of Entries.

The fee payable by a person inspecting the register in connection with any particular trade mark is 1*s.* for every quarter of an hour.

Copies of any entry in the register can be supplied at the rate of 4*d.* for every hundred words, with a minimum charge of 1*s.*

22.—Registration of Subsequent Proprietors of Registered Trade Marks.

The request to be made by a subsequent proprietor on application for the registration in his name of a registered trade mark must be made

on Form TM No. 16 or Form TM No. 18 (*see* paragraph 5), as the case may be. In the case of a firm or partnership the declaration may be made by one member of the firm or partnership. In the case of a body corporate the declaration should be made by a director or by the secretary or a principal officer of such body corporate.

If the Registrar considers it necessary he may require a declaration on Form TM No. 17 or Form TM No. 19 to be furnished in support of the request.

Where a person becomes entitled to the goodwill of a business, he should forthwith ascertain what registered marks have been in use in that business, and at the earliest possible moment get those marks transferred into his name on the register. The mere possession of the certificates of registration is quite insufficient.

23.—Miscellaneous Matters Relating to Trade Marks and the Patent Office.

(*a.*) *Advice on Trade Mark Matters, &c.*—The Patent Office does not undertake to give legal advice or opinions on questions of infringement or on any subject connected with trade mark law, which, like other laws, is left to the interpretation of professional men.

(*b.*) The Registrar cannot recommend any particular agent for employment by applicants. A list of registered patent agents who, as a rule, also transact trade mark business, may be obtained from Messrs. Eyre & Spottiswoode, East Harding Street, Fleet Street, London, E.C., and 32, Abingdon Street, Westminster, London, S.W., or through any bookseller. Price (including postage) 1*s.* 1*d.*

(*c.*) *Application for Reduction of Fees.*—It is not within the power of the Registrar to comply with any request for the reduction or remission of any of the fees required by the trade mark law.

(*d.*) *Use of the word "Registered."*—Any person who represents that a trade mark is registered which is not so is liable for every offence on summary conviction to a fine not exceeding five pounds.

A person is deemed, for the purposes of the Trade Marks Act, 1905, 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 (*see* sec. 67 of the Trade Marks Act, 1905).

(*e.*) *Patent Medicines.*—Communications with respect to the preparation and supply of medicine stamps appropriated to a particular medicine, or as to the liability to stamp duty of so-called "Patent Medicines," should be addressed to the Secretary (Stamps and Taxes), Inland Revenue, Somerset House, London, W.C.

(*f*) *Mere Trading Names.*—Mere trading names or names given to business premises cannot be registered at the Patent Office.

24.—International and Colonial Arrangements.

An International Convention for the protection of industrial property exists between the following States [1]:—

Belgium.
Brazil.
Cuba.

[1] There have been some recent additions and variations. See the List on p. 741.

Denmark with the Faröe Islands.
France with Algeria and colonies.
Germany.
Great Britain with New Zealand and Queensland.
Italy.
Japan.
Mexico.
Netherlands with the Dutch East Indies, Surinam, and Curaçon.
Norway.
Portugal with the Azores and Madeira.
Santo Domingo.
Servia.
Spain.
Sweden.
Switzerland.
Tunis.
United States of America.

Copies of the text of the Convention and of the additional Act modifying the Convention,[1] may be purchased for 2*d.* and 1*d.*, respectively, from Messrs. Eyre & Spottiswoode, East Harding Street, Fleet Street, London, E.C., and 32, Abingdon Street, Westminster, London, S.W., or through any bookseller.

Under this Convention, an applicant for a trade mark in any one of the contracting States may obtain priority of date in any of the other States.

Similar arrangements, for the mutual protection of trade marks, have been made between Great Britain on the one side, and each of the following States and Colonies on the other:—

Ecuador.
Greece.
Honduras.
Paraguay.
Roumania.
Tasmania.
Uruguay.
Western Australia.

The above list may of course be varied from time to time.[2]

25.—Applications for the Registration of Trade Marks in the British Colonies and Foreign States.

Applications for the registration of trade marks in the Colonies and foreign States must be made to the Government of the Colony or foreign State in which protection is desired. A collection of colonial and foreign trade mark laws and rules may be seen in the free library of the Patent Office.

26.—Sale of Official Publications.

Copies of the Act and of the rules can be purchased at the sale branch of the Patent Office. The price of the Act and rules together is 8*d.*, postage 2½*d.*; of the Act alone, 3*d.*, postage 1*d.*; and, of the rules

[1] See below, p. 743.

[2] See the List on p. 741.

alone, 5*d.*, postage, 1½*d.* Sums exceeding 5*d.* should be remitted by postal order or post office order.

Copies of the *Trade Marks Journal* may also be obtained from the sale branch of the Patent Office.

The price of the *Trade Marks Journal* is :—

Nos. 1 to 509 (Years 1876 to 1887) ...	...	1*s.* *per number*
Nos. 510 to 561 (Year 1888) ...	...	1*s.* 6*d.* ,,
No. 562 and following Nos. from 1 January 1889...		6*d.* ,,

27.—Patent Office Library.

The free public library of the Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C., is open daily, from 10 a.m. to 10 p.m., except on Sundays, Christmas Day, Good Friday, and Bank Holidays. On the day observed as His Majesty's birthday, Christmas Eve, Easter Eve, and Whitsun Eve, the library is closed at 4 p.m.

C. N. DALTON,
Registrar.

April, 1906.

APPENDIX IX.

PRECEDENTS OF FORMS UPON AN APPLICATION TO REGISTER A TRADE MARK AND ON APPEAL.[1]

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1. Application for Registration.

(Form TM No. 2, above, p. 678.[2])

2. Appeal from the Registrar to the Board of Trade.[3]

(Form No. 29, above, p. 695.)

3. Order of Board of Trade allowing Appeal.

In the matter of the Trade Marks Act, 1905, and in the matter of an application No. by for the registration of a Trade Mark in Class for .

The Board of Trade having heard the above-named Applicant upon Appeal from the refusal of the Registrar of Trade Marks to register the above-mentioned Trade Mark, No. in Class do hereby allow[4] the said Appeal and Order that the Registrar of Trade Marks do proceed with the registration of the said Trade Mark.

Dated this day of , 190 .

(Signed) ——,
An Assistant Secretary to the Board of Trade.

[1] See Chap. IV., p. 65.

[2] This is the ordinary form. The form for a special application under paragraph (5) of sec. 9 is TM No. 5, above, p. 680; under sec. 62 is TM No. 6, above, p. 681; for a cotton mark, Cotton No. 1, above, p. 692; to enter an old corporate mark on the Sheffield Register is Sheffield No. 1, above, p. 691.

[3] The right of appeal is to the Court or to the Board of Trade, sec. 12 (3).

[4] If the appeal is dismissed the form of order is "do hereby dismiss the appeal, and order that registration of the trade mark in question be not permitted."

3A. Reference by Board of Trade to Court.

Trade Marks Act, 1905.

In the matter of an application No. of for the registration of a Trade Mark under sec. 12 of the above-mentioned Act, and in the matter of a decision of the Registrar, dated the day of , 190 , and in the matter of an Appeal, dated the day of , 190 , to the Board of Trade from the above decision.

Reference of Appeal to the Court.

Whereas an appeal has been made to the Board of Trade against the decision above referred to, and whereas the Board of Trade think fit to refer the said appeal to the Court, now therefore the Board of Trade by virtue of the provisions of sec. 59 of the above-mentioned Act of 1905 do hereby refer such appeal to the Court accordingly.

Dated this day of , 190 .

(Signed) ——,

Secretary to the Board of Trade.

Directions on Reference of the above Appeal to the Court.

For the purpose of the above reference, the Board of Trade, pursuant to Rule 125 of the Trade Marks Rules, 1906, hereby direct that the Appellants make application by motion to the Chancery Division of the High Court of Justice to hear and determine the said Appeal, and that notice of such application be served upon the Registrar of Trade Marks, and upon and that upon the hearing and determination of the said Appeal the Appellants and the Registrar and be respectively at liberty to adduce such evidence by affidavit, examination, or cross-examination of witnesses and otherwise as the Court may see fit to direct or permit.

Dated this day of , 190 .

(Signed) ——,

Secretary to the Board of Trade.

3B. Order of Board of Trade on a Special Application under Sec. 9 (5).

In the matter of the Trade Marks Act, 1905, and in the matter of an application No. by of for the registration of a Trade Mark consisting of the word in Class for under sub-sec. 5 of sec. 9 of the above-mentioned Act.

The Board of Trade having considered the above-named application, the case stating at length the grounds upon which the applicants rely and the Statutory Declarations of and having heard the applicants by their and the Registrar do by this Order determine[1] that the Registrar of Trade Marks do proceed with the registration of the said Trade Mark.

Dated this day of , 190 .

(Signed) ——,

Assistant Secretary to the Board of Trade.

3C. Order of Board of Trade on a Special Application requiring Applicant to apply to the Court.

[*Title.*]

Whereas the above-named applicants in pursuance of the provisions of sub-sec. 5 of sec. 9 of the Trade Marks Act, 1905, and Rule 35 of the Trade Marks Rules, 1906, have applied for the registration of the words in Class in respect of and have, in accordance with Rule 38 of the said Rules, sent to the Registrar in

[1] Or "that the application in question be proceeded with."

writing a case in duplicate stating at length the grounds upon which they rely in support of their application and that they desire to be heard by the Board of Trade.

And whereas by Rule 39 of the said Rules it is provided that the Board may require the applicant to apply to the Court and limit a time for that purpose.

Now therefore the Board of Trade by virtue of the power hereinbefore recited do hereby require the above-named applicants to apply by motion to the Chancery Division of the High Court of Justice within two months from this date to hear and determine the said application and that notice of proceedings be served upon the Registrar of Trade Marks pursuant to Rule 129 of the said Rules.

Dated this day of 190 .

(Signed) ———

Secretary to the Board of Trade.

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4. Notice of Opposition.

(Form TM No. 7, above, p. 681.)

(*Grounds of opposition.*)

1. We are the registered proprietors of a trade mark in Class , for [*describing the goods*] registered on the of 18 , and numbered 1,234, and advertised in the *Trade Marks Journal*, No. , and we use, and since the of , 18 , we have extensively used, the said mark as a trade mark in our business as [*describing the business*].

2. We also use, and since the of , 18 , we have extensively used, a mark consisting of [*describing it*] for [*describing the goods*] as a trade mark, and also in our advertisements and price lists, in our said business.

3. The mark which the applicants by their application above referred to are seeking to register so nearly resembles our said registered trade mark, numbered , and also our said trade mark in paragraph 2 hereof referred to, as to be calculated to deceive.

(For other grounds of opposition, see pp. 70, 91 ; Chap. VIII., p. 127, "What marks may be registered as trade marks" ; Chap. X., p. 221, "Restrictions on registration.") [1]

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5. Counter-statement.

(In answer to the Notice of Opposition, No. 4.)

(Form TM No. 8, above, p. 682.)

We, , the applicants for the above trade mark, hereby give notice that the following are the grounds upon which we rely as supporting our application :—

1. We [*the applicants*] deny that the mark which is the subject of our application so nearly resembles either of the marks referred to in the notice of opposition herein as to be calculated to deceive.

2. [*Describing the principal differences between the applicants' mark, and the opponent's registered mark No.* 1,234.]

3. [*Describing the principal differences between the applicants' mark, and the mark referred to in paragraph 2 of the notice of opposition.*]

4. The last-mentioned mark is not a trade mark, and the opponents have not used the same as a trade mark. If our said mark bears any undue resemblance to the said mark of the opponents (which we deny), the opponents will not in any way, nor will any right of which they are possessed, or to which they are entitled, be prejudiced by the registration of our said mark.

5. Our said mark has been used by us as a trade mark in connection with the goods to which our application relates since the of , 18 , before the opponents had commenced to use either of their said marks, and if it bears any

[1] See also *Kutnow's Tm.*, 10 R. P. C. 403.

undue resemblance to the last-mentioned marks or either of them (which we deny), the said marks, or whichever of them our said mark so resembles, have, or has been, used as a trade mark, if at all, and the opponents' alleged trade mark, numbered 1,234, has been registered, in derogation of our rights, and our application to register ought not to be prejudiced by reason of such user or registration.

We admit the following allegations in the notice of opposition [*set out facts admitted, if any*[1]].

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6. Evidence in Support of the Application or Opposition.[2]

The formal parts of the declarations are as follows:—

[*Heading as in the Counter-statement*, p. 718.]

We do solemnly and sincerely declare as follows: [*setting out the evidence of the declarants*].

And we make this declaration conscientiously believing the same to be true and by virtue of the Statutory Declarations Act, 1835.

Declared at in the City of London, this of 19 , before me,

(Signed) ——,

A commissioner for oaths.

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7. Application for Hearing by the Registrar.

(Form TM No. 9, above, p. 682.)

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8. Form of Appeal from the Registrar to the Board of Trade.[3]

(Form TM No. 29, above, p. 695.)

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9. Statement of Case.[4]

[*Heading as in the Counter-statement*, p. 718.]

1. The appellants, , are manufacturers and vendors of indiarubber hose covered with steel wire, which is wound helically round it by a process protected by certain patents. The opponents, , are vendors of indiarubber hose covered with steel wire, wound round it by a process which is different from that employed by the appellants.

2. On or about the of , 18 , the appellants published a circular containing (*inter alia*) a representation of the device which they now seek to register as a trade mark. The said circular and representation were registered at Stationers' Hall on the of , 18 , in the names of the appellants, and the copyright in the same is now and always has been vested in the appellants.

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[1] Rule 53, p. 662.

[2] This is given by statutory declaration. Rules 53 to 58, p. 662. As to the Registrar's power to dispense with evidence, see Rule 97, p. 668.

[3] The right of appeal is to the Court or, with the consent of the parties to the Board of Trade, an appeal to the Court is by notice of motion, Rule 121; Form 9, below, p. 721, should be adapted. A copy of the decision of the Registrar must accompany the notice of appeal to the Board of Trade, and if the appeal is by the applicant, also a copy of the form of application and six representations of the mark opposed, Rule 123, p. 671.

[4] Rule 123, p. 671. This is substantially the case made use of in *The Sphincter Co.'s Tm.*, 10 R. P. C. 84. The Forms which follow assume the Registrar's decision to have been against the applicant.

3. The said device consists of [*describing it*]. The said device was drawn on the instructions of the appellants, and was entirely novel in design, and it is a distinctive device. The appellants have extensively published and circulated the said circular and the said representation and device amongst persons concerned in the indiarubber and hose trade, and amongst their customers and others from the said of , to the present time.

4. By their application, numbered , the appellants sought to register the said device as a trade mark in Class 50, for use in connection with the hose manufactured or sold by them. The said application was opposed on the grounds following: that the opponents are the proprietors of a trade mark in Class 50, for hose, registered on the of , 18 , under No. ; and that they had (as they alleged) used for a considerable time past a device consisting of [*describing it*] as an advertisement and description of their hose in price lists, circulars, &c.; and that the mark for which the appellants are applying for registration (as was alleged) so nearly resembled their said registered trade mark and advertisement as to be calculated to deceive.

5. The trade mark of the opponents consists of [*describing it*]. It is totally different in design and appearance from the said device of the appellants, and the said device bears no resemblance whatever to it.

6. It is untrue that the opponents have ever used any device similar to or resembling the said device of the appellants, or such as could be mistaken for or confounded with the said device referred to in the appellants' application, or such that the registration of the latter as a trade mark would be calculated to deceive.

7. The opponents exhibited to their declaration in opposition certain copies of price lists and advertisements, and among them a price list marked , containing a figure numbered No. 1. The said price list and figure were first issued and published on the of , 18 , as an advertisement, that is to say, years after the appellants had commenced to issue and publish their said device. The said figure No. 1 consists of [*describing it*]. The said figure is quite different in design and appearance from the said device of the appellants, and the said device bears no resemblance whatever to it.

8. The application was heard before the learned Registrar, and on the of , he gave his decision, and refused to allow the said device of the appellants to be registered.

9. The appellants crave leave to refer, for the purposes of their appeal, to all the evidence used at the hearing of their said application and of the opposition,[1] and also to the written decision of the learned Registrar.[2]

The appellants submit that, under the circumstances hereinbefore stated, the decision of the learned Registrar should be reversed, and the appellants' device No. above mentioned should be admitted to registration, on the following grounds :—

Grounds of appeal.

(1.) Because the said device is a distinctive device which the appellants are entitled to use and register as a trade mark under the above-mentioned Acts.

(2.) Because the learned Registrar was wrong in holding that it has been the custom in the hose trade to advertise pictures of hoses resembling the said device, whereas no such custom was established by the evidence, and such custom, if established, would not be a good ground of objection to the registration of the said device.

(3.) Because the learned Registrar was wrong in holding that the said device resembles the said trade mark of the opponents numbered No. , whereas the said device does not resemble the said trade mark at all, or (alternatively) not so nearly as to be calculated to deceive.

(4.) Because the learned Registrar was wrong in holding that the said device resembles the said figure No. 1, and such resemblance, if it existed, would not be a good ground of objection to the registration of the said device.

(Signed) ——.

[1] See sec. 14 (7) and Rule 125, p. 672.

[2] See note (3) above, p. 719.

10. Form of Reference of the Appeal to the Court by the Board of Trade.

Trade Marks Act, 1905.

In the matter of an application No. of for the Registration of a Trade Mark and in the matter of an opposition thereto, No. of and in the matter of a decision of the Registrar dated the day of 190 , and in the matter of an appeal dated the day of 190 , to the Board of Trade from the above decision.

Reference of Appeal to the Court.

Whereas it appears fit to the Board of Trade to refer the above-mentioned Appeal to the Court. Now therefore the Board of Trade by virtue of the provisions of sec. 59 of the above-mentioned Act do hereby refer such appeal to the Court accordingly.

Dated this day of , 190 .

(Signed) ——,
Secretary to the Board of Trade.

Directions on Reference of the above Appeal to the Court.

For the purpose of the above reference the Board of Trade, pursuant to Rule 125 of the Trade Marks Rules, 1906, hereby direct that the appellant make application by motion to the Chancery Division of the High Court of Justice to hear and determine the said Appeal, and that notice of such application be served upon the Registrar of Trade Marks and upon [*the opponent* [1]], and that the said in default of being served within from the date hereof with notice of any such application as aforesaid by the appellant be at liberty to apply to the Chancery Division of the High Court of Justice as may be advised. And that upon the hearing of any such application as aforesaid, the appellant, the said and the Registrar be respectively at liberty to adduce such evidence by affidavit, examination or cross-examination of witnesses and otherwise as the Court may see fit to direct or permit in addition to the Statutory Declarations used at the hearing before the Registrar, which for this purpose are, if necessary, to be verified by affidavit.

Dated this day of , 190 .

(Signed) ——,
Secretary to the Board of Trade.

11. Notice of Motion for the Determination of the Appeal.

19 , No. .

In the High Court of Justice,
Chancery Division,
Mr. Justice

[*Heading as in the Counter-statement above, p.* 718.]

Take notice that the Court will be moved before the Honourable Mr. Justice at 10.30 in the forenoon on the of , 19 , or so soon thereafter as counsel can be heard, by counsel, on behalf of the above-mentioned applicants , that the appeal of the applicants from the decision of the Registrar of Trade Marks

[1] But see sec. 49, above, p. 616. A modification of this part of the directions is under consideration.

upon their above mentioned application (which has been referred by the Board of Trade to the Court) may be heard and determined: And for an order directing the Registrar of Trade Marks to proceed with the registration of the trade mark referred to in the said application.

Dated this of , 19 .

(Signed) ——,
Solicitors for the above-named

To the Registrar of Trade Marks,
and
To [*the opponents*].

APPENDIX X.

NOTICE OF MOTION TO RECTIFY THE REGISTER.

19 , No. .

In the High Court of Justice,
Chancery Division,
Mr. Justice .

In the matter of a trade mark numbered ,
And in the matter of the Trade Marks Act, 1905.

TAKE NOTICE that this Court will be moved before the Honourable Mr. Justice , on the of 19 , at 10.30 in the forenoon, or so soon thereafter as counsel can be heard, by counsel on behalf of (*the applicant*) of (*address*), for an order that the Register of Trade Marks kept under the above-mentioned Act may be rectified (*as follows*) :—

(1.) By the removal of the mark therein registered for class , and numbered .

(2.) By limiting the registration of the mark therein registered (&c.) for use in connection with part of the goods comprised in the said class only, namely,

(3.) By expunging from the said Register part of the said mark No. , namely,

(4.) By adding to the entry therein of the said mark No. , a disclaimer of any right on the part of the registered proprietor of the said mark to the exclusive use of part of the said mark, that is to say the words,[1]

Or that such other order for the rectification of the said Register may be made as to the Court shall seem fit.

(Signed) ———.

To (*the registered proprietor*),
and
To the Registrar of Trade Marks.

[1] For other forms of rectification see above, p. 294. For forms of orders, see Seton, 6th ed., vol. 3, p. 2402.

APPENDIX XI.

PRECEDENTS OF PLEADINGS IN ACTIONS FOR INFRINGEMENT AND PASSING-OFF.[1]

1. Indorsement of Writ.

The plaintiff's claim is for—

(1.) An injunction to restrain the defendant, his servants, and agents, from infringing the plaintiff's registered trade mark, No. 1234, and from passing off goods not of the plaintiff's manufacture as or for the goods of the plaintiff.[2]

(2.) An account or damages.

(3.) Delivery up of the marked goods.

2. Statement of Claim.

1. The plaintiff and defendant are both manufacturers of hoes, shovels, and other hardware goods, carrying on business in Birmingham and also in London.

The plaintiff's registered trade mark.

2. The plaintiff is the proprietor of a trade mark consisting of the device of a circle and a triangle with a dagger placed between them, and the word "dagger" printed beneath the said device. The said trade mark was registered, as an old mark, in the Register of trade marks, under No. 1234, by the plaintiff, as the proprietor thereof, on the 1st of January, 1890, in Class 13 for hoes and shovels.

Use of the trade mark.

3. The plaintiff, and his predecessors in the business carried on by the plaintiff as aforesaid, have extensively used the said trade mark and also the said word "dagger" as a trade mark upon hoes and shovels manufactured and sold by them since the year 1850, and the plaintiff continues to extensively use the said trade mark and word in his said business.

Plaintiff's goods known as "dagger" hoes.

4. By reason of the user alleged in the last paragraph, the plaintiff's hoes and shovels marked with the said trade mark and word have become known to purchasers or intending purchasers as "dagger" hoes and shovels; and "dagger" hoes and "dagger" shovels in the hardware trade mean respectively the hoes and shovels made and sold by the plaintiff.

Get-up of the plaintiff's goods.

5. The plaintiff is accustomed to paste upon the hoes and shovels manufactured and sold by him a number of small triangular labels arranged in the form of a circle and coloured alternately red and green, and hoes and shovels sold in the market and bearing triangular labels so arranged and coloured are known to purchasers or intending purchasers as, and are bought by them as and for, the goods of the plaintiff.

The infringing mark.

Imitation of the get-up.

6. The plaintiff has recently discovered, as the fact is, that the defendant is selling hoes and shovels not of the plaintiff's manufacture, bearing a mark consisting of the device of an oval and a square with a dagger placed between them, and having pasted upon them a number of small square labels arranged and coloured similarly to the labels used by the plaintiff, and referred to in paragraph 5 hereof.

[1] For the Forms given in the Appendix to the Rules of the Supreme Court, see p. 470. The first set of pleadings here given relate to an action for the infringement of a registered trade mark, and also for passing off goods by the use of a trade name and imitation of get-up. The paragraphs referring to each of the combined causes of action are readily distinguishable. The second set relate to an action for the infringement of an unregistered trade mark.

[2] See a fuller form, p. 725, and other precedents, pp. 730 *et seq.*

7. The plaintiff has also recently discovered, as the fact is, that the defendant has advertised and has invoiced and sold hoes and shovels, not of the plaintiff's manufacture, as "dagger" hoes and shovels. — Use of "dagger" by the defendant.

8. The use of the said device in paragraph 6 mentioned, and also of the word "dagger" as in paragraph 7 mentioned, is an infringement of the plaintiff's said trade mark No. 1234. — Infringement of the registered trade mark.

9. The employment of the said square labels by the defendant is an unlawful imitation of the get-up of the plaintiff's goods referred to in paragraph 5 hereof. — Imitation of get-up.

10. By reason of the unlawful acts aforesaid the defendant has sold and passed off, and has caused to be sold and passed off, large quantities of goods not of the plaintiff's manufacture as and for the plaintiff's goods, and has thereby gained large profits. — Passing-off goods: profits.

The plaintiff claims—

(1.) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade mark, No. 1234, and from passing off goods not of the plaintiff's manufacture as or for the goods of the plaintiff. And in particular to restrain him and them from selling, offering for sale, or disposing of any hoes or shovels, not of the plaintiff's manufacture, bearing the device of a circle and a square with a dagger between them, or any other device colourably resembling the plaintiff's said trade mark, or under the name "dagger" hoes or shovels, or having fixed upon them square labels arranged in a circle, or any other labels in imitation of the get-up of the plaintiff's goods, in paragraph 5 hereof mentioned.[1]

(2.) An account of the profits made by the plaintiff in selling or disposing of any hoes or shovels not of the plaintiff's manufacture, sold under the device in paragraph 6 hereof mentioned, or as "dagger" hoes or shovels, or bearing square labels arranged and coloured as in paragraph 8 hereof mentioned.

(3.) Delivery up to the plaintiff by the defendant upon oath of all hoes and shovels not of the plaintiff's manufacture, in the defendant's possession or under his control, marked with the device, or bearing the said labels, and of all price lists, copies of invoices, and other documents, and of all advertisement-blocks in the defendant's possession or under his control, bearing the word "dagger," for erasure or cancellation of the devices, labels, and words, or for destruction.

(4.) Costs.

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3. Defence.

(In answer to the above Statement of Claim No. 2.)

1. The defendant admits that the plaintiff is registered as the proprietor of the alleged trade mark, No. 1234 in class 13, but he denies that the said mark is a trade mark, and that the plaintiff is properly registered as the proprietor of the same. The said mark was not used by the plaintiff or by his predecessors in business as a trade mark before the 13th of August, 1875. — Traverses of the allegations in the statement of claim.

2. The defendant denies that the said mark and that the word "dagger" is, or at any material time has been, used as a trade mark for hoes or shovels, and that the plaintiff's hoes or shovels are known as "dagger" hoes or shovels, and that "dagger" hoes or shovels mean, or are understood to mean, hoes or shovels made or sold by the plaintiff, and that hoes and shovels sold in the market and bearing labels arranged and coloured as stated in paragraph 5 of the statement of claim are known to purchasers or intending purchasers as, or are bought as or for, the goods of the plaintiff.

3. The devices of a circle or an oval and a triangle, and the word "dagger," and the device of a dagger, are, and each of them is, common to the trade in hoes and shovels. The word "dagger" and the device of a dagger are commonly employed in the hardware trade to indicate a particular pattern of hoe or shovel, namely, a hoe or shovel having an unusually narrow blade. — Devices and word common to the trade.

4. The business of the defendant as a manufacturer of hoes and shovels has been established since the year 1860, and the said business is much larger than that of the plaintiff. The defendant and his predecessors in the said business have for many years, and since the year 1870 at least (as the plaintiff has since the year last — Get-up used for a long time by the defendant.

[1] See other forms of injunction, post, p. 730.

mentioned been well aware), used upon the hoes and shovels manufactured and sold by them a number of small square labels coloured red and green, and arranged in the form of a circle.

Acquiescence and waiver.

5. If the use by the defendant of the said square labels as aforesaid was at any time an infringement of any right of the plaintiff (which the defendant denies), the plaintiff has acquiesced in the same, and has long since forfeited any claim to interfere with such use.

Get-up of defendant's goods is not deceptive.

6. The said square labels arranged and coloured as aforesaid are not an imitation of the plaintiff's triangular labels, but are, and are well known to dealers in and purchasers of hoes and shovels to be, distinct from the same, and to indicate the goods of the defendant.

Denial of infringement.

7. The defendant denies that he has infringed the plaintiff's alleged trade mark, or imitated the get-up of the plaintiff's goods. He admits that he has sold hoes and shovels, as he lawfully might, bearing some of the common marks aforesaid, namely, the devices of an oval, a square, and a dagger. Save as herein expressly admitted, he denies each of the allegations in paragraphs 6, 7, 8 and 9 of the statement of claim.

Denial of passing-off and of profits.

8. The defendant denies that he has sold or passed off, or caused to be sold or passed off, any goods not of the plaintiff's manufacture as or for the plaintiff's goods, and that (if he has done so, which he denies) he has made any profits thereby.

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4. Statement of Claim.[1]

("Common Law Trade Mark.")

Plaintiffs' goods known as "camel hair," etc.

1. The plaintiffs have for many years been manufacturers of belting for driving machinery, and have extensively advertised, and sold the belting made by them under the styles of "Camel," "Camel Brand," and "Camel Hair." In consequence thereof, belting called "Camel," "Camel Brand," or "Camel Hair," has become to be known in all parts of the world where belting is used as belting of the plaintiffs' manufacture, as the defendants well know.

Use of "camel hair," etc., by defendants.

2. The defendants have lately commenced the business of belting manufacturers, and in order to obtain for themselves the reputation acquired by the plaintiffs, and to pass off their belting as that of the plaintiffs, and to deceive purchasers thereof, have adopted the words "Camel," "Camel Brand," and "Camel Hair," so used by the plaintiffs as aforesaid, and have sold belting under the same designation, and have advertised for sale belting manufactured by them as "Camel," "Camel Brand," and "Camel Hair Belting."

Such use calculated to deceive.

3. The use of the words "Camel," "Camel Brand," and "Camel Hair," by the defendants as aforesaid, is calculated to deceive purchasers of belting into the belief that they were buying belting of the plaintiffs' manufacture, and many persons have been so deceived.[2]

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5. Defence.

(In answer to the above-printed Statement of Claim, No. 4.)

Denial of plaintiffs' reputation.

1. The defendants deny that belting called "Camel," "Camel Brand," and "Camel Hair Belting" has become to be known in all parts of the world where belting is used as belting of the plaintiffs' manufacture; and, if it has, they deny that the defendants were aware of the fact.

2. The defendants and their predecessors have long carried on the business of hemp spinning, and some time ago commenced the manufacture of various kinds of belting in connection with and as a branch of their said business.

Manner of user of "camel hair" by defendants.

3. Amongst other materials used by the defendants in the manufacture of belting was yarn made of camels' hair; and the defendants have, as they lawfully may, used. And see *Reddaway* v. *Banham*, 13 R. P. C. 218.

[1] *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, 9 R. P. C. 503. This and the following pleading are taken from the report, and are probably somewhat abbreviated from the forms actually

[2] For forms of claim, see pp. 725 and 730 *et seq.*

described and sold the said belting as the "Bentham Solid Woven Camel-Hair Belting." The defendants have applied to the said belting manufactured and sold by them their distinctive trade mark.

4. Save as aforesaid, the defendants deny that they have sold or advertised their belting manufactured by them as "Camel," "Camol Brand," and "Camel Hair." Denial of other use.

5. The defendants deny that the use of the words "Camel," "Camel Brand," and "Camel Hair" would be calculated to deceive persons into the belief that they were buying goods of the plaintiffs' manufacture. The plaintiffs have no prescriptive or distinctive right to the use of the said words. Denial of probability of deception.

6. The defendants deny that the use of the words "Camel Hair," as used by them, was calculated to deceive purchasers of belting manufactured by the defendants into the belief that they were buying belting of plaintiffs' manufacture. The defendants deny that any persons have been so deceived.

(The defendants also denied that the plaintiffs had been damnified, and alleged that their competition with the plaintiffs was fair trade competition.)

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6. Statement of Claim.[1]

Passing-off—Use of Special Scroll Device.

[Paragraph (1) contained allegations as to the business of the plaintiffs, *Weingarten Brothers*, who were a firm of corset manufacturers carrying on business at New York, in the United States of America, and having at first an agent, and later an office in London.]

(2) Among other varieties of corsets manufactured and sold by the plaintiffs are corsets of the pattern or style commonly known and described as "Straight Fronted Corsets." The plaintiffs were some time since desirous of adopting a new name for their "Straight Fronted Corsets," which should distinguish the "Straight Fronted Corsets" of their make from the "Straight Fronted Corsets" made by other firms, and in pursuance of such desire the plaintiffs adopted as a new and distinctive name for such corsets of their manufacture the term "Erect Form Corsets," and in many cases they have printed those words in a particular and distinctive manner so as to constitute a distinctive device. This is shown at the top of page 2 hereof.[2] The said term "Erect Form Corsets" had never been used in respect of corsets before it was adopted by the plaintiffs as aforesaid, nor has it since been used by any other firm in the United States or the United Kingdom until the defendant began to use the same as hereinafter stated. (3) Prior to the month of February, 1901, some of the plaintiffs' said "Erect Form Corsets" were sold in this country in response to orders, but in that month the plaintiffs began to send over and they have since continued to send over to and sell in the United Kingdom their said "Erect Form Corsets" in large quantities, such corsets being always put up for sale and sold in boxes having printed on the lids thereof the said words "Erect Form Corsets" printed in the said special and distinctive manner adopted by the plaintiffs aforesaid. The plaintiffs further used the words "Erect Form Corsets" as the distinctive name of their corsets aforesaid on their envelopes and other trade documents, and have expended large sums of money in advertising their said corsets under the name aforesaid in the United Kingdom as well as in the United States of America. (4) In consequence of the novelty and distinctiveness of the said name "Erect Form Corsets," assisted by the special type in which the same was frequently printed by the plaintiffs, and also of the merits of the plaintiffs' said corsets themselves, and of the care and skill with which such corsets are manufactured, the said corsets have acquired under the said name a ready and large sale in the United Kingdom, and the said name was and is universally understood as indicating that the corsets in respect of which it is used are corsets manufactured exclusively by the plaintiffs. Persons who wish for corsets of the style and pattern in which the plaintiffs' said corsets are manufactured, but without desiring a particular make, ask for and order them as "Straight Fronted Corsets." Persons who desire a particular make of such corsets ask for and order them by one or another of the special names used by particular manufacturers, and

[1] *Weingarten* v. *Bayer*, 20 R. P. C. 289, 649: 21 R. P. C. 341. The form of the order made by the House of Lords will be found below, p. 740.

[2] See 20 R. P. C. 292.

when the make desired is the plaintiffs' make they ask for and order them by the name "Erect Form Corsets," and this has been so at least in and since the month of February, 1901. (5) In the month of October, 1901, the defendant ———, who carries on business as a corset manufacturer under the name ———, at ———, and who was already manufacturing and selling under other names "Straight Fronted Corsets" similar in pattern and style to the plaintiffs' said "Straight Fronted Corsets," began for the first time to adopt and use in respect of his "Straight Fronted Corsets," instead of any of the names previously used by him, the said name "Erect Form Corsets" used by the plaintiffs as aforesaid, and (as shown at the top of page 3 hereof)[1] to print the same on the boxes in which such corsets were sold and elsewhere in the same special type in which the same is printed by the plaintiffs, and to describe such corsets as "Celebrated," whereas the defendants' said corsets were not celebrated under that name at all, but were in fact entirely unknown in connection with any such name, while, on the other hand, the plaintiffs' said corsets were in fact celebrated under the said name.

The plaintiffs claimed—

(1) An injunction to restrain the defendant ———, his servants and agents, from selling, or offering, or exposing, or advertising for sale, or procuring to be sold, any corsets not of the plaintiffs' manufacture under the name of "Erect Form Corsets" without clearly distinguishing such corsets from the plaintiffs' corsets; (2) and from in any manner reproducing or imitating in connection with or in respect of any such corsets as aforesaid the special form in which the said words "Erect Form" are printed or arranged by the plaintiffs in connection with or in respect of their "Erect Form Corsets" so as to be calculated to deceive; (3) and from in any manner passing off, or enabling or assisting others to pass off, any such corsets as aforesaid as or for the plaintiffs' corsets; (4) an order for delivery up on oath or (at the plaintiffs' option) destruction of all labels, boxes, price lists, advertisements, blocks or dies for producing the same, and other documents, articles and things which are in the possession or power or under the control of defendant, or offend against the foregoing injunction or any of them; (5) damages or an account of profits; (6) costs.

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7. Defence.

(In answer to above-printed Statement of Claim, No. 6.)

(1) The defendant denies that the plaintiffs carry on, or have at any material time or times carried on, a business in the manufacture or sale of corsets which is either old-established or extensive in the United Kingdom. He has no knowledge and makes no admissions of or in regard to the business alleged to be carried on by the plaintiffs in the United States of America. (2) He does not admit that the words "Erect Form Corsets," or the alleged particular and distinctive manner of printing the same, had not been used in respect of corsets or by any other firm before the adoption of the same or either of them by the plaintiffs or before the use thereof by the defendant. (3) The said words were not at any material time a new or a distinctive name for corsets, but they were and are descriptive words and common to the trade. (4) The said manner of printing the said words was not at any material time particular or distinctive, or a distinctive device, but was and is common to the trade. (5) The defendant denies each and every allegation in paragraphs 3 or 4 of the statement of claim respectively contained. (6) The plaintiffs did not until shortly before the commencement of this action, or until after the defendant had begun to sell "Erect Form Corsets," use or attempt to use the said words as the trade name of or to distinguish their goods, but if they use the said words at all (which is not admitted) they use the same as descriptive of the pattern or design of the goods only. The goods of the plaintiffs were and are not known or distinguished by the trade or purchasers as "Erect Form Corsets." (7) The plaintiffs have never employed the alleged particular and distinctive manner of printing upon goods themselves. (8) The defendant admits that he has described certain ranges of corsets made and sold by him as "C. B. Erect Form" of corsets and as "Celebrated C. B. Erect Form Corsets." He denies that he has printed "Erect Form Corsets" in the manner shown in the illustration[1] at the top of page 3 of the Statement of

[1] See 20 R. P. C. 293.

Claim without the letters "C. B." in large type before and after the said words or otherwise than as part of the descriptions aforesaid, or one of the same, the said illustration is incorrect and misleading. (9) The defendant does not admit that he first adopted or used the said words or manner of printing in connection with his said corsets in the month of October, 1901, or that the said ranges of corsets are or were the same as those previously called "Straight Fronted Corsets," or by any other name or names. Save as in paragraphs 8 and 9 hereof expressly admitted, he does not admit any of the several allegations contained in paragraph 5 of the Statement of Claim. (10) If it be the fact (which is denied) that the words "Erect Form" or the use of the said manner of printing are or were under any circumstances known to the trade or to purchasers as indicating or describing the goods of the plaintiffs, the defendant has always clearly, sufficiently, and effectively distinguished his goods in connection with which he has used the said words or manner of printing by the employment of his own initials "C. B." (11) The defendant's trade is old-established and very extensive, and his goods are well known and in high repute, and are celebrated all over the United Kingdom and elsewhere. The said goods are marked "C. B." or the "Celebrated C. B.," and all goods bearing the said marks, or either of them, are known and recognised by the trade and purchasers as being of his manufacture. (12) Except that he knew that the plaintiffs were advertising their goods for sale as "W. B. Erect Form Corsets" and "American Erect Form Corsets" before he began to make "Erect Form Corsets," the defendant denies each and every allegation in paragraph 6 or 7 of the Statement of Claim respectively contained. (13) This action is brought by plaintiffs to endeavour to obtain a monopoly of the words "Erect Form" for corsets. The said manner of printing is of no importance to them or to the defendant. No request was made by or on behalf of the plaintiffs to the defendant before action that he should cease to employ it. The defendant has in fact ceased to print the words in question in the said manner, and, except for the purpose of using up his existing stock, he does not intend to resume the use of the said manner of printing.

APPENDIX XII.

FORMS OF ORDERS IN TRADE MARK CASES AND CASES ANALOGOUS THERETO.[1]

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1. Morison *v.* Moat,[2] 20 L. J. Ch. 529 (1851), Turner, V.-C.

Trade Secret.

Injunction against use

An injunction to restrain the defendant, his agents, servants, and workmen, from selling, or causing or procuring to be sold, under the title or designation of

[1] The forms are, in most instances, taken from the reports cited; in some cases they give only the substance of the orders actually drawn up. For fuller forms and the formal parts of orders, see Seton, 6th ed., Vol. I., p. 623 *et seq.* A large number of orders have been collected by Mr. Sebastian, and are printed in his book, 3rd ed., p. 510; 4th ed., p. 514.

[2] The Lords Justices required the plaintiffs to give an undertaking as to damages; 21 L. J. Ch. 248.

"*Morison's Universal Medicine*," any medicine made or manufactured by him, the said defendant, or by or under his order or direction; and also to restrain the defendant, his agents, servants and workmen, from making or compounding any medicines according to the secret in the said bill mentioned, and from in any manner using the secret of compounding the said medicines or any part thereof.

of name of plaintiff's goods; against use of trade secret.

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2. FARINA *v.* SILVERLOCK, 24 L. J. Ch. 632 (1855), Wood, V.-C.

Trade Mark.

To restrain the defendant from printing or selling any labels similar to those in use by the plaintiff, or containing copies of his signature, or address, or flourish, seal or stamps, or other marks invented and used by the plaintiff, or marks merely colourably differing therefrom, intended to represent that Eau de Cologne prepared by other parties was Eau de Cologne prepared by the plaintiff.

Injunction against printing or selling labels; or passing-off.

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3. SEIXO *v.* PROVEZENDE, L. R. 1 Ch. 194 (1865), Cranworth, L.C.

Trade Mark and Passing-off.

An injunction to restrain the defendants from affixing, or causing to be affixed, to any casks of wine shipped to their orders, the brand or mark of a crown and the word *Seixo*, or any other combination of marks or words so contrived, as by colourable imitation or otherwise, to represent the marks or brands of the plaintiff, and from employing any marks or words which should be so contrived as to represent, or induce the belief, that such wines were Crown *Seixo*, or the produce of the Quinta *do Seixo*, or otherwise using the word *Seixo without clearly distinguishing*[1] the same from the wines produced by the Quinta *do Seixo*.

Injunction against use of trade mark; or of trade name of the plaintiff's goods.

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4. WOTHERSPOON *v.* CURRIE, L. R. 5 H. L. p. 508 (1872).

Trade Name of Goods, Passing-off.

Injunction restraining the respondent, his servants and agents, from using the word "Glenfield" in or upon any labels affixed to packets of starch manufactured by or for him, and from in any other way representing the starch manufactured by or for him to be "Glenfield Starch," and from selling or causing the same to be sold as "Glenfield Starch," and from doing any act or thing to induce the belief that starch manufactured by or for him, the respondent, is "Glenfield Starch" or starch manufactured by the appellants.

Injunction against use of name; and passing-off.

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5. FORD *v.* FOSTER, L. R. 7 Ch. p. 634 (1872), L.JJ.

Trade Mark.

To restrain the defendants from applying the mark or title "*Eureka*" to any shirts manufactured by them, or to any shirts sold by them, unless manufactured by the plaintiffs, and from selling any shirts already marked with the mark and title "*Eureka*," unless such mark or title has been applied with the sanction of the plaintiff; and from issuing any boxes or packages on which the mark or title of "*Eureka*" shall be applied to shirts not of the plaintiff's manufacture; and from affixing or using any label or card or other mark containing the word "*Eureka*" to or upon any shirts not of the plaintiff's manufacture (there was also an order for an account limited to the period since the filing of the bill).

Injunction against use of trade mark.

[1] This is the proper form where the right to use is not absolutely barred. See No. 6, and *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218. Cf. No. 21.

6. Orr-Ewing & Co. v. Johnston & Co., 13 C. D. p. 450 (1880), Fry, J., and C. A.[1]

Trade Mark and Trade Name.

Injunction against use of an infringing mark;

or any similar mark without distinguishing, &c.

To restrain the defendants, Robert Johnson & Co., their servants, workmen, and agents, from affixing or causing to be affixed to any Turkey red yarn not dyed by the plaintiffs, Archibald Orr-Ewing & Co., the ticket marked B, and from using two elephants on any tickets used on Turkey red yarn, without clearly distinguishing such tickets from the plaintiffs' ticket marked A, *and from employing any mark or words which would be calculated to cause any Turkey red yarn not dyed by the plaintiffs to be known in Bombay as "Bhé Hathi" yarn, or to*[1] (or so as to) represent or induce the belief that any of the said yarn was dyed by the plaintiffs; with an order for an account of profits and costs.

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7. Massam v. Thorley's Cattle Food Company, 14 C. D. p. 762 (1880), C. A.

Trade Name and Passing-off.

Injunction against passing-off;

against pretence that defendants' business is the plaintiff's:

against imitation of marks and get-up.

Circulars and advertisement.

An injunction to restrain the defendant company, their servants, workmen, agents and travellers, and representatives respectively, from selling, exporting, or shipping, or causing, or procuring, or allowing to be sold, shipped, or exported, and from in any manner representing, or causing, or procuring to be represented, any goods manufactured by the defendant company as the manufacture or goods of the late *Joseph Thorley*, or of the plaintiffs, his trustees and successors in business; and also from in any manner representing, or causing, or procuring to be represented, or doing anything which shall lead to the belief that the defendant company have been or are carrying on the business of the late *Joseph Thorley*, or are the successors in business of the late *Joseph Thorley*; and also from affixing or permitting, or causing to be affixed to any goods or articles manufactured or bought, or procured, or sold, or shipped, or exported by the defendant company, or otherwise using or employing, or permitting to be used or employed, any labels, wrappers, or marks used by the late *Joseph Thorley* and the plaintiffs, his trustees and successors in business, or so contrived and prepared as to represent or lead to the belief that the goods or articles manufactured, or sold, or shipped, or exported by the defendant company are the goods or manufacture of the late *Joseph Thorley*, or of the plaintiffs; and also from employing, using, or circulating, or causing to be employed, used, or circulated, any circulars, pamphlets, notices, or advertisements of the late *Joseph Thorley* or of the plaintiffs, or which shall in any manner represent or lead to the belief that the defendant company have been or are carrying on the business of the late *Joseph Thorley*, or that they are his successors in business.

(The Court refused to prohibit the defendants using the name Thorley in a way not calculated to mislead the public.)

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8. Hendriks v. Montagu, 17 C. D. p. 638 (1881), C. A.

Company's Trade Name.

Injunction against registration of company with name like plaintiff's name;

against advertising company with name like plaintiff's name;

or carrying on business under such name.

"An injunction to restrain the defendants from applying to the Registrar of Joint Stock Companies in *England* for Registration, under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses, representing that a company is to be incorporated pursuant to the *Companies Act*, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any other such name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid.

[1] The words in italics were struck out by the House of Lords. 7 App. Ca. p. 234.

9. READ *v.* RICHARDSON, 45 L. T. N. S. p. 60 (1881). C. A.

Trade Mark.

The plaintiffs by their counsel undertaking to abide by any order this Court may make as to damages, in case this Court shall hereafter be of opinion that the defendants have sustained any by reason of this order which the plaintiffs ought to pay, this Court doth order that the defendants, E. Richardson & Co., their servants and agents, be restrained from using the figure of a dog's head upon any labels, tickets, or wrappers affixed or applied to bottles of beer or stout sold for exportation, or exported by the defendants to any of the Australian colonies or New Zealand, and from selling for exportation, or exporting, any bottles of beer or stout having affixed or applied thereto any such label, ticket, or wrapper, until judgment in this action, or further order: and it is ordered that the plaintiffs' costs of this motion be their costs in the action.

Undertaking as to damages.

Interim injunction against use of trade marks on goods for exportation.

Costs.

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10. LEVER *v.* GOODWIN, 4 R. P. C. p. 503 (1886), Chitty, J., and C. A.[1]

Trade Mark and Passing-off.

"This Court doth order that this action, so far as the same claims protection in respect of the trade mark, No. 39,714, stand dismissed out of the said Court. And it is ordered, that the defendants, Goodwin Bros., their agents and servants, be restrained from selling, offering for sale, or disposing of any soap, not being manufactured for or by the plaintiffs, in the wrapper, *or* of the form of any one of the three exhibits admitted in this action to have been issued by the defendants, and marked J.S.S.1, J.S.S.4, and B.B.1, or in any wrapper or in any form calculated or intended to pass off, or to enable others to pass off, such soap as or for the goods of the plaintiffs. And it is ordered that the following account be taken, that is to say, an account of the profits made by the defendants in selling or disposing of soap, made by or for the defendants, in any wrapper, such as that contained in the exhibits marked J.S.S.1, J.S.S.4, and B.B.1, and in the form of those exhibits. And it is ordered that the defendants, Goodwin Bros., do within fourteen days after the date of the chief clerk's certificate, to be made pursuant to this order, pay to the plaintiffs, Lever & Co., the amount which, upon taking such account, shall be certified to be payable by the defendants to the plaintiffs. And it is ordered that it be referred to the taxing master to tax the costs of the plaintiffs of this action, up to and including the trial, except so far as the same have been incurred by their claim for protection in respect of the trade mark aforesaid. And it is ordered that it be referred to the taxing master to tax the costs of the defendants of the action, so far as the same have been incurred by the plaintiffs setting up the said claim for protection in respect of the said trade mark, and the costs of the plaintiffs, when so taxed, are to be set off against the said costs of the defendants, when taxed, and the taxing master is to certify to whom, after such set-off, the balance is due. And it is ordered that the party from whom such balance shall be certified to be due do pay the amount thereof to the other party. And the question of the costs of this action incurred subsequent to the trial are reserved, and either of the parties are to be at liberty to apply as they may be advised."

Trade mark action dismissed.

Injunction against use of particular wrapper;

against passing-off.

Account.

Payment of amount found due.

Costs.

Costs of account reserved.

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11. MELACHRINO *v.* THE MELACHRINO EGYPTIAN CIGARETTE CO., 4 R. P. C. 225 (1887), Chitty, J.

Trade Mark and Trade Name.

An injunction to restrain the defendant *Poulides*, his agents and servants, from carrying on at No. 10, Pall Mall, the business carried on by him there under the name of *The Melachrino Egyptian Cigarette Co.*, or of *Melachrino & Co.*, and to restrain the defendants respectively, and their respective agents and servants, until judgment or

Interim injunction against use of name for a particular business

[1] Compare the form of the order in *Payton* v. *Snelling, Lampard & Co., Ltd.*, 16 R. P. C. 290. (An appeal by the defendants in that case was allowed, 17 R. P. C. 48, and the plaintiffs' appeal to the House of Lords was dismissed, 17 R. P. C. 628.)

and use of particular labels.

further order, from selling or offering for sale cigarettes not of the plaintiffs' manufacture or merchandise, in boxes or packages having affixed thereto or connected therewith the labels, exhibits A11 and A12, or any other label being a colourable imitation of the plaintiffs' label.

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12. THE APOLLINARIS CO. *v.* HERRFELDT, 4 R. P. C. 488 (1887), C. A.

Trade Marks.

Interim injunction against use of infringing word; and sale of marked goods.

That the defendants, Messrs. Herrfeldt and Campbell, their servants, agents, and workmen, be restrained, until judgment in this action or further order, from using the word "*Apollinis*," or any other word only colourably differing from the word "Apollinaris," upon any labels or corks used by them in the course of their trade in any mineral water, and also from offering for sale, or selling, or otherwise disposing of any mineral water in bottles bearing the word "*Apollinis*."

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13. JAY *v.* LADLER, 6 R. P. C. 138, 140 (1888), Kekewich, J.

Trade Mark and Passing-off.

Injunction against infringement by circulars or advertisements; and against the use of a particular device.

To restrain the defendant from infringing the plaintiff's trade mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats, or otherwise using the said trade mark in that connection (and also from using the device of a lady and a bear so as to deceive the public).

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14. MONTGOMERY *v.* THOMPSON, 41 C. D. 47 (1889), Chitty, J., and C. A.[1]

Trade Name, Passing-off.

Interim injunction against the use of the plaintiffs' trade name; and against passing-off.

An injunction restraining the defendant until judgment or further order from carrying on the business of a brewer at *Stone*, under the title of "*Stone Brewery*," or "*Montgomery's Stone Brewery*," or under any other title so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling or causing to be sold any ale or beer not of the plaintiffs' manufacture, under the term "*Stone Ale*" or "*Stone Ales*," or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture.

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15. BURLAND'S TRADE MARK, 42 Ch. D. 274; 6 R. P. C. 482 (1889), Chitty, J.

Order for Disclaimer.

Entry of disclaimer on the Register.

This Court doth order that the Register of Trade Marks be rectified by entering thereon a disclaimer of any right of Frederick Adolphus Burland to the exclusive use of the word "Washerine" in the Trade Mark, No. 77,935, and due notice of the said rectification is to be given to the Comptroller of Patents, Designs, and Trade Marks.

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16. WILKINSON *v.* GRIFFITH BROS. & CO., 8 R. P. C. 376 (1891), Romer, J.

Trade Name and Passing-off.

Injunction against the use of a

An injunction restraining the defendants, their agents and servants, from selling, or offering for sale, any French polish not of the plaintiffs' manufacture with the

The injunction was made perpetual, and was upheld by the House of Lords; [1891] A. C. 217.

label complained of upon it, or so labelled or marked as to induce the public to believe that it is of the plaintiffs' manufacture. An inquiry as to the amount of damages suffered by the plaintiffs by the wrongful acts of the defendants. The defendants to pay the costs of the action up to and including the trial. The subsequent costs to be reserved, with liberty to apply. The costs which the defendants are ordered to pay to include the costs of the counterclaim which was not insisted upon.

particular label.

Inquiry as to damages.

Costs.

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17. PAINE & Co. *v.* DANIELLS & SONS' BREWERIES, [1893] 2 Ch. 581, C. A.

Trade Mark and Passing-off.

Restrain the defendants, their servants and agents, from using the label marked "F." in the labels referred to in the plaintiffs' interrogatories, and from otherwise infringing the plaintiffs' registered trade marks aforesaid, and from doing any act calculated to pass off ale or beer made by the defendants as ale or beer made by the plaintiffs.

Injunction against use of trade mark; and against passing-off.

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18. POWELL'S TRADE MARK, [1893] 2 Ch. 388; 10 R. P. C. 63, Chitty, J.[1]

Trade Mark Expunged.

This Court doth order that the Register of Trade Marks kept under the authority of the above-mentioned Act be rectified by expunging therefrom the above-mentioned trade mark, No. 37,030. And it is ordered that the said William Powell do pay to the said Birmingham Vinegar Brewery Co., Ltd., and to the Comptroller-General of Patents, Designs, and Trade Marks their costs of this application, to be taxed by the taxing master.

And it is ordered that an office copy of this order be forthwith left with the Comptroller-General of Patents, Designs, and Trade Marks at the Patent Office.

Removal of mark from Register.

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19. POWELL *v.* BIRMINGHAM VINEGAR BREWERY COMPANY, LTD., [1894] 3 Ch. 449; 11 R. P. C. 563, Stirling, J., and C. A.

Interlocutory Injunction. Trade Name of Goods.

An injunction to restrain the defendants until trial or further order from using the words *Yorkshire Relish* as descriptive of or in connection with any sauce or relish manufactured by them, or sauce or relish not being of the plaintiff's manufacture sold, or offered for sale, by them without clearly distinguishing such sauce or relish from the sauce or relish of the plaintiff.

Interim injunction against use of trade name of plaintiff's goods.

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20. POWELL *v.* BIRMINGHAM VINEGAR BREWERY COMPANY, LTD., [1896] 2 Ch. 54; 12 R. P. C. 496, Stirling, J.[2]

Trade Name of Goods.

This Court doth order that the defendants, The Birmingham Vinegar Brewery Co., Ltd., their servants and agents, be perpetually restrained by injunction from using the words *Yorkshire Relish* as descriptive of or in connection with any sauce or relish manufactured by them, or sauce or relish (not being of the plaintiff's manufacture) sold, or offered for sale, by them without clearly distinguishing such sauce

Injunction against use of trade name of plaintiff's goods.

[1] Affirmed by the Court of Appeal, [1893] 2 Ch. 388; 10 R. P. C. 195; and by the House of Lords, [1894] A. C. 8; 11 R. P. C. 4.

[2] Affirmed on appeal, [1896] 2 Ch. 54; 13 R. P. C. 235, and by the House of Lords, [1897] A. C. 710; 14 R. P. C. 720.

Account of profits.

or relish from the sauce or relish of the plaintiff. And it is ordered that the following account be taken at the risk of the plaintiff: an account of all profits made by the defendants by the sale of any sauce or relish (not manufactured by the plaintiff in bottles having labels with the words *Yorkshire Relish* thereon. And it is ordered that in case the defendants shall on or before 12th November, 1895, serve a notice of appeal from this order, the restraint hereby imposed is, so far as regards the label secondly issued by the defendants, to be suspended until after such appeal shall have been heard or otherwise disposed of. (The defendants were ordered to pay the costs of the action.)

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21. Grezier and Doyle v. Autran, 13 R. P. C. 13 (1896), Chitty, J.

Trade Name of Goods and Passing-off.

Injunction against use of name on goods not made by plaintiff at particular place.

Exception.

Injunction against selling excepted goods under name without distinguishing;

and from referring to recipe.

Similar injunctions and exception as to another name;

and from referring to recipe without a particular statement.

(1) An injunction to restrain the defendant Hippolyte Autran, his servants and agents, until further order from selling, or offering or advertising for sale, within the United Kingdom, under the name of "*Liqueur de Chartreuse*," or "*Chartreuse*," or under any other description of which the name "Chartreuse" forms part, any liqueur which has not been, or shall not be, manufactured by the plaintiff, Gabriel Alfred Grezier, or his assignor, Louis Garnier, at the Monastery of La Grande Chartreuse, in France, or elsewhere in the district or region known as La Grande Chartreuse, in France, hereinafter referred to as the "Monastery Liqueur," save and except the following liqueur, that is to say, liqueur which has been or shall be manufactured at one distillery or establishment at Voiron, in France, by Henri Meunier, the father, or by Henri Meunier, the son, or by other the persons, if any, for the time being entitled, according to the law of France, as set forth in the judgment of the Civil Court of Grenoble, dated the 2nd of March, 1895, to the benefit of the agreement dated the 9th of July, 1842. (2) An injunction to further restrain the defendant Hippolyte Autran, his servants and agents, until further order from selling, or offering or advertising for sale, within the United Kingdom, the said excepted liqueur under the name of "*Chartreuse*" simply, and from selling, or offering or advertising for sale, within the United Kingdom, under the name of "*Liqueur de Chartreuse*," or any other description of which the name "*Chartreuse*" forms part, the said excepted liqueur, without clearly distinguishing the same from the Monastery liqueur; and further, on any sale, or offer or advertisement for sale, of the said excepted liqueur, from making any mention of or reference to the recipe of Don Niviere, given to Charles Meunier, the grandfather, in 1813, intended or calculated to induce to the belief that the said excepted liqueur has been or is made according to such recipe. (3) An injunction to restrain the defendant Hippolyte Autran, his servants and agents, until further order from selling, or offering or advertising for sale, within the United Kingdom, under the name of "*Elixir Vegetal de la Grande Chartreuse*," or under any other description of which the name "*Chartreuse*" forms part, any liquid for medicinal use which has not been or shall not be manufactured by the plaintiff, Gabriel Alfred Grezier, or his assignor, Louis Garnier, at the Monastery of La Grande Chartreuse, in France, or elsewhere in the district or region known as La Grande Chartreuse, in France, hereinafter referred to as "Monastery Elixir," save and except the "Elixir Vegetal," which has been or shall be manufactured at one distillery or establishment at Voiron, in France, by Henri Meunier, the father, or by Henri Meunier, the son, or by other persons, if any, for the time being entitled, according to the law of France, as set forth in the said judgment of the Civil Court at Grenoble, dated the 2nd of March, 1895, to the benefit of the said agreement dated the 9th of July, 1842. (4) An injunction to further restrain the defendant Hippolyte Autran, his servants and agents, until further order from selling, or offering or advertising for sale, within the United Kingdom the said excepted elixir under the name of "*Elixir Vegetal de la Grande Chartreuse*," or under any other name of which the name "*Chartreuse*" forms part, first, without clearly distinguishing the same from the Monastery elixir, and secondly, without stating in English whenever mention or reference is made to the said recipe, that part of Article 4 of the said agreement, dated the 9th of July, 1842, in which it is formally declared that the processes of Henri Meunier, the father, as to the manufacture of the said excepted elixir, have no connection with those at the Monastery of La Grande Chartreuse aforesaid. And the parties were to be at liberty to apply to extend or vary the terms of the said injunctions, having regard to the result of any further proceedings in France relating to the said agreement dated the 9th of July, 1842.

22. ROYAL BAKING POWDER COMPANY'S TRADE MARKS, 14 R. P. C. 425 (1897), Romer, J.[1]

Trade Marks Expunged.

This Court doth order that the Register of Trade Marks be rectified by expunging therefrom Trade Marks Nos. 66,683 and 66,684, both in Class No. 42. And it is ordered that notice of this order be given to the Comptroller-General of Patents, Designs, and Trade Marks[2] by serving a copy of this order upon the said Comptroller, or by leaving the same with a clerk at the office of the said Comptroller, and at the same time producing the duplicate of this order passed and entered.

Order expunging marks.

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23. SAXLEHNER *v.* APOLLINARIS COMPANY, 14 R. P. C. 657 (1897).

Trade Name of Goods.

An injunction to restrain the defendants, their officers, &c., from selling or offering, or exposing or advertising for sale, in the United Kingdom, any Hungarian bitter water, not being "Hunyadi Janos" water derived from the plaintiff's spring near Buda Pesth, in the Kingdom of Hungary, under or with or by means of any name or description of which the name "Hunyadi" forms part, without clearly distinguishing the same from the water derived from the said spring. Delivery up or destruction of all labels and other documents, and also capsules in the possession or power of the defendants, or under their control, which exhibit the name "Hunyadi" in connection with Hungarian bitter water without clearly distinguishing the same from water derived from the said spring. (An account of profits, limited as agreed, was also ordered, and a special order was made as to costs.)

Injunction to restrain use of word without clearly distinguishing.

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24. KYNOCH & Co.'s TRADE MARK, 14 R. P. C. 905 (1897), Kekewich, J.

Order to proceed with Registration.

Upon motion this day made unto this Court for the above-named applicants, Messrs. G. Kynoch & Co., Ltd., being an appeal from the Comptroller-General[3] to register the word *Kynite* in Class 20 in respect of all goods included in that class, which appeal has been referred to the Court by the Board of Trade, and upon, &c., this Court doth order that the Comptroller-General do proceed with the registration of the said trade mark.

Order to proceed with registration.

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25. F. PINET ET CIE. *v.* MAISON LOUIS PINET, LTD.; and SAME *v.* MAISON PINET, LTD., 15 R. P. C. 73 (1898), North, J.

Trade Name.

Upon the two several motions for injunction this day made unto this Court by counsel for the plaintiffs in the respective actions, and upon, &c.; and the plaintiffs and defendants in both actions by their counsel consenting that the hearing of the said motions should be treated as motions for judgment in the respective actions, and the plaintiffs by their counsel waiving any claim for damages. The Court doth order that the defendant, Frederick William Shepherd, the liquidator thereof, be perpetually restrained from transferring, selling, or dealing with any right to the name *Pinet*, or any title or description including that name in connection with the manufacture or sale of boots or shoes. And it is ordered that the defendants, Maison Louis Pinet, Ltd., Frederick Westwood Potter, William Alfred Phillips, Arthur Joshua Eastmead, and Louis Marius Pinet, and Maison Pinet, Ltd., Frederick William Shepherd, and Walter Kelsey, be perpetually restrained from

Injunction restraining liquidator from selling name.

Injunction restraining other defendants from

[1] See 18 R. P. C. 97.

[2] Now called the Registrar of Trade Marks. This is to be done by the person in whose favour the order has been made. Rule 129.

[3] See note (2).

using name in connection with certain goods or conferring use of it on others; and from selling goods under certain names.

using the said name *Pinet*, or any such title or description as aforesaid, in such connection as aforesaid, and from doing any other act or thing conferring, or purporting to confer, either directly or indirectly, upon any other person or persons any right to use the said name or other such title or description as aforesaid, in such connection as aforesaid, and from selling or offering for sale any boots or shoes not of the plaintiff's manufacture under the name of "*Pinet's* Special Boots and Shoes," or "*Pinet's* Boots and Shoes."

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26. EASTMAN PHOTOGRAPHIC MATERIALS COMPANY, LTD. *v.* JOHN GRIFFITHS CYCLE CORPORATION, LTD., and KODAK CYCLE COMPANY, LTD., 15 R. P. C. 112 (1898), Romer, J.

Trade Name and Passing-off.

Injunction restraining carrying on business under name; or representing that defendant's business is connected with plaintiff's; or selling goods under name.

An injunction restraining the defendant companies, or either of them, from carrying on business under the name "*Kodak Cycle Company, Ltd.*," or under any name comprising the word "*Kodak*" likely to mislead or deceive the public into the belief that the defendant company is the same company as or is connected with either of the plaintiff companies, or that the business of the said companies, or either of them, is the same as, or is in any way connected with, the business of the plaintiffs, The Eastman Photographic Materials Company, Ltd. An injunction restraining the defendant companies, and each of them, from selling, or offering to sell, any of their cycles or goods as "*Kodak*." The defendants to pay the costs, including the costs of the Comptroller.[1]

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27. VALENTINE MEAT JUICE COMPANY *v.* VALENTINE EXTRACT COMPANY, LTD., 17 R. P. C. 688 (1900), C. A.

Trade Name and Passing-off.

Injunction restraining certain defendants from carrying on certain business under name; and from selling goods under name; and another defendant from doing so without distinguishing; and all defendants from representing connection with plaintiffs or passing off.

"This Court doth order that the defendants, the Valentine Extract Company, Ltd., and Herbert Hughes, and each of them, their servants and agents, be perpetually restrained from carrying on business as manufacturers or vendors of any preparation of extract of meat or meat juice under any name or title of which the name '*Valentine*' or '*Valentine's*' forms part, and from selling, or offering, or exposing, or advertising for sale, or procuring to be sold any such preparation as aforesaid not being of the plaintiff's manufacture under any name or description of which the name '*Valentine*,' or '*Valentine's*,' or '*Valtine*' forms part. And it is ordered that the defendant, Charles Richard Valentine, his servants and agents, be perpetually restrained from carrying on any such business as aforesaid, under any such name or title as aforesaid, without clearly distinguishing such business from the business of the plaintiffs, and from selling, or offering, or exposing, or advertising for sale, or procuring to be sold, any such preparation as aforesaid, under any such name or description as aforesaid, without clearly distinguishing such preparation from goods of the plaintiffs. And doth order that the defendants, the Valentine Extract Company, Ltd., Charles Richard Valentine, and Herbert Hughes, and each of them, their servants and agents, be perpetually restrained from in any manner representing or acting so as to be calculated to lead to the belief that the defendant, Charles Richard Valentine, is or ever has been interested in or connected with the business of the plaintiffs, and from passing off, or enabling or assisting others to pass off, any such preparation as aforesaid not being of the plaintiff's manufacture, as or for the plaintiff's goods." (The order directed a delivery up of infringing labels and boxes and an inquiry as to profits, and that the costs of the action and the appeal be paid by the defendants.)

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28. J. & J. CASH, LTD. *v.* CASH, 18 R. P. C. 220; 19 R. P. C. 186 (1902), C. A.[2]

Trade Name.

Injunction restraining defendant

An injunction to restrain the defendant, *Joseph Cash*, from *selling any frillings or woven names or initials not manufactured by the plaintiffs as "Cash's Frillings"*

[1] There was also an order to expunge the first defendant company's mark "*Kodak*."

[2] The order made by Kekewich, J., restrained the defendant from carrying

from carrying on business in certain goods under his own name;

or so as to mislead;

or "Cash's Woven Names" or "Initials," and from carrying on the business of a manufacturer or seller of frillings or woven names or initials under the name of "Joseph Cash & Co." while not in partnership with any other person, and from carrying on any such business either in the name of "Cash" or under any style in which the name "Cash" appears without taking reasonable precautions to clearly distinguish the business carried on and the frillings and woven names and initials manufactured or sold by the defendant from the business carried on and the frillings and woven names and initials manufactured by the plaintiffs, and from carrying on any such business under any name or in any manner so as to mislead or deceive the public into the belief that the business of the defendant, or the frillings or woven names or initials manufactured or sold by him, are the business of or goods manufactured by the plaintiffs, or that the defendant is carrying on the business formerly carried on at Coventry by Messrs. J. & J. Cash, the vendors to and predecessors in business of the plaintiffs; an injunction to restrain the defendant from making over his business in frillings or woven names or initials to, or acting as managing director of, any limited or other company formed to carry on business in frillings or woven names or initials, and having a name which is calculated or likely to mislead or deceive the public into the belief that the business, frillings, or woven names or initials of such company are the business, frillings, or woven names or initials of the plaintiffs, or that such company is carrying on the business formerly carried on at Coventry by the said Messrs. J. & J. Cash, and from otherwise assisting any such company to so mislead or deceive the public. (An injunction against soliciting was also granted with the costs of the action, and, the defendant alleging that an interlocutory injunction which had been granted was wider than that granted at the trial, he was to be at liberty to apply for an inquiry as to damages sustained by reason of the interim order).[1]

and from transferring his business to company having name calculated to mislead.

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29. Maréchal and Ruchon v. McCologan, 18 R. P. C. 264 (1901), Chatterton, V.-C., Ireland.

Trade Mark. Infringement by Stamping.

Injunction restraining defendant from stamping pipes as "J. B. D," and from selling pipes so stamped.

An injunction to restrain the defendant, his agents, servants, and workmen from stamping or affixing, or procuring or causing to be stamped or affixed on any pipes, pipe cases, cigar or cigarette cases, the mark "J. B. D.," or any other colourable imitation of the plaintiff's trade mark "G. B. D.," and from selling or exposing for sale any pipes, &c., so marked other than those of the plaintiff's manufacture; and that the defendant deliver up to the plaintiffs or their solicitors all pipes in his possession bearing the mark "J. B. D.," together with the instrument, if any, used for stamping the said mark thereon.

Delivery up of stamp.

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30. La Société Anonyme des Anciens Établissements Panhard et Levassor v. Panhard-Levassor Motor Co., Ltd., and Others, 18 R. P. C. 410 (1901), Farwell, J.

Trade Name. Injunction against Signatories of Memorandum of Association.

Injunction restraining defendants from using certain names in connection with motor cars; and restraining certain defendants from allowing defendant company to remain registered under its name.

"This Court doth order and adjudge that the defendants, the Panhard-Levassor Motor Co., Ltd.," and the seven other defendants, naming them, "their servants or agents, be perpetually restrained from using the names of Panhard and Levassor, or either of them, or any title or description including those names, or either of them, or otherwise colourably resembling the name of the plaintiffs, in connection with the manufacture, use, or sale of or other dealing in, motor cars or parts thereof." And it was ordered that the seven defendants (other than the company), naming them, "do not allow the defendant company to remain registered under its present name, or any such title or description as aforesaid."

on business of a manufacturer or seller of frillings or woven names or initials under the name of Joseph Cash & Company, or under the name of "*Cash.*" For these words the Court of Appeal substituted the words in italics.

[1] There were special reasons for not granting the inquiry at the trial. See the report.

31. Davenport's Trade Mark, 21 R. P. C. 728 (1904), Joyce, J.

Alteration of Trade Mark.

Order allowing certain alterations of registered trade mark as shown in an exhibit.

"The applicants by their counsel undertaking to supply the Comptroller-General of Patents, Designs and Trade Marks[1] with a block of the mark as altered,[2] this Court doth order that the register of trade marks be rectified by altering the registration of the above-mentioned trade mark No. 3,411, in the following respects—that is to say, by adding the word 'Limited' after the name 'J. T. Davenport' where the same first appears on the said trade mark, and by substituting the word 'Manufacturers,' 'Chemists,' and 'Pharmaceutists' for the words 'Manufacturer,' 'Chemist,' and Pharmaceutist,' respectively, and by substituting the address, 117, Union Street, London, S.E., England, for the address which now appears on the said trade mark, and by inserting the word 'Late' before the words 'Duke of Cambridge' and omitting the word 'Government' therefrom, so that the said trade mark as altered may be as shown by the exhibit marked A3, referred to in the said affidavit of Horace Davenport. And it is ordered, that due notice of this order may be given to the said Comptroller by serving a copy of this order upon the said Comptroller or by leaving the same with a clerk at the office of the said Comptroller, and at the same time producing a duplicate of this order duly passed and entered."[3]

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32. Weingarten v. Bayer & Co., 22 R. P. C. 351 (1905), H. of L.

Injunction against Passing-off by Use of Special Scroll. Profits.

Injunction restraining defendant from selling goods in boxes bearing a certain scroll; and account of profits.

An injunction to restrain the defendants, their servants and agents from selling or offering for sale corsets in boxes bearing the scroll or an imitation of the scroll used by the plaintiffs in connection with their corsets or any corsets designated by show cards or labels bearing such scroll or imitation, or otherwise distinguished by such scroll or imitation. Account ordered of the profits derived by the defendants from the sale of corsets in such boxes or so designated or distinguished.

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33. Major Brothers v. J. Franklin & Son, 25 R. P. C. 406 (1908), Jelf, J.

Infringement of Trade Mark. Certificate of Validity.

Certificate of validity of trade mark having come into question.

This action having on the 22nd, 23rd, and 24th days of January, 1908, been tried before the Honourable Mr. Justice Jelf without a jury in the county of London, and the said Honourable Mr. Justice Jelf on the 24th day of January, 1908, having ordered that judgment be entered for the plaintiffs for one shilling damages and granted an injunction restraining the defendants, their servants and agents, from infringing the registered trade marks of the plaintiffs No. 258,116 in Class 42. and No. 258,117 in Class 50, consisting of or comprising the letters "M.A.J.O.," with costs on the High Court scale, and having certified that at the trial of this action the validity of the plaintiffs' registered trade mark came into question,[4]

Damages and costs.

It is this day adjudged that the plaintiffs recover from the defendants one shilling damages and costs on the High Court scale to be taxed, and it is further ordered and adjudged that the defendants, their servants and agents, be and are hereby restrained from infringing the registered trade marks of the plaintiffs, No. 258,116 in Class 42, and No. 258,117 in Class 50, consisting of or comprising the letters "M.A.J.O."

Injunction restraining infringement of trade marks.

[1] Now called the Registrar of Trade Marks.

[2] See now Rule 94, p. 667.

[3] See now Rule 129, p. 672.

[4] *Query*, whether the certificate should not state that the question of validity was decided in favour of the proprietor of the trade mark, see. 46, above, p. 466.

APPENDIX XIII.

ORDERS IN COUNCIL APPLYING THE PROVISIONS AS TO INTERNATIONAL AND COLONIAL ARRANGEMENTS, FOREIGN STATES AND BRITISH POSSESSIONS.[1]

Colonial Arrangements.

Colony.	Date of Order in Council.	Statutory Rules and Orders.
Ceylon	7 Aug., 1903	1905, p. 268, No. 933.
Commonwealth of Australia	26 March, 1907	1907, p. 773, No. 263.
Queensland[2]	17 Sept., 1885	Vol. 5, p. 141.
New Zealand	8 Feb., 1890	1890, p. 887.
Tasmania[2]	30 April, 1894	1894, p. 54, No. 123.
Trinidad and Tobago ...	12 Aug., 1907	1907, p. 777, No. 652.
Western Australia[2] ...	11 May, 1895	1895, p. 587, No. 245.

International Arrangements.[3]

Foreign state.	Date of Order in Council	Statutory Rules and Orders.
Belgium	26 June, 1884	Vol. 5, p. 142.
Brazil	26 June, 1884	Vol. 5, p. 142.
Cuba	12 Jan., 1905	1905, p. 270, No. 10.
Denmark (including the Faroe Islands)	20 Nov., 1894	1894, p. 56, No. 542.
Dominican Republic ...	21 Oct., 1890	1890, p. 887.
*Ecuador	16 May, 1893	1893, p. 65.
France (with Algeria and Colonies)	26 June, 1884	Vol. 5, p. 142.
Germany	9 Oct., 1903	1903, p. 1170, No. 867.
*Greece	15 Oct., 1894	1894, p. 57, No. 234.
*Honduras...	26 Sept., 1901	1901, p. 320, No. 799.
Italy	26 June, 1884	Vol. 5, p. 142.
Japan	7 Oct., 1899	1899, p. 964, No. 759.
Mexico	28 May, 1889	Vol. 5, p. 146.
Netherlands	26 June, 1884	Vol. 5. p. 142.
Netherlands (East Indian Colonies)	17 Nov., 1888	Vol. 5, p. 145.
Netherlands (Curaçao and Surinam.)	17 May, 1890	1890, p. 886.
Norway	See Sweden.	
*Paraguay	24 Sept., 1886	Vol. 5, p. 144.

[1] Sections 103 and 104 of the Patents, &c., Act, 1883. Now replaced by sec. 91 of the Patents and Designs Act, 1907.

[2] Consequent on the Order in Council applying the section to the Commonwealth of Australia, the Orders in Council relating to Queensland and Western Australia were revoked on March 26th, 1907, and that relating to Tasmania on August 12th, 1907.

[3] As to Guatemala, Salvador, and Ecuador, see p. 749. Those countries &c., marked * (including Ecuador) are not parties to the International Convention, but similar arrangements exist between them and Great Britain for the mutual protection of trade marks.

INTERNATIONAL ARRANGEMENTS[1]—*continued.*

Foreign State.	Date of Order in Council.	Statutory Rules and Orders.
Portugal (with the Azores and Madeira)	26 June, 1884	Vol. 5, p. 142.
*Roumania[1]	5 Aug., 1892	1892, p. 650.
Servia	26 June, 1884	Vol. 5, p. 142.
Spain	26 June, 1884	Vol. 5, p. 142.
Sweden	9 July, 1885	Vol. 5, p. 143.
Switzerland	26 June, 1884	Vol. 5, p. 142.
Tunis	26 June, 1884	Vol. 5, p. 142.
United States	12 July, 1887	Vol. 5, p. 145.
*Uruguay[1]	24 Sept., 1886	Vol. 5, p. 144.

PLACES UNDER BRITISH JURISDICTION.

Penalties on British subjects committing offences against the Patents, &c. Acts, 1883 to 1888.[2]

Places.	Date of Order in Council.	Statutory Rules and Orders.
Africa—		
(*a*) *Continent and adjacent Islands* (excluding certain of the territories to which the Order noted infra, under (*b*), and Orders dealing with other parts[3] apply).	15 Oct., 1889, Art. 55 ...	Vol. 3, pp. 259, 273.
(*b*) *East Africa*	7 July, 1897, Art. 17 ...	1897, pp. 134, 141, No. 575.
Brunei	22 Nov., 1890, Art. 40 ...	1890, p. 677.[4]
China and Corea	11 Feb., 1907, Art. 3 ...	1907, p. 185, No. 107.
Egypt	8 Aug., 1899, Art. 57 ...	1899, pp. 643, 662, No. 595.[5]
Morocco	28 Nov., 1889, Art. 112...	Vol. 3, p. 524, 558.
Ottoman Empire (and see Egypt, supra)	8 Aug., 1899, Art. 57 ...	1899, pp. 643, 662, No. 595.
Persia	13 Dec., 1889, Art. 292	Vol. 3, pp. 698, 766.
Persian Coast and Islands	13 Dec., 1889, Art. 50 ...	Vol. 3, pp. 796, 815.
Siam	4 April, 1906, Art. 59 ...	1906, p. 227, No. 282.
Somaliland...	7 Oct., 1899, Art. 12 ...	1899, pp. 705, 711, No. 758.
Turkey. See Ottoman Empire	... ...	... ...
Zanzibar	7 July, 1897, Art. 17 ...	1897, pp. 159, 165, No. 576.

[1] See note (3), previous page.

[2] Orders in Council issued under 41 & 42 Vict. c. 67, now replaced by 53 & 54 Vict. c. 37.

[3] See the Index to the Statutory Rules and Orders in force on December 31st, 1903, and subsequent volumes.

[4] The Brunei Order, 1901, No. 588, does not appear to affect the above-mentioned Order, so far as relates to patents, &c.

[5] This Order (the Ottoman Order in Council, 1899) is (Art. 12) suspended as regards matters within the jurisdiction of the Egyptian Courts established with his Majesty's concurrence, and the limits of the Order as respects Egypt do not extend to any place south of the 22nd parallel of north latitude.

APPENDIX XIV.

THE INTERNATIONAL CONVENTION.[1]

INTERNATIONAL CONVENTION BETWEEN THE GOVERNMENTS OF BELGIUM, BRAZIL, SPAIN, FRANCE, GUATEMALA,[2] ITALY, NETHERLANDS, PORTUGAL, SALVADOR,[2] SERVIA, AND SWITZERLAND, FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

Signed at Paris, March 20th, 1883.

[*Ratifications exchanged at Paris, June 6th*, 1884.]

(Translation.)

ART. I. THE Governments of Belgium, Brazil, Spain, France, Guatemala,[2] Italy, Holland, Portugal, Salvador,[2] Servia, and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

ART. II. The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

Similar provisions to those of this Article and of Art. III. were to be found in particular treaties between individual States; but, owing to differences in municipal law, they were insufficient to provide for the protection of trade marks. Thus, in France, Italy, and other countries, no right arises to the applicant for the registration of a trade mark from the mere registration if another has previously held the same mark for goods of the same kind. In Germany, Sweden, Norway, &c., the mark belongs to the first applicant. "It has thus happened that unscrupulous competitors in countries where the latter system exists have hastened to register in their own names the new names registered in its own country by a well-known house, so that they were *placed in a position to compete unfairly with the house* by means of its own marks, and even to have its goods seized for infringement of trade mark." (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i., 1897, p. 186.) It was impossible to

[1] Further articles were agreed upon at the Conference at Rome in 1886 (see Parliamentary Paper, C.—4837), but were never ratified. The articles printed below, p. 749, were agreed upon at the Conference at Madrid in 1889, and they have been duly ratified by Great Britain, Spain, France, Switzerland, and Tunis. The articles printed below, p. 751, were not ratified by Great Britain. Amendments of the Convention were made by the Brussels Act of December 14th, 1900. These are italicised or are referred to in the notes. Servia and the Dominican Republic have not ratified the Brussels Act.

[2] Salvador withdrew from this Convention by notice dated September 6th, 1886; Guatemala by notice dated November 27th, 1894, taking effect on November 8th, 1895.

compel these countries to alter the basis of their legislation. Hence Art. IV. gave persons interested the necessary time to register their marks in all the States of the Union before another could anticipate them. See note to Art. IV.

ART. III. Subjects or citizens of States not forming part of the Union, who are domiciled, or have *real and effective* industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

See note to Art. II., supra. The italicised words were added by the Brussels Act.

ART. IV. Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

In some foreign countries registration is equivalent to ownership, notwithstanding prior user or prior registration elsewhere. Hence the provision in the Convention as to priority.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it [by a third party], by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be [six] months for patents and [three] months for industrial designs and models and trade marks. [A month longer is allowed for countries beyond sea.]

See note to Art. II. The Brussels Act substitutes "twelve" and "four" for "six" and "three," and omits the other bracketed words. Art. IV., as amended, provides a period of four months during which the mark may be registered in all the Contracting States, and the efficacy of the registration cannot be affected by acts which have been accomplished in the interval, and in particular by another registration or the use of the mark.

ART. IVB. Added by the Brussels Act relates only to patents.

ART. V. The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

Forfeiture for importation is unknown to English law.

Compulsory working was introduced by sec. 27 of the Patents and Designs Act, 1907.

ART. VI. Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

See also note to Art. 4 of the Final Protocol, post, p. 747.

ART. VII. The nature of the goods on which the trade mark is to be used can, in no case, be an obstacle to the registration of the trade mark.

This provision relates to the case where the mark is intended for goods whose sale in the country is either forbidden or permitted only after official investigation. Medical remedies are here principally contemplated. This article, by permitting the registration of marks for such goods, allows the owner of a mark to take care at any rate that no other can obtain the use of the same mark for other similar goods, which might afterwards be opposed to the original mark, when the goods in question can be introduced into commerce. (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i., 1897, p. 188.)

ART. VIII. A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark.

In France it had been decided by the Cour de Cassation, in *Beissel's* case (*Annales de la Propriété Industrielle*, 1880, p. 113), that a mark in becoming public property carried with it the trade name which formed part of it. Hence Art. VIII.

ART. IX. All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

The Act of Brussels adds: "*In those States of which the legislation does not admit of the seizure on importation, this seizure may be replaced by an injunction against importation. The authorities are not obliged to effect a seizure in case of transit.*"

Arts. IX. and X. are applied in English law by the provisions of the M. M. A. 1887, which go much further than, and therefore satisfy, the provisions of the Convention. This article was a great benefit to the States which made liberal provision in regard to the device of marks. But this benefit gradually diminished owing to the tendency of all the States of the Union to adopt a broader conception of marks.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

ART. X. The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any *producer*, manufacturer of, or trader in, such goods, established *either* in the locality falsely designated as the place of origin *or in the region in which such locality is situated*, shall be deemed an interested party.

See note to Art. IX.

ART. XB. *Persons resorting to the countries referred to in the convention (Arts. II. and III.) shall enjoy in all States of the Union, the protection accorded to natives against dishonest competition.*

ART. XI. The high contracting parties agree to grant *in conformity with the legislation of each country* temporary protection to patentable

inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognised international exhibitions *held in the territory of one of them.*

This article is carried out as regards patents and designs by secs. 45 and 59 of the Patents and Designs Act, 1907. No analogous provision was required as regards trade marks, as the right to a trade mark in England is acquired not by priority of registration, but by priority of user. A doubt arose under this article whether temporary protection ought to be granted by every State of the Union merely for the exhibitions which take place in its territory, or whether it should be extended to exhibitions in the other Contracting States. The Brussels Conference (*La Propriété Industrielle*, 1898, p. 2) interpreted the article in the latter sense; and see the sections referred to above.

ART. XII. Each of the high contracting parties agrees to establish a special government department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

ART. XIII. An international office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the central administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

ART. XIV. The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end conferences shall be successively held in one of the Contracting States by delegates of the said States. The next meeting shall take place in 1885 at Rome.

ART. XV. It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present Convention.

ART. XVI. States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention *and shall take effect one month after the despatch of the notification made by the Swiss Government to the other States of the Union, unless a later date is indicated by the acceding State.*

ART. XVII. The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ART. XVIII. The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for

an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other contracting parties.

[*Here follow the Signatures.*]

Final Protocol.

On proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed as follows:—

1. The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.[1]

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union from the fact alone that it does not satisfy, in regard to the signs composing it,[2] the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark,[2] and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.[3]

5. The organisation of the special department for industrial property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

[1] Article 3b relates to compulsory working of patents.

[2] The expressions "in regard to the signs composing it" and "only to the form of the mark" were, no doubt, used because special attention was directed to name marks, which at that time were not considered as marks in a certain number of States. At present the majority of States do recognise names as marks, but with all kinds of restrictions which tend to destroy the effect of the concession. (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i. (1897), p. 144.)

[3] The object of clause 4 has been suggested to be to protect word marks in countries where the local law did not admit them. (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i. (1897), p. 141.) On the other hand, the view has been put forward (*ib.*) that, under the last paragraph of this clause, States may refuse, as "contrary to public order," marks which, whilst apparently mere fancy names, consist of a new name of the product, or words descriptive of it, and those which are more or less likely to lead to mistakes. (*Sed quære?*)

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2,000fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely :—

1st class	... ...	25	units.
2nd „	... ...	20	„
3rd „	... ...	15	„
4th „	... ...	10	„
5th „	... ...	5	„
6th „	... ...	3	„

These coefficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense :—

1st class	...	France, Italy.
2nd „	...	Spain.
3rd „	...	Belgium, Brazil, Portugal, Switzerland.
4th „	...	Holland.
5th „	...	Servia.
6th „	...	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account, which will be communicated to all the other Administrations.

The International Office will centralise information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement, which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said Administrations or by societies or private persons, will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The Administration of the country in which the next Conference is to be held will make preparation for the transactions of that Conference, with the assistance of the International Office.

The Director of the International Office will be present at the

meetings of the Conferences, and will take part in the discussions but without the prlvilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present final protocol, which shall be ratified together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as, the said Convention.

[*Here follow the signatures.*]

Accessions and Withdrawals.[1]

Cuba acceded September 22, 1904.

Denmark (including the Faroe Islands) acceded October 1, 1894.

Dominican Republic acceded December 8, 1884.

Ecuador acceded December 21, 1883, but withdrew February 27, 1886.[1]

Germany acceded May 1, 1903.

Greece, declaration October 15, 1894.

Guatemala withdrew by notice dated November 27, 1894, taking effect November 8, 1895.

Japan acceded by notice dated April 15, 1899, taking effect July 15, 1899.

Salvador, a signatory party, withdrew September 6, 1886.

Sweden acceded June 18, 1885.

United States acceded May 30, 1887.

ARRANGEMENT BETWEEN GREAT BRITAIN, SPAIN, FRANCE, SWITZERLAND, AND TUNIS, FOR THE PREVENTION OF FALSE INDICATIONS OF ORIGIN OF GOODS.[2]

Signed at Madrid, April 14, 1891.

[*Ratifications exchanged at Madrid, June* 15, 1892.]

(Translation.)

THE undersigned Plenipotentiaries of the States hereinafter enumerated,

In view of Article XV. of the International Convention of the 20th March, 1883, for the protection of industrial property,

Have mutually concluded the following arrangement, subject to ratification :—

ART. I. All goods bearing a false indication of origin, in which one of the Contracting States, or a place situated therein, shall be directly or

[1] See the list printed at p. 741, where the list of British Possessions to which the Convention is now applicable will also be found.

[2] Parliamentary Paper, Treaty Series, No. 13 (1892)

indirectly indicated as being the country or place of origin, shall be seized on importation into any of the said States.

The seizure may also take place either in the State where the false indication of origin has been applied, or in that into which the goods bearing the false indication may have been imported.

If the law of any State does not permit seizure on importation, such seizure shall be replaced by prohibition of importation.

If the law of any State does not permit seizure in the interior, such seizure shall be replaced by the remedies assured in such case to natives by the law of such State.

ART. II. The seizure shall take place at the request either of the proper Government Department, or of an interested party, whether individual or society, in conformity with the domestic law of each State.

The authorities are not bound to effect the seizure of goods in transit.

ART. III. The present stipulations are not intended to prevent the vendor from indicating his name or address upon goods coming from a country other than that where the sale takes place; but in such case the address or the name must be accompanied by a clear indication in legible characters of the country or place of manufacture or production.

ART. IV. The tribunals of each country will decide what appellations, on account of their generic character, do not fall within the provisions of the present arrangement, regional appellations concerning the origin of products of the vine being, however, not comprised in the reserve provided for by the present article.

It has been suggested that, instead of the courts of law being left to deal with the question *pro re natâ*, either the Contracting States or the competent authorities in every country should be required to determine beforehand what local names in their territory are to be considered as generic. (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i. (1897).) There would, however, be great difficulty in carrying out either suggestion. In some cases the law of the country might not permit the Executive to trespass in this way on the domain of the Courts. Names that ought to find a place in the generic lists would be omitted. Who would decide as to translated names and names of countries?—as in the case of "Russia leather," which in German (*Russisches leder*) means leather from Russia, while in England and in France (*cuir de Russie*) it means a peculiar kind of leather called in Germany *juchtenleder*. (*Ib.* pp. 179, 180, and n. 120.)

ART. V. States which are parties to the Union for the Protection of Industrial Property, and who have not adhered to the present arrangement, shall be allowed to accede on demand in the manner prescribed by Article XVI. of the Convention of the 20th March, 1883, for the Protection of Industrial Property.

ART. VI. The present arrangement shall be ratified, and the ratifications shall be exchanged at Madrid within six months at the latest.

It shall come into force one month after the exchange of ratifications, and have the same force and duration as the Convention of the 20th March, 1883.

In witness whereof the plenipotentiaries of the States hereinafter enumerated have signed the present arrangement at Madrid, 14th April, 1891.

[Signed on behalf of Brazil, Spain, France and Tunis, Great Britain, Guatemala, Portugal, and Switzerland, but Brazil, Guatemala, and Portugal did not ratify.]

ARRANGEMENT RELATING TO THE INTERNATIONAL REGISTRATION OF TRADE MARKS.[1]

ART. I. The subjects or citizens of each of the contracting States may ensure in all the other States the protection of their trade marks accepted for registration in the country of origin by applying for the said marks at the International Office at Berne, through the agency of the administration of the said country of origin.

ART. II. The subjects or citizens of States which have not adhered to the present arrangement who satisfy the conditions of Article III. of the Convention shall be assimilated to the subjects or citizens of the Contracting States.

ART. III. The International Office shall immediately register marks applied for, in accordance with Article I. It shall notify such registration to the contracting States. The marks registered shall be published in a supplement to the journal of the International Office, by means of a drawing or a description in the French language provided by the applicant.

With a view to provide the necessary publicity in the various States for marks so registered, each administration shall receive gratis from the International Office such a number of copies of the said publication as it shall think fit to demand.

ART. IV. From the date of registration so made at the International Office, the protection in each of the contracting States shall be the same as if the mark had been directly registered there.

ART. V. In the countries where their law authorises them to do so, the administrations to which the International Office gives notice of the registration of a mark shall have power to declare that protection cannot be granted to such mark in their territory. They shall exercise such power within a year of the notice prescribed by Article III.

Such a declaration so notified to the International Office shall be transmitted by it without delay to the administration of the country of origin and to the owner of the mark. The person interested shall have the same remedies as if the mark had been directly registered by him in the country where the protection is refused.

ART. VI. The protection resulting from registration at the International Office shall last for twenty years from such registration, but cannot be invoked in favour of a mark which no longer enjoys legal protection in its country of origin.

ART. VII. Registration may always be renewed in accordance with the provisions of Articles I. and III.

Six months before the expiry of the period of protection, the International Office shall give official notice to the administration of the country of origin and to the owner of the mark.

ART. VIII. The administration of the country of origin shall fix at its pleasure, and shall raise for its own profit, a fee which it may demand

[1] This translation is by Mr. J. F. Iselin (*Trans. Int. Ass. Prot. Ind. Prop.*, vol. i. (1897), p. 111). The restricted Union includes the following States:—Belgium, Brazil, France, Italy, the Netherlands, Portugal Spain, Switzerland, and Tunis. It applies also to the respective colonies of the Contracting States mentioned as forming part of the General Union of 1883. Great Britain did not sign, see above, p. 743.

from the owner of the mark for which international registration is applied for.

To this fee shall be added an international duty of 100 francs, the annual produce of which shall be divided equally amongst the Contracting States, after deducting the costs occasioned by the execution of this arrangement.

ART. IX. The administration of the country of origin shall give notice to the International Office of the annulments, erasures, disclaimers, transfers, and other changes which shall take place in the ownership of the mark.

The International Office shall register these changes, give notice of them to the contracting administrations, and immediately publish them in its journal.

ART. X. The administrations shall regulate by agreement the details relating to the execution of the present agreement.

ART. XI. The States of the Union for the Protection of Industrial Property which have not taken part in the present arrangement shall be permitted to adhere to it upon their demand, and in the form prescribed by Article XVI. of the Convention of the 20th March, 1883, for the Protection of Industrial Property.

As soon as the International Office shall be informed that a State has adhered to the present arrangement, it shall send to the administration of that State, in accordance with Article III., a general notice of the marks which at that time enjoy international protection.

ART. XII. The present arrangement shall be ratified, and the ratifications shall be exchanged at Madrid within six months at the latest. It shall come into force one month after the exchange of ratifications, and shall have the same force and duration as the Convention of the 20th March, 1883.

Final Protocol.

Upon proceeding to the signature of the arrangement relating to the International Registration of Trade Marks, concluded this day, the Plenipotentiaries of the States which have adhered to the said arrangement have agreed as follows:—Doubts having arisen as to the scope of Article V., it is understood that the power of refusal which this Article leaves to the administrations does not affect the provisions of Article VI. of the Convention of the 20th March, 1883, or of paragraph 4 of the accompanying final protocol, these provisions being applicable to marks registered at the International Bureau, as they are, and shall still continue to be applicable to those directly registered in any of the Contracting States. The present protocol shall have the same force and duration as the arrangement to which it relates.

This exchange of ratifications took place on June 15th, 1892.

APPENDIX XV.

TREATY WITH THE UNITED STATES.

The Government of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, and the Government of the United States of America, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:—

The subjects and citizens of each of the contracting parties shall have, in the dominions and possessions of the other, the same rights as belong to native subjects or citizens, or as are now granted or may hereafter be granted to the subjects and citizens of the most favoured nation in everything relating to property in trade marks and trade labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective countries.

In witness whereof the undersigned have signed the present declaration, and have affixed thereto the seal of their arms.

Done at London, the 24th day of October, 1877.

DERBY.

EDWARD PIERREPONT.

APPENDIX XVI.

THE UNITED STATES TRADE MARKS ACT, 1905.[1]

An Act to authorise the registration of trade marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same (*February 20th*, 1905).

BE it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:—That the owner of a trade mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States,[2] or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trade mark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade mark is appropriated;[3] a description of the trade mark itself,[4] and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade mark has been used. With this statement shall be filed a drawing of the trade mark, signed by the applicant, or his attorney, and such number of specimens of the trade mark, as actually used, as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this Act and such regulations as may be prescribed by the Commissioner of Patents.

2. That the application prescribed in the foregoing section, in order to create any right whatever in favour of the party filing it, must be accompanied by a written declaration verified by the applicant, or by a member of the firm or an officer of the corporation or association

[1] This Act has been amended by Acts of 1906 and 1907; see below, p. 801.

[2] The Act of 1906, s. 3, confers the same rights on the owner of a trade mark who shall have a manufacturing establishment within the territory of the United States.

[3] The Act of 1906 provides for a classification, and by sec. 2 enacts that "on a single application for registration of a trade mark the trade mark may be registered at the option of the applicant for any or all goods upon which the mark has actually been used comprised in a single class of merchandise, provided the particular descriptions of goods be stated."

[4] The Act of 1906, s. 1, adds: "Only when needed to express colors not shown in the drawing."

applying, to the effect that the applicant believes himself or the firm, corporation, or association in whose behalf he makes the application, to be the owner of the trade mark sought to be registered, and that no other person, firm, corporation, or association, to the best of the applicant's knowledge and belief, has the right to such use, either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trade mark is used in commerce among the several States, or with foreign nations or with Indian tribes, and that the description and drawing presented truly represent the trade mark sought to be registered. If the applicant resides or is located in a foreign country, the statement required shall, in addition to the foregoing, set forth that the trade mark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or the application therefor, as the case may be, except that in the application in such cases it shall not be necessary to state that the mark has been used in commerce with the United States or among the States thereof. The verification required by this section may be made before any person within the United States authorised by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge or magistrate having an official seal and authorised to administer oaths in the foreign country in which the applicant may be whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States.

3. That every applicant for registration of a trade mark, or for renewal of registration of a trade mark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, as hereinafter provided for, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trade mark of which such applicant may claim to be the owner, brought under the provisions of this Act or under other laws of the United States, may be served with the same force and effect as if served upon the applicant or registrant in person. For the purpose of this Act it shall be deemed sufficient to serve such notice upon such applicant, registrant, or representative by leaving a copy of such process or notice addressed to him at the last address of which the Commissioner of Patents has been notified.

4. That an application for registration of a trade mark filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States, an application for registration of the same trade mark shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trade mark was first filed in such foreign country: Provided, that such application is filed in this country within four months from the date on which the application was first filed in such foreign country: And Provided, That certificate of registration shall not be issued for any mark for registration of which application has been filed by an applicant located in a foreign country

until such mark has been actually registered by the applicant in the country in which he is located.

5. 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:[1] 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.

6. [This section provides for examination of the application and, if the mark is not refused, advertisement in the Official Gazette of the Patent Office, and for notices of opposition, stating the grounds therefor, within thirty days after advertisement, or, if no such notice is given, for issue of a certificate of registration.[2]]

7. That in all cases where notice of opposition has been filed, the Commissioner of Patents shall notify the applicant thereof and the grounds therefor.

Whenever application is made for the registration of a trade mark which is substantially identical with a trade mark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another, or for registration of which another has previously made application, or which so nearly resembles such trade mark, or a known trade mark owned and used by another, as, in the opinion of the Commissioner, to be likely to be mistaken

[1] The Act of 1907 introduces here the words: "Or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem."

[2] Sec. 6 is slightly amended by the Act of 1907, thereby permitting notice of opposition to be given by attorney, subject to verification by the opponent within a reasonable time after filing.

therefor by the public, he may declare that an interference exists as to such trade mark, and in every case of interference or opposition to registration he shall direct the examiner in charge of interferences to determine the question of the right of registration to such trade mark, and of the sufficiency of the objections to registration, in such manner and upon such notice to those interested as the Commissioner may by rules prescribe.

The Commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark, as a trade mark, for the person first to adopt and use the mark, if otherwise entitled to register the same unless an appeal is taken, as hereinafter provided for, from his decision, by a party interested in the proceeding, within such time (not less than twenty days) as the Commissioner may prescribe.

8. [This section gives a right of appeal from the examiner in charge of trade marks, or the examiner in charge of interferences, to the Commissioner in person.]

9. [This section gives a further right of appeal to the Court of Appeals of the district of Columbia.]

10. That every registered trade mark, and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the goodwill of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof. The Commissioner shall keep a record of such assignments.

11. [This section provides for the issue of certificates of registration stating the date of application for registration. It also provides for certified copies of the record being evidence.]

12. That a certificate of registration shall remain in force for twenty years, except that in the case of trade marks previously registered in a foreign country such certificates shall cease to be in force on the day on which the trade mark ceases to be protected in such foreign country, and shall in no case remain in force more than twenty years, unless renewed. Certificates of registration may be, from time to time, renewed for like periods on payment of the renewal fees required by this Act, upon request of the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be made at any time not more than six months prior to the expiration of the period for which the certificates of registration were issued or renewed. Certificates of registration in force at the date at which this Act takes effect shall remain in force for the period for which they were issued, but shall be renewable on the same conditions and for the same period as certificates issued under the provisions of this Act, and when so renewed shall have the same force and effect as certificates issued under this Act.

13. [This section provides for rectification of the Register by the cancellation of a registered trade mark. The trade mark may be

cancelled if the registrant was not entitled to the use of the mark at the date of his application for registration, or on the ground of non-user, or abandonment. An application may be made by any person who shall deem himself injured by the registration.]

14. That the following shall be the rates for trade mark fees :—

On filing each original application for registration of a trade mark, ten dollars; Provided, That an application for registration of a trade mark pending at the date of the passage of this Act, and on which certificate of registration shall not have issued at such date, may, at the option of the applicant, be proceeded with and registered under the provisions of this Act without the payment of further fee.

On filing each application for renewal of the registration of a trade mark, ten dollars.

On filing notice of opposition to the registration of a trade mark, ten dollars.

On an appeal from the examiner in charge of trade marks to the Commissioner of Patents, fifteen dollars.

On an appeal from the decision of the examiner in charge of interferences, awarding ownership of a trade mark or cancelling the registration of a trade mark, to the Commissioner of Patents, fifteen dollars.

For certified and uncertified copies of certificates of registration and other papers, and for recording transfers and other papers, the same fees as required by law for such copies of patents, and for recording assignments and other papers relating to patents.

15. [This section makes certain provision as to patent fees applicable to trade mark fees.]

16. That the registration of a trade mark under the provisions of this Act shall be *primâ facie* evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colourably imitate any such trade mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colourable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable for an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the Court may enter judgment therein for any sum above the amount found by the verdict as the actual damages according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

17. [This section defines the Courts having jurisdiction in matters relating to registered trade marks.]

18. [Writs of certiorari may be granted by the Supreme Court of the United States for review.]

19. [Power to grant injunctions and award profits and damages.]

20. [Power to order delivery up of infringing labels, &c., and to punish for contempt by breach of injunction.]

21. That no action or suit shall be maintained under the provisions of this Act in any case when the trade mark is used in unlawful

business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained.

22. [Where there are interfering registrations, any person interested in any of them may sue the interfering registrant in equity; and the Court may adjudge either of the registrations void in whole or in part.]

23. [Saving of remedies of person aggrieved by any wrongful use of any trade mark as if the Act had not been passed.]

24. [This section deals with pending applications.]

25. [A person procuring registration by false or fraudulent declarations or means to be liable in damages to the injured party.]

26. [Power to make rules and regulations.]

27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade mark registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade mark, issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade mark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

28. That it shall be the duty of the registrant to give notice to the public that a trade mark is registered, either by affixing thereon the words "Registered in U.S. Patent Office," or abbreviated thus, "Reg. U.S. Pat. Off.," or when, from the character or size of the trade mark, or from its manner of attachment to the article to which it is appropriated, this cannot be done, then by affixing a label containing a like notice to the package or receptable wherein the article or articles are inclosed.: and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

29. That in construing this Act the following rules must be observed,

except where the contrary intent is plainly apparent from the context thereof:—The United States includes and embraces all territory which is under the jurisdiction and control of the United States. The word "States" includes and embraces the district of Columbia, the territories of the United States and such other territory as shall be under the jurisdiction and control of the United States. The terms "person" and "owner," and any other word or term used to designate the applicant or other entitled to a benefit or privilege, or rendered liable under the provisions of this Act, include a firm, corporation, or association, as well as a natural person. The term "applicant" and "registrant" embrace the successors and assigns of such applicant or registrant. The term "trade mark" includes any mark which is entitled to registration under the terms of this Act and whether registered or not, and a trade mark shall be deemed to be "affixed" to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by, or with which the goods are packed or inclosed or otherwise prepared for sale or distribution.

30. [Commencement of Act, April 1st, 1905. Repeal of prior Acts inconsistent with this Act except as to certificates of registration issued under Act of March 3rd, 1881, or Act of August 5th, 1882.]

APPENDIX XVII.

THE COMMONWEALTH OF AUSTRALIA.

TRADE MARKS ACT, 1905 (No. 20 of 1905).

An Act Relating to Trade Marks.

[Assented to 21st December, 1905.]

BE it enacted by the King's Most Excellent Majesty, the Senate, and the House of Representatives of the Commonwealth of Australia, as follows :—

PART I.—INTRODUCTORY.

Short title.

1. This Act may be cited as the Trade Marks Act, 1905.

Commencement.

2. This Act shall commence on a day to be fixed by proclamation not less than four months after the passing of this Act.

Parts.

3. This Act is divided as follows :—

Part I.—Introductory.
Part II.—Administration.
Division 1.—The Minister, the Registrar, and the Trade Marks Office.
Division 2.—The Transfer of the Administration of the State Trade Marks Acts.
Part III.—Registrable Trade Marks.
Part IV.—Registration of Trade Marks.
Division 1.—General.
Division 2.—Applications.
Division 3.—Opposition.
Division 4.—Registration and Effect of Registration.
Division 5.—Renewal of Registration.
Part V.—Assignment of Trade Marks.
Part VI.—The Register of Trade Marks.
Part VII.—Workers' Trade Marks.
Part VIII.—The Commonwealth Trade Mark.
Part IX.—Protection of Trade Marks.
Part X.—Miscellaneous.

Definitions.

4. In this Act, except where otherwise clearly intended—

"The Court" means the High Court or the Supreme Court of the State in which the Trade Marks Office is situate or a Justice thereof.

"The Law Officer" means the Attorney-General or Crown Solicitor of the Commonwealth.

"Person" includes a body corporate and a firm and any association of persons bodies corporate or firms.

"The Register" means the Register of Trade Marks under this Act.
"Registered Trade Mark" means a trade mark registered under this Act.
"The Registrar" means the Registrar of Trade Marks.
"State Trade Marks Act" means any State Act relating to the Registration of Trade Marks.
"This Act" includes all regulations made thereunder.

Application of common law.

5. Subject to this Act, or any Act of the Parliament, the common law of England relating to trade marks shall, after the commencement of this Act, apply throughout the Commonwealth.

Provided that this section shall not affect any right, privilege, obligation, or liability acquired, accrued, or incurred under the law of any State before the commencement of this Act.

State Trade Marks Acts to cease to apply to trade marks.

6. The State Trade Marks Acts of each State shall, on the commencement of this Act, cease to apply to trade marks further than as follows:—

(*a*) The State Trade Marks Act under which a trade mark is registered shall continue to apply to that trade mark so long as the registration under that Act remains in force.

Cf. *Patents Act*, 1903, s. 6.

(*b*) Proceedings under a State Trade Marks Act, pending at the commencement of this Act, may be continued and completed under the State Trade Marks Act.

(*c*) Applications for the registration of trade marks may be received and dealt with under a State Trade Marks Act, if made by virtue of some right acquired, before the commencement of this Act, in pursuance of any International Convention for the protection of industrial property.

Registration under State Trade Marks Acts to cease after a certain period.

7. (1.) The registration of a trade mark under a State Trade Marks Act shall cease either—

(*a*) at the expiration of fourteen years from the commencement of this Act, or

(*b*) at the time when, under the State Trade Marks Act, the trade mark would, if after the commencement of this Act no fee for the continuance of its registration were paid, first become liable to removal from the register,

whichever first happens.

(2.) No fee shall be receivable nor shall any act be done after the commencement of this Act for the continuance of the registration of a trade mark under a State Trade Marks Act.

Trade marks registered under State Act may be registered under this Act.

8. (1.) The registered proprietor of a trade mark properly registered in any State under a State Trade Marks Act may make application for the registration of his trade mark under this Act.

(2.) The application shall, subject to paragraphs (3), (4), and (5) of this section, be dealt with in the same manner as other applications for registration of trade marks.

(3.) The trade mark may be registered even if it does not contain the essential particulars required by this Act, but subject, in that case, to such conditions and limitations as to mode or place or period of user as the Registrar, Law Officer, or Court thinks fit to impose.

Cf. *Patents Act*, 1903, s. 7.

(4.) Where the same trade mark or a nearly identical trade mark is owned or registered by another proprietor in any part of the Commonwealth in respect of the same goods, the trade mark may be registered subject to such conditions and limitations as to mode or place of user or

otherwise as the Registrar, Law Officer, or Court thinks fit to impose to preserve the rights of each proprietor.

(5.) Where the trade mark or a nearly identical trade mark is common to the trade in another State, the registration under this Act shall confer no exclusive rights in that State on the registered proprietor, and that State may be excepted from the registration under this Act.

(6.) The registration of the trade mark under a State Trade Marks Act shall cease upon its registration under this Act.

Unregistered trade marks in use in States.

9. (1.) The unregistered proprietor of a trade mark in use in any State at the commencement of this Act may make application for the registration of his trade mark under this Act.

(2.) The application shall, subject to paragraphs (3), (4), (5), and (6) of this section, be dealt with in the same manner as other applications for registration of trade marks.

(3.) The trade mark may be registered if it could have been lawfully registered under the State Trade Marks Act in force, at the commencement of this Act, in the State in which the trade mark was then used, had an application for its registration been made before the commencement of this Act.

(4.) If the trade mark does not contain the essential particulars required by this Act, it may nevertheless be registered subject to such conditions and limitations as to mode or place, or period of user, as the Registrar, Law Officer, or Court thinks fit to impose.

(5.) Where the same trade mark or a nearly identical trade mark is owned or registered by another proprietor in any part of the Commonwealth in respect of the same goods, the trade mark may be registered subject to such conditions and limitations as to mode or place of user or otherwise as the Registrar, Law Officer, or Court thinks fit to impose to preserve the rights of each proprietor.

(6.) Where the trade mark, or a nearly identical trade mark, was, at the commencement of this Act, common to the trade in another State, the registration under this Act shall confer no exclusive rights in that State on the registered proprietor, and that State may be excepted from the registration under this Act.

PART II.—Administration.

Division 1.—*The Minister, the Registrar, and the Trade Marks Office.*

Administration.

Cf. *Patents Act*, 1903, s. 9.

10. The Minister for Trade and Customs or other the Minister for the time being administering the Department of Trade and Customs shall be charged with the execution of this Act.

Registrar.

Ib. s. 10.

11. (1.) There shall be a Registrar of Trade Marks.

(2.) Until the Governor-General otherwise determines the Commissioner of Patents shall be the Registrar of Trade Marks.

(3.) The Governor-General may appoint a Deputy Registrar of Trade Marks who shall, subject to the control of the Registrar of Trade Marks, have all the powers conferred by this Act on the Registrar.

Trade Marks Office.

Ib. s. 12.

12. For the purposes of this Act an office shall be established which shall be called the Trade Marks Office, and a sub-office shall be established

in every State other than the State in which the Trade Marks Office is established.

Seal of Trade Marks Office.

Ib. s. 13.

13. There shall be a seal of the Trade Marks Office, and impressions thereof shall be judicially noticed.

DIVISION 2.—*The Transfer of the Administration of the State Trade Marks Acts.*

Transfer of administration.

Effect of transfer of administration.

Ib. ss. 18 and 19.

14. On the commencement of this Act, the administration of the State Trade Marks Acts of all the States shall be transferred to the Commonwealth and thereupon—

(*a*) the State Trade Marks Acts of each State shall, so far as they have any relation to trade marks, cease to be administered by the State, and shall thereafter be administered by the Commonwealth so far as is necessary for the purpose of completing then pending proceedings and of giving effect to then existing rights, and the Registrar shall collect for each State the fees which become payable thereunder; and

(*b*) all powers and functions under any State Trade Marks Act vested in the Governor of a State or in the Governor with the advice of the Executive Council of a State or in any Minister officer or authority of a State shall vest in the Governor-General or in the Governor-General in Council or in the Minister officer or authority exercising similar powers under the Commonwealth as the case requires or as is prescribed; and

(*c*) all records registers deeds and documents of the Trade Marks Office of each State vested in or subject to the control of the State shall, by force of this Act, be vested in and made subject to the control of the Commonwealth.

PART III.—REGISTRABLE TRADE MARKS.

Of what trade marks may consist.

Cf. 51 & 52 Vict. c. 50, s. 10.

15. A registrable trade mark shall consist of essential particulars with or without additional matter.

Essential particulars.

Cf. *ib.* s. 10 (1).

16. The essential particulars of a registrable trade mark shall be one or more of the following particulars:—

(*a*) A name or trading style of a person printed, impressed, or woven in some particular and distinctive manner; or

(*b*) A written signature or copy of a written signature of the person applying for registration thereof or some predecessor in his business; 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 used or likely to be understood in a geographical sense.

Additional matter.

Cf. *ib.* s. 10 (2).

17. The additional matter which may be added to the essential particulars of a registrable trade mark shall be—

(*a*) Any letters, words, or figures; or

(*b*) Any combination of letters, words, or figures, or of any of them.

Use of certain words, &c., forbidden in trade marks.
Cf. T.M. Regulations (Eng.) 29.

18. Except in the case of a trade mark properly registered in any State under a State Trade Marks Act, a registrable trade mark must not contain—

(*a*) the words "Trade Mark," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery" or words to the like effect; or

(*b*) a representation of the King, the Queen, or any member of the Royal Family, or of the Royal Crown.

Use of words, &c., indicating Royal patronage.
Cf. *ib.* 30.

19. A registrable trade mark must not contain—

(*a*) the word "Royal" or any word, letter, or device, indicating Royal or Government patronage; or

(*b*) a representation of the Royal Arms, or of the national flag of the United Kingdom, or of the flag of the Commonwealth, or of the national arms of the United Kingdom, or of the arms or seal of the Commonwealth or any State; or

Representation of living person.

(*c*) a representation of any living person without his written consent.

Mark made distinctive by user.
Cf. 5 Edw. VII. c. 15, s. 9.

20. In determining whether any particular of a trade mark is distinctive, regard may be had, in the case of a trade mark in actual use, to the extent to which user has rendered the trade mark or the particular distinctive for the goods with respect to which the trade mark is sought to be registered.

Coloured trade marks.
Cf. 5 Edw. VII. c. 15, s. 10.

21. A trade mark may be limited in whole or in part to a particular colour or colours, and in case of any application for the registration of a trade mark the fact that the trade mark is so limited shall be taken into consideration by any tribunal in determining whether it is distinctive or not. If a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

Standardisation &c., trade marks.
Cf. *ib.* s. 62.

22. (1.) Where any Commonwealth or State authority, or any association or person, undertakes the examination of any goods in respect of origin, material, mode or conditions of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by a mark used upon or in connection with such goods, the Minister may, if he judges it to be to the public advantage, permit the authority association or person to register the mark as a trade mark in respect of such goods, whether the authority association or person is or is not a trader, or is or is not possessed of a goodwill in connection with such examination and certifying.

(2.) When registered, the trade mark shall be deemed in all respects to be a registered trade mark, and the authority, association, or person to be the registered proprietor thereof, save that the trade mark shall not be transmissible or assignable except with the permission of the Minister.

(3.) This section shall as to conditions of manufacture apply to Commonwealth and State authorities only.

PART IV.—Registration of Trade Marks.

Division 1.—*General.*

Trade mark must be for particular goods.
Cf. *ib.* s. 8.

23. A trade mark must be registered in respect of particular goods or classes of goods as prescribed.

Disclaimers.
Cf. *ib.* s. 15.

24. (1.) If a trade mark—

(*a*) contains parts not separately registered by the proprietor as trade marks, or

(*b*) contains matter common to the trade or otherwise of a non-distinctive character,

the Registrar or the Law Officer or the Court, in deciding whether the trade mark shall be entered or shall remain upon the Register, may in his or its discretion require, as a condition of its being upon the Register, that the proprietor shall disclaim any right to the exclusive use of any of those parts, or of that matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they think needful for the purpose of defining his rights under the registration.

Provided always that no such disclaimer shall affect any rights of the proprietor of the trade mark except such as depend upon its registration.

What matters deemed common to trade.

(2.) The fact that a mark or matter therein is publicly and honestly used by more than three several persons in any one State as a mark on or in connection with similar goods shall be treated as conclusive evidence that it is common to the trade.

Identical marks.
Cf. 5 Edw. VII. c. 15, s. 19.

25. Except by order of the Court, the Registrar shall not register in respect of goods a trade mark identical with one belonging to a different proprietor which is already on the Register in respect of the like goods, or class of goods, or so nearly resembling such a trade mark as to be likely to deceive.

Names, &c., of living persons.

26. Where the name or a representation of a living person or a person believed by the Registrar to be living appears on a trade mark, the Registrar may require the applicant to furnish him with the consent of that person to the name or representation appearing on the trade mark before he proceeds with the registration of the trade mark.

Registrar may refer rival claims to the Court.
Cf. *ib.* s. 20.

27. Where each of several persons applies to be registered as the proprietor of the same trade mark, or of nearly identical trade marks in respect of the like goods or class of goods, the Registrar may refuse to register the trade mark until the rights of the applicants have been determined, and may himself submit or require the applicants to submit their rights to the Court.

Concurrent user.
Cf. *ib.* s. 21.

28. In case of honest concurrent user or of special circumstances the Registrar, Law Officer, or the Court may, in his or its discretion, permit the registration of the same trade mark or of nearly identical trade marks for the like goods or class of goods by more than one proprietor, subject to such conditions and limitations as to mode or place of user or otherwise as he or it thinks fit to impose.

Associated trade marks.
Cf. *ib.* ss. 24, 25.

29. (1.) Where application is made for the registration of a trade mark so nearly resembling a trade mark of the applicant which is already on the Register as to be likely to deceive or cause confusion if used by a person other than the applicant, the Registrar may require as a condition of registration that the trade marks shall be entered on the Register as associated trade marks.

(2.) If the proprietor of a trade mark claims to be entitled to the exclusive use of any part of it separately he may, if the part satisfies all the conditions of a trade mark, register it as a separate trade mark.

(3.) When a part of a registered trade mark is registered separately, 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, and the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of the part separately registered as a trade mark.

(4.) Except for the purpose of assignment or transmission, and subject to the provisions of this Act as to use of associated trade marks, associated trade marks shall be deemed to be registered independently.

User of associated trade mark.
Cf. *ib.* s. 27.

30. Where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the Registrar, Law Officer, or the Court, as the case may be, may, if and so far as he or it thinks fit, 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 the user of the first-mentioned trade mark.

Series of trade marks.
Cf. 5 Edw. VII. c. 15, s. 26.

31. (1.) When a person claiming to be the proprietor of several trade marks, which while resembling each other in the essential 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,

seeks to register such trade marks, they may be registered as a series in one registration.

(2.) 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.

DIVISION 2.—*Applications.*

Who may apply for registration.
Cf. *ib.* s. 62.

32. (1.) Any person, claiming to be the proprietor of a trade mark, may make application to the Registrar for the registration of his trade mark.

(2.) The application must be made in the form prescribed and must—

Form of application.

(*a*) specify the goods or class of goods in respect of which the applicant desires the trade mark to be registered;

(*b*) state what are the essential particulars of his trade mark and disclaim any right to the exclusive use of the matter added to the essential particulars of his trade mark; and

(*c*) state an address within the Commonwealth as an address for service:

Provided that an applicant need not disclaim his own name or address or the foreign equivalents thereof or that of a predecessor in business.

(3.) Separate applications must be made for the registration of a trade mark in respect of each class of goods in respect of which the applicant desires it to be registered.

Lodging of application.
Cf. *Patents Act*, 1903, ss. 33 & 46.

33. (1.) Every application must be lodged by being left at or sent by post to the Trade Marks Office or a sub-office.

(2.) Such application shall be forthwith referred by the Registrar to an examiner, who shall ascertain and report whether the trade mark is

a registrable trade mark, and whether it is identical with a trade mark already on the Register under this Act or any State Trade Marks Act in respect of the like goods or class of goods, or so nearly resembles the latter trade mark as to be likely to deceive, and whether the trade mark or any matter therein is common to the trade.

(3.) Subject to this Act the Registrar may either accept the application, with or without modifications or conditions, or refuse it.

Appeal.
Cf. 46 & 47 Vict. c. 57, s. 62 (4).

34. (1.) An appeal shall lie to the Law Officer from any conditional acceptance or any refusal by the Registrar of the application.

(2.) The Law Officer shall hear the applicant and the Registrar, and shall decide whether and subject to what conditions or modifications (if any) the application shall be accepted.

Appeal to Court.

(3.) An applicant aggrieved by the decision of the Law Officer may in the time and in the manner prescribed appeal to the Court.

(4.) The Court shall hear the applicant and determine whether the application ought to be refused or ought to be accepted with or without any modifications or conditions.

Direct appeal by consent from Registrar to Court.

35. If the applicant so desires, he may appeal direct from the Registrar to the Court without any appeal to the Law Officer.

Advertisement.

36. If the application is accepted with or without conditions or modifications it shall forthwith be advertised in the prescribed manner.

Limit of time for proceeding with application.
Ib. s. 63.
51 & 52 Vict. c. 50, s. 9.

37. If, by reason of default on the part of the applicant, the registration of a trade mark has not been completed within twelve months from the date of the lodging of the application, the Registrar shall give notice of the non-completion to the applicant, and if, at the expiration of fourteen days from that notice or such further time as the Registrar in special cases permits, the registration is not completed, the application shall be deemed to be abandoned.

Division 3.—*Opposition.*

Notice of opposition.
Cf. 46 & 47 Vict. c. 57, s. 69 (1).

38. Any person may, within three months after the advertisement of the application or such further time not exceeding three months as the Registrar on application made within the first period of three months allows, lodge at the Trade Marks Office a notice of opposition in duplicate to the registration of the trade mark, setting out the grounds on which he relies to support his notice.

Address for service.

39. Every notice of opposition shall state an address in Australia as an address for service.

Notice to applicant.
Cf. *ib.* s. 69 (1).

40. The Registrar shall send a duplicate of the notice of opposition to the applicant.

Counter-statement by applicant.
Cf. *ib.* s. 69 (2).

41. (1.) Within three months after the lodging of notice of opposition or such further time not exceeding three months as the Registrar on application made within such first mentioned three months allows, the applicant may lodge at the Trade Marks Office a counter-statement in duplicate, setting out the grounds on which he relies to support his application.

Failure to lodge counter-statement.

(2.) If the applicant fails to so lodge a counter-statement he shall be deemed to have abandoned his application, and in that event he shall not be liable for costs, but if he lodges a counter-statement and thereafter abandons his application he shall, unless the Registrar otherwise orders, pay to the opponent such costs as the Registrar allows.

(3.) The Registrar shall send a duplicate of the counter-statement to the opponent. Service of counter-statement.

42. (1.) The Registrar shall fix a day for the hearing of the application, and shall give notice thereof to the applicant and to the opponent. Day of hearing.

(2.) On the day so fixed, or on any other day to which the hearing is adjourned, the Registrar shall hear the applicant and the opponent, and shall decide whether the application is to be refused or whether it is to be granted either with or without any modifications or conditions. Hearing.

43. (1.) Any party aggrieved by the decision of the Registrar may in the time and in the manner prescribed appeal to the Law Officer. Appeal to Law Officer.

(2.) The Law Officer shall hear the applicant and the opponent, and may determine whether the application ought to be refused or ought to be granted with or without any modifications or conditions. Cf. 46 & 47 Vict. c. 57, s. 62 (4).

44. (1.) Any party aggrieved by the decision of the Law Officer may in the time and in the manner prescribed appeal to the Court. Appeal to Court.

(2.) The Court shall hear the applicant and the opponent, and determine whether the application ought to be refused or ought to be granted with or without any modifications or conditions.

45. If either party so desires and gives written notice thereof the appeal shall be taken direct from the Registrar to the Court without any appeal to the Law Officer. Direct appeal from Registrar to Court.

46. If a person giving notice of opposition or appeal does not reside in Australia, the Registrar Law Officer or the Court may order him to give security for costs, and if the order is not complied with the opposition or appeal shall be deemed to be abandoned. Security for costs.

Division 4.—*Registration and Effect of Registration.*

47. When an application for registration has been accepted and has not been opposed and the time for notice of opposition has expired, or has been opposed and has been granted, the Registrar shall register the trade mark as on the date of the lodging of the application, which date shall be deemed to be the date of the registration, and shall issue to the applicant a certificate of registration of the trade mark in the prescribed form. Date of Registration. Cf. 5 Edw. VII. c. 15, s. 16.

48. 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. Duration of Registration. *Ib.* s. 28.

49. (1.) Subject to this Act the person for the time being entered in the register as proprietor of a trade mark shall have power to assign the trade mark, and to give effectual receipts for any consideration for such assignment. Rights of registered proprietor. Cf. *ib.* s. 39.

(2.) No entry of any name shall affect the right of any owner of the same name to use it or its foreign equivalent. Cf. 51 & 52 Vict. c. 50, s. 16.

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

50. The registration of a person as proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of the trade mark upon the goods in respect to which it is registered and of the validity of the registration. Register to be *primâ facie* evidence. 46 & 47 Vict. c. 57, s. 76.

51. The registration of a person as proprietor of a trade mark shall, Registers to be conclusive

evidence after five years.
Cf. *ib.* s. 76.

after the expiration of five years from the date of registration (in the absence of fraud) be conclusive evidence of the validity of the registration, and, subject to this Act, of his right to the exclusive use of the trade mark in respect of the goods in respect of which it is registered, upon the registered proprietor proving that he or his predecessors in title have continuously used the trade mark in respect of the goods to a substantial extent for the five years immediately preceding the commencement of the legal proceedings.

For the purposes of this section user shall be deemed to be continuous if there has been no actual interruption thereof for a longer total period than twelve months.

Unregistered trade mark.
Cf. *ib.* s. 77.

52. No person shall be entitled to institute any proceeding to prevent or recover damages for the infringement of a trade mark, unless in the case of a registrable trade mark it is registered under this Act or a State Trade Marks Act.

Infringement.

53. The rights acquired by registration of a trade mark shall be deemed to be infringed by the use, in respect of the goods in respect of which it is registered, of a mark substantially identical with the trade mark or so nearly resembling it as to be likely to deceive.

Cf. 5 Edw. VII. c. 15, s. 43.

In an action for the infringement of a trade mark the Court, in trying the question of infringement, shall admit evidence of the usages of the trade in respect to the get-up of those goods and of any trade marks or get-up legitimately used in respect of them by other persons.

Division 5.—*Renewal of Registration.*

Renewal of registration.
Cf. *ib.* s. 29.

54. The Registrar may, on application made by the registered proprietor of a trade mark in the prescribed manner, at any date not later than fourteen years from the date of the original registration or the last renewal of registration, as the case may be (in this division termed "the date of the last registration"), renew the registration of the trade mark for a period of fourteen years from the date of the expiry of the period of the last registration.

Procedure on expiry of period of registration.
Cf. *ib.* s. 30.

55. At the prescribed time before the expiration of fourteen years from the date of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor or his agent in Australia of the date at which the existing registration will expire and the conditions as to proof of substantial user and 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 those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, but any party aggrieved shall have a right to appeal in manner prescribed.

Restoration of trade mark removed for non-payment of renewal fee.
Cf. 5 Edw. VII. c. 15, s. 30.

56. Where a trade mark has been removed from the register for non-payment of the prescribed fee the Registrar may within three months from such removal if satisfied that it is just so to do restore such trade mark to the register on payment of the prescribed additional fee for renewal.

Status of unrenewed trade mark.
Cf. *ib.* s. 31.

57. Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for registration during one year next after the date of the removal, be deemed to be a trade mark which is

already registered, unless it is shown to the satisfaction of the Registrar that the non-payment of the fee arises from the death or bankruptcy or liquidation of the proprietor of the trade mark, 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.

PART V.—Assignment of Trade Marks.

Assignment and transmission of trade marks.
46 & 47 Vict. c. 57, s. 70.

58. A trade mark when registered may be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or class of goods in respect of which it has been registered and shall be determinable with that goodwill.

Apportionment of marks on dissolution of partnership.
Cf. 5 Edw. VII. c. 15, s. 23.

59. In any case where by reason of dissolution of partnership or other cause a person ceases to carry on business, and the goodwill of the person does not pass to one successor but is divided, the Court may (subject to the provisions of this Act as to associated trade marks and series of trade marks), on the application of any 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 as it thinks necessary in the public interest.

Assignment of associated trade marks.
Cf. *ib.* s. 27.

60. Associated trade marks may be assigned or transmitted only as a whole.

PART VI.—The Register of Trade Marks.

Register of trade marks.
Cf. *ib.* s. 4.

61. There shall be kept at the Trade Marks Office a Register of Trade Marks wherein shall be entered particulars of—

(*a*) all registered trade marks, with the names and addresses of their proprietors, together with the date of registration and expiry thereof;

Notification of assignments and transmissions.

(*b*) notifications of assignments and transmissions, and disclaimers; and

(*c*) any other matters relating to registered trade marks which are prescribed.

Trusts not to be noticed.
Cf. 5 Edw. VII. c. 15, s. 5.

62. Where a trade mark has been lawfully assigned or transmitted, a notification of the assignment or transmission, in the form and authenticated in the manner prescribed, may be given to the Registrar, who shall thereupon register the assignment.

Inspection of register.
Ib. s. 7.

63. No notice of any trust, expressed implied or constructive, shall be entered in the register, or be received by the Registrar.

Certified copies to be supplied.
Ib. s. 7.

64. The register shall be open to the inspection of the public at all convenient times, on payment of the prescribed fee.

Certified copies evidence.
Cf. 46 & 47 Vict. c. 57, s. 89

65. Certified copies of entries in the register shall be given to any person applying for them on payment of the prescribed fee.

66. Documents purporting to be copies of or extracts from the register, and to be certified by the Registrar and sealed with the seal of the Trade Marks Office, shall be admitted in evidence in all Federal and State Courts without further proof or production of the originals.

False entries in register. *Ib.* s. 93.

67. No person shall wilfully—

(*a*) Make any false entry in the register; or

(*b*) Make any writing falsely purporting to be a copy of an entry in the register; or

(*c*) Produce or tender in evidence any writing falsely purporting to be a copy of an entry in the register.

Penalty: Three years' imprisonment.

Correction of register. Cf. *ib.* s. 91. Cf. 5 Edw. VII. c. 15, s. 32.

68. (1.) The Registrar may, on request made in the prescribed manner by the registered proprietor of a trade mark, amend or alter the register by—

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

(*b*) altering the name or address of the registered proprietor who has changed his name or address; or

(*c*) cancelling the registration of the trade mark; or

(*d*) striking out any goods or classes of goods from those in respect of which the trade mark is registered; or

(*e*) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark.

(2.) Where the register has been amended or altered under this section the Registrar may—

(*a*) cancel the certificate of registration of the trade mark, and issue a new certificate of registration; or

(*b*) make such amendments or alterations in the certificate of registration of the trade mark as are rendered necessary by the amendment or alteration of the register.

Registration of assignments, &c. Cf. 46 & 47 Vict. c. 57, s. 87.

69. Subject to the provisions of this Act, where a person becomes entitled to a registered trade mark by assignment, transmission, or otherwise, the Registrar shall on request, and on proof of title to his satisfaction, cause the name and address of the person to be entered on the register as proprietor of the trade mark.

Alteration in registered trade mark. Cf. 46 & 47 Vict. c. 57, s. 92. Cf. 5 Edw. VII. c. 15, s. 34.

70. The registered proprietor of a trade mark may apply to the Court for leave to add to or alter the trade mark in any manner not substantially affecting its identity, and the Court may refuse or grant the leave on such terms as it thinks fit. If leave be granted, the Registrar shall, on service of the order of leave, cause the register to be altered in accordance with the order, and shall, in the prescribed manner, advertise the trade mark as altered.

Rectification of register by Court. Cf. 46 & 47 Vict. c. 57, s. 90. 51 & 52 Vict. c. 50, s. 23. Cf. 5 Edw. VII. c. 15, s. 35.

71. (1.) Subject to this Act, the Court, on the application of any person aggrieved or of the Registrar, may order the rectification of the register by—

(*a*) the making of any entry wrongly omitted to be made in the register; or

(*b*) the expunging of any entry wrongly made in or remaining on the register; or

(*c*) the insertion in the register of any exception or limitation affecting the registration of a trade mark which in the opinion of the Court ought to be inserted; or

(*d*) the correction of any error or defect in the register.

(2.) The Registrar shall only make application to the Court under this section in cases where he thinks the application necessary or desirable in the public interest.

(3.) Notice of every application to the Court pursuant to this section (other than an application by the Registrar) shall be given to the Registrar, who may be heard thereon.

Removal of trade mark from register if no *bonâ fide* user.

72.—(1.) The Court may, on the application of any person aggrieved, if it is shown that there has been no *bonâ fide* user of a trade mark for a consecutive period of three years since the date of the last registration thereof, order its removal from the register, unless it was at the date of the application in *bonâ fide* use and had been so for a period of six months immediately prior to the date of the application.

Cf. 5 Edw. VII. c. 15, s. 37.

(2.) For the purpose of this section *bonâ fide* user or use means user or use of a trade mark in respect of the goods in respect of which it is registered for the purposes of trade by the proprietor of the trade mark or a predecessor in title.

Registrar to carry out orders for rectification.

73. The Registrar, upon being served with any order of the Court for the rectification of the register or for the removal of the registration of a trade mark from the register by the party seeking to enforce it, shall cause the rectification or removal to be made accordingly.

PART VII.—Workers' Trade Marks.

False application of workers' trade marks prohibited.

74. (1.) No person shall—

(*a*) falsely apply to any goods for the purpose of trade or sale; or

(*b*) knowingly sell or expose for sale, or have in his possession for sale or for any purpose of trade or manufacture, any goods to which there is falsely applied; or

(*c*) knowingly import into Australia any goods not produced in Australia to which there is applied

a mark which is a distinctive device, design, symbol, or label registered by any individual Australian worker or association of Australian workers corporate or unincorporate for the purpose of indicating that articles to which it is applied are the exclusive production of the worker or of members of the association (and which mark is hereby declared to be a workers' trade mark), or any mark substantially identical with a registered workers' trade mark), or so nearly resembling it as to be likely to deceive.

(2.) The workers' trade mark is falsely applied unless in truth—

(*a*) the goods to which it is applied are exclusively the production of the worker or of members of the association; or

(*b*) the goods to which it is applied are in part but not exclusively the production of the worker or of members of the association, and the mark is applied in such manner as clearly to indicate that its application does not refer to, describe, or designate the parts of the goods not being the production of the worker or of members of the association; and

(*c*) the mark is applied to the goods (being goods produced in Australia) by the employer for whom they are produced, or, with the authority of the employer, by the worker or a member of the association registering the mark.

(3.) In this section—

"Association" includes any number of associations acting together, and in such case the members of the "association" shall be the members of the associations which are acting together;

"Production" means production, manufacture, workmanship, preparation, or product of labour;

"Produced" has a meaning corresponding with "production."

Penalty: Fifty pounds, in addition to any liability to forfeiture provided by law.

Registration.

75. (1.) A worker or association may register a workers' trade mark in the prescribed manner and shall thereupon be deemed the registered proprietor thereof, and be entitled to institute legal proceedings to prevent and recover damages for any contravention of this Part in respect of that trade mark.

Removal from register.

(2.) A workers' trade mark may be removed from the register for the causes and in the manner prescribed, and subject thereto the registration of the trade mark shall continue for fourteen years, at the expiration of which it shall cease unless renewed in the manner prescribed.

Duration.

No assignment.

(3.) A workers' trade mark shall not be capable of assignment either by act of the parties or by operation of law.

Non-application.

(4.) Parts III., IV., V., and VI. of this Act shall not apply in relation to workers' trade marks.

Deception prohibited.

(5.) A workers' trade mark shall not be registered if it is substantially identical with any registered trade mark within the meaning of this Act or so nearly resembles it as to be likely to deceive.

Illegality not authorised.

76. Nothing in this Part shall be so construed as to make it lawful for any person or association or combination of persons to do any act which it would have been unlawful for such person, association, or combination of persons to do before the commencement of this Act.

This Part not to apply to agricultural, viticultural, and similar products.

77. This Part shall not apply to any primary products of the agricultural, viticultural (including wine-making), horticultural, dairying (including butter-making and cheese-making), or pastoral industries.

PART VIII.—The Commonwealth Trade Mark.

Application of Part.

78. (1.) This Part shall apply to all goods included in or specified by a resolution passed by both Houses of the Parliament that in their opinion the conditions as to the remuneration of labour in connection with their manufacture are fair and reasonable.

(2.) A resolution shall be deemed to have been passed at the commencement of this Act by both Houses of the Parliament that the conditions as to the remuneration of labour are fair and reasonable in respect of goods which are manufactured in any part of the Commonwealth under conditions as to the remuneration of labour prescribed, required, or provided in relation to the goods, by an industrial award or order, or an industrial agreement, under an industrial law.

(3.) In this Part "an industrial law" means any Act or State Act existing at the commencement of this Act and providing for conciliation or arbitration or both conciliation and arbitration, or the determination of the remuneration of labour in connection with industrial matters or the manufacture of goods, or any statutory modification amendment or re-enactment thereof respectively, or any Act or State Act passed after the commencement of this Act and declared by resolution of both Houses of the Parliament to be an industrial law within the meaning of this Part; and "industrial award or order" includes any determination of any Special Board or Court under an industrial law.

(4.) A resolution passed or deemed to have been passed as aforesaid may be by both Houses of the Parliament revoked in whole or in part, and thereupon this Part shall to the extent of the revocation cease to apply.

Registration of Commonwealth trade mark.

79. (1.) The Minister may cause to be designed and registered a trade mark (in this Part called the Commonwealth Trade Mark), consisting of a distinctive device or label bearing the words "Australian Labour Conditions."

(2.) The Commonwealth trade mark shall not contain the name of or indicate any State.

(3.) Parts III., IV., V., and VI. of this Act shall not apply in relation to the Commonwealth trade mark.

Effect of registration of Commonwealth trade mark.

80. (1.) Upon the registration of the Commonwealth trade mark, the Minister shall be deemed to be the proprietor thereof, and shall be entitled to prevent the unauthorised application of the Commonwealth trade mark.

(2.) The rights of the proprietor of the Commonwealth trade mark shall be deemed to be infringed by the unauthorised application to goods of a mark identical or substantially identical with the Commonwealth trade mark, or so nearly resembling it as to be likely to deceive.

(3.) The Minister may sue to prevent infringement of the Commonwealth trade mark.

Unauthorised application of Commonwealth trade mark.

81. The application of the Commonwealth trade mark to goods shall be deemed to be unauthorised unless—

(*a*) it is applied by or by direction of the first proprietor of the goods, and is so applied by the authority of the Minister; and

(*b*) it is applied to goods to which this Part applies; and

(*c*) the first proprietor of the goods has personally manufactured them, or has paid for the labour other than his own in connection with their manufacture at least the minimum amount prescribed, required, or provided to be paid to persons actually making the goods by an industrial award or order, or an industrial agreement under an industrial law.

Authority of Minister.

82. (1.) The authority of the Minister to any person to apply the Commonwealth trade mark may be given either generally or in respect of specific goods, and shall be given if in his opinion the trade mark will not be applied except as authorised by this Part.

(2.) The Minister may revoke his authority in whole or in part if in his opinion a person to whom it has been given has applied or is likely to apply the trade mark in a manner unauthorised by this Part.

Penalty for infringing Commonwealth trade mark.

83. (1.) No person shall wilfully infringe the rights of the Minister as proprietor of the Commonwealth trade mark.

Penalty: Fifty pounds.

(2.) No person shall knowingly sell or expose for sale, or have in his possession for sale or for any purpose of trade or manufacture, any goods to which any mark is applied in infringement of the rights of the Minister as proprietor of the Commonwealth trade mark.

Penalty: Fifty pounds.

Prohibition of importation of goods to which Commonwealth trade mark applied.

84. No person shall knowingly import into Australia any goods, not manufactured or produced in Australia, to which there is applied—

(*a*) the Commonwealth trade mark, or

(*b*) a mark substantially identical with the Commonwealth trade mark, or

(*c*) a mark so nearly resembling the Commonwealth trade mark as to be likely to deceive.

Penalty: One hundred pounds in addition to any liability to forfeiture provided by law.

Removal from register of Common-wealth trade mark.

85. The Commonwealth trade mark may, on the application of the Minister, be removed from the register in the manner prescribed.

PART IX.—Protection of Trade Marks.

Forgery or false application of trade marks.

Cf. 50 & 51 Vict. c. 28, s. 2 (1).

86. Whoever—

(*a*) forges a registered trade mark; or

(*b*) falsely applies a registered trade mark to any goods; or

(*c*) makes any die, block, machine, or instrument for the purpose of forging or of being used for forging a registered trade mark; or

(*d*) disposes of or has in his possession any die, block, machine, or instrument for the purpose of forging or of being used for forging a registered trade mark,

shall, unless he proves that he acted without intent to defraud, be guilty of an indictable offence, and liable to imprisonment for any term not exceeding three years.

Selling, &c., goods with false marks.

Ib. s. 2 (2).

87. Whoever sells or exposes for sale, or has in his possession for sale or for any purpose of trade or manufacture, any goods to which any forgery of a registered trade mark is applied or to which any registered trade mark is falsely applied, shall be guilty of an offence against this Act, unless he proves—

(*a*) that he acted without intent to defraud; or

(*b*) that the goods were manufactured in or imported into Australia and the trade mark was applied to them before the commencement of this Act, and were held by him *bonâ fide* and without intent to defraud.

Penalty: One hundred pounds.

Importing goods with false marks.

88. Whoever imports into Australia any goods to which any forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied shall, unless he proves that he did not knowingly import the goods in contravention of this Act, be guilty of an offence against this Act.

Penalty: One hundred pounds.

Aiding and abetting offences.

Ib. s. 11.

89. Whoever aids, abets, counsels, or procures, or is in any way knowingly directly or indirectly concerned in or privy to—

(*a*) the commission of any offence against this Act; or

(*b*) the commission of any act outside Australia which if committed in Australia would be an offence against this Act,

shall be guilty of an offence against this Act.

Penalty: One hundred pounds.

Prohibition of importation of fraudulently marked goods.

Ib. s. 16.

90. (1.) The following goods are prohibited to be imported, and, if imported, may be seized as forfeited to the King:—

(*a*) all goods to which any forgery of a registered trade mark is applied, or to which any registered trade mark is falsely applied; and

(*b*) all goods manufactured at any place outside Australia and having applied to them any trade mark being the registered trade

mark of any manufacturer, dealer or trader in Australia, unless the trade mark is accompanied by a definite indication of the country in which the goods were made or produced.

(2.) Subject to the regulations, the Comptroller-General, or on appeal from him the Minister, may, if in his opinion the contravention has not occurred either knowingly or negligently, permit any goods which are liable to be or have been seized as forfeited under this section to be delivered to the owner or importer upon security being given to the satisfaction of the Comptroller-General that the improper marks will be effectually removed from the goods or that the goods will be forthwith exported.

(3.) All imported goods liable to be seized under this section may be seized by any officer of Customs.

(4.) The provisions of the *Customs Act*, 1901, shall apply to the seizure and forfeiture of goods under this section to the same extent as if they were prohibited imports under that Act.

(5.) Before taking any action under this section or permitting any officer of Customs to act thereunder, the Collector of Customs for the State may require any person requesting any action on the part of the Customs to give security in accordance with the regulations, but the Collector of Customs may act under this section without any request.

What deemed forgery of trade mark.
50 & 51 Vict. c. 28, s. 4.

91. A person shall be deemed to forge a registered trade mark who either—

(*a*) without the assent of the proprietor of the trade mark or the authority of this Act, makes it or a mark so nearly resembling it as to be likely to deceive; or

(*b*) falsifies any registered trade mark, whether by alteration, addition, effacement, or otherwise.

When trade mark deemed applied.
Ib. s. 5 (2).

92. (1.) A trade mark shall be deemed to be applied to any thing if it is woven in, impressed on, worked into, or annexed or affixed to, the thing.

(2.) A trade mark shall be deemed to be applied to goods if—

(*a*) it is applied to the goods themselves; or

(*b*) it is applied to any covering, label, reel, or thing in or with which the goods are sold or exposed or had in possession for any purpose of trade or manufacture; or

(*c*) it is used in any manner likely to lead to the belief that it refers to or describes or designates the goods.

When trade mark deemed applied to goods.
Ib. s. 5 (1).

(3.) "Covering" includes any stopper, glass, bottle, vessel, box, capsule, case, frame, or wrapper; and "label" includes any band or ticket.

What deemed false application of a trade mark.
Ib. s. 5 (3).

(4.) A trade mark shall be deemed to be falsely applied to goods if, without the assent of the proprietor of the trade mark or the authority of this Act, it or a mark so nearly resembling it as to be likely to deceive is applied to the goods.

Trade mark, how described in pleading.
50 & 51 Vict. c. 28, s. 9.

93. In any indictment, information, pleading, or proceeding in relation to a registered trade mark, it shall not be necessary to set out a copy or facsimile of the trade mark or a description of it, but the trade mark may be referred to as a registered trade mark.

PART X.—MISCELLANEOUS.

Governor-General may make regulations.

Patents Act, 1903, s. 108.

94. The Governor-General may make regulations, not inconsistent with this Act, prescribing the fees to be paid under this Act and all matters which by this Act are required or permitted to be prescribed or which are necessary or convenient to be prescribed for giving effect to this Act or for the conduct of any business relating to the Trade Marks Office.

Incidental powers of Court.

Ib. s. 111.

95. In addition to any other powers conferred on it by this Act, the Court may in relation to any appeal or application under this Act—

(*a*) refuse to make any order;

(*b*) order any issue of fact to be tried in such manner as it directs;

(*c*) order any party to deliver to the Court or to the Registrar the certificate of registration of any trade mark; and

(*d*) order any party to pay costs to any other party.

Powers of Registrar and Law Officer.

Ib. s. 14.

96. The Registrar and the Law Officer, respectively, may for the purposes of this Act—

(*a*) summon witnesses;

(*b*) require the production of documents; and

(*c*) award costs against any party to any proceeding before him.

Penalty for disobedience to summons.

Ib. s. 15.

97. No person who has been summoned to appear as a witness before the Registrar or the Law Officer shall, without lawful excuse, and after tender of reasonable expenses, fail to appear in obedience to the summons.

Penalty: Fifty pounds.

Penalty for refusing to give evidence.

Ib. s. 16.

98. No person who appears before the Registrar or the Law Officer as a witness shall, without lawful excuse, refuse to be sworn or make an affirmation or to produce documents or to answer questions which he is lawfully required to answer.

Penalty: Fifty pounds.

Recovery of costs.

99. Any sum awarded for costs by the Registrar or the Law Officer may, in default of payment, be recovered in any civil court of competent jurisdiction as a debt due by the person against whom the order is made to the person in whose favour the order is made.

Certificate of validity.

51 & 52 Vict. c. 50, s. 18.

100. (1.) In any legal proceeding in which the validity of the registration of a registered trade mark comes into question, the Court or a Justice may certify that the right to the exclusive use of the trade mark came in question and was decided in favour of the registered proprietor of the trade mark, and then in any subsequent action for infringement of the trade mark the plaintiff 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 a Justice trying the subsequent action certifies that he ought not to have them.

(2.) In this section "Court" means any Federal Court or any superior State Court having jurisdiction to entertain an action for infringement of a trade mark, and "Justice" means a Justice of any such Court.

False representation to Registrar or officer.

Patents Act, 1903, s. 112.

101. No person shall wilfully make any false statement or representation to deceive the Registrar or any officer in the execution of this Act, or to procure or influence the doing or omission of anything in relation to this Act or any matter thereunder.

Penalty: Three years' imprisonment.

Power of amendment.

102. The Registrar may at any time before registration of a trade mark permit the amendment of the application for the registration of the trade mark and may at any time permit the amendment of any notice of opposition on such terms as to costs or otherwise as he thinks just.

Exercise of discretionary power.

46 & 47 Vict. c. 57, s. 94.

103. Where any discretionary power is by this Act given to the Registrar, he shall not exercise that power adversely to the applicant for registration of a trade mark without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Fees to be paid in advance.

104. Where any prescribed fee is payable in respect of any act or document the Registrar may refuse to permit or perform the act or to receive or issue the document as the case requires until the fee payable in respect thereof is paid.

Extension of time.

105. Where by this Act any time is specified within which any act or thing is to be done, the Registrar may, unless otherwise expressly provided, extend the time either before or after its expiration.

Applications and notices by post.

Ib. s. 97.

106. Any application, notice, or other document, authorised or required under this Act to be left, made, or given at the Trade Marks Office, or to the Registrar, or to any other person, may be sent by a prepaid letter through the post.

Address for service.

107. (1.) Any address for service stated in any application or notice of opposition shall for all purposes of the application or notice of opposition be deemed to be the address of the applicant or opponent, as the case requires, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them to the address for service of the applicant or opponent, as the case requires.

(2.) Any address for service may be changed by notice in writing to the Registrar.

Declaration by infant, lunatic, &c.

Cf. 46 & 47 Vict. c. 57, s. 99.

108. 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 the regulations, then the guardian or committee (if any) of such incapable person, or if there be none any person appointed by any Federal or State Court or Justice thereof, possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of the incapable person or of any other person interested in the making of such declaration or doing such thing, may make the declaration or a declaration as nearly corresponding thereto as circumstances permit, and do the thing in the name and on behalf of the 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.

Death of party to a proceeding.

109. If a person who is party to a proceeding under this Act dies pending the proceeding, the Registrar may on request made in the prescribed manner, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceeding his successor in interest in his place, or, if he is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceeding to continue without such substitution.

Registrar may recognise agent.

T.M. Rules (Eng.), s. 9.

110. Subject to the regulations the Registrar may permit any agent to do, on behalf of any other person, any act in connection with the registration of trade marks or any procedure relating thereto.

Certificate of Registrar evidence.

111. A certificate purporting to be under the hand of the Registrar and the seal of the Trade Marks Office as to any entry, matter, or thing which he is authorised by this Act 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.

Penalty on falsely representing a trade mark as registered.

Cf. 46 & 47 Vict. c. 57, s. 105.

112. (1.) No person shall falsely represent that any trade mark, applied to any article sold by him, is registered.

Penalty : Five pounds.

(2.) A person shall be deemed, for the purposes of this section, 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 a registration has been obtained for the trade mark stamped, engraved, or impressed on, or otherwise applied to, the article.

Penalty on unauthorised assumption of Royal Arms.

Ib. s. 106.

113. No person shall without the authority of the King, or of some member of the Royal Family, or of the Governor-General, or of the Governor of a State, or of some Department of the Government of the Commonwealth or a State (proof whereof shall lie upon the person accused), assume or use in connection with any trade business calling or profession the Royal Arms, or arms so nearly resembling them as to be likely to deceive, in such a manner as to be likely to lead other persons to believe that he is carrying on his trade business calling or profession by or under such authority.

Penalty : Twenty pounds.

Scandalous and improper marks.

Cf. 46 & 47 Vict. c. 57, s. 73.

114. No scandalous design, and no mark the use of which would by reason of its being likely to deceive or otherwise be deemed disentitled to protection in a court of justice, or the use of which would be contrary to law or morality, shall be used or registered as a trade mark or part of a trade mark.

International arrangements for protection of trade marks.

See 46 & 47 Vict. c. 57, s. 103.

Patents Act, 1903, s. 121.

115. (1.) If upon the request of the Governor-General the King is pleased to apply to the Commonwealth any law of the United Kingdom for carrying into effect any arrangement made with the Government of any foreign State for the mutual protection of trade marks, then any person who has applied for protection for any trade mark in the United Kingdom or the Isle of Man, or in any foreign State with which the arrangement has been made, shall be entitled to registration of his trade mark under this Act in priority to other applicants, and such registration shall have the same date as the date of the original application in the United Kingdom or the Isle of Man or such foreign State as the case may be :

Provided that such application shall be made within six months from such person applying for protection in the United Kingdom or the Isle of Man or the foreign State with which the arrangement is in force :

Provided also that nothing in this section contained shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the date of the actual registration of his trade mark in the Commonwealth.

(2.) The use of the trade mark in the Commonwealth during the period aforesaid shall not invalidate its registration.

(3.) The application for the registration of a trade mark under this section must be made in the same manner as an ordinary application under this Act.

(4.) The provisions of this section shall, in the case of foreign States, apply only to those foreign States with respect to which His Majesty, by Order in Council, has before or after the commencement of this Act declared the provisions of the aforesaid law to be applicable, and so long only in the case of each such State as the order continues in force with respect to that State.

Provision for intercolonial, &c., arrangements.

Cf. 46 & 47 Vict. c. 57, s. 104.

Patents Act, 1903, s. 122.

116. (1.) Where it is made to appear to the Governor-General that any British possession has made satisfactory provision for the protection in that possession of trade marks registered in the Commonwealth, the Governor-General may by order apply all or any of the provisions of the last preceding section with such variations or additions (if any) as to him seem fit to trade marks registered in that British possession.

(2.) An order under this section shall, from a date to be mentioned therein, take effect as if its provisions were contained in this Act, but it shall be lawful for the Governor-General to revoke any such order.

APPENDIX XVIII.

FOREIGN AND COLONIAL TRADE MARK LAWS.[1]

1. Principal Foreign Laws.

Argentine Republic.

The Act in force is No. 3973 of 1900. A new bill was brought forward in 1907.

Austria-Hungary.[2]

The law of December 7th, 1858, which for thirty-two years regulated the protection to property in trade marks in Austria-Hungary, gave way in 1890 to a new law, which was published in Vienna on January 6th, and in Buda-Pesth on April 6th of that year.

The law in question is the same for both halves of the Dual Monarchy, and came into force three months after the date of its publication in Austria and Hungary respectively.

This law, subject to certain modifications hereinafter mentioned, still regulates all questions as to trade marks in Austria-Hungary, and contains full particulars as to procedure, forms, and fees for registration.

Sec. 4, para. 32, of the law enacts that, with reference to the protection of marks, as also of names, firms, arms, or business descriptions of foreign establishments or undertakings, the conventions or treaties concluded with the respective foreign States are decisive.

The subjects of His Britannic Majesty, therefore, by virtue of Article VI. of the treaty concluded between Great Britain and Austria on December 5th, 1876, enjoy in Austria-Hungary the same protection as native subjects with regard to rights of ownership over trade marks, and other distinctive marks of goods, or their packages, as well as over patterns and designs for manufactures.

British subjects, however, in order that they may enjoy the benefit of protection, must obtain the registration of their trade marks both at Vienna and Buda-Pesth, and, to this end, must deposit four specimens of such marks in the Chambers of Commerce at each capital, whereas under the law of 1858 only two copies were required.

[1] The summary contained in the 2nd edition was prepared from the following Blue Books:—*Reports relative to Legislation in Foreign Countries*, 1879 (C. 2284, 2420); *Reports from Her Majesty's Representatives Abroad on Trade Marks Laws and Regulations*, 1900 (Cd. 104). In this edition the editors have endeavoured, with the use of the information to which they have access in the Patent Office Library and elsewhere, to bring the summary accurately up to date, but they are conscious of the possibility of error in so large a field.

[2] A law as to Patents, Designs and Trade Marks, dated December 31st, 1907, has been enacted.

It should be further noted that under the old law it was only necessary for an applicant for registration to prove that his trade mark had been registered in the United Kingdom in order to effect its registration in Austria-Hungary. Now, however, the law enacts that the mere fact of a mark being registered abroad does not necessarily imply that it is qualified for registration by the Austrian and Hungarian authorities, foreigners being called upon to satisfy the same requirements for registration as any native of the Dual Monarchy.

By virtue of an enactment, dated July 30th, 1895, the following amendments and additions to the Law of 1890 were made. These modifications of the law are still in force :—

Amendment

1. The stipulations of sec. 3, No. 2, of the Law of 1890, enacting that those marks of goods which consist only of words are excluded from registration, are restricted to those words which contain exclusively statements as to place, time, and manner of production, and as to quality, price, designation, quantity, and weight.

Addition.

2. (1) It is enacted, with reference to sec. 2 of the Law of 1890, that the sole right to a mark consisting of words is not restricted only to the deposited forms of a mark in words, but also extends to the use of those forms of execution by which the protected word or words are rendered in other characters, colours, or sizes, wholly or in part.

(2) It is enacted, with reference to sec. 21, sec. (*e*), of the Law of 1890, that a mark can be annulled when it is found that the same has a striking resemblance to a mark previously granted upon a similar class of goods, the Minister of Commerce to give his decision in the matter after he has heard the owner of the trade mark, and, if necessary, called in the evidence of experts.

(3) It is enacted, with reference to sec. 21 of the Law of 1890, that the actual user of a non-registered mark can bring an action for annulment against the owner, or his legal successor, of a registered mark, if, at the time of registration of the contested mark, or one strikingly similar, the said mark was known in commercial circles as the mark of his goods. Such an action for annulment shall be considered inadmissible when the mark in question has been registered with the consent of the plaintiff, or when the firm or other undertaking which has registered the mark has used the mark unregistered for the same period as the plaintiff, or even longer.

The complaint must be lodged with the Ministry of Commerce within two years of the registration of the mark, the annulment to come into force from the date of the filing of the action, where such action is successful.

The successful plaintiff is entitled to register the annulled mark in his own name as soon as the annulment has been declared valid.

This enactment is only applicable to those marks which have been registered since August 2nd, 1895.

(4) In those cases where a party is non-resident in Austria-Hungary, including Bosnia and Herzegovina, and has no settled abode, the said party will only be able to establish his claims under the Law of 1890, or the supplementary enactment of 1895, by nominating an attorney resident within the territory in question. The name of the said attorney may, but need not necessarily, be entered in the register of marks. Where such name has not been entered, judgment may be given in any

action brought for annulment of a mark without having the evidence of the non-resident owner.

(5) The Minister of Commerce has the right, according to his own free judgment, to determine in all disputes occurring subsequent to August 2nd, 1895, the proportion of the costs of the proceedings and of the legal representatives to be borne by the parties in question. Any legal decision concerning costs can be enforced by legal distraint.

(6) In those cases where marks have been annulled consequent upon a delay in the re-registration, or upon an action at the instance of the legitimate claimant, the same or strikingly similar marks for the same or a similar class of goods cannot be registered in favour of another or of the previous owner, or his legal successor, until two years after the legal annulment.

The foregoing supplementary enactment to the Law of 1890 came into force on February 2nd, 1896.[1]

From January 1st, 1908, the two States administer matters relating to trade marks separately and independently, but a reciprocity arrangement was made on February 10th, 1908.

Brazil.

All matters relating to the registration and protection of trade marks in Brazil are at present regulated by the Law of October 14th, 1887.[2]

In its main provisions this law is very similar to the decree of October 23rd, 1875, a French translation of which was published in Parliamentary Blue Book, "Commercial, No. 25, 1879." Contrary, however, to the British Act, while no prohibition appears of the importation of goods bearing the name or trade mark of a Brazilian dealer, an endeavour has been made (Law of December 16th, 1896), "with the view of protecting national industry, and in order to give greater publicity to its products, to prohibit, under penalty of a fine of from 1,000 to 5,000 milreis (about £30 to £150), the printing or importation of labels and marks of foreign products, or in a foreign language, to be affixed to Brazilian products, and to prohibit the sale of products of Brazilian origin to which such labels have been affixed."

As regards registration of trade marks, the following modifications appear in the Law of 1887:—

The manufacturer or his special delegate is required to present three facsimiles of a trade mark for registration, instead of two as formerly; after registration two of these are returned to him.

An explanation or description of the trade mark must accompany the facsimile, with a declaration of the branch of trade or commerce for which the mark is destined.

The application and the print or sketch of the mark must be on thick paper 33 × 22 centims. in dimension, with a margin for binding. This paper must not be folded, nor must other parts be attached to it. Each sheet must be stamped, dated, and signed.

[1] See also the Ordinance of August 19th, 1903, respecting the renewal and transfer of foreign marks; and the Ordinance, concerning the deposit of marks, of December 15th, 1906, which came into force on January 1st, 1906; and note (2), p. 782.

[2] Now modified by Decree No. 1236 of September 24th, 1904. Regulations thereunder were issued on January 10th, 1905.

Within thirty days after the date of registration the applicant is required to publish in the official *Gazette* the certificate of registration, with an explanation of the distinguishing features of the mark.

Within sixty days from the same date he must also deposit a copy of the *Gazette* containing this publication at the office of the Commercial Tribunal of Rio.

Trade marks composed of arms, national or foreign medals, or emblems are prohibited; also a trading name to which the applicant is not entitled; also the partial or entire imitation of a mark already registered for goods of the same description.

As regards the system of official fees for registration of trade marks, it appears to be impossible to give precise information, as the system of registration fees in Brazil is so complicated and variable.

In the first place the power of attorney (*pouvoir*) and the certificate of registration of the country of origin must be taken to the stamp office to be stamped, the value of such stamp varying according to the dimensions of the paper and the number of sheets. The next step is to present these two documents at the Ministry of Foreign Affairs, where a fee of 550 reis (about 4½*d.* at present rate of exchange) has to be paid for each. These two documents must then be translated by a sworn translator on stamped paper; the price charged for these two translations is very variable. This done, a form of application, with a 300-reis stamp (about 2½*d.*) affixed, and a description in triplicate of the trade mark with a 900-reis stamp (about 7¼*d.*) affixed, must be deposited at the Junta Commercial, together with a fee of 2 milreis (about 1*s.* 4*d*).

The stamps required for the certificate of deposit amount to 6$600 reis (about 3*s.* 11*d.*): the publication of the certificate of registration in the official *Gazette* costs 200 reis (about 1⅗*d.*) per line.

Lastly, it is required to furnish a copy of the official *Gazette* (100 reis = about ⅘*d.*), stamped with a 1$200-reis stamp (about 9½*d.*), together with a stamped petition (100 reis = about ⅘*d.*) accompanied by a fee of 2 milreis (about 1*s.* 4*d.*).

Brazil, on January 9th, 1903, approved the additional Act of December 14th, 1900, modifying the International Convention, which was signed at Brussels.

Denmark.

The Danish Trade Mark Law of April 11th, 1890, replaced the old one of July 2nd, 1880. The reason for making a new law was that Sweden and Norway were to get a uniform law (there was already a law in Sweden, but none in Norway), and the two countries invited Denmark to join and have similar rules as to protection and reciprocity. In Sweden and Norway there were a good many timber and iron firms, who used as marks single letters ("A," "B," "BB," "BC," &c.).

Such letter combinations could be registered by the owners within six months from the date of the coming into force of the law. After the expiration of the six months they could not be registered (sec. 14, para. 7).

The following is a translation of Articles 4 and 7:—

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.

On September 28th, 1894, Denmark joined the International Convention for the protection of trade marks of March 20th, 1883, and to which almost all civilised States have adhered.

On December 19th, 1898, an amendment was passed for the purpose of enabling traders to register words or figures, but the law prescribes that to make registration possible these words or figures should not contain any indication as to the origin, kind, use, quality, or price of the goods.

On March 29th, 1904, certain further amendments in the law of 1890 were made.

FRANCE.

(Law of June 23rd, 1857.)

Part I.—The Ownership of Trade Marks.

ART. I.—(Sec. 1.) Trade marks are optional. Nevertheless, decrees in the form of administration orders may, by way of exception, declare trade marks compulsory for certain specified articles.

The following are considered trade marks :—Names of a distinctive character, appellations, emblems, imprints, stamps, seals, vignettes, reliefs, letters, numbers, wrappers, and every other sign serving to distinguish the products of a manufacture or the articles of a trade.

ART. II. No person can assert his exclusive ownership of a trade mark, unless two copies of the pattern of the mark have been deposited (registered) at the Tribunal of Commerce of his domicile.[1]

ART. III. This deposit (registration) is effective for a period of fifteen years only. The ownership of the mark may, however, be secured for a further term of fifteen years by means of a fresh deposit (registration).

ART. IV. A fixed fee of one franc is charged for entering the minute of deposit of each mark, and making a copy thereof, exclusive of stamp and registration fees.

Part II.—Provisions Relating to Foreigners.

ART. V. Foreigners who have industrial or commercial establishments in France enjoy the protection of the present law for the products thereof, provided they comply with the formalities herein prescribed.[2]

[1] This article has been amended by the Law of May 3rd, 1890 (see infra, p. 787).

[2] Compare Art. III. of the International Convention of 1883 (p. 744).

ART. VI.—(Sec. 1.) Foreigners and Frenchmen whose houses or places of manufacture are situate out of France also enjoy the protection of the present law for the products thereof, if, in the countries where such houses or factories are situate, diplomatic conventions have stipulated reciprocity for French trade marks.

Sec. 2. Foreign marks in this case shall be registered at the Tribunal of Commerce of the Department of the Seine.

The Law of June 23rd, 1857, is still in force, with the exception of Article II., which has been amended by the Law of May 3rd, 1890.

A Presidential Decree of February 27th, 1891, regulates the working of the provisions of the Law of 1857 in its amended form, and annuls the Imperial Decree of June 23rd, 1857.

Under Article II. thus modified the applicant for a trade mark must, in order to claim exclusive rights over that trade mark, deposit at the "Tribunal de Commerce" of his place of domicile, or, in the case of a foreigner, at the "Tribunal de Commerce du Département de la Seine": Procedure.

1. Copies in triplicate (instead of in duplicate, as heretofore) of his trade mark; and

2. The plate (or die) of that trade mark.

This plate must not exceed 12 centim. in length; it must be of metal, and of such a kind as is usually employed for printing purposes, 23 millim. in thickness, and must be inclosed in a solid wooden box.

It is returned to the interested party after the official publication of the trade mark in the "Bulletin Officiel de la Propriété Industrielle et Commerciale."

The delay between the time of application for the registration of a trade mark and its publication is usually about forty-five days.

A fee of 1 fr. is charged for each *procès-verbal* of deposit besides the stamp and registration fees, which amount together to about 8 fr. 38 c. (see annexed table):— Fees.

(A.) *Dépôt de la Marque de Fabrique et délivrance de l'Expédition.*

	Fr.	c.
1. Timbre de la minute du procès-verbal. (Décret du 18 Juin, 1880, Article XII., s. 3)	0	60
2. Enregistrement de la minute du procès-verbal... ...	5	63
3. Rédaction du procès-verbal y compris le coût de l'expédition. (Décret du 27 Février, 1891, Article XII. Décret du 18 Juin, 1880, Articles VIII. et X.)	1	00
4. Mention sur le répertoire et remboursement du timbre. (Décret du 18 Juin, 1880, Articles X. et XII.) ...	0	35
5. Timbre de l'expédition	1	80

If more than one trade mark is deposited by the same person, an additional fee of 1 fr. is charged for each trade mark, the other stamp and registration fees of 8 fr. 38 c. being sufficient to cover the registration of any number of trade marks.

The *procès-verbal* of deposit should be renewed every fifteen years.

Any person wishing to have an extract from the Trade Marks Register must pay a fee of 1 fr. for each trade mark, together with

stamp and registration fees, amounting together to 4 fr. 8 c. or 4 fr. 68 c., as the case may be (see annexed table).—

(B.) *Délivrance du Certificat d'Identité de la Marque de Fabrique.*

	Fr.	c.
1. Timbre du certificat ... ... 60 c. ou	1	20
2. Enregistrement de la Minute	1	88
3. Délivrance du certificat. (Décret du 18 Juin, 1880, Article VIII., s. 8)	1	00
4. Mention sur le répertoire et remboursement du timbre. (Décret du 18 Juin, 1880, Articles X. et XII.) ...	0	35
5. Légalisation. Décret du 18 Juin, 1880, Article X., s. 1)	0	25

A Presidential Decree of December 17th, 1892, relates to International Registration of Trade Marks.

GERMANY.

The 1874 law on trade marks and its defects.

The first uniform Law on trade marks for the Empire of Germany was that of November 30th, 1874, which, however, proved to be defective, and was replaced twenty years later by the present Law of May 12th, 1894 (supplemented by "regulations to carry the same into effect").

The present Law extended legal protection to trade marks which did not fall within the limits of the old Law. The 1874 Law had this peculiarity, that it was uniform in its application to all parts of the Empire, but each Federated State was allowed to retain its separate offices for the registration, cancellation, &c. of trade marks, and each Commercial Court in each Federated State still continued to have its separate register of trade marks, though all the registered marks were published in the *Imperial Gazette* (*Reichsanzeiger*), but without any central reference index.

The inconveniences occasioned by this state of things, which may be described as a want of centralisation, together with the non-examination of applications for trade marks, the exclusion of the registration of "word marks," and the fact that marks could only be protected by such traders or merchants as were inscribed on the official Commercial Registers ("Handelsregister") brought about changes that were urgently needed in the interests of the public.

The 1894 law on trade marks: position of foreigners.

The Trade Marks Law of 1894 is characterised by the fact that any person whatsoever can acquire protection for a trade mark, and that all foreigners in Germany are placed on an exactly equal footing with Germans in the eye of the law, so long as they have a domicile ("Niederlassung") within the Empire (*i.e.*, a place of business or a residence which involves the payment of German taxes). Failing this domicile in Germany, protection for a trade mark is made strictly dependent upon the reciprocity of trade mark rights in the country of the foreign applicant; therefore, in order that a foreigner may obtain the benefit of the German Trade Mark Law, there must have been previously published in the *Imperial Gazette* (*Reichsanzeiger*) a notice

stating that German trade marks are granted legal protection, in the country or State in which the foreign applicant's domicile is located, to the same extent as the national trade marks of that country. (Sec. 23 of Law.)

If that reciprocity is accorded, the nationality of the applicant is immaterial. Such notifications have been published for Austria-Hungary, Belgium, Brazil, Bulgaria, Denmark, France, Greece, the United Kingdom, Guatemala, Italy, Japan, Luxembourg, the Netherlands, Mexico, Roumania, Russia, Sweden and Norway, Switzerland, Servia, Venezuela, and the United States.

As such a notice has been published as regards the United Kingdom, the only other condition to be fulfilled by a British applicant (not having a domicile in Germany) for the registration of a foreign trade mark is that he produce proof that he has applied for and has secured protection for the mark in the United Kingdom by registration there (sec. 23 of Law). His application, however, for a similar registration in Germany does not follow as a matter of course. The German Trade Marks Office (a branch of the Patent Office) first examines his application to see if it conforms to the requirements of the 1894 Act in every particular; and registration in the German Empire may be refused on various grounds, such as the previous registration of the same mark by another applicant, or the too great similarity of the mark to some other mark already registered for a German or foreign trader.

Germany is now a member of the "Union for the Protection of Industrial Property."

The German Empire on March 21st, 1903, signified its adhesion to take effect from May 1st, 1903, to the "International Union for the Protection of Industrial Property," founded in 1883, including the addition protocol of Madrid of April 15th, 1833, and the additional Act of Brussels of December 14th, 1900.

British trade marks may be appropriated by other persons if not registered in Germany.

As in Germany non-registered marks can be used by anyone, notwithstanding the fact that such marks are the property of British firms or individuals in Great Britain and are there registered for them, it may happen that German or other firms or persons in the German Empire have already adopted certain British marks, in which case there is not much hope of redress for such British firms or persons as have neglected to register their marks in due time in Germany. Moreover, the previous use of a registered British mark for a lengthened period in the German Empire would not entitle the owner to any rights or priority in the matter of registration, as against a German or any foreigner who had already applied for its registration as his own trade mark. The actual date of the application for registration is determinative. No registration of such a British trade mark by a German or other foreigner would be cancelled in favour of the British owner, even if previous use and consequent material ownership of the said mark over a lengthened period in Germany were proved, save under exceptional circumstances (under the provisions of sec. 9 of Trade Marks Law). It is therefore most important that all British exporters of goods, going both to the German Empire and to all other important neutral markets abroad, should, if they have not already done so, effect immediately a proper registration of their trade marks. Otherwise they may suffer unnecessary injury all over the world, merely because they have not taken the trouble to effect a proper registration in Germany, as well as in the United Kingdom, for their trade marks.

Fees for registration and renewal.

The actual procedure to be followed in order to obtain registration of a British trade mark is to be found in the "Regulations for Applications for the Registration of Trade Marks."[1] The preliminary fee is £1 10s., of which £1 will be returned if the application for registration is not accepted. A further 10s. is payable for each application for the renewal of a mark on the expiration of the first ten years (sec. 2 of Law). There are no other fees or expenses whatever. In Germany there are forty-two classes of trade marks, and the initial fee of £1 10s. covers the registration of the mark for all these classes of goods if noted in the complete list of goods to which the mark is to be applied accompanying the application.

Conditions of the renewal of registration.

The registration of a trade mark expires *ipso facto* after ten years from the date of registration or from the date of renewal. It can also be cancelled if the registration ought to have been refused in the first instance. Notice of cancellation on account of failure to renew is given to the proprietor of the mark by the Trade Mark Branch of the Patent Office. If 10s. fine besides the renewal fee of 10s., or £1 altogether, be paid within one month of the delivery of the notice, then the renewal will be considered to have been properly made on the day of the expiration of the former registration (sec. 8 of Law). But, even after this time, the expired mark can nevertheless be again registered afresh by an entirely new application. In this case, however, the application has no priority whatever on account of its previous registration, and such re-registration may meantime have been barred by the fact that some other firm or person has registered the same mark or one nearly resembling it.

Testamentary and contract transfer of trade mark rights.

The rights in trade marks can be transferred to other persons by contract, or they can pass over by a testamentary enactment, but only together with the business to which the trade mark belongs. Such transfers are officially registered (sec. 7 of Law).

Grounds for cancellation of a mark.

Anyone can petition for the cancellation of a mark on the following grounds (sec. 9 of Law):—

1. If the mark has been entered in the Trade Marks Register in his name for the same or similar goods on the basis of a prior application, or in pursuance of the Trade Marks Act of November 30th, 1874.

2. If the business to which the mark belongs is no longer carried on by the registered proprietor.

3. If there are any circumstances that show that the mark used is misleading and is calculated to deceive.

These provisions are valuable where the British owner of a trade mark wishes to try to remove the registration and to prevent the use of his mark in Germany by some other person. It is only under the provisions of sec. 9 that he might possibly obtain redress.

Sec. 17 of the Law is important, and reads thus:—

Penalties for wrongfully using German trade marks.

"Foreign products which wrongfully bear the name and locality of a German firm, or which wrongfully bear a registered trade mark, on entering Germany as imports or for transit through the country are liable to seizure and confiscation if the injured party files a petition to that effect and gives security. The seizure is effected by the Custom

[1] See the Ordinances of June 30th, 1894, and of November 28th, 1898.

House authorities, and the confiscation is decided according to the Penal Code (sec. 459 of Code)."

Actions in the Courts in trade mark matters are provided for in sec. 21.

A most important provision is found in sec. 22; but the important rights conferred by it have not as yet been made use of by the Federal Council. It is as follows:— Powers of Federal Council as to compelling imported goods to bear a mark showing their origin.

"If German goods must bear a certain mark or sign on being imported into, or for transit through, a foreign country to show that they are of German origin, or if such goods are not so favourably treated at the Custom House in respect of trade marks as the goods of other countries, then the Federal Council is empowered to subject goods imported into Germany from such other countries, or for transit through Germany, to the same obligations, and to order that, in the case of violation of this regulation, the goods shall be seized and confiscated. The seizure is effected by the Custom House authorities, and the confiscation will be decided by the verdict of the Department of Administration (sec. 459 of the Regulations of the Criminal Law)."

It is, therefore, to be noticed that the above regulation might be applied to British goods entering Germany whenever, in Great Britain, German goods imported there, or for transit merely, are obliged to bear a mark showing that they are of German origin, or whenever German imports do not, in the matter of trade marks, receive most-favoured-nation treatment at the British Custom House. Liability of British imports to bear a mark showing their origin.

Any kind of sign can become a trade mark, either on the article itself or on its covering when packed, if it affords a clear and distinguishing mark. But by sec. 4 entry in the Register is to be denied to merchandise marks— Definition of what may be registered as a trade mark.

(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.

In the registration of "word marks" it is important to state in the application whether protection is wanted only for it as a design or for its sound, or for both; for the Trade Marks Office, in its examination, investigates this point.

The use of German or foreign State coats-of-arms, as well as of the arms of German municipalities or corporations, in order to unduly enhance the market value of goods, is forbidden under a penalty of a fine of £250, or by imprisonment not exceeding six months (sec. 16 of Law). As to use of coats-of-arms.

The Trade Mark Office in Berlin publishes a list of so-called "Free Marks" ("Freizeichen"). These consist of marks that are generally used by the public to indicate certain trades, such as crossed hammers for the coal trade, and an anchor for some marine trades, which cannot be acquired by anyone as a private trade mark. Additions are often Definition of "free marks."

made to this list, and applications for the registration of trade marks are refused if it is found that the mark applied for resembles too closely a listed "Free Mark."

German colonies and protectorates.

The German Trade Marks Law was also put into force for the German Colonies and Protectorates on October 1st, 1894.

Special agreements.

Special agreements, dealing with trade marks, &c., exist with Austria-Hungary (December 6, 1891), with Italy (January 18, 1892), with Switzerland (April 13, 1892), and with Servia (August 21, 1892).

Trade mark relations between the United Kingdom and Germany.

The relations, in trade mark matters between the United Kingdom and the German Empire were formerly governed by Art. VI. of the Treaty of Commerce of May 30th, 1865 (extended to the whole German Empire by the Declaration of April 14th, 1875), which expired on July 30th, 1898. Since that date our rights in Germany with regard to trade marks are regulated by the German law.

Protection of German trade marks in China.

The German Government has concluded agreements with several other countries including France in 1898, with Holland in 1899, with Belgium in 1901, with Great Britain and the United States in 1906, regarding the protection of German trade marks in China. Under these several agreements German Consular officers in China will take legal proceedings against any German subjects residing in China who may imitate French, Dutch, Belgian, British or United States trade marks registered in the German Empire. The representatives of the above-mentioned Governments in China are likewise bound to act similarly in the case of their subjects.

GREECE.

The Law in force is that enacted in 1893. According to this Law in order for a British subject to obtain registration of a trade mark, it must be on the Register in England. By a declaration of July 27th, 1894, between Great Britain and Greece, each declared that the subjects of the other should have the same rights as the subjects of their own States or subjects of the most favoured nation.

GUATEMALA.

The Law is contained in decrees of 1897 and 1899. There is a convention with Great Britain, dated July 20th, 1898, each party placing subjects of the other on the same footing as their own subjects.

ITALY.

No change has taken place in internal Italian legislation with regard to trade marks since the report presented to Parliament in 1879.

Legislative effect has, however, been given with regard to foreign trade marks to the requirements of the Paris Convention of 1883, and the similar requirements of the Italo-German Convention of 1892. These modifications in the existing Law only affect the period of delay conceded to the proprietors of foreign trade marks during which the priority of a trade mark registered abroad may be made valid in Italy. Special regulations issued in 1898 determine the formalities necessary

to obtain the notification on the certificate of registration of the right of priority of a trade mark claimed under the above-mentioned Conventions.

Further, a Law of November 19th, 1894, puts in force the provisions of the Madrid Convention of 1891 for the international registration of trade marks, and affords protection in this country, without the fulfilment of the formalities required by the Law of Italy, to trade marks registered in the countries adhering to the Union, and fulfilling the conditions contemplated by that instrument.

A decree of 1905 relates to applications for trade marks by foreigners.

Japan.

The present Japanese Law relating to trade marks is one of a series of Laws which came into force on July 1st, 1899.

According to this Law, which has superseded the Trade Mark Regulations contained in the Imperial Ordinance No. 86 of 1888, the protection of property in trade marks in Japan depends upon registration, but trade marks which were actually in use before July 1st last would appear to be protected by sub-heading 5 of Article II., unless their registration has meanwhile been obtained by other persons and three years have been allowed to elapse without protest.

The course to be pursued by owners of foreign trade marks to obtain registration in Japan is laid down in the Law and in the "Detailed Regulations for carrying out the Trade Marks Law" of July 20th, 1899, as modified by the Regulations No. 3 of January 4th, 1905.

The reference in Article XX. to Articles VI. to X. of the Japanese Patent Law is important, as it makes it obligatory on persons not resident in Japan to appoint a duly qualified agent through whom the application for registration of a trade mark should be made. The registration may be cancelled if the owner of a trade mark fails to appoint an agent within six months (Article XI., 2).

In the case of British subjects previous registration of their trade marks in the United Kingdom does not appear to be necessary, but if it has taken place certified copies of the original certificate of registration and specifications must accompany the application for registration in Japan (Detailed Regulations, Article II.). Article IX. of the Law also gives priority to a trade mark registered in a country belonging to the Union for the Protection of Industrial Property, provided that application for its registration in Japan is made within four months.

No limit of time is stated within which persons who have used trade marks before registration are obliged to register them. Penalties, however, are imposed by Article XVII. on persons who use a trade mark "to which a deceptive mark, which suggests that it has been registered, is applied."

In order to obtain redress in the event of the infringement of trade marks which have been registered in Japan, proceedings must be instituted by the injured party either by an application to the Patent Bureau for a trial of the case, or by a criminal action for an infraction of Article XVI. of the present Law.

All documents relating to an application for the registration of a trade

mark, or any other matter connected therewith, must be in Japanese, and all copies of foreign documents must be accompanied by a Japanese translation.

The fee for registration is £3 2*s.* 6*d.* (30 yen) for each trade mark and each class of goods for which it is used. The application for registration must bear revenue stamps to the amount of 6*s.* 3*d.* (3 yen). Further payments in connection with trade marks are enumerated in the list of fees contained in the Imperial Ordinance No. 195, or in Regulations No. 4 of January 4th, 1905.

MEXICO.

A new Law was passed and new Regulations made in the year 1903.

NETHERLANDS.

Since the publication by the Foreign Office in 1879 of "Reports relative to Legislation in Foreign Countries on the subject of Trade Marks" a completely new Law has been passed on the subject in the Netherlands, distinct from the draft bill which appeared in the above-mentioned Blue-Book.

The Law now in force on the subject for the Netherlands is dated September 30th, 1893, as amended by that of December 30th, 1904.

For the colonial possessions of the Netherlands three other Laws on trade marks exist, all dated November 9th, 1893—*i.e.*, for the Netherlands East Indies in twenty-six articles, and for Surinam and Curaçao in twenty-five articles each. All three are practically identical, with the exception of that regulating trade marks in the Netherlands Indies, which has one additional article. It has, therefore, merely been necessary to have one of these Laws translated for the purposes of this report; for, if Article XII. of the Law for the Netherlands Indies be omitted, the rest of that Law and the twenty-five articles of the other two are the same; they are, therefore, applicable, not only to the Netherlands East Indies, but also to Surinam and Curaçao. The Laws of November 9th, 1893, have since been modified by those of May 30th, 1905, which practically make all the changes in the Law, introduced in the Netherlands in 1904, applicable to the colonial possessions.

The Trade Marks Law of September 30th, 1893, for the Netherlands came into force on December 1st, 1893, and it completely superseded the former law of May 25th, 1880, and the subsequent amendments of the Law of July 22nd, 1885. The Law of 1904 came into force on January 21st, 1904.

Trade Marks in the Netherlands are now entirely controlled by the Industrial Property Office at The Hague, which was established there on December 1st, 1893, from which date applications for the registration of trade marks had to be directed to that office instead of to the registrars of the local Courts as had previously been the case.

The Netherlands (including Dutch colonies) have joined the International Convention for the Protection of Industrial Property, concluded at Paris on March 20th, 1883, which was approved by the Law of April 23rd, 1884. Trade marks can, therefore, obtain in the Netherlands

international registration (including Dutch colonies). There are thus two distinct forms of registration possible at The Hague Bureau :—

(*a*) Merely for the Netherlands.

(*b*) For international registration—*i.e.*, for Holland, France, Spain, Portugal, Switzerland, Belgium, Italy, Brazil, and Tunis, as well as for the colonies of the first four countries, and in Netherlands India, Surinam, and Curaçao.

The regulations to be followed to secure this international registration are to be found in Part B of "The Regulations for Registration," issued by the Industrial Property Office at The Hague. Part A of those regulations contain the rules for registration in Holland only. An official note giving the formalities required for registration under the amended Law of 1904 was issued in 1905. The formalities for renewal of trade marks will be found in Regulations issued on January 3rd, 1908.

With regard to the course of procedure to be followed by owners of British trade marks to obtain protection for their marks, it is to be observed that no difference whatever is made between natives and foreigners in such applications; but the foreigner must choose a "domi ile" in order to be able to follow the ordinary procedure for the registration of a trade mark. The Industrial Property Office at The Hague states that this merely means a "trade domicile," which is constituted by merely giving an address in Holland, such as a lawyer's address, or the name of an hotel at which the applicant for a trade mark might be residing. The actual steps to be taken by a British applicant, either for registration in Holland only or for international registration, are to be found in "The Regulations for Registration."

The previous registration of British trade marks in the United Kingdom is not required. In applications for international registration, sec. 3 of Article III. of "The Law on Trade Marks for the Netherlands" says :—

"The person who, within the period fixed by Article IV. of the International Convention of Paris has sent in a mark to the Office for Industrial Property, which, with due observance of Article VI. of the said Convention, he has deposited according to the regulations of one of the States that is a party to that Convention, shall be considered to have already made use of the mark in the Netherlands."

A similar provision is found in the Laws on trade marks for the Dutch colonies.

There is no limit of time within which persons who have used trade marks before registration in the Netherlands are obliged to register their trade marks in order to secure the benefit of the Dutch Laws on trade marks.

The steps to be taken by the owners of trade marks used in the Netherlands, to obtain redress in the event of infringement, are the following :—

(*a*) By a prosecution, founded upon Article 337 of the Penal Law. This is effected by denouncing (to the justice of the local Court of the place of the occurrence) the infringement.

(*b*) By means of a civil law suit, founded upon—

1. Article X. of the Dutch Law on Trade Marks. This is effected by petitioning the Court of Justice at The Hague to cancel the registration

of a trade mark which is similar or nearly similar to a mark which has already been made use of by some other person for the same kind of merchandise.

2. Article 1,401 of the Dutch Civil Law, in order to obtain indemnification.

The consequence of neglect on the part of British subjects to observe the regulations as to trade marks entails possible adoption of those marks by Dutchmen or by other foreigners. It is most advisable to register marks, which are then protected by the Office for Industrial Property, which will prevent similar or nearly similar marks from being registered.

Nicaragua.

The Law of November 20th, 1907, regulates the registration of trade marks.

Peru.

Law of December 19th, 1892, as modified by that of December 31st, 1895.

Portugal.

The Law in force is that of December 15th, 1894. Regulations of March 16th, 1905.

Russia.

The question of trade marks in Russia is regulated by the Law of February 26th (March 9th), 1896, and the following are its main provisions :—

Trade marks may be adopted and used by all persons engaged in trade and manufacturing industries; such adoption, however, is not compulsory.

No trade marks may be used with designs and inscriptions contrary to public morality, nor such as may fraudulently mislead and deceive a purchaser; also are prohibited trade marks showing medals, &c. of distinction on which the year of award is not indicated. Marks exhibiting such honorary awards may, moreover, be exhibited only on goods and articles of the class for which the award was made.

The exclusive use of a trade mark is secured by application to the Department of Trade and Manufactures, which, on approval of the mark, issues a certificate of registration.

Application for more than one trade mark can be made by a single applicant for distinguishing goods differing in kind and variety.

Exclusive right to a trade mark cannot be secured if it does not differ distinctly from one already registered in the name of another person for goods of a kindred nature.

The registration of trade marks may be effected, according to the desire of applicants, for terms ranging from one to ten years. On the expiration of the term of registration the same may be renewed for a further period.

A trade mark registered in any one colour and in one size may be used in other colours and sizes.

A trade mark is registered in the name of the first person applying for its registration.

The registration of a trade mark does not deprive any other person of the right during three years after such registration of contesting at law the validity of the same.

The transfer of a trade mark to another person or firm is allowed under certain conditions, and subject to the sanction of the Department of Trade and Manufactures.

The exclusive right of using a particular trade mark ceases at the request of the person to whom such right was granted, or on the close of the manufacturing or other business in which it was used. It also lapses on the non-renewal of the registration or non-notification to the Department of Trade and Manufactures of the transfer of a business, &c., within six months of such transfer; moreover, the exclusive right of using a trade mark expires when a Court of law shall declare such right to be non-existent.

The fee payable to the Government for registering or renewing a trade mark is 3 roubles for the first year of duration of the certificate of registration, and 1 rouble for each succeeding year.

All applications for the registration of a trade mark must have affixed on each sheet of the same a Russian revenue stamp of the value of 80 copecks.

Fraudulent use and counterfeit of trade marks are punishable by imprisonment from four to eight months.

A dealer found in possession of goods bearing fraudulent trade marks is liable to the same punishment.

Persons selling or found in possession of goods bearing prohibited trade marks are liable to a fine not exceeding 100 roubles for the first offence, and for the second and succeeding offences in a sum not exceeding 200 roubles on each occasion.

Spain.

Law of May 16th, 1902. Royal Ordinances of July 30th, 1904, concerning International Trade Marks, of July 26th, 1905, and of November 13th, 1905, respecting trade marks in foreign languages.

Sweden.

With the exception of stamps set on iron goods, no legislation existed in Sweden until the year 1885 protecting trade marks, other than the very incomplete regulations which were to be found in the general Penal Law. The affixing of stamps on iron and steel goods has, on the other hand, been from time immemorial and continues to be obligatory in Sweden on the Swedish manufacturers. Up to the year 1885 the control and registration of the iron stamps belonged to the Director-General of the Mining Department, now the Commercial Department of the Royal Board of Trade.

In the year 1877 a committee sat for the purpose of drawing up a bill regarding patents and protection for patterns and models as well as trade marks. The proposals made by this committee led, however, as far as concerned the protection of trade marks, to no result.

In the year 1881, however, committees met simultaneously in Sweden, Norway, and Denmark with the object, among others, of drawing up a bill concerning the protection of trade marks as nearly as possible in the same form for the three countries.

When these committees met together for united work in 1882, they laid on the table bills respecting the protection of trade marks which were in all essentials similar. After some slight amendments the Swedish bill was passed in the 1884 session of the Riksdag, and the Law on the protection of trade marks now in force was promulgated on July 5th of the same year and came into force on January 1st, 1885.

The provisions of this Law have since been modified, partly by a Law of March 5th, 1897, which provided protection to certain so-called "word marks," and partly by Decrees which were issued later.

The Decrees which are at present in force are (1) the Royal Proclamation of December 31st, 1895, relating to the character of the documents which are to be presented on the registration of trade marks; (2) the Royal Proclamation of June 25th, 1897, relating to a change in the wording of paragraph 2 of the above-mentioned Royal Proclamation; (3) the Royal Proclamation of November 18th, 1898, relating to the register of trade marks; and (4) a Law of June 16th, 1905, modifying one article of the Law of 1884 relating to illegal applications of names or marks.

Paragraph 3 of the Law on trade marks relates to the formalities required for registration and the costs attached thereto. It runs as follows:—

Anyone who wishes to have a trade mark registered shall hand into the registration authority, or send in a prepaid letter, a written application containing a clear description of the mark and a full statement of the name, business, and postal address of the applicant or firm, and also in cases where the right to the trade mark embraces only certain kinds of wares, a statement of those kinds. The application must be accompanied by (1) a drawing upon good stout paper of the mark, in triplicate, not more than 10 centims. long and 15 centims. broad; (2) two stamps such as are used in printing the mark (*clichés*), of the same size as the drawing; (3) a fee of 40 kroner for registration and publication.

There are no fixed forms of publication, but more detailed information as to what the application should contain will be found in the above-mentioned Royal Proclamation of June 25th, 1897.

Beyond the above-mentioned fee of 40 kroner, the applicant has nothing more to pay for registration. The protection of a registered trade mark ceases, however, when an application for its renewal is not made, the first time, within ten years of the day of registration, and subsequently, within ten years from the previous day of renewal. A person wishing to renew his registration must hand or send in (in the way stated in paragraph 3 of the Law on trade marks) a written application to that effect, accompanied by one copy of such drawing as is there prescribed, and also a registration fee of 10 kroner.

To insure mutual protection of trade marks between Sweden and foreign States, the King has come to an understanding with certain States, and also, by an Act of Adhesion on behalf of Sweden on June 26th, 1885, has become a party to the Convention for the International Protection of Industrial Property, concluded at Paris on March 20th, 1883. His Majesty, by a Royal Proclamation of June 26th, 1885, in regard to States belonging to the Union founded through the above-mentioned convention, has also decreed, among other things, that protection of trade marks, according to the Law of July 5th, 1884, belongs to those persons who, in a foreign State forming one of the Union, carry on manufactures or trades, agricultural, mining, or other business; and also to those who are the subjects of such a State, or have a fixed residence there but carry on their business in another State.

Besides the documents which, as above stated, must accompany an application for registration, such applications from foreigners must also be accompanied by an attestation, consisting of an extract from the proper register of trade marks, that the applicant has fulfilled the conditions which in the foreign State are required in order to insure protection of the trade mark.

The Norwegian Law of May 26th, 1884, is believed to be similar to that of Sweden of July 5th, 1884.[1]

SWITZERLAND.

The law of December 19th, 1879, respecting the registration and protection of trade marks, was superseded by that of September 26th, 1890.

Articles 1 and 3 are as follows:—

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 attiente aux bonnes mœurs."

The formalities required by the latter for the registration of a trade mark are the following:—

An application must be made to the Bureau Fédéral de la Propriété Intellectuelle in French, German, or Italian, in the prescribed form, in duplicate, with a designation of the goods for which it is to be used.

Further, an exact reproduction, in duplicate, of the trade mark, with the date of deposit, signed by the owner, or his representative, must be sent in, together with a stereotype of the same.

[1] See also Norwegian Law of May 31st, 1900, modifying the Law of May 26th, 1884.

In the case of firms or individuals whose industry is carried on in Switzerland, an official attestation is required as regards their entry in the commercial register, or, in default of such entry, respecting the domicile of the depositor.

In the case of firms or individuals established in other countries which accord reciprocity of treatment, an official attestation certifying the registration of the trade mark in question in the country of origin is required.

The right of the depositor to any honorary distinctions mentioned on the trade mark must be duly established, and it must be shown that a power of attorney has been conferred on the representative who acts for the owner if the latter does not appear personally in the business.

All papers in connection with the application for registration must be in the same language, or a translation furnished at the same time.

The fee for registration is 20 fr. At the expiration of twenty years it is necessary to renew the registration within six months for a fresh term of twenty years, the registration fee being, as before, 20 fr.

A trade mark which is not made use of during three consecutive years is regarded as having lapsed.

In the case of refusal on the part of the Bureau Fédéral to register the trade mark, appeal can be made to the competent department; if the decision of the former is upheld, final appeal can be made to the Conseil Fédéral.

A registered trade mark can only be transferred with the industry the products of which it served to identify. Such transfer is subject to a fee of 20 fr., in addition to the same formalities as were required for the original registration, and is valid for a period of twenty years.

Any change or modification in the designation of the firm must be duly registered, the registration being gratuitous when such modification does not consist of a change of partners, or involve an alteration in the trade mark. If, on the other hand, the change or modification affects the trade mark, a tax of 10 fr. is levied, the publication of the trade mark, as modified, being necessary.

An extension of the use of a registered trade mark beyond the original limits specified at the time of registration involves formalities identical with those previously required, the fee for such extension being 20 fr., and a fresh period of twenty years commencing from that date.

A restriction, on the other hand, as regards its employment may be simply notified by letter, no tax attaching to such notification.

The cancelling of a registered trade mark can take place—

By a written renunciation of the same from the owner.

On the expiration of the period of twenty years for which protection was originally granted, if a renewal of the term has not been formally made.

By decision of the competent Federal Department: or, in virtue of a legal sentence justifying the demand for such a step.

The owners of trade marks applied to products at an exhibition from countries which have no convention with Switzerland on the subject can enjoy temporary protection for a period not exceeding two years, on the payment of a fee of 10 fr. for registration.

Their application must be accompanied by a stereotype of the trade mark.

The United States.

The Act of 1905 is, so far as material, printed above, pp. *754 et seq.* It has been somewhat amended by an Act of May 4th, 1906, and an Act of March 2nd, 1907. Under the Act of 1906, a new classification was made to take effect on July 1st, 1906. Rules under the Act of 1905 took effect from April 1st, 1905, the date of the commencement of the Act. These were amended by rules of April 13th, 1905, of June 13th, 1906, and of July 19th, 1906.

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2. Laws of the British Empire.

(Outside the United Kingdom.)

The Australian Trade Marks Act of 1905 is fully set out above.

It has not been thought necessary to increase the size of the book by a summary of the provisions of the trade marks laws of all the colonies and British possessions, as these follow very closely the lines of British legislation on the subject at the date of the local Acts, but the following information as to the dates of the various Acts, &c., may be useful.

Where a statute is stated to follow one of the British Acts, this is intended to mean in the main provisions, and especially as to essential particulars.

Australia.

The Act of 1905 is set out above, pp. 761 *et seq.*

The existing rules thereunder are those of 1906, Statutory Rules, No. 122.

The Commonwealth adhered to the International Convention as from August 5th, 1907.

Bahamas.

The existing Law is contained in the Trade Marks Act, 1906. It practically follows the British Act of 1905. There are rules of 1908.

Bermuda.

The Act in force is the Patents, Designs and Trade Marks Act, 1902. It is as regards trade marks on the lines of the British Act of 1883, as amended by the Act of 1888. An amendment Act of 1904 makes some unimportant amendments.

British Central Africa Protectorate.

Under an Ordinance, No. 9 of 1903, the Registrar of the Protectorate is Registrar of trade marks, and the law as in England is applied to the Protectorate.

Canada.

The Acts in force are the Trade Marks and Designs Act of 1879 (Revised Statutes of Canada, c. 63), and an Amendment Act of 1891, which lays down rules as to refusal of registration.

Cape of Good Hope.

The principal Act is the Trades Marks Registration Act, 1877. As regards "essential particulars," it followed the British Act of 1875. It has been amended by the Trade Marks Registration Amendment Acts of 1891 and 1895, which follow respectively the British Acts of 1883 and 1888. Some minor amendments were made by the Patent and Designs Trade Marks Act of 1904.

Ceylon.

The Trade Marks Ordinance No. 14 of 1883 follows the provisions of the British Act of 1875, and the amending Ordinance No. 4 of 1890 follows the British Act of 1888. An amending Ordinance No. 6 of 1904 relates to international and intercolonial arrangements. The Trade Marks and Designs Ordinance, 1906, establishes the office of a Registrar-General. The rules in force are those of June 1st, 1906.

Fiji.

The Law is contained in the Trade Marks Registration Ordinance, 1886, and general rules thereunder. The Ordinance follows the terms of the British Act of 1875.

Gold Coast Colony.

The Law in force is the Trade Marks Ordinance, 1899, which follows the British Act of 1888; there is also an Ordinance of 1902, relating to international and intercolonial arrangements and making some minor amendments. By an Ordinance of 1903, no trade mark is to be registered for imported cotton piece goods, silk piece goods or goods in the miscellaneous class, unless such trade mark is registered in the United Kingdom as the trade mark for such goods. The rules in force are those of 1902 as amended by those of 1905.

Hong-Kong.

The Trade Marks Ordinance, 1898, follows the British Act of 1888. There are also rules of 1898.

India.

There is no registration law. A notice in the *Board of Trade Journal* of December 12th, 1907, states that according to the *Times of India* (Bombay) the Upper India Chamber of Commerce has decided to undertake the registration of trade marks.

JAMAICA.

The Registration of Trade Marks Law, 1888, follows the British Act of 1883. But an amending Act of 1889 introduces amendments corresponding to the British Act of 1888. A slight amendment as to application was made in 1905.

LAGOS.

The Trade Marks Ordinance, 1901, follows the British Act of 1888.

LEEWARD ISLES.

The original Act is that of 1887, but it is amended by an Act of 1890, which follows the British Act of 1888.

MALTA.

The Patents, Designs and Trade Marks Ordinance, No. 11 of 1899, follows as regards trade marks the British Act of 1888. There is an amending Ordinance, No. 7 of 1907. There are regulations of 1902 and 1907.

NATAL.

The Act in force is that "To establish a Register of Trade Marks in Natal, 1885." It follows the British Act of 1883. The Rules, Regulations and Scale of Fees are those of 1885 (No. 456) as amended in 1898 (No. 704) and 1901 (No. 433).

NEWFOUNDLAND.

The Law in force is No. 112 of the Consolidated Statutes. It follows the Act of 1888.

NEW ZEALAND.

The Patents, Designs and Trade Marks Act, 1889, contains the statutory law following the British Act of 1888. The rules in force as to trade marks are the Trade Mark Rules, 1890.

ORANGE RIVER COLONY.

The Law in force is No. 3 of 1891 as amended by No. 13 of 1893. It approximates closely to that of Cape Colony.

RHODESIA.

By virtue of a Proclamation of June 10th, 1891, the Cape of Good Hope Registration Act (No. 22 of 1877) came into force in Mashonaland, but

its provisions have since been modified by Ordinance No. 5 of 1893, Regulations No. 59 of 1897, which have the effect of making the law as to what may be registered similar to that contained in the British Act of 1888. See also the rules contained in Government Notice, No. 60 of 1897.

Southern Nigeria.

An Ordinance dated January 27th, 1907, consolidates the Law as to Trade Marks.

Transvaal.

The Trade Marks Registration Proclamation, 1902, which repealed the Law No. 6 of 1892, so far as inconsistent with it, follows the British Act of 1888. It has been slightly amended by an Ordinance of 1904. The rules in force are those of 1902.

Zanzibar.

The Trade Marks Act, 1890, follows the British Act of 1888. There are general rules of 1890.

APPENDIX XIX.

MERCHANDISE MARKS ACT, 1887.[1]

(50 & 51 Vict. c. 28.)

ARRANGEMENT OF SECTIONS.

SEC.
1. Short title.
2. Offences as to trade marks and trade descriptions.
3. Definitions.
4. Forging trade mark.
5. Applying marks and descriptions.
6. Exemption of certain persons employed in ordinary course of business.
7. Application of Act to watches.
8. Mark on watch case.
9. Trade mark, how described in pleading.
10. Rules as to evidence.
11. Punishment of accessories.
12. Search warrant.
13. Extension of 22 & 23 Vict. c. 17, to offences under this Act.
14. Costs of defence or prosecution.
15. Limitation of prosecution.
16. Prohibition on importation.
17. Implied warranty on sale of marked goods.
18. Provisions of Act as to false description not to apply in certain cases.
19. Savings.
20. False representation as to Royal Warrant.
21. Application of Act to Scotland.
22. Application of Act to Ireland.
23. Repeal of 25 & 26 Vict. c. 88.

An Act to consolidate and amend the Law relating to Fraudulent Marks on Merchandise. [23rd August, 1887.]

BE it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. This Act may be cited as the Merchandise Marks Act, 1887. Short title.

2. (1.) Every person who— Offences as to trade marks and trade descriptions.

(a) forges any trade mark; or

(b) falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive; or

[1] See Book II. of 2nd edition, p. 554. The general Orders and Regulations under the Act are printed in that edition at pp. 818 *et seq.*

(c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade mark; or
(d) applies any false trade description to goods; or
(e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade mark; or
(f) causes any of the things above in this section mentioned to be done,

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

(2.) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark or mark so nearly resembling a trade mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

(a) That having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark, mark, or trade description; and
(b) That on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or
(c) That otherwise he had acted innocently;

he guilty of an offence against this Act.

(3.) Every person guilty of an offence against this Act shall be liable—

(i.) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and
(ii.) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and
(iii.) in any case, to forfeit to her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

(4.) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit.

(5.) If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions.

(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts: Provided that a person charged with an offence under this section before a court of summary jurisdiction shall, on appearing before the court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly.

42 & 43 Vict. c. 49.

3. (1.) For the purposes of this Act—

Definitions. 46 & 47 Vict. c. 57.

The expression "trade mark" means a trade mark registered in the register of trade marks kept under the Patents, Designs, and Trade Marks Act, 1883,[1] and includes any trade mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of the one hundred and third section of the Patents, Designs, and Trade Marks Act, 1883, are, under Order in Council, for the time being applicable :[2]

The expression "trade description" means any description, statement, or other indication, direct or indirect,

(a) as to the number, quantity, measure, gauge, or weight, of any goods, or

(b) as to the place or country in which any goods were made or produced, or

(c) as to the mode of manufacturing or producing any goods, or

(d) as to the material of which any goods are composed, or

(e) as to any goods being the subject of an existing patent, privilege, or copyright,

and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act :

The expression "false trade description" means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement or otherwise, where that alteration makes the description false in a material respect, and the fact that a trade description is a trade mark, or part of a trade mark, shall not prevent such trade description being a false trade description within the meaning of this Act :

The expression "goods" means anything which is the subject of trade, manufacture, or merchandise :

The expressions "person," "manufacturer, dealer, or trader," and "proprietor" include any body of persons corporate or unincorporate :

The expression "name" includes any abbreviation of a name.

(2.) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods of any such figures, words, or marks, or arrangement or combination thereof, whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.

(3.) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in like manner as if such name or initials

[1] The reference must now be taken to be to the Trade Marks Act, 1905 ; see sec. 38 of the Interpretation Act, 1889, above, p. 654.

[2] See above, pp. 576 *et seq.*, and p. 741.

were a trade description, and for the purpose of this enactment the expression false name or initials means as applied to any goods, any name or initials of a person which—

(a) are not a trade mark, or part of a trade mark, and

(b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of such name or initials, and

(c) are either those of a fictitious person or of some person not *bond fide* carrying on business in connection with such goods.

Forging trade mark.

4. A person shall be deemed to forge a trade mark who either—

(a) without the assent of the proprietor of the trade mark makes that trade mark or a mark so nearly resembling that trade mark as to be calculated to deceive; or

(b) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise;

and any trade mark or mark so made or falsified is in this Act referred to as a forged trade mark.

Provided that in any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.

Applying marks and descriptions.

5. (1.) A person shall be deemed to apply a trade mark or mark or trade description to goods who—

(a) applies it to the goods themselves; or

(b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture; or

(c) places, encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade mark or trade description has been applied; or

(d) uses a trade mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark or mark or trade description.

(2.) The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression "label" includes any band or ticket.

A trade mark, or mark, or trade description, shall be deemed to be applied, whether it is woven, impressed, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label, reel, or other thing.

(3.) A person shall be deemed to falsely apply to goods a trade mark, or mark, who without the assent of the proprietor of a trade mark applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive, but in any prosecution for falsely applying a trade mark or mark to goods the burden of proving the assent of the proprietor shall lie on the defendant.

Exemption of certain persons employed in ordinary

6. Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade mark, or with falsely applying to goods any trade

mark or any mark so nearly resembling a trade mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves— course of business.

(a) That in the ordinary course of his business he is employed on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

(b) That he took reasonable precautions against committing the offence charged; and

(c) That he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(d) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence.

Application of Act to watches.

7. Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *prima facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for sale, or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly, and for the purposes of this section the expression "watch" means all that portion of a watch which is not the watch case.

Mark on watch case.

8. (1.) Every person who after the date fixed by Order in Council sends or brings a watch case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom), and in such a mode as may be from time to time directed by Order in Council.

(2.) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorised to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

(3.) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence.

Trade mark, how described in pleading.

9. In any indictment, pleading, proceeding, or document, in which any trade mark or forged trade mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade mark or forged trade mark to be a trade mark or forged trade mark.

Rules as to evidence.

10. In any prosecution for an offence against this Act,—

(1.) A defendant, and his wife or her husband, as the case may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness.

(2.) In the case of imported goods, evidence of the port of shipment shall be *primâ facie* evidence of the place or country in which the goods were made or produced.

Punishment of accessories.

11. Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any county or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed.

Search warrant.

12. (1.) Where, upon information of an offence against this Act, a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture under this Act.

(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

(3.) Any goods or things forfeited under this section, or under any

other provision of this Act, may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct, and the Court may, out of any proceeds which may be realised by the disposition of such goods (all trade marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

Extension of 22 & 23 Vict. c. 17, to offences under this Act.

13. The Act of the session of the twenty-second and twenty-third years of the reign of her present Majesty, chapter seventeen, intituled, "An Act to prevent vexatious indictments for certain misdemeanours," shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland.

Costs of defence or prosecution.

14. On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively.

Limitation of prosecution.

15. No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens.

Prohibition on importation.

16. Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act; be it therefore enacted as follows:

(1.) All such goods, and also all goods of foreign manufacture, bearing any name or trade mark being or purporting to be the name or trade mark of any manufacturer, dealer, or trader in the United Kingdom, unless such name or trade mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were specified in section forty-two of the Customs Consolidation Act, 1876. 39 & 40 Vict. c. 36.

(2.) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

(3.) The Commissioners of Customs may from time to time make, revoke and vary, regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.

(4.) Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the

country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom.

(5.) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

(6.) The Commissioners of Customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion, or otherwise, shall act under the control of the Commissioners of her Majesty's Treasury.

(7.) The regulations may provide for the informant reimbursing the Commissioners of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

(8.) All regulations under this section shall be published in the "London Gazette" and in the "Board of Trade Journal."

(9.) This section shall have effect as if it were part of the Customs Consolidation Act, 1876, and shall accordingly apply to the Isle of Man as if it were part of the United Kingdom.

46 & 47 Vict. c. 55.

(10.) Section two of the Revenue Act, 1883, shall be repealed as from a day fixed by regulations under this section, not being later than the first day of January one thousand eight hundred and eighty-eight, without prejudice to anything done or suffered thereunder.

Implied warranty on sale of marked goods.

17. On the sale or in the contract for the sale of any goods to which a trade mark, or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade mark and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee.

Provisions of Act as to false description not to apply in certain cases.

18. Where, at the passing of this Act, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

Savings.

19. (1.) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

(2.) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act.

(3.) Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bond fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

False representation as to royal warrant.

20. Any person who falsely represents that any goods are made by a person holding a royal warrant, or for the service of her Majesty, or any of the Royal Family, or any government department, shall be liable, on summary conviction, to a penalty not exceeding twenty pounds.

Application of Act to Scotland.

21. In the application of this Act to Scotland the following modifications shall be made :—

The expression "Summary Jurisdiction Acts" means the Summary Procedure Act, 1864, and any Acts amending the same.

The expression "justice" means sheriff.

The expression "Court of Summary Jurisdiction" means the Sheriff Court, and all jurisdiction necessary for the purpose of this Act is hereby conferred on sheriffs.

Application Act to Ireland.

22. In the application of this Act to Ireland, the following modifications shall be made :—

The expression "Summary Jurisdiction Acts" means, so far as respects the police district of Dublin metropolis, the Acts regulating the powers and duties of justices of the peace of such district, and as regards the rest of Ireland means the Petty Sessions (Ireland) Act, 1851, and any Act amending the same. 14 & 15 Vict. c. 93.

The expression "Court of Summary Jurisdiction" means justices acting under those Acts.

Repeal of 25 & 26 Vict. c. 88.

23. The Merchandise Marks Act, 1862, is hereby repealed, and any unrepealed enactment referring to any enactment so repealed shall be construed to apply to the corresponding provision of this Act; provided that this repeal shall not affect—

(a) any penalty, forfeiture, or punishment incurred in respect of any offence committed against any enactment hereby repealed; nor

(b) the institution or continuance of any proceeding or other remedy under any enactment so repealed for the recovery of any penalty incurred, or for the punishment of any offence committed, before the commencement of this Act; nor

(c) any right, privilege, liability, or obligation acquired, accrued, or incurred under any enactment hereby repealed.

APPENDIX XX.

MERCHANDISE MARKS ACT, 1891.

(54 Vict. c. 15.)

An Act to amend the Merchandise Marks Act, 1887.

[11th May, 1891.]

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

Customs entry to be trade description.

1. The customs entry relating to imported goods shall, for the purposes of the Merchandise Marks Act, 1887, be deemed to be a trade description applied to the goods.

50 & 51 Vict. c. 28.

Official prosecutions.

2. (1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the Merchandise Marks Act, 1887, shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament.

(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of Her Majesty's Stationery Office.

(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations.

Short title.

3. This Act may be cited as the Merchandise Marks Act, 1891, and the Merchandise Marks Act, 1887, and this Act may be cited together as the Merchandise Marks Act, 1887 and 1891.

APPENDIX XXI.

MERCHANDISE MARKS (PROSECUTION) ACT, 1894.

An Act for enabling the Board of Agriculture to undertake Prosecutions in certain cases under the Merchandise Marks Act, 1887.

[20th July, 1894.]

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

Power of Board of Agriculture to prosecute in certain cases. 54 & 55 Vict. c. 28.

1. The powers exerciseable by the Board of Trade under the Merchandise Marks Act, 1891, with respect to the prosecution of offences under the Merchandise Marks Act, 1887, may in cases which appear to the Board of Agriculture to relate to agricultural or horticultural produce be exercised by that Board, and in such cases the former Act shall apply as if the Board of Agriculture were referred to therein instead of the Board of Trade.

Extent of Act.

2. This Act shall not extend to Ireland.

Short title.

3. This Act may be cited as the Merchandise Marks (Prosecutions) Act, 1894, and shall be read with the Merchandise Marks Acts, 1887 and 1891.

APPENDIX XXII.

STATUTES REQUIRING PARTICULAR CLASSES OF GOODS TO BE MARKED IN A SPECIFIED MANNER[1] IN ENGLAND.[2]

ANCHORS AND CHAIN CABLES.]—Manufacturer to place his name or initials and the number and weight of the anchor on every anchor (57 & 58 Vict. c. 60, s. 543); contract for sale of chain cable or anchor exceeding in weight 168 lbs. to imply a warranty of testing and stamping (62 & 63 Vict. c. 23, s. 2 (1)); no chain cable or anchor of greater weight than 168 lbs. to be sold unless tested and stamped according to the Anchor and Chain Cables Act, 1899 (62 & 63 Vict. c. 23, s. 1 (1)).

BREAD.]—Penalty for making or exposing for sale any bread made wholly or partially of peas, beans, potatoes (not including potato-yeast), or any sort of corn or grain other than wheat, unless it be marked with a Roman M. The Act applies only beyond ten miles from the Royal Exchange, London. 6 & 7 Will. 4, c. 37, s. 10. But the same provision is made for the excepted area by 3 Geo. 4, c. cvi.

BUTTER.]—Imitations of butter to be sold only as "margarine." *See* "Margarine."

BUTTONS (metal).]—Penalties for marking, ordering, or exposing for sale any words or marks denoting quality on metal buttons, or any words or marks on the undersides thereof, unless the buttons be silver-plated or gold-gilt; only the marks, gilt, plated, double or treble gilt to be marked; penalties for falsely marking buttons; Act not to extend to buttons of gold, silver, tin, pewter, lead, tin and lead, tinned iron, Bath metal, white metal, any of these metals inlaid with steel, or buttons plated on shells. 36 Geo. 3, c. 60.

CARDS.]—Playing cards (except toy cards) to be sold in stamped wrappers. 25 & 26 Vict. c. 22, ss. 1, 2, 28, 36; 27 & 28 Vict. c. 56, s. 6. So as to foreign cards. 16 & 17 Vict. c. 107, ss. 114—116; 39 & 40 Vict. c. 36, s. 286.

CHAIN CABLES.]—*See* "Anchors."

CHICORY AND COFFEE.—Imitations of coffee and coffee mixtures not to

[1] A more detailed summary of all or most of these statutes will be found in Mr. Safford's "Law of Merchandise Marks," Appendix D., and in Mr. Sebastian's "Trade Marks." I am indebted to the former book for the suggestion of many of the classes of goods referred to, and to the Official Index to Statutes for reference to the statutes mentioned under the different heads. Statutes (as the Copyright Acts, for example) which require marks to be put upon particular goods in order to secure some right or privilege (as copyright in designs, for instance) are not here included. They would naturally be sought for in works devoted to the law regarding the rights or privileges in question.

[2] The Scotch and Irish statutes are given by Mr. Safford.

be sold, except in packets containing one or more quarters of a pound, each packet bearing a label showing the amount of duty, and a label showing the constituents of the mixture. 45 & 46 Vict. c. 41, s. 6.

CLOCKS.]—Bearing marks implying manufacture in the United Kingdom not to be imported. 39 & 40 Vict. c. 36, s. 42.

CUTLERY.]—*See* above, p. 587, and Sheffield marks, p. 112.

GOLD.]—*See* "Plate."

GUNPOWDER.]—If sold in quantities greater than 1lb., to be packed in closed packages and labelled "Gunpowder." 38 & 39 Vict. c. 17, s. 32.

HOPS.]—Bags to be marked with the name of the owner, the parish and county where they were grown, and the date, number, and weight; penalty for false marking. 54 Geo. 3, c. 123, s. 1; 29 & 30 Vict. c. 37, s. 2. *Implied warranty that the marks are genuine.* 29 & 30 Vict. c. 37, s. 18.

LINEN.]—Penalties for affixing counterfeit marks to linen. 17 Geo. 2, c. 30; 18 Geo. 2, c. 24. English linen for exportation to be marked with name and place of abode of the maker and of the exporter, the year and number and length. 18 Geo. 2, c. 24, s. 2.

MARGARINE.]—All imitations of butter to be sold, and marked, when exposed for sale, as "margarine." 50 & 51 Vict. c. 29, ss. 3—7. Penalties for dealing in, selling, or exposing for sale any margarine contrary to the Act. *Ibid.* s. 7. Considerable amendments affecting butter, milk-blended butter, and margarine are made by the Butter and Margarine Act, 1907 (7 Edw. 7, c. 21). *See* also the Sale of Food and Drugs Act, 1899 (62 & 63 Vict. c. 51).

MEDALS (Exhibition).]—Penalties for false representations as to grants of medals or certificates of the Exhibitions of 1851 or 1862. 26 & 27 Vict. c. 119.

PLATE.[1]]—The rules regulating the marking and standards of fineness required and allowed in respect of gold and silver goods are contained in the statutes referred to below.[2] They require to be marked on the goods the first letters of the christian and surnames of the worker (12 Geo. 2, c. 26, s. 5), and the *assay mark* of the town where the goods were made, or (if they were not made in an assay town) marked (2 Hen. 6, c. 17, London; 12 & 13 Will. 3, c. 4, York,[3] Exeter, Bristol,[4] Chester, and Norwich;[3] 1 Anne, c. 3, Newcastle-on-Tyne; 13 Geo. 3, c. 52, Sheffield; 5 Geo. 4, c. lii. s. 1, *local*, Birmingham), the variable or date mark to show the year of marking (12 & 13 Will. 3, c. 4, s. 3; 12 Geo. 2, c. 26, s. 5). And, in addition, on gold wares of twenty-two or eighteen carats fineness, the *standard* and *quality* marks of a crown and 22 (7 & 8 Vict. c. 22, s. 15), or a crown and 18 (38 Geo. 3, c. 69, s. 2) respectively; and on silver wares of 11 ozs. 10 dwts. and 11 ozs. 2 dwts. fineness, the standard marks of Britannia and a lion *passant* respectively (6 Geo. 1, c. 11, s. 41; 12 Geo. 2, c. 26), and a *duty* mark[5] of the king's head. (24 Geo. 3, sess. 2, c. 53, s. 5.)

Before 1854, gold wares were required to be of either twenty-two or eighteen carats fineness (38 Geo. 3, c. 69); but her Majesty was

[1] See "Encyclopædia Britannica," "Plate."

[2] These statutes are summarised by Mr. Sebastian, 4th ed., p. 614, and Mr. Safford, p. 204.

[3] The marks for these towns are now discontinued.

[4] Bristol never exercised its right to mark: Sebastian, 4th ed., p. 614.

[5] The duty on plate is now abolished: 53 Vict. c. 8, s. 10.

authorised, under an Act of that year (17 & 18 Vict. c. 96), by Order in Council, to allow any standard for gold plate not being less than one-third part of the whole in fine gold, and to approve any instrument for stamping or marking the wares, setting forth in figures the actual fineness thereof according to the standard declared. The new inferior standard gold wares were declared not to be liable to duty. Under this Act, the nine, twelve, and fifteen carat gold standards have been authorised.

Silver wares must all be of either the 11 ozs. 10 dwts. or 11 ozs. 2 dwts. of silver to the pound troy standard. (6 Geo. 1, c. 11.)

The following wares are exempted from marking :—chains, necklace beads, lockets, filigree work, shirt buckles or brooches, stamped medals, or spouts to china, stone, or earthenware teapots, or any of them, of any weight; tippings, swages, or mounts, or any of them, not exceeding 10 dwts. of silver each, except only necks and collars for castors, cruets, or glasses, appertaining to any sort of stands or frames; silver goods not weighing 5 dwts., except necks, collars, and tops for castors, cruets, or glasses appertaining to any sort of stands or frames, buttons to be affixed or set on any wearing apparel, solid sleeve buttons, and solid studs, not having a bissiled edge soldered on, wrought seals, blank seals, bottle tickets, shoe clasps, patch boxes, salt spoons, salt shovels, salt ladles, tea-spoons, tea-strainers, caddy ladles, buckles (shirt buckles or brooches before mentioned excepted), and pieces to garnish cabinets, or knife cases, or tea-chests, or bridles, or stands, or frames. (30 Geo. 3, c. 31.) Gold wedding rings are to be marked as gold plate. (18 & 19 Vict. c. 60, s. 1.)

Imported foreign plate, except ornamental plate, made before 1800 (5 & 6 Vict. c. 56, s. 6), is to be marked as English plate (5 & 6 Vict. c. 47, s. 59), and under sec. 2 of 39 & 40 Vict. c. 35 had to be marked with the figure F. on an oval shield. That section is now repealed by the Hall-marking of Foreign Plate Act, 1904 (4 Edw. 7, c. 6) and by the last-mentioned Act foreign plate is to be marked in such manner as determined by Order in Council so as readily to distinguish whether the plate was wrought or made in England, Scotland, or Ireland, or was imported from foreign parts.

Penalties for counterfeiting assay marks and connected offences are provided by 7 & 8 Vict. c. 22.

The importation of clocks and watches, or any other article of metal impressed with any mark or stamp, representing or in imitation of any legal British assay mark or stamp, or purporting by any mark or appearance to be of the manufacture of the United Kingdom, is forbidden (39 & 40 Vict. c. 36, s. 42).

Watch cases of foreign manufacture brought for assay to any assay office in the United Kingdom are to be marked as directed by an Order in Council of November 28th, 1887, made under the Merchandise Marks Act, 1887, s. 8, that is to say, with the word "foreign," and a shield which is cross-shaped for gold and octagon-shaped for silver.

Gold and silver watch-cases, forming parts of finished watches imported into the United Kingdom from abroad are gold and silver plate within the meaning of the Customs Act, 1842: *Goldsmiths' Company* v. *Wyatt*, [1907] 1 K. B. 95. In 1907 an Act (7 Edw. 7, c. 8) was passed exempting existing stocks of such goods.

PLATED GOODS.]—Makers of plated goods in Sheffield, or within 100 miles thereof, are authorised to strike on their goods their surnames, or the names of their firm, with a mark (not being an imitation of an assay-mark) which is approved by the guardians of the assay office and registered (24 Geo. 3, sess. 2, c. 20, ss. 2 and 3).

SILVER.]—*See* "Plate."

STORES (PUBLIC).]—The marks enumerated below to denote that stores to which they are affixed are his Majesty's property; the marks not to be applied by unauthorised persons[1]; obliterating the marks with intent to conceal his Majesty's property in the stores is a felony; regimental necessaries, &c., issued to soldiers, militiamen, or volunteers are excepted from the Act (38 & 39 Vict. c. 25; 44 & 45 Vict. c. 58, s. 156).

Stores.	Marks.
Hempen cordage and wire rope ...	White, black, or coloured worsted threads laid up with the yarns and wire respectively.
Canvas, fearnought, hammocks, and seamen's bags.	A blue line in a serpentine form.
Bunting	A double tape in the warp.
Candles	Blue or red cotton threads in each wick, or wicks of red cotton.
Timber or metal. Any stores not before enumerated, whether similar to the above or not.	The name of her Majesty (Queen Victoria), her predecessors, her heirs or successors, or of any public department or any branch thereof, or the broad arrow, or a crown, or her Majesty's arms, whether such broad arrow, crown, or arms be alone or be in combination with any such name as aforesaid, or with any letters denoting any such name.

TOBACCO.]—Cavendish and negro-head tobacco to be delivered for home consumption in separate packets not exceeding 1 lb. or less than 1 oz. in weight, and wrapped in a wrapper and label approved by the Commissioners of Customs; not to be sold, or had in possession, except wrapped and labelled as aforesaid; penalties for forging labels (26 & 27 Vict. c. 7, ss. 3—8).

WEIGHTS AND MEASURES.]—To be marked with proper indicating marks: see the Weights and Measures Acts, 1878 to 1904, 41 & 42 Vict. c. 49; 52 & 53 Vict. c. 21; 4 Edw. 7, c. 28.

YARN.]—Penalty for reeling short lengths of yarn, 17 Geo. 3, c. 11 (ss. 17—19, 24, in part repealed by the S. L. Rev. Act, 1861; ss. 12, 22, repealed in part; ss. 20, 23, repealed by 47 & 48 Vict. c. 43, s. 4; and s. 24 by 56 & 57 Vict. c. 61, s. 2).

[1] See 28 & 29 Vict. c. 89, s. 45 (Greenwich Hospital Mark) and 38 & 39 Vict. c. 25, s. 17.

APPENDIX XXIII.

THE following are a few of the very numerous words which have been allowed by the Board of Trade under sec. 9 (5) of the Act.[1] The references are to the number and pages of the *Trade Marks Journal*:—

"Grosvenor." Paper. Grosvenor, Chater & Co., Ltd. 1504, p. 145.
"Fruit Salt." Medical Preparation. J. C. Eno, Ltd. 1515, p. 624.
"Paisley Flour." Raising Powder for cooking purposes. Brown and Polson. 1519, p. 807.
"Valentine." Meat Juice. Valentine Meat Juice Co. 1523, p. 950.
"Iron Ox." Medical Preparation. Iron Ox Remedy Co. 1525, p. 1046.
"Hudson's Soap." R. W. Hudson. 1528, p. 1202.
"Napier." Motor Vehicles. D. Napier & Son, Ltd. 1529, p. 1237.
"Benefit Brand." Boots. Public Benefit Boot Co., Ltd. 1533, p. 1412.
"Wood Milne." India Rubber Heels. T. H. Roberts. 1547, p. 2058.
"Neave" and "Neave's Food." A Foodstuff Preparation. J. R. Neave. 1547, p. 2058.
"Ilford." Photographic Apparatus. Ilford, Ltd. 1548, p. 2083.
"Colman's Mustard." J. & J. Colman, Ltd. 1551, p. 2218.
"Peugeot." Motor Cars. Société Peugeot. 1556, p. 103.
"Pears' Soap." Common Soap. A. & F. Pears, Ltd. 1556, p. 119.
"Rolls Royce." Motor Cars. Rolls Royce, Ltd. 1561, p. 300.
"Leyland." Rubber Goods. Leyland & Birmingham Rubber Co., Ltd. 1562, p. 349.
"Smith." Typewriters. Smith's Premier Typewriter Co. 1570, p. 684.
"Eadie." Cycle and Car parts. Eadie Manufacturing Co., Ltd. 1571 p. 717.
"Mellin" and "Mellin's Food." Foods. Mellin's Food, Ltd. 1575, p. 913.

[1] See above, pp. 82 and 172.

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THE END.

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