THE LAW

OF

TRADE-MARKS AND TRADE-NAMES.

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A TREATISE

ON THE

LAW OF TRADE-MARKS

AND TRADE-NAMES,

INCLUDING

FOREIGN LAWS APPLICABLE TO BRITISH TRADE-MARKS.

BY

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WITH A SUPPLEMENT

CONTAINING THE

TRADE MARKS REGISTRATION ACTS 1875 & 1876.

TOGETHER WITH

THE RULES OF SEPTEMBER, 1876, AND FEBRUARY, 1877.
WITH AN INTRODUCTION AND NOTES.

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PREFACE.

The principal object of this work is to afford a practical treatise on a branch of law of continually increasing importance, and every effort has been made to adapt it for the use of the practitioner engaged in actual business. It will, the authors believe, be none the less serviceable to him, because it aims at taking a scientific view of the whole subject; and they hope that most of it will be understood by the beginner without difficulty, although there are parts relating to details of practice which are intended rather for the information of the practitioner than for the instruction of the student.

The English law of trade-marks is the parent of the law of Scotland and the United States. References have been made to American cases which furnish useful deductions or good illustrations. The purely Scotch cases are so very few that it has been thought well to note them in Chapter VIII. for the convenience of the Scotch practitioner.

The same Chapter contains an account of the various laws under which protection may be obtained abroad for trade-marks belonging to persons who carry on business in the United Kingdom. The actual text of these laws will generally be found in the Appendix. In this part of the work much assistance has been derived from the Reports on the foreign law of trade-marks issued from the Foreign Office. (Parl. Pap. 1872, C. 596 and 633.)

The Notes contain all the important cases published before March 1873.

LINCOLN'S INN,
Feb. 1873.

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A TREATISE

ON THE

LAW OF TRADE-MARKS AND TRADE-NAMES.

CHAPTER I.

DEFINITION AND NATURE OF A TRADE-MARK.

EXACTLY to mark out by concise definition the space to be occupied by a treatise on a single branch of law is at all times difficult, and sometimes impossible. The entire field of law is, in fact, continuous, and any boundaries which are traced must therefore be to some extent arbitrary. This is especially true where, as in the case of Trade-Marks, the law has been gradually developed by a course of judicial decisions, giving authoritative sanction to practices current in the mercantile world.

A trade-mark may be said roughly to be any name or device adopted by a person to designate goods to be of his manufacture or to be his goods; but this is only a rough definition, as the name of a magazine (*a*), or the name and colour of an omnibus (*b*), are species of trade-marks.

In order to obtain a clear view of the law relating to trade-marks, it is necessary, first, to consider the pur-

(*a*) *Hogg* v. *Kirby*, 8 Ves. 215; *Maxwell* v. *Hogg*, L. R. 2 C. A. 307.
(*b*) *Knott* v. *Morgan*, 2 Keen, 213.

Chap. I.

poses for which they are in fact employed in the mercantile world, and then to determine the place which the law regulating the right to use them occupies in the general system of jurisprudence.

Function of trade-marks.

Trade-marks were probably in the first instance adopted as marks of origin; that is, in order to inform the public that the goods so marked were the work of a particular maker. But this is not the only function which they now discharge; and at present a trade-mark may signify no more than this, that the article to which it is affixed has passed into the market through the hands of the person entitled to use the mark, and finally may come to be regarded by the public as a mere guarantee of quality. Buyers may have found by experience that iron branded with a particular mark was specially free from brittleness, and the mark may have come to suggest this and no other conclusion. The quality may be derived from the process of manufacture, but the permanent value of the trade-mark will altogether depend upon the truthfulness with which it answers to its reputation. In such a case there is a strong motive inducing the owner of the mark to maintain its character, and if the goods marked with it be of known credit, and have an extensive sale, there will arise in the minds of buyers a well-grounded presumption that the owner, whoever he is, will take care to keep up its reputation. Neither the maker, who first used the mark as an indication of origin, nor the present owner, who now uses it merely as an indication of quality, is legally bound to satisfy the expectations to which it gives rise, but both are impelled to do so by the same motive. A successful trade-mark, it is obvious, always tends to become a mere mark of quality. It is clear, also, that in this there is no fraud upon the public,

who buy, not out of personal favour to the original maker, but because they believe that the goods will be of the quality and description which they require. Chap. I.

Thus much being premised, we must endeavour to assign to the law on the subject its proper place in the legal system, and this will be found to have an important practical bearing. How the right to use a trade-mark is acquired will hereafter be considered in detail; at present it is sufficient to say that, by certain means, a person may obtain the right to sell his goods under a given mark, and to prevent any one else from applying that mark to goods of the same description. But his right does not consist in the power of precluding others from *every* use of the mark. Thus, if a trader stamps his cloth with a lion, or with a figure of his own invention, he acquires no right to prevent another trader from stamping iron with this device; but the community at large are required to forbear from marking cloth resembling his with this device, or with any device likely to be confounded with it. So that the right consists not in the symbol itself, but in the application of the symbol to a particular description of goods. And it is a right, availing, not as a right founded on contract against this or that man, but against the world at large. In other words, the right to the use of a trade-mark is in the language of scientific jurisprudence, a *jus in rem* (*c*). If this form of expression be thoroughly understood, it will give increased facility in considering questions which have been much discussed in the Courts.

Nature of the right to a trade-mark.

Right is a *jus in rem*.

(*c*) See Austin on Jurisprudence (1863), vol. ii. pp. 33 *et seq.*; vol. iii. pp. 157 *et seq.* Lord Cranworth's language, in *Farina* v. *Silverlock*, 6 De G. M. & G. 217, describes the right in perfect accordance with the analysis in the text. "It is in fact a right which can

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The characteristic of a *jus in rem* is that it corresponds to duties incumbent upon all men. The most familiar instance is afforded by the rights which are attached to the ownership of visible objects, such as land, houses, or ships; and such a collection of rights as the ownership of some material thing implies, is that which is most naturally suggested by the term "property." But instances are not wanting of rights *in rem* apart from any material subject. The right of a patentee consists only in the power of compelling every one else to abstain from making or selling the patented article. The right of the owner of a ferry consists only in the duty incumbent upon everyone else of doing nothing directly tending to draw away custom from the ferry. The right of personal security belongs to the same class of rights *in rem*. It is obvious that the right to a trade-mark agrees with such rights, in that it consists only in the right of compelling every one else to abstain from infringing it. It is therefore a *jus in rem* having no material subject.

The two classes of rights, rights availing against men in general and rights availing against determinate persons, exist in every system of law, but English law furnishes no terms universally accepted to denote this distinction. The phrases, rights founded on property and rights founded on contract, correspond most nearly with it; and the proposition that a trade-mark is property, if carefully examined, will probably be found to assert *vi termini* nothing

In what sense a trade-mark is property.

be said to exist only, and can be tested only, by its violation; it is the right which any person designating his wares or commodities by a particular trade-mark, as it is called, has to prevent others from selling wares which are not his marked with that trade-mark in order to mislead the public, and so incidentally to injure the person who is the owner of the trade-mark."

more than this, that the right to a trade-mark is a *jus in rem*, and with this qualification may safely be adopted. The rights attached to one *jus in rem* are not necessarily co-extensive with those attached to another, although both must be included under the English term property.

If indeed the conception of property be analysed in the case of a material thing such as a house or ship, it will be found to involve two distinct conceptions. A full owner has an indefinite power over the thing, a power of using or even destroying it, and he has also an indefinite power of excluding the world at large from the use of it. With certain limitations, which it is not here necessary to notice, a man may do what he pleases with his own, and may exclude everyone else from meddling with it in any way. Now, as it is in respect of the former power that a man is called *dominus*, so it is in respect of the latter that the thing is *proprium*. Etymologically, therefore, the word "property" seems peculiarly applicable to the right of a trade-mark owner. But it must not be imagined that by using this expression it is intended covertly to assume anything as to the general transferableness of a trade-mark or as to the remedy of a person whose right is infringed. Both these points will have to be considered hereafter.

Remedy for infringement of trade-mark not founded on fraud.

The view that the right of action against the infringer of a trade-mark rests upon property is opposed to the idea, which seems to have prevailed in the courts of common law, that it is founded upon the fraud of the infringer. But attention to the precise import of the terms will, it is submitted, show that the latter is an inaccurate mode of expression. Let it be for the present assumed that the action will lie only against a defendant

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who has knowingly affixed to his goods the plaintiff's trade-mark with the view of attracting to himself custom due to the reputation of the trade-mark or of injuring the plaintiff by depreciating its credit. Still it is not upon the plaintiff but upon some third person that fraud is practised, and this distinguishes the action from one founded on fraud (*d*). A comparison of a trade-mark with another *jus in rem* to which it bears a considerable analogy, the right of the owner of a ferry, will show the importance of this distinction. Each of these rights consists in nothing else than the duty incumbent upon the world at large of doing nothing directly tending to draw away customers. By the nature of things this can be done in the case of a trade-mark only through imposition upon the public, but the right of the owner of a ferry may be invaded by fraud or by violence. If a third person assaulted a customer going to the ferry, and so prevented him from making use of it, both the customer and the owner of the ferry would have a right of action against the wrong-doer. But these two rights of action would be perfectly distinct. The customer would sue for the assault, the owner of the ferry for damage to his right of ferry consequent upon the assault. Again, if customers were diverted from the ferry by a person spreading a false report that it was broken down, the owner of the ferry would have a right of action against the deceiver, not because he is deceived, but because he suffers damage consequent upon his customers being deceived. In exactly the same way it is not true to say, that the owner of a

(*d*) See *Behn* v. *Kemble*, 7 C. B. N. S. 260 ; *Gerhard* v. *Bates*, 2 E. & B. 476 ; *Bedford* v. *Bagshaw*, 4 H. & N. 548; *Burnes* v. *Pennell*, 2 H. of Lds. 497.

trade-mark is deceived or defrauded by the acts of an infringer, but he is injured by third persons being deceived or defrauded. So also the right as against third persons of a master in his servant may be disturbed by fraud upon the servant or by imprisoning him. But the master is no more defrauded in the one case than he is imprisoned in the other. On the whole, therefore, it is conceived that *jus in rem* or property is the only true basis for the action at law against the infringer, and this view will, it is believed, be confirmed by an attentive examination of the cases decided at law.

The language used in courts of equity was at first the same as that of the common law judges, but lately a different view has begun to prevail, and several equity judges following Lord Westbury have asserted that jurisdiction in cases of trade-marks depends not upon fraud but upon property.

Jurisdiction in cases of trade-mark founded on property.

Taking the word property with the qualification which we have already explained, it is submitted that this is the true view, and ought ultimately to prevail in courts of law as well as in courts of equity.

There is also another way of regarding a trade-mark which leads to the same result. A trade-mark evidently depends for its value upon the trade-reputation of its owner (*e*), or, to express the same idea in different words, it is a visible means of collecting the whole or some portion of the goodwill attaching to the trade-mark-owner. For this reason a trade-mark is not in practice sold, and probably cannot legally be sold, apart from the goodwill of the owner's business (*f*). And as it is settled

(*e*) See *Clark* v. *Clark*, 25 Barbour, S. C. 79 (Am.).
(*f*) See *Hall* v. *Barrows*, 33 L. J. Ch. 207.

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that goodwill is rightly termed "property" (*g*), it seems impossible to deny the appropriateness of the term when applied to a trade-mark.

(*g*) *Potter* v. *The Commissioners of Inland Revenue*, 11 Exch. 147. Trade-reputation and goodwill are clearly subjects of *jus in rem*, which will in some cases be protected by injunction. See *infra*.

CHAPTER II.

COMMON LAW REMEDY FOR INFRINGEMENT OF TRADE-MARKS.

Examination of cases at common law.

THE ground on which the remedy for the infringement of a trade-mark was for a long time supposed to rest was, that the infringement is a fraud on the part of the infringer, in trying to pass off his manufacture as the manufacture of the owner of the trade-mark, and on this principle it came under the general jurisdiction which the courts exercise to protect innocent persons against fraud and misrepresentation.

Under that general jurisdiction an action lies against a person who falsely represents that another is to be trusted with goods (*a*), or that a company is prosperous so as to induce another to take shares in it (*b*).

And the Court of Chancery will restrain a person by injunction from publishing poems or a magazine which are represented to be those of another, or from representing himself to belong to a firm to which he does not belong (*c*).

Consequently it is not always easy to distinguish

(*a*) *Pasley* v. *Freeman*, 3 T. R. 51, 2 Smith's L. C. 70 (6th edit.).

(*b*) *Gerhard* v. *Bates*, 2 E. & B. 476.

(*c*) *Lord Byron* v. *Johnston*, 2 Mer. 29; *Hogg* v. *Kirby*, 8 Ves. 215; *Glenny* v. *Smith*, 2 Dr. & Sm. 476. See also *Spottiswoode* v. *Clarke*, 2 Ph. 154; *Hoolham* v. *Pottage*, L. R. 8 Ch. 91.

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between the cases which relate strictly to trade-marks and those which relate to other cases of misrepresentation.

The first reported case of any real importance was decided by Lord Mansfield in 1783 (*d*). The plaintiff's father, and after his death the plaintiff, sold a medicine called "Dr. Johnson's yellow ointment," and the action was brought against the defendant for selling a medicine under the same name. Lord Mansfield said that if the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie. But here both the plaintiff and defendant used the name of the original inventor, and no evidence was given of the defendant having sold it as if prepared by the plaintiff. He accordingly held that the action would not lie.

The next case is *Sykes* v. *Sykes* (*e*), which was decided in 1824. The plaintiff in that case had acquired a reputation for powder-flasks and shot-belts, which he marked with the words "Sykes' patent," although the patent which was granted had been held invalid (*f*). The de-

(*d*) *Singleton* v. *Bolton*, 3 Douglas, 293. The first case usually cited is one in the time of Elizabeth, in which an action on the case for a deceit was held to lie against a clothier who put on his inferior cloths the trade-mark of a clothier who made superior cloths. The case is cited by Dodridge, J., in *Southerne* v. *Howe*, Pop. 143, 2 Rolle, 26, 2 Cro. 471. Popham's report states that the action was brought by the rival clothier, but Rolle remarks that Mr. Justice Dodridge did not say whether the action lay for the clothier or the vendee, but it seemed it lay for the vendee; and Croke's report states expressly the action was by him who bought the cloth. Whichever it was, the case, though frequently referred to, seems to have had no influence on subsequent decisions.

(*e*) 3 Barn. & Cres. 541, 5 Dowl. & Ry. 202.

(*f*) Probably this would now, in equity at all events, disentitle

fendant intending to appropriate the advantage of this reputation, marked his goods in the same way. At the trial it was proved that the dealers who bought the goods of the defendant knew by whom they were manufactured, but that the defendant sold them to the dealers for the purpose of being resold as goods of the plaintiff's manufacture. No evidence appears to have been given that any one was actually deceived, but a verdict in favour of the plaintiff was upheld by the Court in Banco.

In *Blofeld* v. *Payne* (1833) (*g*), the defendants had wrapped their hones in envelopes similar to the plaintiff's. The declaration did not allege fraud, and no evidence was adduced that any one was deceived. The jury found that the defendants' hones were not inferior to the plaintiff's, but under the direction of the judge they found a verdict for the plaintiff, with nominal damages. The ruling was upheld by the Court in Banco. "The act of the defendants," said Littledale, J., "was a fraud against the plaintiff; and if it occasioned him no specific damage, it was still, to a certain extent, an injury to his right."

In *Morison* v. *Salmon* (1841) (*h*), the plaintiffs sold a medicine which they called, "Morison's Universal Medicine," and the declaration alleged that the defendants "deceitfully and fraudulently" prepared and sold medicines under the same name, and in similar boxes and wrappers, "in order to denote that such medicine was

the plaintiff to relief. See *Flavel* v. *Harrison*, 10 Hare, 467; *Morgan* v. *McAdam*, 36 L. J. N. S. 228. But see *Ford* v. *Foster*, L. R. 7 C. A. 611.

(*g*) 4 Barn. & Ad. 410.

(*h*) 2 Man. & Gr. 385.

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the genuine medicine prepared and sold by the plaintiffs." A verdict was found for the plaintiffs, with nominal damages. The Court in Banco held that the declaration disclosed a good cause of action. The judge at nisi prius certified, under 3 & 4 Vict. c. 24, that the action was brought to try a right. The defendants contended the judge had no power to give the certificate. The Court decided that he had, and Maule, J., who had given the certificate, expressly said that the action *was* brought to try a right. "The right is of a well-known description: it is not a general right to carry on a particular trade, but a right to protection which a party has who uses certain marks, and to the use of which he may have as good a right as though he were a patentee."

In each of these four cases expressions occur indicating that some of the judges thought the action to be founded upon the defendant's fraud. But the view which we have endeavoured to explain that *jus in rem* is the true foundation, was not present to their minds, and in none of them was there any necessity for strict accuracy of expression. The decisions are quite reconcileable with Lord Westbury's statement, that "imposition on the public is the *test* of the property in the trade-mark having been invaded and injured" (*i*). In *Morison* v. *Salmon*, it was urged in argument, that the declaration contained no averment that any one was in fact deceived; but this objection was disregarded, and in several of the cases successful fraud upon any one does not appear to have been proved.

(*i*) *Leather Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, 33 L. J. N. S. Ch. 200.

The cases upon which the doctrine that fraud is the foundation of the action seems mainly to rest are *Crawshay* v. *Thompson* (*k*) and *Rodgers* v. *Nowill* (*l*).

Crawshay v. Thompson.

In the former, the declaration alleged that the defendants "knowingly and fraudulently" stamped their bars of iron with a stamp which they knew and intended to be in imitation of the plaintiff's, and "knowingly and fraudulently" sold the iron so marked as and for the plaintiff's iron. The case came on for trial before Lord Chief Justice Tindal. There was no evidence to show that any one had been actually deceived by the mark used by the defendants, and the Lord Chief Justice left it to the jury to say, first, whether they were satisfied that the defendants' mark bore such a close resemblance to the plaintiff's as in its own nature was calculated to deceive the unwary, or persons who were moderately skilled in the article, and to injure the sale of the plaintiff's goods; and, secondly, what was the intention of the defendants in using the mark complained of, because it seemed to him that unless there was a fraudulent intention existing (at least before notice), the defendants would not be liable. The jury having found for the defendants, there was a motion for a new trial, on the ground of misdirection; and the Court held that, having regard to the language of the declaration, the direction was right in both its branches. In other words, the Court held that an intention on the defendants' part to deceive buyers, added to a probability that buyers would be deceived, was a sufficient ground of action.

Rodgers v. Nowill.

In *Rodgers* v. *Nowill* (*m*), the declaration was similar

(*k*) 4 Man. & Gr. 357. (*l*) 5 C. B. 109.

(*m*) *Loc. cit.*

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to that in *Crawshay* v. *Thompson*, and the judge in summing up used language almost identical with C. J. Tindal's. The jury found for the plaintiff with nominal damages. A motion for a new trial and in arrest of judgment was unsuccessfully made, and the judgment in *Crawshay* v. *Thompson* was considered and approved. It should be noticed, that in the course of the argument the counsel for the defendants cited authorities relating to the action on the case for a deceit. Maude, J., thereupon asked, "Is this an action on the case for a deceit?" To which the answer was, "There is no other title under which such an action can be classed"—an answer which seems to have silenced the inquirer. This is an incident not without importance, since it shows that the action for infringing a trade-mark came to be classed amongst actions founded on fraud in consequence of the class of rights known as *jura in rem*, and the actions based upon them, not having any distinctive name in the English system (*n*).

These two cases of *Crawshay* v. *Thompson* and *Rodgers* v. *Nowill* bring out another point in which the action for the infringement of a trade-mark differs from an action truly based on fraud. In the former it is evident that an attempt to deceive may ground an action. In all other cases fraud gives no ground of action unless it is successful. One man has no right of action against another because the latter has tried to deceive him and has failed (*o*).

But although in the opinion of the authors the view that the action depends upon fraud is incorrect, still as it has long maintained its ground, and has never in

(*n*) With the cases cited, compare *Archbold* v. *Sweet*, 1 M. & R. 162.
(*o*) See *Attwood* v. *Small*, 6 Cl. & Fin. 448.

the common law courts been judicially abandoned, it is necessary for the practitioner to be acquainted with it.

Essentials in action at law.

"Fraud in law consists in knowingly asserting that which is false to the injury of another" (*p*).

According to the view which we are now considering, it becomes necessary, therefore, in an action for infringement of a trade-mark, to show :—

1. That the defendant asserted that which was false, as by selling his manufactures as and for the manufactures of the plaintiff.
2. That the defendant did this knowingly, that is, with the intention to pass them off as the plaintiff's manufactures.
3. That the plaintiff has been injured.

Taking these essentials for an action in their order,—

False representation.

(1.) It is obvious that putting a trade-mark on goods is only one mode of representing them to be the manufacture of the owner of the trade-mark, and this becomes important in considering what is a trade-mark. Moreover, the extent to which a trade-mark is known affects materially the question of representation.

Intention to deceive.

(2.) Every case of putting another's trade-mark on one's own goods is not actionable; it must be put on with the intention to deceive. Thus, if the defendant in an action has put on a trade-mark innocently, not knowing that it is the plaintiff's mark, and thinking that it is only descriptive of the quality of the goods, it seems that he would not be liable to pay damages (*q*). But even a remote intention is sufficient. For instance, if a defendant sells his own manufactures to a dealer who knows

(*p*) *Per* Cresswell, J., in *Rodgers* v. *Nowill*, 5 C. B. 109.

(*q*) *Crawshay* v. *Thompson*, 4 M. & G. 357; *Myers* v. *Baker*, 28 L. J. Ex. 90, 3 H. & N. 802; *Rodgers* v. *Nowill*, 5 C. B. 109.

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they are not the plaintiff's with the intention that the dealer should resell them to the public as the plaintiff's manufactures, this is a sufficiently fraudulent intention to maintain the action (*r*).

This intention to deceive is a question for the jury (*s*); but notice to a person who is using a trade-mark of the title of the real owner of the mark will not amount to proof of *mala fides*, unless it appears not only that the notice was true, but also that credence was given to it by the person to whom it was addressed (*t*).

Injury to plaintiff.

(3.) Injury to the plaintiff is essential to enable him to recover. This injury is twofold, (1,) to his reputation by reason of the defendant having sold inferior goods; and (2,) to his trade by drawing away his custom.

A possibility of injury is, however, sufficient, and it is not necessary to show special damage. For where (*u*) it was proved that the defendant's manufactures were not inferior to the plaintiff's, and no proof was given of the plaintiff having lost any custom, the plaintiff was held entitled to nominal damages, because, as Littledale, J., said, "the act of the defendant's was a fraud against the plaintiff, and if it occasioned him no specific damage it was still to a certain extent an injury to his right," and he might have been prevented from selling as much of his own manufactures. Of course on the theory that the action rests on *jus in rem*, this is readily intelligible and

(*r*) *Sykes* v. *Sykes*, 3 B. & C. 541.

(*s*) *Crawshay* v. *Thompson*, 4 M. & G. 357.

(*t*) *Rodgers* v. *Nowill*, 5 C. B. 109. See *Leather Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, 1 H. & M. 271; *McAndrew* v. *Bassett*, 33 L. J. Ch. 564, 4 De G. J. & S. 380.

(*u*) *Blofield* v. *Payne*, 4 B. & Ad. 410, 1 Nev. & Man. 303. See also *Rodgers* v. *Nowill*, 5 C. B. 109; *Dent* v. *Turpin*, 30 L. J. Ch. 495, 2 J. & H. 139.

in analogy with actions for infringing a patent or copyright.

Where, however, there is no possibility of any injury to the plaintiff, as if he has never put out his trade-mark to the world or has not carried on business, he cannot recover (*x*).

Measure of Damages.

On the question of the measure of damage in an action for the infringement of a trade-mark there is scarcely any authority. The plaintiff must make out by evidence any special damage which he has sustained, and his remedy in general consists much more in security for the future than in indemnity for the past (*y*). The matter was discussed in a case before Wood, V.-C., but no general rule was suggested, and the only result arrived at was, that in the absence of evidence it could not be assumed, that the amount of goods sold by the defendant under the trade-mark would have been sold by the plaintiffs, but for the defendant's unlawful use of the mark (*z*).

Aiders and abetters of infringer.

There are it seems some cases in which the owner of a trade-mark has a right of action not only against the person who actually sells spurious articles under his trade-mark, but also against a person who, by furnishing the means of effecting such sales, has made himself a party

(*x*) In *Lawson* v. *Bank of London*, 18 C. B. 84, an action for using the name of plaintiff's bank, where the plaintiff did not allege that he had ever carried on the business of banking in that name, and was in a position to be damnified, Willes, J., said, "No action could, I apprehend, be maintained for the sale of goods branded or stamped with another manufacturer's mark, which mark had never been put forth to the world by the party complaining of the misuse of it." Compare also cases in equity on this point, cited *infrà*.

(*y*) See Sedgwicke on Damages, 4th edit. p. 680.

(*z*) *Leather Cloth Company* v. *Hirschfield*, L. R. 1 Eq. 299. A similar difficulty exists in the case of patents. See *Penn* v. *Jack*, L. R. 5 Eq. 81.

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to the transaction. In *Farina* v. *Silverlock* (*a*) the plaintiff obtained a verdict against the defendant, who printed labels, fac-similes of those affixed by the plaintiff to his bottles of eau de Cologne, and supplied them to persons who to the defendant's knowledge intended to make an improper use of them. But it seems to be necessary that some of the spurious goods should have been actually sold (*b*). In this respect, the remedy in equity and by criminal proceedings is more extensive than by action at law. By statute (*c*) any one who with intent to defraud, or to enable another to defraud any person, forges or counterfeits a label or other trade-mark (*d*) is guilty of a misdemeanor, and forfeits the dies, stamps, and other instruments used in the production of the counterfeit trade-mark (*e*). The intent to defraud is sufficient, and therefore it is not necessary to show that any goods have been sold under the counterfeit mark (*f*). Persons aiding or abetting the making or using of counterfeited trade-marks are also guilty of a misdemeanor (*g*).

No change in the remedy at law.

The remedy at law appears to have been firmly established in 1783 by Lord Mansfield's dictum quoted above. For in the next reported case in 1824 the principle seems admitted, and the case was defended on the ground that the defendant had no intention to defraud, and on other

(*a*) 4 K. & J. 650. The circumstances which led to the action appear, from the reports of the case, in 6 De G. M. & G. 214, 1 K. & J. 509.

(*b*) The bill in *Farina* v. *Silverlock* contained an averment to this effect. See *Delondre* v. *Shaw*, 2 Sim. 237.

(*c*) 25 & 26 Vict. c. 88.

(*d*) See the definitions of "mark" and "trade-mark," sect. 1.

(*e*) This seems the effect of sect. 2.

(*f*) Sect. 12.

(*g*) Sect. 13.

collateral points, and the principle is only developed and confirmed by the subsequent cases (*h*).

Remedy in equity generally preferred.

Of the actions tried at law, several were brought in consequence of the Court of Chancery requiring the plaintiff to establish his right there as a condition precedent to giving him relief in equity. The remedy at law alone, which generally amounted to no more than a judgment for nominal damages, was of course much less efficient than the equitable remedy by injunction and account, and accordingly when the Court of Chancery was prohibited (*i*) from sending the plaintiff to law before granting him relief, the remedy by action fell into disuse.

Injunction at law.

The courts of law have now the power of awarding an injunction against a defendant who has infringed a trade-mark (*k*), but the procedure of the Court of Chancery still offers many advantages which an action at law practically fails to afford, and the remedy by bill is therefore still resorted to in almost every case.

Merchandise Marks Act, 1862.

"The Merchandise Marks Act, 1862" (*l*), was passed mainly with the view of rendering the infringers of trade-marks amenable to the criminal law, but it contains provisions applying to the ordinary remedies by action or suit. It is necessary in this place to notice section 11, under which a party or witness cannot refuse to answer on the ground of his being liable to criminal proceedings; section 21, under which the Court may order an article wrongfully bearing a trade-mark to be destroyed, may award an injunction, and may allow the plaintiff to have an inspection of the defendant's process, articles, and

Witness.

Destruction.

Injunction.

Inspection.

(*h*) See the cases *ante*, p. 10 *et seq.*

(*i*) By 25 & 26 Vict. c. 42, s. 1.

(*k*) 25 & 26 Vict. c. 88, s. 21, 17 & 18 Vict. c. 125, ss. 79—82.

(*l*) 25 & 26 Vict. c. 88.

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instruments; and section 22, under which *every person* (*m*) *aggrieved* by the forging or counterfeiting of a trade-mark, or by its wrongful use, may maintain an action or suit.

Importation forbidden.

By 35 & 36 Vict. c. 20, s. 4, it is forbidden to import inwards or in transit any articles of foreign manufacture, and any packages of such articles bearing any name, brand, or mark which states or implies that such articles were manufactured at any place in the United Kingdom. And any name, brand, or mark which states or implies that any such articles were manufactured at a town or place having the same name as a place in the United Kingdom, unless accompanied by the name of the country in which such place is situate, is to be deemed for the purposes of this section to state or imply that such articles were manufactured at a place in the United Kingdom.

Remedy of vendee.

Measure of damages.

It is clear that any one having been induced to purchase an article by a trade-mark which, to the vendor's knowledge, is improperly affixed to it, can by the common law maintain an action for the deceit against the vendor, and he will be entitled to recover the difference between the actual value of the article and what would have been its value if the trade-mark had been properly affixed, together with damages for any loss which is the direct and natural consequence of his acting on the faith of the trade-mark being properly affixed (*n*). Thus if the vendee were proceeded against in Chancery by the owner of the trade-mark he would, no doubt, be entitled to

(*m*) See the definition of "person," sect. 1, in which aliens are included.

(*n*) *Mullett* v. *Mason*, L. R. 1 C. P. 559, Sedgwicke, 338; *Clarke* v. *Dickson*, 6 C. B. N. S. 453.

recover from the vendor the costs of the Chancery suit (*o*), and if he sold the goods to a third party, would be entitled to recover any damages he might have to pay to such third party by reason of their spuriousness. The vendee may also, provided he can restore the article in the condition in which it was sold, elect to disaffirm the contract and recover back the price in an action for money had and received (*p*).

Implied warranty by vendor.

Now, by the "Merchandise Marks Act, 1862" (*q*), the vendor of an article bearing a trade-mark is to be deemed to warrant that the trade-mark is genuine and true, and not forged or counterfeit, and not wrongfully used, unless the contrary shall be expressed in some writing signed by or on behalf of the vendor, and delivered to and accepted by the vendee. The remedy thus given is, it is conceived, in addition to the remedies previously open to the vendee.

Measure of damages for breach of warranty.

The general measure of damages in this case is the difference between the actual value of the article and what would be its value if it conformed to the warranty (*r*), but it is doubtful whether, in the absence of fraud, the plaintiff is also entitled to damages arising from his acting on the faith of the warranty being true (*s*).

Infringement by order.

A person who orders goods and directs them to be marked with a trade-mark which he knows he is not authorised to use, is liable to repay the person who

(*o*) *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537, 30 L. J. Q. B. 137; *Collen* v. *Wright*, 7 E. & B. 301, 26 L. J. Q. B. 147, in error, 8 E. & B. 647, 27 L. J. Q. B. 215.

(*p*) *Clarke* v. *Dickson*, 1 E. B. & E. 148.

(*q*) 25 & 26 Vict. c. 88, s. 19.

(*r*) See Sedgwicke on Damages, 325 (4th edit.); *Jones* v. *Just*, L. R. 3 Q. B. 197.

(*s*) See *Mullett* v. *Mason*, L. R. 1 C. P. 559.

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innocently executes the order, the costs he reasonably incurs in consequence of a suit being brought against him to restrain the infringement of the trade-mark (*t*).

Remedy by Indictment or Summary Proceeding.

Indictment by common law.

Counterfeiting a trade-mark, even if it is a signature, like an artist's signature on a picture, is not forgery at common law (*u*), but fraudulently putting a trade-mark (*x*) or a colourable imitation of one (*y*) on a spurious article to pass it off as genuine, and selling the article by means of the mark, is a cheat at common law (*z*), and under the statute as to false pretences (*a*).

Merchandise Marks Act, 1862.

By the Merchandise Marks Act, 1862 (*b*), the criminal remedy has been greatly extended. The protection of the Act extends only to marks lawfully used as trade-marks, and it is conceived that this excludes marks which contain false statements, or are otherwise calculated to deceive the public, as for instance a mark which falsely represents the article to be the subject of an existing patent (*c*).

Misdemeanors by statute.

The Act makes it a misdemeanor to do any of the following things with intent to defraud (see sec. 12) :—

(*t*) *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537, 30 L. J. Q. B. 137. See, too, *Spedding* v. *Nevell*, L. R. 4 C. P. 212 ; *Godwin* v. *Francis*, L. R. 5 C. P. 295.

(*u*) *Reg.* v. *Closs*, Dearsley & B. 460, 27 L. J. M. C. 54 ; *Reg.* v. *Smith*, Dearsley & B. 566, 27 L. J. M. C. 225.

(*x*) See *Reg.* v. *Smith*, loc. cit.

(*y*) *Reg.* v *Dundas*, 6 Cox, C. C. 380 ; *Reg.* v. *Bryan*, 7 Cox, C. C. 312, Dearsley & B. 265.

(*z*) *Reg.* v. *Closs*, loc. cit.

(*a*) 24 & 25 Vict. c. 96, ss. 88—90, and see s. 1. As to preferring an indictment, see 22 & 23 Vict. c. 17, s. 1.

(*b*) 25 & 26 Vict. c. 88. Printed in full in the Appendix.

(*c*) See *infrà*.

To forge or counterfeit another's trade-mark (*d*), and a trade-mark fraudulently altered so as to resemble some other trade-mark is deemed a counterfeit of the latter (*e*):

Marks used for particular class of goods.

Wrongfully to apply a trade-mark, and this extends to the case where the trade-mark-owner denotes by a special mark a particular kind of goods, and the mark is applied to goods which though they are his are not of this particular kind (*f*).

A person convicted of a misdemeanor may be either fined or imprisoned for not more than two years, and that with or without hard labour, or punished in both ways (*g*), and he forfeits to the Crown all articles and all labels, reels, wrappers, &c., wrongfully marked, and all instruments for impressing or applying the marks, and the Court may order the forfeited things to be destroyed (*h*).

Aiders and abetters.

Persons aiding and abetting the commission of the before-mentioned misdemeanors are themselves guilty of a misdemeanor (*i*), and liable to the same punishment as the principals (*k*).

Selling goods wrongfully marked.

Knowingly to sell goods wrongfully marked is an offence for which the seller forfeits a sum equal to the value of the articles sold, and a further penalty not exceeding 5*l*., nor less than 10*s*. (*l*). The penalties may be recovered in a *qui tam* action (*m*), or summarily before justices at petty sessions (*n*) under 11 & 12 Vict. c. 43.

Any one who sells an article wrongfully marked may be compelled by an order of a justice to state when and from whom he obtained it. A refusal to comply with such

(*d*) Sect. 2.
(*e*) Sect. 5.
(*f*) Sections 2 & 3, and see *infrà*.
(*g*) Sect. 14.
(*h*) Sections 2 & 3.
(*i*) Sect. 13.
(*k*) Sect. 14.
(*l*) Sect. 4.
(*m*) See sections 15, 17, 18, 23.
(*n*) See sections 15 & 16.

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order exposes the party to a penalty of 5*l.*, and is *prima facie* evidence of guilty knowledge (*o*).

The Act does not affect any civil right or remedy, and its penalties do not exempt a person from giving evidence or discovery. But the answers of such a person cannot be used against him (*p*).

Exhibition medal.

An Exhibition medal is not a trade-mark, but false representations respecting the obtaining of a medal are penal (*q*).

(*o*) Sect. 6. (*p*) Sect. 11.
(*q*) *Batty* v. *Hill*, 1 H. & M. 264, 26 & 27 Vict. c. 119.

CHAPTER III.

REMEDY IN CHANCERY.

Refusal of interference.

THE Court of Chancery was later in giving a remedy for infringement of trade-marks than the courts of common law.

Lord Hardwicke refused (*a*) to restrain a defendant from imitating the plaintiff's mark on playing-cards, a mark granted by the Cardmakers' Company. His judgment was based, to a great extent, on the ground that the charter of the company was a monopoly and illegal. But he also said that there was no precedent for restraining one trader from using the same mark with another, and thought it would be of mischievous consequence to do so; and, further, that the objection that the plaintiff was prejudiced by his custom being taken away was of no weight. There appears to have been no case of interference by the Court of Chancery, with reference to an actual trade-mark, until 1833 (*b*), though for some years before that the law has been gradually tending in that direction by an extension of the analogous jurisdiction of the Court. The grant of injunctions to restrain infringements of patents and copyright books was a familiar exercise of the jurisdiction of the Court of Chancery.

(*a*) *Blanchard* v. *Hill* (1742), 2 Atk. 484.

(*b*) *In Gout* v. *Alcploglu*, 1 Chitty, General Practice (edit. 1837), 721, 6 Beav. 69, note.

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Commencement of jurisdiction.

In 1803 (*c*), however, Lord Eldon granted a temporary injunction to restrain the defendant from publishing a magazine, which was an imitation of, and had been sold as and for the magazine of the plaintiff; but directed the plaintiff to bring an action to try his right at law. This case is referred to as the authority for subsequent decisions. It appears to have rested on the general resemblance of the two magazines, constituting misrepresentation, and not on any right of the plaintiff to the title-page of his magazine as alone constituting a trade-mark. In *Longman* v. *Winchester* (*d*), Lord Eldon says, in reference to *Hogg* v. *Kirby*, "The defendant in that case published a number of a work as a continuation of the plaintiff's old work, taking the credit which had been acquired by that to his own, and that he was not permitted to do." And in 1813 (*e*) Sir Thomas Plumer, V.-C., refused to restrain the defendant from selling "Velno's Vegetable Syrup," because the plaintiff had no exclusive right to the medicine, and the defendant had not represented it to be of the plaintiff's manufacture (*f*).

Moreover, Eden on Injunctions (*g*) (1827) lays it down that where a person does not "assume the name

(*c*) *Hogg* v. *Kirby*, 8 Ves. 215. This case was argued as one of copyright, contract, and trust (the defendant having been plaintiff's publisher), but Lord Eldon appears to have set aside these arguments, and proceeded on the ground mentioned in the text.

(*d*) 16 Ves. 269, 271.

(*e*) *Canham* v. *Jones*, 2 V. & B. 218.

(*f*) In *Sedon* v. *Senate*, cited in *Canham* v. *Jones*, the injunction was granted on the ground of contract.

(*g*) Page 34, citing *Blanchard* v. *Hill*, and *Canham* v. *Jones*, he refers to an injunction granted in 1816 (*Day* v. *Day*) to restrain the use of labels for blacking similar to those used by plaintiff, but does not state the ground, whether contract or otherwise.

and character of another, he will not be prevented from selling another article under the same title."

First case of injunction.

It was not until 1833 that the first clear case (*h*) of restraining the infringement of a trade-mark in the Court of Chancery was decided. That case went a good deal further than this rule of Eden, as the defendants were restrained from putting on watches, not merely the plaintiff's name, but the word "pessendede," the Turkish for "warranted" (*i*).

This case was followed by various others (*k*), in some of which the plaintiff was successful, in others not.

Two classes of cases not reconcileable.

These cases are divided into two classes, which appear to be not quite reconcileable. The first class follow a supposed analogy to the case of an action based on personal fraud. The latter class tend to approximate more and more closely to the view that the right of the trade-mark-owner is *jus in rem* or property.

First class:

In the first class of cases the right of the plaintiff to

(*h*) An attempt to restrain the issue of spurious labels in 1828 failed on technical grounds (*Delondre* v. *Shaw*, 2 Sim. 240). An *ex parte* injunction restraining the issue of blacking-labels similar to the plaintiff's was obtained in 1831, but on what grounds, and whether it was maintained or not, is not stated (*Day* v. *Benning*, C. P. Cooper, 489). See note above on *Day* v. *Day*.

(*i*) *Gout* v. *Aleploglu*, 1 Chitty's General Practice (edit. 1837), 721, 6 Bea. 69 note. This injunction was continued on the hearing of the cause.

(*k*) Particularly *Ransome* v. *Bentall* (1834), 3 L. J. (Ch.) 161; *Knott* v. *Morgan* (1836), 2 Keen, 213, the omnibus case; *Motley* v. *Downman* (1837), 3 My. & Cr. 1; *Millington* v. *Fox* (1838), 3 My. & Cr. 338; *Perry* v. *Truefitt* (1842), 6 Bea. 73; *Croft* v. *Day* (1843), 7 Bea. 84; *Franks* v. *Weaver* (1847), 10 Bea. 297; *Rodgers* v. *Nowill* (1846-8), 6 Hare, 325, 3 De G. M. & G. 614; *Pierce* v. *Franks* (1846), 15 L. J. (Ch.) 122; *Holloway* v. *Holloway* (1850), 13 Bea. 209; and other cases mentioned in subsequent notes.

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legal right, intentional deceit necessary.

relief against the defendant was held to be a legal right (*l*), and the interference of the Court of Chancery was considered as only ancillary to that legal right; consequently the rule applied that the Court of Chancery when exercising jurisdiction over legal rights, although in strong cases interfering at once by injunction, yet in general required the plaintiff to prove his right in an action at law; we find, therefore, that in some cases where the intentional fraud of the defendant was palpable the injunction was granted at once (*m*) on interlocutory motion; whether with or without requiring the plaintiff to bring an action is not in all cases quite clear. In other cases the plaintiff was required as a matter of course to prove his right at law (*n*).

Injunction refused because no intentional deceit.

In others, either the injunction has been refused on the ground that there was no fraud (*o*), or if the right of the plaintiff to the use of the mark as against the defendant was doubtful (*p*), or if he had been guilty of misrepresentation (*q*), or if he had delayed or not behaved quite fairly (*r*), or if there were circumstances rebutting the *primâ facie* inference of fraud arising from the use of

(*l*) *Motley* v. *Downman*, 3 My. & Cr. 1; *Collins Company* v. *Reeves*, 28 L. J. Ch. 56; *Rodgers* v. *Nowill*, 3 Hare, 625; *Hine* v. *Lart*, 10 Jur. 106.

(*m*) *Croft* v. *Day*, 7 Bea. 84; *Franks* v. *Weaver*, 10 Bea. 297; *Holloway* v. *Holloway*, 13 Bea. 209; *Burgess* v. *Burgess*, 3 De G. M. & G. 890; *Shrimpton* v. *Laight*, 18 Bea. 164; *Dent* v. *Turpin*, 2 J. & H. 139.

(*n*) Cases cited in note (*l*) above.

(*o*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896, 22 L. J. Ch. 675.

(*p*) *Motley* v. *Downman*, 3 My. & Cr. 1; *Rodgers* v. *Nowill*, 5 C. B. 109.

(*q*) *Pidding* v. *Hoive*, 8 Sim. 477; *Perry* v. *Truefitt*, 6 Bea. 66; *Flavel* v. *Harrison*, 10 Hare, 467.

(*r*) *Perry* v. *Truefitt*, 6 Bea. 66; *Flavel* v. *Harrison*, 10 Hare, 467; *Collins Company* v. *Reeves*, 28 L. J. Ch. 56.

similar marks (*s*), he was required to try his right by an action at law, either before he was held entitled to the injunction, or as a condition of his maintaining the injunction.

In this class of cases, the Court clearly granted relief on the same grounds only as would support an action, namely, intentional deceit of the defendant. The language of the judges, however, is not uniform. In the earlier cases the Court proceeded on the ground that the defendant had no right by any means (whether by using the name or trade-mark of the plaintiff, or by any other misrepresentation), to pass off his goods as the goods of the plaintiff to the injury of the latter. To do so was a fraud on the public and on the plaintiff, even though the name was the defendant's own name; though the Court did not interfere on behalf of the public (and indeed could not, except on the information of the Attorney-General), but on behalf of the injured trader.

Misrepresentation and intentional fraud, ground of jurisdiction.

In these cases it was clearly laid down that the ground of jurisdiction of the Court is intentional fraud (*t*); that the deceit of the defendant, as in other cases of misrepresentation (*u*), must be intentional, and it was expressly stated that the plaintiff had no exclusive right to—no property in—the trade-mark, but only a personal right to be protected against fraud (*x*).

(*s*) *Collins Company* v. *Reeves*, 28 L. J. Ch. 56; *Farina* v. *Silverlock*, 26 L. J. Ch. 11, 1 K. & J. 509, 6 De G. M. & G. 214.

(*t*) Fraud by itself is ambiguous, as the result of a man's act done in ignorance, may be deceptive, and so fraudulent.

(*u*) *Henderson* v. *Lacon*, L. R. 5 Eq. 249, see p. 262.

(*x*) *Perry* v. *Truefitt*, 6 Bea. 66; *Croft* v. *Day*, 7 Bea. 84; *Franks* v. *Weaver*, 10 Bea. 297; *Flavel* v. *Harrison*, 10 Hare, 467; *Edelsten* v. *Vick*, 11 Hare, 78; *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Collins Company* v. *Comen*, 3 K. & J. 428; *Knott* v. *Morgan*, 2 Keen, 213.

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But in the later cases a change is observable. It is admitted that the plaintiff has an exclusive right of using his trade-mark for a particular kind of goods, and dicta are found admitting the principle of the second class of cases. The principle also was stated in the form, that "no one may sell goods of his own marked with another's trade-mark, so as (or in order) to deceive the public;" an ambiguous expression which may refer to cases where the deceit is intentional or to cases where the result only is deceptive and the intention innocent (*y*).

If it refers to intentional deceit, it is hardly reconcileable with the second class of cases.

If it refers merely to a deceptive result, it is only reconcileable with the practice (followed in the very case where the expression occurs) of requiring the plaintiff to try his right at law by supposing that where the result is deceptive, intentional fraud on the part of the defendant may be presumed (*z*), a presumption, however, which was not made in *Millington* v. *Fox* (*a*).

The admission of the exclusive right, however, goes a long way to establish a right of property in the trade-mark, especially when coupled with the principle established by the second class of cases.

(*y*) *Farina* v. *Silverlock, ubi sup.*; *Collins Company* v. *Brown*, 3 K. & J. 423; Wood, V.-C., said, in *Welch* v. *Knott* (1858), 4 K. & J. 747, that *Millington* v. *Fox* showed that it was not a sufficient defence to allege ignorance. "How far the doctrine in that case was capable of being reconciled with cases at law in which the *scienter* had been held to be essential in order to enable the plaintiff to recover was not material." In that court the rule was clear, and he had so held in Bass's case. And see *Harrison* v. *Taylor*, 11 Jur. N. S. 408.

(*z*) *Collins Company* v. *Brown*, 3 K. & J. 423; *Edelsten* v. *Vick*, 11 Hare, 78.

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

Trade-mark is property.

The practice, however, of requiring the plaintiff to bring an action is stopped by Rolt's Act (*b*), and since 1863 it has been clearly laid down in several cases (*c*) that the right to a trade-mark is a right to the exclusive use of it for the particular goods for which it is used; that it is therefore property, and will be protected by the Court as if it were property, that is to say, whether the infringement is intentional or not (*d*), as will be seen from the second class of cases which we now proceed to examine.

Millington v. *Fox*.

In these the right of the trade-mark-owner is rested on a broader basis. *Millington* v. *Fox* (*e*) is the first of such cases. There the plaintiffs and their predecessors in

(*b*) 25 & 26 Vict. c. 27. Frequently where the practice was to send the plaintiff to law, the case now is tried before a jury.

(*c*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Hall* v. *Barrows*, 33 L. J. Ch. 205; *Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*), 33 L. J. Ch. 199, 11 H. L. 523.

(*d*) Wood, V.-C., however, said (*Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*), 1 H. & M. 271), that the protection is founded on the jurisdiction of the Court to prevent fraud from one person on the right of another, and that where the defendant has acted ignorantly the Court restrains him because it thinks that if he continues that representation after he has been told what the nature of the plaintiff's right is, he will be committing a fraud. The same judge took a similar view in *McAndrew* v. *Bassett*, 33 L. J. Ch. 561, 4 De G. J. & S. 380, where he is reported to have said that this was the foundation of *Millington* v. *Fox*. This, however, is not the view that other judges (see *Perry* v. *Truefitt*, *Hall* v. *Barrows*, *ubi sup.*) have taken of that case, and the correctness of this report (33 L. J. Ch. 561) may be doubted, as it is not easy to reconcile with the decision of the same judge in *Welch* v. *Knott*, 4 K. & J. 747, *supra*, p. 30, note (*y*), and seems to have no ground in the rest of the report of the case, as it was argued for the defendants that no perpetual injunction could be granted against them, because they had (as stated in their answer) ceased to use the marks as soon as they knew the plaintiffs claimed them.

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

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business had long been in the habit of branding their iron with the marks "Crowley," "Crowley Millington," and "I. H." The defendants had made use of these marks, believing them to be mere indications of quality, and as soon as they heard that the plaintiffs claimed them as trade-marks and before bill filed, they ceased to use them.

At the hearing, Lord Cottenham, although he acquitted the defendants of any intention to defraud, nevertheless, held that the plaintiffs were entitled to a perpetual injunction against them, but under all the circumstances of the case, he left each party to bear his own costs.

Millington v. *Fox* was followed by other cases in which the principle was acted upon, that relief would be granted although the defendants proved that they acted in ignorance of the plaintiff's rights (*f*).

Lord Westbury's statement of the law.

When it was conceded that the right of the plaintiff did not depend upon the good or bad faith of the defendant, he was in this respect put upon the footing of *an owner of ordinary property*. *Lord Westbury*, however, was the first judge who fully and clearly enunciated the principle, that jurisdiction in cases of trade-mark, rests not upon *tort*, but upon property. This is in substance,

(*f*) *Clement* v. *Maddick*, 5 Jur. (N. S.) 592, 1 Giff. 98, where the marginal note is incorrect; *Burgess* v. *Hateley*, 26 Beav. 249; *Burgess* v. *Hills*, 26 Beav. 244. See also *Collins Company* v. *Brown*, 3 K. & J. 423, 433. It is to be observed, however, that in all these cases the plaintiff's mark had been imitated; in none of them had two persons accidentally hit on the same mark. In *Dixon* v. *Fawcus* (1861), 30 L. J. Q. B. 137, 3 Ell. & Ell. 537, the Queen's Bench held that intention to deceive was not necessary to ground an injunction in the Court of Chancery. In France the law is the same. "Le fait matériel de la reproduction d'une marque de fabrique constitue la contrefaçon, indépendamment des circonstances tendant à établir la bonne ou la mauvaise foi de la partie contrevenante." Dalloz, Jur. Gen. 1868, Pt.ii.p. 233. So also in New York, *Dale* v. *Smithson*, 12 Ab. Pr. 238.

the same thing as saying that the right of the trade-mark-owner is a *jus in rem*, as has been already explained. In giving judgment in *Hall* v. *Barrows* (*g*), he made the following remarks:—"It has been pressed upon me on the part of the defendant, that there is no property in a trade-mark, and that the right to relief is merely personal, founded on the fraud that is committed when one man sells his own goods as the goods of another. It is true that the cases contain expressions by eminent judges that there is no property in a trade-mark, which must be understood to mean that there can be no right to the exclusive ownership of any symbol or mark universally, in the abstract. Thus, an ironfounder who uses a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed upon cotton or woollen goods; for the property in a trade-mark consists in the exclusive right to the use of that mark as applied to some particular manufacture. Nor is it correct to say that the right to relief is founded on the fraud of the defendant, as appears from the case of *Millington* v. *Fox*, already referred to. Imposition on the public is indeed necessary for the plaintiff's title, but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property; for there is no injury done to the plaintiff if the mark used by the defendant be not such as may be mistaken, or is likely to be mistaken, by the public for the mark of the plaintiff. But the true ground of the Court's jurisdiction is property."

The same principle was again maintained by Lord Westbury in *The Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*) (*h*), and was

(*g*) 33 L. J. Ch. 204.

(*h*) 33 L. J. Ch. 199.

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approved by the House of Lords (*i*) in the same case.

It is true that in *Hall* v. *Barrows* the question at issue was the nature of the right to a trade-mark for the purpose of transfer, and not for the purpose of relief against infringement, and the case of the Leather Cloth Company, which involved the question of the transferableness of a trade-mark, as well as the question of infringement, was decided by the Lord Chancellor on the ground of misrepresentation by the plaintiff, and by the House of Lords on that ground, and also on the ground of want of resemblance in the trade-marks. But the question of the right of transferring a trade-mark has a very important bearing on the nature of the protection which the Court gives it. And, after all, these cases only state more broadly the principle of *Millington* v. *Fox*, and carry it out so far as regards the right of transfer. And it seems now to be settled that although originally the Court proceeded on the equity of preventing one person from committing a fraud on the rights of another, it will now interfere to protect a trade-mark as if it were property, and not, as in other cases of misrepresentation, merely where there is intentional deceit on the part of the defendant (*k*), and that a person may be entitled to

(*i*) 11 H. L. 523.

(*k*) Wood, V.-C., said in *McAndrew* v. *Bassett*, 33 L. J. Ch. 561, 4 De G. Jo. & Sm. 380, 4 N. R. 12, 123, that "Lord Westbury's decision in *Hall* v. *Barrows* did not alter the law, and that whether the right to the trade-mark was property or not was merely a question of nomenclature." On the other hand, his language and decision in *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518, is rather against the view stated in the text. He says, "The use of the name of another manufacturer, whether done *scienter* or not, is an interference with his business, which this court will interpose to prevent, on the ground that the defendant is endeavouring to pass off the goods of his own or somebody else's manu-

the exclusive use of a trade-mark as applied to a particular description of goods. Chap. III.

But although a trade-mark is property, it is not so for all purposes. The property is not in the mark, but in the application of the mark to particular goods; consequently, a person has not such an abstract right to the mark which he adopts, as to entitle him to have another person prevented from using the same mark for other goods, and it is even doubtful whether he has a right in all cases to prevent the use of it by another person for the same class of goods. Limit of right of property in trade-mark.

He must show, as in an action at law, that there has been in effect a false representation, that the acts of the defendants have misled or were calculated to mislead the public (*l*). For instance, it has been said that if the mark is applied without the consent of the owner to goods which are his, there is no misleading of the public, and that such use cannot be interfered with (*m*).

facture as the manufacture of the plaintiff." He considered there had been an unjustifiable use of the plaintiff's labels, but refused to interfere, because they were not so used as clearly to represent that the goods were the plaintiff's manufacture. But query, whether it is not still necessary to show intentional fraud in cases where the defendant has the same name as the plaintiff, see *Burgess* v. *Burgess*, 3 De G. M. & G. 897, 32 L. J. Ch., 675.

(*l*) *Welch* v. *Knott*, 4 K. & J. 747; *Burgess* v. *Burgess*, 3 De G. M. & G. 897.

(*m*) *Farina* v. *Silverlock*, 6 De G. M. & G. 214; Wood, V.-C. (4 K. & J. 50), doubted whether Lord Cranworth meant to say that the use of labels to renew worn-out labels might be legitimate, but his own decision in *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518, where the plaintiff was admitted to be injured, seems to support the view stated in the text. A case of *Guiness* v. *Sutton* (M. R. 28 July, 1853) is mentioned in the evidence before the Committee of the House of Commons on the Trade-Marks Bill of 1862 (H. C. Sessional Papers, 212, Qu. 2663); but, from the short-hand notes of the argument and judg-

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If the mark as denoting a given description of goods is property, it seems to follow that no one can use it for this purpose without the consent of the owner, for if the right is to an exclusive use of a given kind, any similar use is an infringement of the right; it is doubtful, therefore, whether an use such as in the case above mentioned would now be held to be legitimate. If the goods are really those of the owner of the mark, he could hardly object to consent to the renewal of worn-out labels, and his assent might fairly be presumed in the absence of an express stipulation to the contrary. But to allow this to be done without the consent of the owner, or to allow labels to be affixed to goods to which he has not thought fit to affix them, is clearly to open a wide door to fraud. Accordingly, the Merchandise Marks Act, 1862, makes it a misdemeanor to apply, with a fraudulent intent, a trade-mark to any chattel or article not being the particular or peculiar description of manufacture, workmanship, production, or merchandise denoted, or intended to be denoted, by such trade-mark (*n*). This would seem also to give a party injured a civil remedy (*o*). All pre-existing remedies are expressly saved.

Renewing old labels.

Fraudulent transfer of labels.

ment, it appears to have turned on special circumstances. The precise point arose in an American case of *Gillott* v. *Kettle*, 3 Duer, 624 (N. Y.), where the plaintiff, the eminent steel-pen maker of Birmingham, marked boxes of pens of the first quality with the number 303, while other boxes containing pens of an inferior quality were marked 753. The defendant removed the labels from the last-mentioned boxes, and put upon them labels numbered 303, closely resembling the genuine labels bearing that number. The defendant was restrained from so doing by injunction.

(*n*) 25 & 26 Vict. c. 88, s. 2.

(*o*) *Atkinson* v. *Newcastle and Gateshead Waterworks Company*, L. R. 6 Exch. 404; *Couch* v. *Steel*, 3 Ell. & Bl. 402, 23 L. J. Q. B. 121; but see *per* Lord Chelmsford in *Wilson* v. *Merry*, L. R. 1 H. of Lds. Sc. 326.

Injury to the plaintiff.

The tendency to mislead the public forms an important element in a matter which a plaintiff must prove in equity as well as at law, the injury to himself. If there is no probability of imposition on the public, the plaintiff has suffered no injury (*p*), though on the contrary there may be imposition on the public, and yet the plaintiff may not be entitled to maintain a suit, either because he is not injured pecuniarily (*q*), or because he has not acquired any property in his trade-mark.

Desirable to show actual imposition.

As a consequence of this necessity of showing injury, there is some practical difficulty in stopping a piracy in trade-marks, before goods have been actually sold with the pirated marks on them. For the defendant, if his mark has not misled any one, may in many cases fairly argue that it is not calculated to mislead. A plaintiff therefore generally (*r*) does best to wait until he can obtain evidence of persons having been actually misled, and if he gives the defendant notice of his claim to the mark, a reasonable delay for the purpose of getting such evidence will not prejudice him in an application for an interlocutory injunction (*s*).

(*p*) "Imposition on the public is necessary for the plaintiff's title, but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property; for there is no injury done to the plaintiff if the defendant's mark is not such as may be mistaken, or is likely to be mistaken, by the public for the mark of the plaintiff." *Per* Westbury, C., in *Hall* v. *Barrows*, 33 L. J. Ch. 205. See also *Farina* v. *Silverlock*, 6 De G. M. & G. 217.

(*q*) *Clark* v. *Freeman*, 11 Beav. 112; *Welch* v. *Knott*, 4 K. & J. 747; *Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*), 33 L. J. Ch. 199. A possibility of injury, however, is enough as at law (*supra*, p. 16), *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495.

(*r*) There may be exceptional cases. See *Chappell* v. *Sheard*, 2 K. & J. 117.

(*s*) *Lee* v. *Haley*, L. R. 5 Ch. 155.

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The result is, that of the three things said to be essentials in an action at law, false representation by the defendant, intentional deceit by the defendant, and injury to the plaintiff, the last is necessary to ground relief in equity, the second is not necessary, the first is necessary, at any rate so far as it is required to prove the injury.

Discovery of names of defendant's customers.

The defendant is frequently required by the plaintiff to discover the names of customers to whom he has sold goods stamped with a mark which the plaintiff claims as his, and the prices at which he sold them. After a decree directing an account or an inquiry as to damages, or before decree, if the plaintiff's right is not substantially disputed, the defendant must give such discovery (*t*). If he is unable to give precise information, he may then (but not otherwise) be required to disclose the names of all persons to whom he has sold any goods, which he will not positively swear were unstamped (*u*). Where, however, the Court sees reasonable ground for believing that the plaintiff's right to the mark in question is *bonâ fide* disputed, it will not compel the discovery of facts which will not aid the plaintiff in establishing his right, and may prove injurious to the defendant. In such a case, therefore, it will not in general compel the defendant to discover prices and the names of customers to a rival trader (*x*).

The answer of a defendant cannot be used against him

(*t*) *Howe* v. *McKernan*, 30 Beav. 547, and compare cases cited *infrà*, note (*x*).

(*u*) *The Leather Cloth Company* (*Limited*) v. *Hirschfeld*, 1 H. & M. 295.

(*x*) *Carter* v. *Pinto Leite*, 20 W. R. 134. And see *Moore* v. *Craven*, W. N. 1870, p. 13, cited in *Thompson* v. *Dunn*, L. R. 5 Ch. 573; *Lockett* v. *Lockett*, L. R. 4 Ch. 336.

in any criminal proceedings, and he cannot, therefore, refuse to answer, on the ground that he will expose himself to penalties or forfeiture (*y*). Chap. III.

Inspection.

By the Merchandise Marks Act, 1862 (25 & 26 Vict. c. 88, s. 21), the Court is empowered to grant inspection in the three following cases:—

1. Of any manufacture or process of the defendant's, in which the plaintiff's trade-mark is alleged to be infringed:

2. Of any articles under the defendant's control, alleged to be so marked as to infringe the plaintiff's trade-mark:

3. Of any instruments under the defendant's control, capable of subserving such infringement.

No order seems yet to have been made under this section. In patent cases, inspection is sometimes granted before the trial or hearing, in order to enable the parties to establish their case (*z*). But in the case of trade-marks, public use is necessary to constitute infringement, and it seems, therefore, that there is no ground for granting inspection before the hearing (*a*).

Interlocutory injunction.

The plaintiff generally applies for an interlocutory injunction soon after filing his bill, and where there is reason to doubt the defendant's good faith, much less absolute proof of the plaintiff's title is required (*b*). In order to obtain one he must be prompt in coming to the Court (*c*),

(*y*) 25 & 26 Vict. c. 88, s. 11.

(*z*) *Morgan* v. *Seaward*, 1 Webster, 169; *Russell* v. *Cowley*, Ibid. 458; *Bovill* v. *Moore*, 2 Cooper C. C. 56, note.

(*a*) For form of order in a patent case, see *Davenport* v. *Jepson*, 1 N. R. 308.

(*b*) *Radde* v. *Norman*, L. R. 14 Eq. 348, 41 L. J. Ch. 525.

(*c*) *Flavel* v. *Harrison*, 10 Hare, 467; *Chappell* v. *Sheard*, 2 K. & J. 117; *Chubb* v. *Griffiths*, 35 Beav. 127.

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Delay,

and in bringing on his motion (*d*). In *Isaacson* v. *Thompson* (*c*) an unexplained delay of about seven months was held to disentitle the plaintiff to an interlocutory injunction. But, as has been already observed, time will not begin to run against the plaintiff until the expiration of the period during which he might, with reasonable diligence, have obtained satisfactory evidence that the acts of the defendant do, in fact, mislead the public (*f*).

and acquiescence.

At the hearing, a defendant who sets up delay or acquiescence on the part of the plaintiff as a bar to an injunction, must show a much stronger case than suffices on an interlocutory application (*g*). In the case of trade-marks, if the only acts of which the plaintiff is entitled to complain occurred a considerable time before the filing of the bill, the presumption is that the defendant has discontinued his invasion of the plaintiff's rights, and the Court will, no doubt, be disinclined to encourage a stale complaint. But if the infringement is continued down to the time of bill filed, delay or acquiescence in order to be a bar to an injunction must amount almost to a licence (*h*) or to an abandonment of the plaintiff's rights in favour of the world at large (*i*). But delay or other circumstances not sufficient to deprive the plaintiff of his right to an injunction and costs of suit, may prevent him

(*d*) *Pickford* v. *Grand Junction Railway Company*, 3 Rail. Cases, 538.

(*e*) 20 W. R. 196.

(*f*) *Lee* v. *Haley*, L. R. 5 Ch. 160; *Isaacson* v. *Thompson*, loc. cit.

(*g*) *Johnson* v. *Wyatt*, 2 D. J. & S. 18; *Patching* v. *Dubbins*, Kay, 11; *Gordon* v. *Cheltenham Railway Company*, 5 Beav. 233.

(*h*) See *Kinahan* v. *Bolton*, 15 Ir. Ch. 75; *Rodgers* v. *Nowill*, 3 De G. M. & G. 614; *Amoskeag Manufacturing Company* v. *Spear*, 2 Sandf. S. C. 605.

(*i*) See *Cocks* v. *Chandler*, L. R. 11 Eq. 446, 449. In *Beard* v. *Turner*, 13 L. T. N. S. 746, the observations of the Vice-Chancellor as to acquiescence refer only to the prayer for an account. See p. 750.

from having an account of profits (*j*), or induce the Court to give only a limited account (*k*).

A mere protest, not followed up (*l*), is not enough to save the protester from the imputation of laches (*m*). But as to anything which at the time he knew to be intended, it will relieve him from the imputation of assenting or standing silently by (*n*). The issuing of advertisements cautioning the public against an improper use of marks identical with the advertiser's trade-mark or likely to be mistaken for it, is strong evidence of non-acquiescence in such use (*o*).

Protest.

The full measure of relief to which a plaintiff is entitled gives him compensation for past wrongs and security as to the future. Under the usual decree at the hearing, the defendant is perpetually enjoined from infringing the plaintiff's trade-mark (*p*). The plaintiff is also, in some cases, entitled to an account of profits, or, if he prefers it, an inquiry as to damages (*q*); but he cannot have both (*r*).

Decree.

Account, damages.

(*j*) *Harrison* v. *Taylor*, 11 Jur. 408, where the delay was from Aug. 1863, to May, 1864; *Beard* v. *Turner*, loc. cit.

(*k*) *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*l*) See *Coles* v. *Sims*, 5 De G. M. & G. 1.

(*m*) *Attorney-General* v. *Sheffield Gas Company*, 3 De G. M. & G. 304; *Clegg* v. *Edmondston*, 8 De G. M. & G. 810; *Birmingham Canal Company* v. *Lloyd*, 18 Ves. 515.

(*n*) *Motley* v. *Downman*, 3 My. & Cr. 1, 16; *Buxton* v. *James*, 5 De G. M. & G. 80, 84.

(*o*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75.

(*p*) For forms of decrees, see Seton on Decrees (3rd edit.), p. 905, No. 1, erroneously put under the head Copyrights, 914, and 938, No. 3.

(*q*) *The Leather Cloth Company* (*Limited*) v. *Hirschfeld*, L. R. 1 Eq. 299.

(*r*) 21 & 22 Vict. c. 27, s. 2; *Neilson* v. *Betts*, L. R. 5 Eng. & Ir. App. 1, 22, overruling *Betts* v. *De Vitre*, 34 L. J. Ch. 289.

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The practical difficulty both in taking the account (*s*) and in assessing the damages (*t*) is great, and the plaintiff often waives his right to either.

Extent of injunction.

The injunction awarded will be made as extensive as is necessary for the protection of the plaintiff's right, and will, as of course, prohibit the use of the plaintiff's very trade-mark, or "any other mark only colourably differing therefrom." But if it is only under particular circumstances that the use of a given name or mark is likely to mislead the public, the use of it under other circumstances will not be prohibited. Thus, where the plaintiffs carried on business in Pall Mall, London, under the style of "The Guinea Coal Company," the defendant, who had set up business in Pall Mall under the style of "The Pall Mall Guinea Coal Company," was restrained from using this title. But the Court being satisfied that a business carried on under it elsewhere than in Pall Mall would not be likely to be mistaken for the plaintiffs', confined the injunction to Pall Mall (*u*).

Motion to commit.

If an injunction has been granted restraining a defendant from using a trade-mark, it will be no defence to a motion to commit for breach of the injunction, that the plaintiff has acquiesced in the use of the trade-mark, unless the acquiescence amounts almost to a licence (*x*). But in *Cartier* v. *May* (*y*), Wood, V.-C., in a case in which there had been a breach of the injunction, refused to commit in respect of such breach on account of the

(*s*) As to the account, see *infrà*.

(*t*) As to damages, see *The Leather Cloth Company (Limited)* v. *Hirschfeld*, loc. cit., and *supra*, p. 17.

(*u*) *Lee* v. *Haley*, L. R. 5 Ch. 155.

(*x*) *Rodgers* v. *Nowill*, 8 D. M. & G. 614.

(*y*) 12th July, 1861 (unreported), Reg. Lib, 1861, A. 1738.

plaintiff's delay in coming to the Court, but ordered the defendant to pay the costs of the motion.

Removal of marks.

It follows, from the terms of the injunction, that the defendant must remove the mark before parting with any of the goods to which it is wrongfully affixed (*z*). The Court may indeed order such goods to be destroyed (*a*), but it probably will only do this in an extreme case. The plaintiff is also entitled to a discovery upon oath of all labels improperly bearing his trade-mark which are in the possession or power of the defendant, and of all stamps, &c., used for impressing the trade-mark, and to have such labels, stamps, &c., cancelled and defaced at the defendant's expense (*b*).

Account.

A court of equity will not only grant an injunction to restrain the use of a trade-mark, but will also require a dishonest defendant to account for the profits which he has made by the improper use of it. In *Farina* v. *Silverlock* (*c*), it was argued that the injunction was ancillary to the account, and that if no account were asked for, no injunction could be granted; but this was not acceded to, and in very many cases an injunction has been obtained, though the account was waived. In *Delondre* v. *Shaw* (*d*), the same argument was used. There Delondre had employed a celebrated French chemist Pelletier, to make for him sulphate of quinine, which Delondre sold in England for his sole benefit. The bottles had on the cork a seal with the words—

(*z*) See *Ponsardin* v. *Peto*, 33 Beav. 642; *Upmann* v. *Elkan*, L. R. 12 Eq. 140, on appeal, L. R. 7 Ch. 130, 20 W. R. 137.

(*a*) 25 & 26 Vict. c. 88, s. 21.

(*b*) See the decree in *Emperor of Austria* v. *Day*, Seton, 938.

(*c*) 1 K. & J. 509.

(*d*) 2 Sim. 237.

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"Produits Chimiques de J. Pelletier. J. P."—and a label was pasted upon the bottles, inscribed—"Sulphate de Quinine, Auguste Delondre, negt., à Paris." The defendants engraved and printed seals and labels resembling these. It was held, that Pelletier having no interest in the account, was improperly joined as a co-plaintiff with Delondre in a bill seeking an injunction and account. It is conceived, however, that Pelletier might, according to the present practice, maintain a suit to restrain the wrongful use of his name, and have an inquiry as to damages.

The defendant will not be compelled to account for profits made by the use of the trade-mark, so long as he was unaware that it was a trade-mark at all (*e*). But the burden of proving this lies upon him, and it is not sufficient to show that he was ignorant of the rights, or even of the existence, of the plaintiff (*f*). The plaintiff is not entitled to the whole of the profits made upon the sale of goods wrongfully marked, but only to the extra profit arising from the use of the trade-mark (*g*). But upon the principle *omnia præsumuntur contra spoliatorem* (*h*), it is conceived, that it lies upon the wrongdoer to show that in the absence of the trade-mark, he would have made any profit at all (*i*). The account cannot be taken beyond six years before bill filed (*f*). A defendant ordered to account cannot be

(*e*) *Edelsten* v. *Edelsten*, 1 D. J. & S. 185; *Moet* v. *Couston*, 33 Beav. 578, 4 N. R. 86. The ground on which the judge distinguished this case from *Cartier* v. *Carlile* (loc. cit.) is omitted from Mr. Beavan's report.

(*f*) *Cartier* v. *Carlile*, 31 Beav. 292.

(*g*) *Cartier* v. *Carlile* (loc. cit.).

(*h*) *Armory* v. *Delamirie*, 1 Strange, 505.

(*i*) As to one of several co-owners of a trade-mark suing for an account, see *infrà*.

charged with bad debts as profits, but he is not entitled to charge the plaintiff with the cost of manufacturing the goods in respect of which the bad debts were incurred (*k*).

Injunction against printers, &c.

The owner of a trade-mark is entitled to an injunction against a person, such as a printer of labels or an engraver, who knowingly enables another to appropriate his trade-mark. The use of the labels or instruments for impressing the mark will be prohibited, and in general by an interlocutory injunction. At the hearing, the labels, or the stamps, dies, or other instruments, will be ordered to be cancelled and defaced, but the plaintiff is bound to show that the defendant threatens and intends to make an improper use of them (*l*).

Consignees.

An injunction may be obtained against a consignee, wharfinger, or other innocent person having in his hands or under his control goods wrongfully branded, restraining him from parting with them until the brand is removed. It is his duty as soon as he becomes aware of the wrongful use of the trade-mark, to give the owner of it all the information in his power, that may enable him to discover the guilty parties, or prevent the infringement of the trade-mark, and to undertake not to part with the goods until the brand has been removed, and to offer to give all facilities to the person injured, for the purpose. If, after this, the trade-mark-owner files a bill, in general the defendant will not have to pay costs, and

(*k*) *Edelsten* v. *Edelsten*, 10 L. T. N. S 780.

(*l*) *Farina* v. *Silverlock*, 1 K. & J. 509, 6 D. M. & G. 214, 4 K. & J. 650; *Emperor of Austria* v. *Day*, 3 D. F. & J. 217; *Gout* v. *Aleploglu*, 6 Beav. 79, note; *Delondre* v. *Shaw*, 2 Sim. 237, can hardly be considered an authority to the contrary.

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Action against wharfinger restrained.

the plaintiff may have to pay them (*m*). A wharfinger, who refused to deliver, though before an injunction against him was obtained, was held entitled upon a bill filed by him, to restrain an action for non-delivery (*n*).

Rights of third party.

If a third person acquires rights over goods wrongfully branded, without notice that the trade-mark is improperly affixed to them, he can deal with the goods according to his rights, subject only to the obligation of removing the mark. Thus, if the dock warrants of such goods have been deposited with him as a security, he will be entitled to the possession of the goods after the mark is removed and after paying the wharfinger's charges. In *Ponsardin* v. *Peto* (*o*), which was a suit to restrain the wrongful use of a champagne brand, the innocent mortgagee, who was not a party, was allowed, but as it seems by consent (*p*), to intervene by motion, *pro interesse suo*, on paying the costs of all parties of the motion. Sir John Romilly, M.R., there held, that the charges upon the goods ranked as follow:—the charges of the dock company, including their costs of suit; the monies advanced by the intervening mortgagee, including the costs of the motion which he was ordered to pay in the first instance; the plaintiff's costs of suit (*q*).

Innocent infringer.

If the defendant has actually infringed the plaintiff's trade-mark, whether knowingly or not, the plaintiff is entitled to a perpetual injunction, and is not bound to rest satisfied with the defendant's promise to commit no

(*m*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140, on appeal, 20 W. R. 134, L. R. 7 Ch. 130. As to costs, see further *infrà*.

(*n*) *Hunt* v. *Manière*, 34 Beav. 157.

(*o*) 33 Beav. 642, 33 L. J. Ch. 371, 3 N. R. 237.

(*p*) See 3 N. R. 238.

(*q*) 33 L. J. Ch. 371.

further infringement (*r*), but as against an innocent defendant, he is not entitled to an account or damages (*s*). Such a defendant, therefore, if he does not resist the injunction, should offer to appear and consent to a perpetual injunction on motion (*t*), and to pay all costs up to and including those of obtaining the injunction (*u*). If, after this, the plaintiff unnecessarily brings the cause to a hearing, he will not get any more costs than he would have got under the defendant's offer (*x*). Indeed, in *Millington* v. *Fox* (*y*), a plaintiff in such a position was refused costs altogether, notwithstanding he was held entitled to an injunction. But there were special circumstances, and the case has not been considered as laying down a general rule (*z*). Under the present practice, a suit can generally be brought on without any unnecessary expense, by motion for decree. The defendant, if he has done all that can be required of him, may himself move to stay proceedings (*a*), though he must pay the costs of the motion (*b*). But where the answer may be of use to the plaintiff in working out his

Staying proceedings.

(*r*) *Geary* v. *Norton*, 1 De G. & Sm. 9; *Burgess* v. *Hills*, 26 Beav. 244; *Burgess* v. *Hately*, ibid. 249; *Moet* v. *Couston*, 33 Beav. 578; but see *Upmann* v. *Elkan*, L. R. 7 Ch. 130, 12 Eq. 140, and *Nunn* v. *D'Albuquerque*, 34 Beav. 595.

(*s*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Moet* v. *Couston* (loc. cit.).

(*t*) *Leaf* v. *Taylor*, Seton on Decrees (3rd edit.), 944; *Webb* v. *Thorpe*, ibid.

(*u*) *Collins Company* v. *Walker*, 7 W. R. 222; *Pierce* v. *Franks*, 15 L. J. Ch. 122.

(*x*) *Colburn* v. *Simms*, 2 Hare, 543; *Pierce* v. *Franks* (loc. cit.).

(*y*) 3 Mylne & Craig, 338.

(*z*) See *Colburn* v. *Simms*, 2 Hare, 561.

(*a*) *Wallis* v. *Wallis*, 4 Dr. 458.

(*b*) See *Hume* v. *Beale*, Seton on Decrees (3rd edit.), 944.

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rights under the decree, as in the case of a decree to account, a defendant, required to answer, is not in a position to require proceedings to be stayed until he has put in a sufficient answer (*c*). In the case of a *mala fide* defendant, the plaintiff may both exact an answer, and in addition to an injunction, is entitled to an account or inquiry as to damages, and in some cases, as we have seen, to other relief. He may therefore, in general, bring the suit to a hearing, in order to obtain such additional relief. Even in this case, he is not at liberty to vex the defendant unnecessarily. If, therefore, the defendant offers to submit to a perpetual injunction with costs, and at the time of the offer, or subsequently on the answer coming in, it was clear that any relief beyond this, such as an account or inquiry as damages, would be barren; the plaintiff at the hearing will run the risk of getting no more costs than he would have got had he accepted and acted upon the offer (*d*).

Negotiations.

Except in cases of bad faith, negotiations antecedent to the suit cannot be taken notice of, unless they amount to a binding release of the cause of suit (*e*).

In a case where the plaintiffs failed because their mark contained a misrepresentation, but the Court did not approve of the defendant's conduct, the bill was dismissed without costs (*f*).

(*c*) *Kelly* v. *Hutton*, 1 Y. & C. C. C. 197; *Stephens* v. *Brett*, 10 L. T. N. S. 231, 12 W. R. 572.

(*d*) *Colburn* v. *Simms*, 2 Hare, 543, 561.

(*e*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *McAndrew* v. *Bassett*, 4 N. R. 12. In *Williams* v. *Thomas*, 2 Dr. & Sm. 29, 37, the plaintiff was not entitled to an injunction.

(*f*) *Leather-Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, 33 L. J. Ch. 199, 203. See *Morgan* v. *McAdam*, 36 L. J. Ch. 228, 233.

CHAPTER IV.

WHAT IS A TRADE-MARK.

Uncertainty of what is a trade-mark.

It is not easy to say what is a trade-mark, in consequence partly of its depending so much on circumstances and the mode of user; partly of the early decisions having proceeded on the ground of misrepresentation and negatived any exclusive right in the name. For instance, the plaintiff was held to have no exclusive right to the name "Velno's Vegetable Syrup," and the defendant was allowed to sell it, if he did not represent it to be of the plaintiff's manufacture (*a*). The general principle applicable to all cases of trade-marks and similar rights is, that no one is permitted to appropriate the benefit of another's reputation by adopting or closely imitating the insignia under which that other sells his goods or carries on his business. The term trade-mark was no doubt in the first instance applied to cases where a trader marked his goods with some arbitrary sign, such as a lion or an anchor, which became known in the market as his mark (*b*). But the law which was originally applied to simple cases of this kind has been extended to cases in which the term trade-mark would not generally be used in reference to the subject imitated. The name, colour, and general appearance of a line of

(*a*) *Canham* v. *Jones*, 2 Ves. & B. 218.

(*b*) See *Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*), 11 H. of L. 538.

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omnibuses (*c*), or the title of a magazine (*d*), are instances of this.

This distinction, however, is not of much practical importance, and we shall use the term trade-mark, or some other word, so as to comply as nearly as may be with ordinary usage. But there is another division of trade-marks and similar insignia which will be found to be of some importance. They are either arbitrary and unmeaning, as a lion or anchor, or they contain a statement of fact. As trade-marks of the former kind any unmeaning device, letters, or combination of letters and numbers may be used (*e*).

Arbitrary trade-marks.

Fancy names.

So, also, any fancy name not before applied to the article in question may be adopted, as "Howqua's Mixture" (*f*), "Medicated Mexican Balm" (*g*), "Excelsior Soap" (*h*), but words in common use, indicating quality, as "superior," "superfine" (*h*), or the material of the manufacture, as "paraffin" (*i*), or even fancy names in common use in any particular trade (*k*) cannot be appropriated for purposes for which they are in common use. The word "pessendede," Turkish for warranted, was protected in the case of watches intended for the Turkish market, but possibly only in conjunction with the other words and devices (*l*).

(*c*) *Knott* v. *Morgan*, 2 Keen, 213.

(*d*) *Maxwell* v. *Hogg*, L. R. 2 Ch. App. 307.

(*e*) *Ransome* v. *Bentall*, 3 L. J. Ch. 161; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518.

(*f*) *Pidding* v. *Howe*, 8 Sim. 447.

(*g*) *Perry* v. *Truefitt*, 6 Beav. 73.

(*h*) *Braham* v. *Bustard*, 1 H. & M. 453; *Hirst* v. *Denham*, L. R. 14 Eq. 542.

(*i*) *Young* v. *Macrae*, 9 Jur. N. S. 322.

(*k*) *Williams* v. *Osborne*, 3 L. T. N. S. 498.

(*l*) *Gout* v. *Aleploglu*, 6 Beav. 69, note. See *Broadhurst* v. *Barlow*, W. N. 1872, p. 212.

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Local Names.

The name of a country from whence the material for the goods comes cannot be adopted, if it is the only country from whence the goods come, or if it is required for, or is usually adopted as, a designation of the goods or the material for them, as "Burgundy" for the wine of that country. But otherwise a name of a country, as "Anatolia" (*m*) (the old name of Anadoli), or of a district, as "Seixo," may be used (*n*).

A local name may of course be used, when it is employed, not in its ordinary meaning, but in a metaphorical or purely arbitrary manner, as "Ethiopian" (*o*), applied to black stockings, or "Belgravia" (*p*), as the title of a magazine (*q*).

Names derived from persons.

Cases not unfrequently occur in which a new article, the manufacture of which is sometimes a secret, is brought into the market and designated by the name of the inventor, or by some other distinctive appellation. If the article is not protected by a patent, and there is no secret as to its composition, any one else may make and sell it. If there is a secret, any one who becomes possessed of it without fraud or breach of trust (*r*) may, unless restricted by agreement or on the ground of trust (*s*), make use of it. And in either case, if the

(*m*) *McAndrew* v. *Bassett*, 33 L. J. Ch. 561, 4 N. R. 12, 123, 4 De G. J. & S. 380. (*n*) *Seixo* v. *Provezende*, L. R. 1 Ch. App. 192.

(*o*) *Hine* v. *Lart*, 10 Jur. 106.

(*p*) *Maxwell* v. *Hogg*, L. R. 2 Ch. App. 307.

(*q*) Motions for injunction were unsuccessful in the following cases: *Colonial Life Assurance* v. *Home and Colonial Assurance Company (Limited)*, 33 Beav. 549, 33 L. J. Ch. 741; *London and Provincial Law Assurance Society* v. *London and Provincial Joint Stock Life Assurance Company*, 11 Jur. 938; *London Assurance* v. *London and Westminster Assurance Corporation (Limited)*, 32 L. J. Ch. 664.

(*r*) *James* v. *James*, L. R. 13 Eq. 421, 20 W. R. 434.

(*s*) *Morison* v. *Mout*, 9 Hare, 241.

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article is commonly known by the name which the introducer first gave it, though this will not make the name common property (*t*), yet any subsequent dealer may, it seems, use this name, provided he does not lead the public to believe that the article in which he deals has been made or sold by the original inventor or his trade-successors (*u*), and does not call his manufacture "the only genuine" article (*v*). Thus, in *Edelsten* v. *Vick* (*x*), a property was successfully asserted in the name of a particular description of solid-headed pins, called "Tayler's pins," but Wood, V.-C., thought that there would be no objection to such an announcement as this—"I, John Smith, manufacture and sell Tayler's solid-headed pins" (*y*). This is pretty nearly what happened in *Stokes* v. *Landgraff* (*z*), where the plaintiff, a glass manufacturer, invented and used certain peculiar names of quality, such as "Lake," "Cylinder," which came into common use among glass-manufacturers as designations of quality. It was held, that the defendant was entitled to sell his glass as "Landgraff's Lake," or "Landgraff's Cylinder." It seems that if an article is made according to a secret recipe, and the inventor gives it a fancy name, but through acquiescence or otherwise the right of property in the name ceases, he and his trade-successors having the recipe, are alone

(*t*) *Millington* v. *Fox*, 3 My. & Cr. 338.

(*u*) *Leather Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, 11 H. of L. 539; *James* v. *James*, L. R. 13 Eq. 421; *Canham* v. *Jones*, 2 V. & B. 218; *Green* v. *Rooke*, W. N. 1872, p. 49; *Liebig's Extract of Meat Company* v. *Hanbury*, 17 L. T. N. S. 298.

(*v*) *James* v. *James* (loc. cit.), but see *Seeley* v. *Fisher*, 11 Sim. 581 *ad fin.*

(*x*) 11 Hare, 78.

(*y*) 11 Hare, 85.

(*z*) 17 Barbour, S. C. 609 (Am.).

entitled to use the word "original" in conjunction with the name (*a*). In a case where the article was called by the name of the inventor, the Master of the Rolls considered that any one who had honestly acquired a knowledge of the recipe might sell the article under this name *simpliciter* after the inventor's death (*b*). A name may be common property as between wholesale and retail dealers, but not common as between retail dealers and the public (*c*).

Trade-marks involving statement of fact.

The second division of trade-marks or insignia comprises those which contain some statement of fact. Thus, in some cases, the name of an article implies that it is protected by a patent, as "Patent Plumbago Crucibles" (*d*) or "Flavel's Patent Kitchener" (*e*). Of a similar character are labels on reels of cotton containing numbers expressing the quantity upon the reel, or the words "J. R. & C. P. Crocketts, Manufacturers" (*f*) as part of the stamp upon leather cloth.

Direct and formal statements are also frequently annexed to the article, as testimonials, directions for use (*g*), statements as to the composition of the article (*h*), or the origin of the recipe under which it is made (*i*).

(*a*) *Cocks* v. *Chandler*, L. R. 11 Eq. 446; *Lazenby* v. *White*, therein cited. But see *Browne* v. *Freeman*, 4 N. R. 476, 12 W. R. 305.

(*b*) *James* v. *James*, L. R. 13 Eq. 421, 20 W. R. 434.

(*c*) *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*d*) *Morgan* v. *McAdam*, 36 L. J. Ch. 228.

(*e*) *Flavel* v. *Harrison*, 10 Hare, 467.

(*f*) *Leather Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, 11 H. of Lds. 523.

(*g*) *Franks* v. *Weaver*, 10 Beav. 297; *Sedon* v. *Senate*, cited 2 Ves. & Bea. 220; *Abbott* v. *Bakers' and Confectioners' Tea Association*, W. N. 1871, p. 207: 1872, p. 31.

(*h*) *Pidding* v. *How*, 8 Sim. 447.

(*i*) *Perry* v. *Truefitt*, 6 Beav. 73.

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Protection is not afforded to distinctive insignia of this kind if they contain in themselves false statements, or are calculated to mislead the public as to material facts (*j*).

Thus, where a plaintiff issued false statements respecting the composition of "Howqua's Mixture" tea (*k*), and the origin of the recipe for "Medicated Mexican Balm" (*l*), he was left to bring his action and refused an injunction in the meantime; but on the other hand, extravagant representations respecting the value and effect of a plaintiff's medicine (*m*) did not deprive him of an immediate remedy, being, probably, looked upon as mere puffing; so also with the name of a fictitious person, as the editor of a magazine (*n*).

"Patent."

Where the word "patent" forms part of the trade-mark, and either no patent has ever been taken out (*o*), or the word is only adopted after a patent has expired (*p*), the trade-mark will be refused protection. Under the old practice, protection was refused until the plaintiff established his right by an action at law. Where a patent has been taken out, and the trade-mark becomes established during the existence of it, it is not quite clear whether the word patent may continue to be used after its expiration (*q*) or not. If it is desired to be so used,

(*j*) *Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*), 11 H. of Lds. 523, 543.

(*k*) *Pidding* v. *How*, 8 Sim. 477.

(*l*) *Perry* v. *Truefitt*, 6 Bea. 73, 418.

(*m*) *Holloway* v. *Holloway*, 13 Bea. 209.

(*n*) *Hogg* v. *Kirby*, 8 Ves. 215.

(*o*) *Flavel* v. *Harrison*, 10 Hare, 467.

(*p*) *Edelsten* v. *Vick*, 11 Hare, 78.

(*q*) It was said that it might by Wood, V.-C., in *Edelsten* v. *Vick*, 11 Hare, 78, but the decision has been questioned by Lord Kingsdown in *Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*), 11 H. L. 533; and Wood, V.-C., in a subsequent case of

the precaution should be taken of adding the date of the patent (*r*).

As since 1862 the Court of Chancery cannot retain a bill with liberty to bring an action, it is to be presumed that it will refuse to interfere altogether in cases where there is material misrepresentation by the plaintiff, or it may try the case before a jury.

In a case at law (*s*) the plaintiff having proved *mala fides* against the defendant, was allowed to recover, although his mark improperly contained the word "patent." But no objection seems to have been taken, on the ground that the use of the word "patent" was a fraud on the public, and the case, therefore, cannot be relied upon as an authority that the courts of law act, in such cases, upon different principles to the courts of equity.

Under the Merchandise Marks Act, 1862 (*t*), no person is liable to prosecution for counterfeiting a trade-mark which contains the word "patent" if that is a misrepresentation (*u*).

But fraud, in order to disentitle a plaintiff to protection in equity, must be embodied in the trade-mark, or the trade itself must be fraudulent. And in such a case the plaintiff cannot succeed at law. Mere collateral misrepresentations will not disentitle him to relief either at law or in equity (*x*).

Collateral misrepresentation.

Morgan v. *McAdam*, 36 L. J. Ch. 228, said that he only considered the word might continue to be used as part of the name of the article, as "patent pins."

(*r*) *Morgan* v. *McAdam*, 36 L. J. Ch. 228.

(*s*) *Sykes* v. *Sykes*, 3 Barn. & Cres. 541.

(*t*) 25 & 26 Vict. c. 88.

(*u*) *Morgan* v. *McAdam*, 36 L. J. Ch. 228.

(*x*) *Ford* v. *Foster*, L. R. 7 Ch. 711.

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Name, how far a trade-mark.

It is very common for a manufacturer to stamp his name on his goods, which in time becomes a trade-mark, and it is said by Wood, V.-C. (*y*) to be as strong an instance of trade-mark as can be suggested. But the simple use of the name causes great difficulty, because two traders may have the same name, and it is impossible to prevent a man from using his own name. The courts have, however, restrained persons from using their own names, even apart from a trade-mark, in such a manner as to represent their goods to be the goods of another, although that other was only the successor of the original maker, and had a different name (*z*). But they cannot go further, and such an injunction is not nearly so good a protection as an absolute one against all use. And it may be that stricter evidence of misrepresentation would be required in such a case, because the fact of misrepresentation does not necessarily follow from the sale under the given name, as it does where the seller has not the same name, or has imitated the mark (*a*). The name of a manufacturer, therefore, is not a trade-mark in quite the same sense as the mark of an anchor is.

By the French law for the registration of trade-marks, a name must be "Sous une forme distinctive."

The name of the place of manufacture may be adopted (*b*), and has this advantage, that where the name

(*y*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. Ca. 518.

(*z*) *Croft* v. *Day*, 7 Beav. 84; *Rodgers* v. *Nowill*, 6 De G. M. & G. 614; *Holloway* v. *Holloway*, 13 Beav. 209; *Churton* v. *Douglas*, Johns. 147; *James* v. *James*, L. R. 13 Eq. 421, 20 W. R. 434.

(*a*) See *Burgess* v. *Burgess*, L. J. Ch. 675; *Rodgers* v. *Nowill*, 6 Hare, 337; *Howe* v. *Howe Machine Company*, 50 Barbour, 236 (Am.)

(*b*) *Leather Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, 11 H. L. 523; *Motley* v. *Downman*, 3 My. & Cr. 1; *Wotherspoon* v. *Currie*, L. R. 5 Eng. & Ir. App. 508.

of a place in the United Kingdom forms part of a trade name or mark, counterfeits will be stopped at the Custom House (*c*).

Unauthorised use of name of a physician.

In the cases to which we have referred, a man has employed his name to designate goods or his business, but whether the Court of Chancery can restrain the unauthorised use of a name in other cases has been the subject of doubt. In *Clark* v. *Freeman* (*d*) the eminent physician, Sir James Clark, applied for an injunction to restrain the defendant from selling a quack medicine under the name of "Sir James Clarke's Consumption Pills," and from representing it as sold on his behalf or under his sanction and approbation. The defendant issued handbills calculated to create the impression that the pills were sold by the defendant as agent of Sir James Clark, and under his direct authority; and there was evidence that this impression had been actually produced. Lord Langdale, however, refused to interfere, on the ground that, as Sir James Clark did not manufacture or sell pills, there was no damage to property. The decision seems to be approved of by Lord Westbury (*e*), but has been questioned by Lord Cairns (*f*) and Sir R. Malins, the latter of whom says, "It is perfectly clear to my mind, at all events, that a man has a sufficient property in his own name to prevent another from falsely passing off, injuriously to his reputation, medicines as personally prescribed by him, which might cause a total loss of his professional character" (*g*).

(*c*) 35 & 36 Vict. c. 20, s. 4, and 16 & 17 Vict. c. 107, s. 44.
(*d*) 11 Beav. 112.
(*e*) 33 L. J. Ch. 200.
(*f*) *Maxwell* v. *Hogg*, L. R. 2 Ch. 310.
(*g*) *Springhead Spinning Company* v. *Riley*, L. R. 6 Eq. 551. As to

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There can be no doubt that issuing quack medicines under the name of an eminent physician is an impudent fraud upon the public, and one that may do harm to the ignorant and inexperienced, and it is to be regretted that the criminal law does not afford summary redress against such impostors. In *Lord Byron* v. *Johnston* (*h*) the Court acted upon the principle that it had jurisdiction to restrain the defendant from publishing, as Lord Byron's, poems which were not his; but the case is very shortly reported (*i*).

A defendant may be restrained from representing himself as successor to a person, who, in fact, has not retired from business at all (*j*).

The nature of the *jus in rem*, or property, which a person has in his own name will be readily understood, and in many cases it is protected by the laws against forgery, or by other criminal sanctions (*k*). The question, which will be discussed hereafter, how far names of individuals can be subjects of transfer, is not without difficulty.

Definitions in Act of 1862.

The Merchandise Marks Act, 1862 (*l*), contains the following definitions for the purposes of the Act, of the terms "mark" and "trade-mark."

the nature of professional reputation, see Austin on Jurisprudence, table ii. note 3, C.b. p. 980 (3rd edit.).

(*h*) 2 Mer. 29.

(*i*) See also *Archbold* v. *Sweet*, 1 M. & R. 162, and *Prince Albert* v. *Strange*, 1 Mac. & Gor. 25, 40; *Routh* v. *Webster*, 10 Beav. 561; *Dixon* v. *Holden*, L. R. 7 Eq. 488; *Mulkern* v. *Ward*, L. R. 13 Eq. 619.

(*j*) *Harper* v. *Pearson*, 3 L. T. N. S. 547; and see *Edgington* v. *Edgington*, 11 L. T. N. S. 199; and *Christie* v. *Christie*, W. N. 1873, p. 7; and as to "Agent" see *Wheeler and Wilson Manufacturing Company* v. *Shakespear*, 39 L. J. Ch. 36.

(*k*) *McAndrew* v. *Bassett*, 33 L. J. Ch. 566, 4 N. R. 14. See the last paragraph but one of the judgment.

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

The word "mark" shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any 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 of any other description, lawfully used by any person to denote any chattel or, in Scotland, any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, production, or merchandise of such person, or to be an article or thing of any peculiar or particular description, made or sold by such person, and shall also include any name, signature, word, letter, number, figure, mark, or sign, which in pursuance of any statute or statutes for the time being in force relating to registered designs, is to be put or placed upon or attached to any chattel or article during the existence or continuance of any copyright or other sole right acquired under the provisions of such statutes, or any of them." By section nine there is excepted from this definition "any name, word, or expression, generally used for indicating such chattel or article to be of some particular class or description of manufacture only."

Name of company.

No company can be registered in accordance with the Companies Act of 1862, under a name identical with that of a pre-existing company, or so nearly resembling it as to be likely to mislead the public (*m*).

Complex insignia.

Most of the cases of trade-marks or insignia with which we have hitherto had to deal, have been of a simple character, so far as regards external appearance.

(*m*) 25 & 26 Vict. c. 89, s. 20.

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But cases occur where they are of a more complex nature, and it will be useful to refer particularly to some peculiar instances of this sort.

Titles of periodicals.

The cases of magazines, newspapers, and other periodicals, are among the earliest instances in which property in a name or title was recognised and protected by the Court of Chancery. In *Hogg* v. *Kirby* (*n*), the plaintiff was the proprietor of a work published in monthly numbers, under the title of the "Wonderful Magazine." The defendant published the first five numbers by agreement with the plaintiff, after which the agreement was determined, and the defendant ceased to be the publisher. The fifth number was published in December 1802, and on the 1st of January 1803 the defendant published the first number of a monthly periodical, called "The Wonderful Magazine, New Series, Improved." This publication, though not exactly similar to the plaintiff's, was so contrived as to lead to the belief that it was in continuation of the plaintiff's publication. The device on the cover was the same, though not exactly similar in the execution. Kirby's number took up the same article in continuation which had been left unfinished in the middle of a sentence by the plaintiff's fifth number, and commenced with the word at the bottom of the last page. A description and a print of a remarkable character were introduced, which had been promised in the plaintiff's fifth number, as part of the contents of the sixth. The defendant's number also contained in a separate half-sheet, a short index of the contents of the plaintiff's first five numbers, under the name of an index to the first part. The execution of the two works was generally similar.

(*n*) 8 Ves. 215. See, too, *Mack* v. *Petter*, L. R. 14 Eq. 431.

Lord Eldon granted an injunction restraining the defendant, not only from publishing any copy of the plaintiff's work, but also "from printing, publishing, or exposing to sale, any other work or publication, as, or being, a continuation of the plaintiff's work." The ground of the decision as stated by Lord Eldon in the judgment, and as further explained in *Longman* v. *Winchester* (*o*), was that the defendant's publication had been "handed out to the world as the continuation of the plaintiff's work." In *Edmonds* v. *Benbow* (*p*), a similar injunction was granted in the case of a newspaper called "The Real John Bull;" and the proprietors of "Bell's Life in London and Sporting Chronicle," obtained an injunction against the publishers of the "Penny Bell's Life and Sporting News," restraining them from publishing a newspaper under any title, of which the words "Bell's Life" formed part (*q*).

Fraudulent publication of old edition.

The publication of an old edition in which the copyright is expired, as a later edition in which there is a subsisting copyright, will be restrained, but an advertisement stating that any additional matter contained in the later edition, is spurious and of no value, is no subject for an injunction, although, if untrue, it may found an action for libel (*r*).

(*o*) 16 Ves. 269, 271. See, too, *Crutwell* v. *Lye*, 17 Ves. 335, 342.

(*p*) 20 Feb. 1821, A. 572; Seton on Decrees (3rd edit.), 905.

(*q*) *Clement* v. *Maddick*, 1 Gif. 98: better reported 5 Jur. N. S. 594; *Prowett* v. *Mortimer*, 2 Jur. N. S. 414. Injunctions were refused in *Spottiswoode* v. *Clarke*, 2 Ph. 154; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Bradbury* v. *Beeton*, 39 L. J. Ch. 57; and in *Noah* v. *Snowden*, Hopkins, 347 (Am.). See, too, *Keene* v. *Harris*, cited 17 Ves. 338; and as to degree of resemblance, *Ingram* v. *Stiff*, 5 Jur. N. S. 947; and as to transfer of title of a newspaper, see *infra*.

(*r*) *Seeley* v. *Fisher*, 11 Sim. 581.

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Name, &c., of song.

Music publishers who had adopted original words to an old American air, which was re-arranged for them, and had given to the song so composed, the name of "Minnie," and procured it to be sung by a popular singer in London, by which means it became a popular song, published it with a title page containing a picture of the singer and the words "Minnie, sung by Madame A. T. and Miss D., at Jullien's concerts, written by George Linley," &c. It was held that they had acquired a property in the name, title, and title-page of the song which a rival music publisher would be restrained from invading (*s*).

Name and sign of hotel.

Property of the kind which we are considering, exists in the name and sign of an hotel. Thus, the proprietor of an hotel, which he opened as "Irving House," but which became generally known as "Irving Hotel," was held to have a property in both names (*t*). In *Knott* v. *Morgan* (*u*),

Of an omnibus.

the plaintiffs and defendant both ran omnibuses between Paddington and the Bank. The defendant was restrained from running omnibuses having upon them such names, words, and devices as to form a colourable imitation of the names, words, and devices on the omnibuses of the plaintiffs. In an American case of *Marsh* v. *Billings* (*x*), the plaintiffs agreed with the proprietor of an hotel in Boston, called "Revere House," to provide coaches at a railway station to convey customers to the hotel, and the proprietor authorised them to put upon their coaches and the caps of the attendants, as a

(*s*) *Chappell* v. *Sheard*, 2 K. & J. 117; *Chappell* v. *Davidson*, ibid. 123; 8 De G. M. & G. 1.

(*t*) *Howard* v. *Henriquez*, 3 Sandf. S. C. 727 (Am.); *Woodward* v. *Lazar*, 21 California Rep. 449 (Am.).

(*u*) 2 Keen, 213. See the observations of Wood, V.-C., on this case in *Woollam* v. *Ratcliff*, 1 H. & M. 261.

(*x*) 7 Cushing, 322.

badge, the words "Revere House." The defendant also ran coaches from the station to the hotel, and he put the words "Revere House" upon them, and upon the caps of his attendants. It was held, that the plaintiffs were entitled to recover damages against the defendant, for using these words, so as to lead passengers to believe that he had the patronage of the hotel for the conveyance of passengers. A trader who has adopted a peculiar and distinctive mode of making up or packing his goods, is entitled to restrain an exact or colourable imitation of it (*y*).

Mode of packing.

Currency of a foreign state.

A foreign State has a property in the credit of its currency, and can therefore obtain from the Court of Chancery an injunction restraining the issue of spurious notes, which purport to be, and are likely to be taken to be, issued by the public authority of the State (*z*). This right is in most cases protected by the criminal law, and consequently it is only in an exceptional case that the Court of Chancery is appealed to. The Crown, it is conceived, has similar rights in respect of the currency of this country, but no case has arisen in which they have been vindicated through the civil tribunals.

(*y*) *Woollam* v. *Ratcliff*, 1 H. & M. 259; *Abbott* v. *Bakers' and Confectioners' Tea Association*, W. N. 1871, p. 207: 1872, p. 31.

(*z*) *Emperor of Austria* v. *Day*, 3 De G. F. & J. 217.

CHAPTER V.

ACQUISITION AND TRANSFER OF TRADE-MARKS.

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Trade-mark, how far property.

A TRADE-MARK has been established, as before stated, to be property, but it is not property for all purposes. It is merely the exclusive right of applying a particular mark to particular goods, and the owner of such right has no interest in the mark independently of such application. It has been compared to a singer's voice (*a*), a copyright, or a patent (*b*). It differs from a copyright and patent, as in those cases the author or inventor has benefited the public by the invention of something new, to the reproduction of which he has an exclusive right. A trade-mark is primarily for the benefit of the trader alone, is not new, and may be used for other manufactures.

Different from patent.

In some cases it has been argued that a trade-mark, if it is property, must be a monopoly like a patent, but a patent excludes other persons from making the same article, and improvements on the same article. A trade-mark excludes no one from making the same article, but only from using the same mark or designation for it. Even if a man has a right to the name of the article, as, for instance, some particular medicine, there is nothing to prevent any one making the same medicine, or an im-

(*a*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 525.
(*b*) See 11 Ho. of Lds. 533.

provement of the same medicine, and selling it as equal to, or better than the original medicine (*c*), only he must do so honestly, and not print the "equal to," in very small letters and the name of the original medicine in very large letters (*d*).

The object of a patent is to secure to an inventor the pecuniary benefit of his invention; the object of a trade-mark is to secure to a trader the benefit of his reputation and to protect the public from fraud or deception on the part of a rival trader.

Acquisition of trade-mark by use.

A trade-mark is therefore more like the goodwill of a trade, and is acquired not by invention but by use and the knowledge of such use in the market. Thus, it has been said that a person has no right to prevent even the use of his own name, unless with reference to the same class of goods as are actually manufactured by him (*e*). The reason given is that pecuniary injury to the plaintiff is necessary to ground any relief at law or equity, and unless there is actual known user in the market, there can be no pecuniary injury to the plaintiff by the use of his name or mark by another.

Long use is not required; it is only necessary that the article should have been brought into the market under the trade-mark (*f*). And, indeed, the fact that a person finds it worth his while to imitate a trade-mark is sufficient to show that it is known in the market (*g*).

(*c*) *Edelsten* v. *Vick*, 11 Hare, 85.

(*d*) *Day* v. *Binning*, C. P. Cooper, 39.

(*e*) *Clark* v. *Freeman*, 12 Beav. 112; *Leather Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, 33 L. J. Ch. 200.

(*f*) *Hall* v. *Barrows*, 33 L. J. Ch. 548. See *Purser* v. *Brain*, 17 L. J. Ch. 141; *Collins Company* v. *Brown*, 3 K. & J. 425.

(*g*) *McAndrew* v. *Bassett*, 33 L. J. Ch. 561, 568, 4 De G. J. & S. 380. See *Hine* v. *Lart*, 10 Jur. 106.

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But mere advertisement prior to use is not sufficient (*h*).

Trade-marks, titles of periodicals, etc., have sometimes been registered under the Copyright Act (*i*), but it is clear that no right is obtained by this means, and the proceeding seems quite useless (*k*).

Proof of use.

As a trade-mark is acquired by use, it is necessary for the plaintiff, in all suits for infringement, to show that he or his predecessors used the mark before the defendant, and that it was known in the market to be so used, a proof which frequently causes some trouble and expense. For although the Courts are inclined to presume from the fact of imitation that it was so well known as to be worth imitating, there are cases where the mark is alleged to be common property as the name of a particular quality of goods (*l*).

Duration of right.

A person who has acquired a right to a trade-mark retains that right only while he continues to use the mark; if he discontinues the use, he loses the right of preventing others from using it. The proper test of this having happened is, that the use of the trade-mark by other persons has ceased to deceive the public as to the maker of the article, and the exclusive right to the use of a fancy name as a trade-mark is not lost by the inventor habitually using it in conjunction with his own name as maker of the article (*m*).

Origin of

Trade-marks may be acquired both by design and ac-

(*h*) *Maxwell* v. *Hogg*, L. R. 2 Ch. 307.

(*i*) 5 & 6 Vict. c. 45.

(*k*) *Maxwell* v. *Hogg*, L. R. 2 C. A. 307; *Kelly* v. *Hutton*, L. R. 3 Ch. 708.

(*l*) *Hillington* v. *Fox*, 3 My. & Cr. 338.

(*m*) *Ford* v. *Foster*, L. R. 7 Ch. 611.

cidentally. For instance, in *Edelsten* v. *Edelsten* (*n*) the plaintiff having used designedly an anchor as a trade-mark for his wire, his wire consequently became known as "anchor wire," or "anchor brand wire." And he was held to have a trade-mark in these names which had grown up accidentally, as well as in the anchor (*o*).

Transmission of trade-marks.

In a great number of the cases where persons have complained of infringements of their trade-marks, they were not the original owners of the trade-marks, but the successors in business of the original owners. No question was ever raised to their right on this ground, but this may partly have been owing to their having themselves in all cases used the trade-mark.

It is, however, now established, that a trade-mark in the more limited sense of the term, that is to say, a mere arbitrary device or name, involving no statement of fact, may in all cases be transferred together with the goodwill or business to which it belongs (*p*). Indeed this principle was admitted as early as 1805, when it was decided in *Longman* v. *Tripp* (*q*) that the right to publish a newspaper under a given title was goods and chattels within the Bankruptcy Acts, and passed accordingly by the assignment of the bankrupt's property by the commissioners under the old law. For, as is observed by Wood, L. J., "There is nothing analagous to copyright in the name of a newspaper, but the proprietor

(*n*) 1 De G. Jo. & Sm. 185, 201.

(*o*) See, too, *Howard* v. *Henriquez*, 5 Sandf. S. C. 727 (Am.).

(*p*) *Hine* v. *Last* (1846), 10 Jur. 106; *Hall* v. *Barrows* (1863), 33 L. J. Ch. 205, overruling 32 L. J. Ch. 548; *Leather Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, 33 L. J. Ch. 199, 11 H. of Lds. 523.

(*q*) 2 Bos. & Pull. N. R. 67.

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has a right to prevent any other person from adopting the same name for any similar publication, and this right is a chattel interest capable of assignment" (r).

As to trade-marks, or insignia involving statements of fact, it is often said that they cannot be transferred, if the transfer would be a fraud upon the public. Such insignia, however, cannot be used even by the original inventor, if they are, or when they become untruthful (s), and of course a transferee takes them under a similar limitation. So that, as suggested by L. J. Turner (t), the restriction "applies rather to the use of the mark assigned than to the power of assigning it." Thus, the purchaser of a business is in general entitled to carry it on under the name or firm under which the vendor carried it on. If, however, the vendor's trade-mark were such as to imply that he personally took part in the business, it could not be used by the purchaser without modification. "The question in every such case must be whether the purchaser, in continuing the use of the original trade-mark would, according to the ordinary usages of trade, be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade-mark" (u).

Use of firm by transferee, or trade-successor.

So the use of the words "J. R. & C. P. Crockett, Manufacturers," as part of a stamp upon American cloth, by a company who had purchased part of the business established by J. R. and C. P. Crockett, was, under the circumstances, held to represent that the Crocketts per-

(r) L. R. 3 Ch. 708, and see *Ex parte Foss*, 2 De G. & Jo. 230; *Platt* v. *Walter*, 17 L. T. N. S. 157.

(s) *Ante*, p. 54.

(t) *Bury* v. *Bedford*, 33 L. J. Ch. 465, 469.

(u) 11 H. of Lds. 534. See *Bloss* v. *Bloomer*, 23 Barbour, 609 (Am.)

sonally were concerned in the manufacture of the goods, and thus to deprive the stamp of the right to protection (*v*). Again, a person like an artist, whose name is of value, as showing personal skill, cannot allow another to use it (*x*). There are, however, many cases in which a successor to a business, though he would not be at liberty to use *simpliciter* the name of a person identified with it, would still be entitled to denominate himself as successor to that person (*y*), and to prevent any one else from so describing himself (*z*). And a trade-mark which originally had a personal reference may eventually come to be a mere arbitrary trade-mark, passing in the market as nothing more than an indication of quality (*a*).

On the whole, therefore, it appears that by the usages of trade, a trade-mark, even if it consists of the name of one or more of a firm, will, in general, pass to the successors in business of the firm, although they bear a different name, because no one supposes that the members of a firm have necessarily the same name as a firm. If a member of a firm for valuable consideration releases to his co-partners, who continue to carry on the business, his interest in the name of the firm, he will be restrained from setting up a business under that name or otherwise inducing the public to believe that his business is identical with the business of the firm. In *Churton* v. *Douglas* (*b*), the defendant, John Douglas, was, under such circumstances, restrained

Release of interest in trade-name by co-partner.

(*v*) *Leather Cloth Company (Limited)* v. *American Leather Cloth Company (Limited)*, loc. cit.

(*x*) 11 H. of Lds. 545.

(*y*) *Hall* v. *Barrows*, 33 L. J. Ch. 204, 207.

(*z*) *Churton* v. *Douglas*, Johns. 174, 190.

(*a*) 33 L. J. Ch. 207.

(*b*) Johns. 174. See *Burrows* v. *Foster*, 1 N. R. 156.

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Trade-name, partnership assets.

from carrying on business under the firm of "John Douglas & Co.," though he really had partners (*c*). If a partnership is dissolved and the assets have to be sold, the trade-mark and the name and style of the firm must be included in the sale (*d*), and a partner, unless he has purchased them, will, after the sale, be excluded from further use of them (*e*); except that, if the name of one of the partners constituted the style of the firm, that partner will not be prevented from carrying on business in his own name, but he will not be at liberty to add anything to lead the public to the belief that his business is the same as the business of the late firm (*f*). But if the partners agree to divide the assets, each will have a right to use the trade-mark, even though the mark is the name of the firm, and one partner has the same name and the other partner a different one (*g*).

Trade-mark incident to certain works.

In *Motley* v. *Downman* (*h*), Lord Cottenham thought that the mark "M. C." on tin plates, having been always used by owners of particular works, had become attached to the works, and would, as a matter of course, be used by a lessee.

It was at one time considered that the assignment of a trade-mark was nothing more than a licence to the assignee to use it, and that, consequently, the assignor might continue to use it, unless he had contracted not to

(*c*) As to a stranger pretending to be "successor" to a subsisting firm, see *Harper* v. *Pearson*, 3 L. T. N. S. 547, and *ante*, p. 58.

(*d*) *Hall* v. *Barrows*, loc. cit.; *Bradbury* v. *Dickens*, 27 Beav. 53; but see *Lewis* v. *Langdon*, 7 Sim. 421, *et quære*; *Hookham* v. *Pottage*, L. R. 8 Ch. 910.

(*e*) *Hine* v. *Lart*, 10 Jur. 106.

(*f*) See *Labouchere* v. *Dawson*, L. R. 13 Eq. 322; *Johnson* v. *Helleley*, 34 Beav. 63, 2 D. J. & S. 446.

(*g*) *Banks* v. *Gibson*, 34 L. J. Ch. 592, 34 Beav. 566

(*h*) 3 My. & Cr. 1.

do so (*i*). But it is now established that the trade-mark passes as property by the assignment, and the seller will be restrained from using it himself (*k*); and he could not, therefore, ordinarily assign it to more than one person. But if a man has two places of business and one trade-mark, as he could devise so he could probably assign each business and the trade-mark to two separate persons.

Two owners of one trade-mark.

That he can devise it, was decided by Wood, V.-C., in the case of Mr. Dent, the clockmaker (*l*). There the devisee of each business was held entitled to sue separately against the infringer of their common trade-mark, for an injunction, an account of profits, and payment to the plaintiff of so much of the profits as he was entitled to. But there would obviously be great difficulty in ascertaining this proportion, and it seems that the devisees might, if they pleased, have sued jointly (*m*).

But many persons cannot be entitled to the same trade-mark, and partly on this ground it was held that there was no trade-mark in a prize medal (*n*).

Alien owner of trade-mark.

Questions have sometimes been raised as to the right of an alien to have his trade-mark protected, and it is now clearly settled that he has this right. The scientific division of rights into *jura in rem* and *jura in personam* must not be confounded with the old division of actions under English law into real and personal. As applied to an action, the word "personal" is used with some

(*i*) See 1 H. & M. 285.

(*k*) *Bury* v. *Bedford*, 33 L. J. Ch. 565. As to assignment by assignees in bankruptcy, see *Hudson* v. *Osborn*, 39 L. J. Ch. 79.

(*l*) *Dent* v. *Turpin*, 2 J. & H. 139, 30 L. J. Ch. 495; acc. *Southorn* v. *Reynolds*, 12 L. T. N. S. 75.

(*m*) 2 J. & H. 149.

(*n*) *Batty* v. *Hill*, 1 H. & M. 264.

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variety of meaning. Most frequently it designates an action which does not concern land or real estate. And a personal action of this kind for the violation, in this kingdom, of a right recognised by common law, may, in general, be maintained by an alien, though resident abroad, as well as by a subject (*o*). So that the action may be maintainable, although the right violated is a *jus in rem*, or partakes of the nature of property (*p*). An alien, therefore, though he does not carry on business here, and his goods are not sold here, may maintain an action or suit against any one who violates his trade-mark in this country, on the same principle as permits him to bring an action for libel or slander (*q*). In cases coming within the Merchandise Marks Act, 1862, the right of the alien is secured by statute (*r*).

(*o*) *Pisani* v. *Lawson*, 6 Bing. N. C. 90.

(*p*) See and consider *Emperor of Austria* v. *Day*, 3 De G. F. & J. 217; and *Jefferys* v. *Boosey*, 4 Ho. of L. 885.

(*q*) *Collins Company* v. *Brown*, 3 K. & J. 425; *Collins Company* v. *Cowen*, ibid. 428; *Collins Company* v. *Reeves*, 28 L. J. Ch. 56. The rule is the same in the American Courts; *Coats* v. *Holbrook* 2 Sandf. N. Y. 586; *Taylor* v. *Carpenter*, 2 Sandf. N. Y. 603, 11 Paige (N. Y.), 297; *Taylor* v. *Carpenter* (Massachusetts), 3 Story, 458; 2 Wood & Min. 7. As to alien enemy, see *Collins Company* v. Brown (loc. cit.).

(*r*) 25 & 26 Vict. c. 88, s. 22, and see definition of "person" in sect. 1.

CHAPTER VI.

INFRINGEMENT.

THE right of the owner of a trade-mark is, as we have seen, a *jus in rem*, that is to say, it springs from a command which is addressed by the State to its subjects in general, and, taking a simple case as a type, requires them to abstain from selling articles of the description to which the owner applies the mark under that mark, or under any other mark or device likely to be mistaken for it by ordinary observers. According to English law, a person who in fact violates a right of this kind in most cases renders himself liable to an action, although he may have had no intention of violating it, and may even have been unaware of its existence. Instances of this occur in the cases of trespass, and of infringement of patents or copyrights. But even in English law the rule is not universal, and it seems to have no place in the Roman system (*a*). It must not therefore be imagined that the right of a trade-mark-owner is anything else than a *jus in rem* or proprietary right, because cases may occur in which unlawful intention is a necessary element of infringement.

Trade-mark actually copied.

The cases in which names or arbitrary marks are appropriated without alteration by persons who have no right

(*a*) Dig. vi. tit. 1, l. 60; Dig. ix. tit. ii. l. 5, § 2, l. 7, § 2, l. 30, § 3; Dig. xxvi. tit. 7, l. ult.

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to use them, do not call for any further remark. Here, as we have seen, the *bona fides* of the defendant is in equity at all events no bar to the plaintiff's right to an injunction.

It happens, however, in far the larger number of cases that the infringement is intentional, and perpetrated with the view of defrauding the public. A court of justice, when this is established, naturally gives the wrong-doer the credit of doing something which had a tendency to effect the object he had in view, and seldom, if ever, stops to inquire whether the imitation is so clumsy as to be likely to mislead no one. So that very often the question of infringement practically resolves itself into a question of the defendant's intention. This is especially true where the imitation is not exact, but differences are introduced which the trade-mark-owner alleges to be colourable only and insufficient for his protection (*b*). In *Croft* v. *Day* (*c*) the defendant was charged with imitating the labels on the plaintiffs' blacking-bottles. The plaintiffs carried on business under the firm of Day and Martin, at 97, High Holborn; the defendant sold his blacking as of the manufacture of Day and Martin, 90½, Holborn Hill. In giving judgment, Lord Langdale observed:

Imitation with colourable variation.

"It is perfectly manifest that two things are required for the accomplishment of a fraud such as is here contemplated. First, there must be such a general resemblance of the forms, words, symbols, and accompaniments as to mislead the public; and, secondly, a sufficient distinctive individuality must be preserved, so as to procure for the person himself the benefit of that deception which

(*b*) *Wotherspoon* v. *Currie*, L. R. 5 Eng. & Ir. App. 508.
(*c*) 7 Beav. 83.

the general resemblance is calculated to produce. To have a copy of the thing would not do, for though it might mislead the public in one respect, it would lead them back to the place where they were to get the genuine article, an imitation of which is improperly sought to be sold."

It has clearly been laid down that to avoid infringement there must be such distinction between the two marks as will prevent the deception of an ordinary purchaser buying the goods over the counter, and not merely of a manufacturer or of a person who carefully inspects the two marks (*d*); but further than this it is impossible to give any definition of what degree of resemblance is necessary.

The difficulty of determining whether resemblance amounts to infringement is increased where that which the plaintiff claims as his peculiar mode of denotation consists of a combination of circumstances, such as method of packing, shape and colour of labels or wrappers, and the like, some of which are undoubtedly in general use in a particular trade. Here the plaintiff must point out some distinctive thing which the defendant has imitated, and in all the cases which have hitherto occurred the Court was satisfied that the plaintiffs' insignia had been intentionally imitated. This is analogous to what happens in the case of a book, such as a directory, a gazetteer, or a table of logarithms, compiled from open sources. The plaintiff in such a case must prove not only identity between his work and the defendant's, but also an *animus furandi* on the part of the latter (*e*).

(*d*) *Rodgers* v. *Nowill*, 6 Hare, 325; *Shrimpton* v. *Laight*, 18 Beav. 164; *Seixo* v. *Provezende*, L. R. 2 Ch. 196.

(*e*) *Cary* v. *Kearsley*, 4 Esp. 168; *Lewis* v. *Fullarton*, 2 Beav. 6; *Jarrold* v. *Houlston*, 3 K. & J. 708; *Kelly* v. *Morris*, L. R. 1 Eq. 697.

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As each case turns very much upon its own particular circumstances, and the decisions often depend on the union of several similarities, there is no advantage in referring to them in greater detail (*f*).

(*f*) The similarity has been discussed in the following cases:—*Hogg* v. *Kirby*, 8 Ves. 215 (magazine); *Spottiswoode* v. *Clarke*, 2 Ph. 154 (almanack); *Chappell* v. *Davidson*, 8 De G. M. & G. 1 (song set to music). The following relate to wrappers, stamps, &c.:—*Edelsten* v. *Vick*, 11 Hare, 78; *Shrimpton* v. *Laight*, 18 Beav. 164; *Franks* v. *Weaver*, 10 Beav. 297; *Woollam* v. *Ratcliffe*, 1 H. & M. 259 (a peculiar case); *Leather Cloth Company* (*Limited*) v. *American Leather Cloth Company* (*Limited*), 11 H. of Lds. 523; *Blackwell* v. *Crabbe*, 36 L. J. Ch. 504; *Foot* v. *Lea*, 13 Ir. Eq. 490; *Edelsten* v. *Edelsten*, 1 De G. Jo. & Sm. 185; *Wotherspoon* v. *Currie*, L. R. 5 Eng. & Ir. App. 508; *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (name and labels); *London and Provincial Law Assurance Society* v. *London and Provincial Joint Stock Life Insurance Company*, 11 Jur. 938 (name).

CHAPTER VII.

SPECIAL TRADE-MARKS.

Hallamshire Acts as to cutlers.

THERE are several Acts (*a*) relating to persons in Hallamshire, and within six miles' compass of the same, who make knives, blades, scissors, shears, sickles, cutlery, and all other wares of iron and steel. And by the last Act the Acts are extended to persons exercising the trade of manufacturers of steel, of saws and edge tools and other articles of steel and iron combined having a cutting edge.

The Acts incorporate the persons exercising the above trades as the masters, wardens, searchers, assistants, and commonalty of the company of cutlers of Hallamshire, and provide for the election of a governing body and the regulation of apprentices and their admission as freemen.

Formerly a person not a freeman of this company could not carry on any of the above trades in Hallamshire, or within six miles of it, except by licence of the company. This was repealed in 1814, and by the last Act any person may become a freeman of the company on payment of 20*l*.

One of the privileges of a freeman of the company was

(*a*) 21 Jac. 1, c. 21; 31 Geo. 3, c. 58; 41 Geo. 3, c. lxvii.; 54 Geo. 3, c. cxix.; 23 Vict. c. xliii.

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that he could have a mark granted him by the company. This mark was not to be the property of another freeman, or to consist of a surname. It was made personal property, and, subject to the life-interest of the owner's widow, which was indefeasible, could be devised by will, and would pass to the next of kin. A mark rent of 6*d.* a year was to be paid, and if the executors did not "claim and pay the mark rent for such mark," it was to be deemed surrendered to the company.

In 1814 it was enacted that any one, whether a freeman or not, might take out a mark on payment of 40*s.* fee, with an additional fee of 3*l.* if the mark had ever been assigned to some one else and since surrendered. This mark was to be personal property, as in the case of a freeman's mark, but not more than one member of a family was to have a right to use it at the same time.

At the same time the mark rent was repealed, and it was also provided that no mark used in common amongst the manufacturers of the above-mentioned goods in Hallamshire should be granted.

A trade-mark granted to a freeman is said to be incapable of assignment. However this may be, one granted to a non-freeman is capable of assignment, though whether it will pass to the assignees in bankruptcy is doubtful (*b*).

The Acts contain penalties for the infringement in Hallamshire, or within six miles' compass, of the trade-marks granted under them.

Cutlery Trade Act, 59 Geo. 3, c. 7.

A General Act of 1819 authorises manufacturers of knives and articles with cutting edges to stamp the form of a hammer on the goods, if they are forged by hammer, and prohibits that mark if they are not so forged.

(*b*) *Bury* v. *Bedford*, 4 N. R. 18[illegible], 33 L. J. Ch. 465.

The Act also forbids the stamping on the above-mentioned articles words indicating other than the true quality thereof, and forbids the use of the words "London" or "London made," except for goods made in the city of London, or within twenty miles of it.

Linen.

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

Patent.

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

Hops.

An Act relating to the hop trade contains some special provisions relating to trade-marks upon hops (*c*).

Gun-barrels and hall-marks.

Counterfeiting the proof-marks upon gun-barrels and the hall-marks upon gold and silver plate are made penal by statute (*d*).

(*c*) 29 & 30 Vict. c. 37.

(*d*) The former by 53 Geo. 3, c. 115, s. 9; the latter by 7 & 8 Vict. c. 22.

CHAPTER VIII.

PROTECTION AFFORDED TO BRITISH TRADE-MARKS IN FOREIGN COUNTRIES.

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In this chapter it is intended to give some account of foreign law as to trade-marks, and to point out how far, under the provisions of treaties or otherwise, British subjects, carrying on business in the British dominions, can obtain protection for their trade-marks abroad.

Scotland.

The law as to trade-marks in Scotland is substantially identical with that of England, and the authorities cited in reference to such cases in the Scotch Courts are almost entirely English. Three cases only, all turning on points of practice, are to be found in the Scotch law reports, and they are here noted for the convenience of the Scotch practitioner.

In *Wotherspoon and Co.* v. *Gray and Co.* (*a*), the Court was of opinion, upon inspection of the labels and wrappers of the plaintiffs and defendants, that they were essentially different, and refused to send the question to a jury.

In *Green* v. *Shepherd* (*b*), the question was considered whether, in an action for damages for infringement of a trade-mark concluding also for an interdict, the plaintiff could, in any case, move for an *interim* interdict.

(*a*) 2 Macph. 38, 36 Jur. (Sc.) 24.
(*b*) 4 Macph. 1028, 38 Jur. (Sc.) 523.

In *Dixon* v. *Jackson* (*c*), an *interim* interdict was granted, under the circumstances, on the ground of balance of convenience.

United States.

The American law, so far as it is independent of statute, is based upon the English authorities. A collection of the most important American cases has been recently published by Mr. Rowland Cox (*d*).

We have already noticed that under the decisions of the American courts a foreigner, resident and carrying on business out of the United States, is entitled to have his trade-mark protected by the American courts (*e*).

A statute consolidating the law as to patents, copyrights and trade-marks was passed by Congress, and approved July 8, 1870. The part relating to trade-marks will be found in the Appendix. It is expressly enacted that it shall not "prevent, lessen, impeach or void any remedy at law or in equity, which any party, aggrieved by any wrongful use of any trade-mark might have had if the Act had not been passed."

The provisions of the United States statute apply (*f*) to subjects of any foreign power between whom and the United States reciprocity is established by treaty. As there is no treaty between the United States and Great Britain to this effect, and the privileges of subjects of the United States in Great Britain depend upon the general law, it seems that British subjects are not within the statute.

Treaties.

Under treaties between Great Britain and Austria (*g*),

(*c*) 5 Macph. 326.

(*d*) Cincinnati, Robert Clarke & Company, 1871.

(*e*) *Ante*, p. 72, note (*q*). (*f*) Sect. 77.

(*g*) 16th Dec. 1865, Art. 9. Hertzlet's Commercial Treaties, vol xii. 174. This treaty extends to Leichtenstein, ibid. 175.

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Belgium (*h*), Columbia (*i*), France (*k*), Germany (*l*), Italy (*m*), Russia (*n*), and Prussia and the Zollverein (*o*), British subjects enjoy the same rights as natural born subjects in respect of trade-marks. British subjects who claim the benefit of treaties or laws of foreign countries must of course comply with all laws as to registration, deposit, or other matters which are in force in the foreign country, and in the declaration between England and Russia (*p*) this is expressly provided.

The treaties already referred to, except those with France and Columbia, contain the usual clause giving British subjects the same privileges as the subjects of the most favoured nation, so that if a mode and place of registration is provided for the subjects of *any* foreign country, registration in that mode and place will give British subjects the benefit of the treaty, if there are no provisions expressly applicable to them.

There are no treaties directly referring to trade-marks between Great Britain and Greece, Portugal, Spain, Sweden or Norway, Switzerland, Turkey, or the United States, but by express legislation or custom British sub-

(*h*) 23rd July, 1862, Arts. 16 & 17, 11 Hertz. 70.

(*i*) 16th Feb. 1866, Art. 12, 12 Hertz. 372.

(*k*) 23rd Jan. 1860, Art. 12, 11 Hertz. 169, and Art. 16 of the treaty of 5th Nov. 1872, which will supersede the former if ratified.

(*l*) 1st April, 1869.

(*m*) 6th Aug. 1863, Art. 12, 11 Hertz. 1115.

(*n*) 31st Dec. 1858, Art. 20, 10 Hertz. 1063; Declaration of 11th July, 1871, Parl. Pap. 1871 [C. 412]. See App.

(*o*) 30th May, 1865, Art. 6, 12 Hertz. 763, but this only extends to the name or firm; see *infrà*. The articles referred to in the above notes will also be found in Parl. Pap. 1872 [C. 633].

(*p*) 11 h July, 1871, Parl. Pap. 1871 [C. 412].

jects enjoy the same privileges as natives in Turkey (*q*) and the following Swiss cantons:—Appenzell (Rhodes Extérieures), Berne, Fribourg, Geneva, Lucerne, Neufchatel, St. Gall, Schaffhausen, Soleure, Tessin, Valais, Vaud, Zurich (*r*).

In Denmark, according to an opinion given at the Ministry of Justice, foreigners may claim the benefit of the provisions of the Criminal Code of 1866 as to trade-marks. Under section 278, if the mark be affixed to articles inferior to the genuine, the infringer is liable to imprisonment for a term varying from five days to two years; if the articles are not inferior, the infringer is liable to a fine of 100 rix-dollars, and ultimately to higher fines and imprisonment (*s*).

Under the project of the Portuguese Penal Code, articles 296 and 297, the violation of a foreign trade-mark is punishable with a fine of from 10,000 reis (£2 4*s*. 5*d*.) to 100,000 reis (£22 4*s*. 2*d*.). It does not seem clear from Sir Charles Murray's report whether this code has been promulgated (*t*).

Commercial treaties between Great Britain and Denmark (*u*) and Spain (*v*) contain a clause securing to British subjects the same privileges as are or may be granted to the most favoured nation. By treaty subjects of Belgium, Italy, and Austria enjoy in respect of trade-marks the protection of the Spanish laws. It is

(*q*) Reports on Foreign Trade-Mark Legislation, Parl. Pap. 1872 [C. 596], p. 76.

(*r*) Ibid. p. 72.

(*s*) Ibid. p. 25.

(*t*) Reports on Foreign Trade-Mark Legislation, Parl. Pap. 1872 C. 596], p. 56.

(*u*) 12th July, 1670, Art. 40, 1 Hertz. 201.

(*v*) $\frac{13}{23}$ May, 1667, Art. 38, 2 Hertz. 155.

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therefore conceived that British subjects are entitled to similar protection.

In the commercial treaty with the Netherlands there is a most favoured nations clause, somewhat less full in its terms (*w*). French subjects are by their commercial treaty entitled to protection for their trade-marks (*x*), on depositing two fac-similes at the Registry of the Tribunal d'Arrondissement of Amsterdam (*x*).

The procedure of most, if not all, Continental countries gives the person whose trade-mark is invaded a summary mode of obtaining redress by criminal proceedings, and in some cases by confiscation of the articles and award of damages.

The French law on the subject may be taken as a type of the laws of most Continental states. It is contained in a Law of 27 June, 1857, which is printed in the Appendix. An abstract of its principal provisions will be useful.

French law.

A French subject, or a foreigner having an establishment in France, can obtain exclusive property in a trade-mark by depositing two fac-similes at the office of the Tribunal of Commerce of his domicile. The deposit must be renewed every fifteen years. Names in a distinctive form, *e. g.*, the fac-simile of an autograph, can be deposited as trade-marks. In consequence of the reciprocity clauses of the commercial treaty between France and Great Britain, British subjects and companies (*y*) not having establishments in France, on depositing their trade-marks at the office of the Tribunal of Com-

(*w*) 27th Oct. 1837, Art. 1, 5 Hertz. 338.

(*x*) See Reports on Foreign Trade-Mark Legislation, Parl. Pap. 1872 [C. 596], p. 54.

(*y*) Dalloz, Jur. Gen. (1866) Pt. 1. p. 191.

merce of the department of the Seine, enjoy the same benefits as French subjects. Foreigners having establishments in France are considered, for the purpose of the law, as French subjects.

The following persons are liable to fine or imprisonment, or both, as specified in the law :—Those who have forged a trade-mark, or made use of a forged trade-mark; those who have fraudulently applied to their goods a trade-mark belonging to another; those who have knowingly sold, or offered for sale, one or more articles bearing a forged or fraudulent trade-mark; those who have made a fraudulent imitation of a trade-mark calculated to deceive, or have made use of such an imitation, or have knowingly sold, or offered for sale, one or more articles bearing such an imitation.

Complaints of the infringement of a trade-mark may be made before a Civil or Correctional court. A complainant can, before commencing his suit, obtain, *ex parte*, a detailed description by a proper officer, and upon giving security, if required by the judge, a seizure and detention of goods alleged to be wrongfully marked. But if he fails to commence a suit within a limited time he is liable in damages for these acts.

The Court of Cassation decided that where the name or mark of a British subject had, before the treaty of 1860, been commonly used in France, so as to become public property, it could not again be made individual property by registration under the treaty (*z*). But in each of the cases in which this was decided, the Court found as a fact that the name had been so long current

(*z*) Dalloz, Jur. Gen., (1864), Pt. I. p. 452; ibid. (1865), Pt. I. p. 197.

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as a mere name of quality, that no one buying an article so denoted would imagine he was buying the manufacture of a *particular maker*.

It will be observed that the terms of the German laws given in the Appendix apply only to the unauthorised use of a name or firm. Property in trade-marks in the strict sense, *i. e.*, mere arbitrary devices, is not in general recognised in the German empire, nor can the imitation of them be made a ground of action or criminal proceedings (*a*). There exist, however, in certain parts of the empire, special laws affording conditional protection to such trade-marks; as, for instance, in the Prussian Rhine Provinces and Westphalia the Law for the Protection of Trade-marks on Iron and Steel Products (August, 1847, and Law of April 24, 1854, amending the same).

The Appendix contains the enactments applicable to British subjects of the most important civilized countries.

(*a*) Letter of Mr. Malcolm, Assistant Secretary to the Board of Trade, to the Chairman of the Association of Chambers of Commerce of 5th October, 1872.

APPENDIX.

25 & 26 VICT. c. 88.

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

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

Construction of words.

1. In the construction of this Act the word "person" shall include any person, whether a subject of Her Majesty or not, and any body corporate or body of the like nature, whether constituted according to the law of this country or of any of Her Majesty's Colonies or Dominions, or according to the law of any foreign country, and also any company, association, or society of persons, whether the members thereof be subjects of Her Majesty or not, or some of such persons subjects of Her Majesty and some of them not, and whether such body corporate, body of the like nature, company, association, or society be established or carry on business within Her Majesty's dominions or elsewhere, or partly within Her Majesty's dominions and partly elsewhere; the word "mark" shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description; and the expression "trade-mark" shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark as aforesaid lawfully used by any person to denote any chattel, or (in *Scotland*) any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, production, or merchandise of such person, or to be an article or thing

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

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

2. Every person who, with intent to defraud, or to enable another to defraud, any person, shall forge or counterfeit, or cause or procure to be forged or counterfeited, any trade-mark, or shall apply, or cause or procure to be applied, any trade-mark or any forged or counterfeited trade-mark to any chattel or article not being the manufacture, workmanship, production, or merchandise of any person denoted or intended to be denoted by such trade-mark, or denoted or intended to be denoted by such forged or counterfeited trade-mark, or not being the manufacture, workmanship, production, or merchandise of any person whose trade-mark shall be so forged or counterfeited, or shall apply, or cause or procure to be applied, any trade-mark or any forged or counterfeited trade-mark to any chattel or article, not being the particular or peculiar description of manufacture, workmanship, production, or merchandise denoted or intended to be denoted by such trade-mark or by such forged or counterfeited trade-mark, shall be guilty of a misdemeanor, and every person so committing a misdemeanor shall also forfeit to Her Majesty every chattel and article belonging to such person to which he shall have so unlawfully applied, or caused or procured to be applied, any such trade-mark or forged or counterfeited trade-mark as aforesaid, and every instrument in the possession or power of such person, and by means of which any such trade-mark or forged or counterfeited trade-mark as aforesaid shall have been so applied, and every instrument in the possession or power of such person for applying any such trade-mark or forged or counterfeited trade-mark as aforesaid, shall be forfeited to Her Majesty; and the court before which any such misdemeanor shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such court shall think fit.

Applying a forged trade-mark to any vessel, case,

3. Every person who, with intent to defraud, or to enable another to defraud, any person, shall apply or cause or procure to be applied any trade-mark or any forged or counterfeited trade-mark to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, on, or with which any chattel or

article shall be intended to be sold or shall be sold or uttered or exposed for sale, or intended for any purpose of trade or manufacture, or shall enclose or place any chattel or article, or cause or procure any chattel or article to be enclosed or placed in, upon, under, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing to which any trade-mark shall have been falsely applied, or to which any forged or counterfeited trade-mark shall have been applied, or shall apply or attach or cause or procure to be applied or attached to any chattel or article any case, cover, reel, ticket, label, or other thing to which any trade-mark shall have been falsely applied, or to which any forged or counterfeited trade-mark shall have been applied, or shall enclose, place, or attach any chattel or article, or cause or procure any chattel or article to be enclosed, placed, or attached, in, upon, under, with, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing having thereon any trade-mark of any other person, shall be guilty of a misdemeanor, and every person so committing a misdemeanor shall also forfeit to Her Majesty every such chattel and article, and also every such cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing as aforesaid in the possession or power of such person; and every other similar cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing made to be used in like manner as aforesaid, and every instrument in the possession or power of such person, and by means of which any such trade-mark or forged or counterfeited trade-mark as aforesaid shall have been applied, and also every instrument in the possession or power of such person for applying any such trade-mark or forged or counterfeit trade-mark as aforesaid, shall be forfeited to Her Majesty, and the court before which any such misdemeanor shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such court shall think fit.

wrapper, &c. in or with which any article is sold or intended to be sold, a misdemeanor.

4. Every person who, after the Thirty-first day of December, One thousand eight hundred and sixty-three, shall sell, utter, or expose either for sale or for any purpose of trade or manufacture, or cause or procure to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article, together with any forged or counterfeited trade-mark, which he shall know to be forged or counterfeited, or together with the trade-mark of any other person applied or used falsely or wrongfully or without lawful authority or excuse, knowing such trade-mark of another person to have been so applied or used as aforesaid, and that whether any such trade-mark or forged or counterfeited trade-mark as aforesaid, together with which any such chattel or article shall be sold, uttered, or exposed for sale or other purpose

Selling articles with forged or false trade-marks after 31st December, 1863, penalty equal to value of article sold, and a sum not

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exceeding 5*l.* nor less than 10*s.*

as aforesaid, shall be in, upon, about, or with such chattel or article, or in, upon, about, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, upon, about, or with which such chattel or article shall be so sold or uttered or exposed for sale or other purpose as aforesaid, shall for every such offence forfeit and pay to Her Majesty a sum of money equal to the value of the chattel or article so sold, uttered, offered, or exposed for sale or other purpose as aforesaid, and a further sum not exceeding Five Pounds and not less than Ten Shillings.

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

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

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

6. Where any person who, at any time after the Thirty-first day of December, One thousand eight hundred and sixty-three, shall have sold, uttered, or exposed for sale or other purpose as aforesaid, or shall have caused or procured to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article, together with any forged or counterfeited trade-mark, or together with the trade-mark of any other person used without lawful authority or excuse as aforesaid, and that whether any such trade-mark, or such forged or counterfeited trade-mark as aforesaid, be in, upon, about, or with such chattel or article, or in, upon, about, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, upon, about, or with which such chattel or article shall have been sold or exposed for sale, such person shall be bound, upon demand in writing delivered to him or left for him at his last known dwelling-house or at the place of sale or exposure for sale by or on the behalf of any person whose trade-mark shall have been so forged or counterfeited, or used without lawful authority or excuse as aforesaid, to give to the person requiring the same or his attorney or agent, within forty-eight hours after such demand, full information in writing of the name and address of the person from whom he shall have purchased or obtained such chattel or article, and of the time when he obtained the same; and it shall be lawful for any

justice of the peace, on information on oath of such demand and refusal, to summon before him the party refusing, and on being satisfied that such demand ought to be complied with to order such information to be given within a certain time to be appointed by him; and any such party who shall refuse or neglect to comply with such order shall for every such offence forfeit and pay to Her Majesty the sum of Five Pounds, and such refusal or neglect shall be *primâ facie* evidence that the person so refusing or neglecting had full knowledge that the trade-mark together with which such chattel or article was sold, uttered, or exposed for sale or other purpose as aforesaid at the time of such selling, uttering, or exposing was a forged, counterfeited, and false trade-mark, or was the trade-mark of a person which had been used without lawful authority or excuse, as the case may be.

Power to justices to summon parties refusing to give information.

Penalty for refusal, 5*l.*

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

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

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

Selling or exposing for sale after the 31st December, 1863, articles

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with false statement of quantities, &c., penalty not more than 5*l.* nor less than 5*s.*

such chattel or article shall be sold or uttered or exposed for sale or other purpose as aforesaid, shall have been so put, or upon any case, frame, or other thing used or employed to expose or exhibit such chattel or article for sale shall have been so put, any false description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article or any part thereof, or the place or country in which such chattel or article shall have been made, manufactured, or produced, shall for every such offence forfeit and pay to Her Majesty a sum not exceeding Five Pounds and not less than Five Shillings.

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

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

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

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

Conviction not to affect any right or civil remedy.

11. The provisions in this Act contained of or concerning any Act or any proceeding, judgment, or conviction for any Act hereby declared to be a misdemeanor or offence, shall not nor shall any of them take away, diminish, or prejudicially affect any suit, process, proceeding, right, or remedy which any person aggrieved by such Act may be entitled to at law, in equity, or otherwise, and shall not nor shall any of them exempt or excuse any person from answering or making discovery upon examination as a witness or upon interrogatories or otherwise in any suit or other civil proceeding: Provided always, that no evidence, statement, or discovery which any person shall be compelled to give or make shall be admissible in

evidence against such person in support of any indictment for a misdemeanor at common law or otherwise, or of any proceeding under the provisions of this Act.

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

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

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

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

Punishment for misdemeanor under this Act.

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

Recovery of penalties.

15. In every case in which any person shall have committed or done any offence or act whereby he shall have forfeited or become liable to pay to Her Majesty any of the penalties or sums of money mentioned in the provisions of this Act, every such penalty or sum of money shall or may be recovered in England, Wales, or Ireland in an action of debt, which any person may as plaintiff for and on behalf of Her Majesty commence and prosecute to judgment in any court of record, and the amount of every such penalty or sum of money to be recovered in any such action shall or may be determined by the jury (if any) sworn to try any issue in such action, and if there shall be no such jury then by the court or some other jury,

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as the Court shall think fit, or instead of any such action being commenced such penalty or sum of money shall or may in England or Wales be recovered by a summary proceeding before two justices of the peace having jurisdiction in the county or place where the party offending shall reside or have any place of business, or in the county or place in which the offence shall have been committed; and shall or may in Ireland be recovered in like manner by civil bill in the Civil Bill Court of the county or place in which the offence was committed, or in which the offender shall reside or have any place of business; and shall or may in Scotland be recovered by action before the Court of Session in ordinary form or by summary action before the sheriff of the county where the offence shall have been committed or the offender may reside or have any place of business, which sheriff, upon proof of the offence, either by the confession of the person offending or by the oath or affirmation of one or more credible witnesses, shall convict the offender, and find him liable in the penalty or penalties aforesaid as also in expenses; and it shall be lawful for the sheriff in pronouncing such judgment for the penalty or penalties and costs to insert in such judgment a warrant in the event of such penalty or penalties and costs not being paid to levy and recover the amount of the same by poinding: Provided always, that it shall be lawful to the sheriff, in the event of his dismissing the action and assoilzing the defender, to find the complainer liable in expenses, and any judgment so to be pronounced by the sheriff in such summary action shall be final and conclusive, and not subject to review by advocation, suspension, reduction, or otherwise.

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

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

In actions penalties to be accounted for in like

17. In every case in which judgment shall be obtained in any such action as aforesaid for the amount of any such penalty or sum of money forfeited to Her Majesty, the amount thereof shall be paid by the defendant to the sheriff or the officer of the court, who shall

account for the same in like manner as other monies payable to Her Majesty, and, if it be not paid, may be recovered, or the amount thereof levied, or the payment thereof enforced, by execution or other proper proceeding, as money due to Her Majesty: and the plaintiff suing on behalf of Her Majesty, upon obtaining judgment, shall be entitled to recover and have execution for all his costs of suit, which shall include a full indemnity for all costs and charges which he shall or may have expended or incurred in, about, or for the purposes of the action, unless the court, or a judge thereof, shall direct that costs of the ordinary amount only shall be allowed.

Recovery of penalties in manner as other monies payable to the crown, and plaintiffs to recover full costs of suit.

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

Limitations of actions, &c.

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

After 31st December, 1863, vendor of an article with a trade-mark to be deemed to contract that the mark is genuine.

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

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

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some writing signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

In suits at law or in equity against persons for using forged trade-marks court may order article to be destroyed and may award injunction, &c.

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

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

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

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

Defendant obtaining a verdict to have full indemnity for costs.

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

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

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

Act not to affect the corporation of cutlers of Hallam-

25. Nothing in this Act contained shall be construed to affect the rights and privileges of the Corporation of Cutlers of the Liberty of Hallamshire in the county of York, nor shall anything in this Act contained be construed in any way to repeal or make void any of the provisions contained in the fifty-ninth George Third, chapter

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seven, intituled, "An Act to Regulate the Cutlery Trade in England."

shire, not to repeal 59 G. 3, c. 7.

26. The expression "The Merchandise Marks Act, 1862," shall be a sufficient description of this Act (*a*).

Short title.

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35 & 36 VICT. c. 20.

An Act to grant certain Duties of Customs and Inland Revenue, and to alter other Duties.

Short title.

§ 1. This Act may be cited as the Customs and Inland Revenue Act, 1872.

Extension of 16 & 17 Vict. c. 107, s. 44, to articles of foreign manufacture purporting to be manufactured in United Kingdom.

4. There shall be included among goods absolutely prohibited to be imported inwards, or in transit, any articles of foreign manufacture, and any packages of such articles, bearing any name, brand, or mark, which states or implies that such articles were manufactured at any place in the United Kingdom.

Any name, brand, or mark which states or implies that any such articles were manufactured at a town or place having the same name as a place in the United Kingdom, shall, unless accompanied by the name of the country in which such place is situate, be deemed for the purpose of this section to state or imply that such articles were manufactured at a place in the United Kingdom.

Foreign Laws as to Trade-marks applicable for the protection of British subjects.

AUSTRIA.

[Parl. Pap. 1872, C. 596.]

Law for the Protection of Trade Marks and other Denotations.

I.—*General Provisions.*

§ 1. In this law marks are understood to be those special signs which serve to distinguish the productions and goods of one tradesman intended for the commercial market, from those of any other tradesmen (devices, ciphers, vignettes, and the like).

§ 2. A tradesman who wishes to secure to himself the sole right to the use of a mark, must have it registered according to the provisions of the next division.

§ 3. No exclusive right can be acquired in marks which consist of such signs as are commonly used in the trade in particular kinds of

(*a*) As to an artist's signature see now 25 & 26 Vict. c. 68, s. 7.

goods, nor in such as consist merely of letters, words, or numbers, or of the arms of states and countries.

§ 4. The exclusive right to a mark precludes the use thereof by other tradesman only in regard to that kind of goods to which the productions or commercial articles of the trade for which the protected mark is intended belong.

§ 5. The right in marks continues with the trade-undertaking for which the marks are intended; it expires therewith, and changes owners therewith.

In the latter case, however, unless the business be carried on by the widow or an heir under age, or on account of inheritors or creditors, the new owner must have the mark transferred to his name within three months; otherwise the right in them expires.

§ 6. No one must arbitrarily appropriate to himself the name, style, arms, or designation of the establishment of another inland trader or producer, for the denotation of goods.

§ 7. All that is said in this law about the denotation of goods, also applies to the denotations affixed to the packing, the receptacles, wrappers, &c.

§ 8. The present law makes no alteration in the existing regulations respecting the special distinguishing marks prescribed for certain goods, particularly the stamping regulations.

II.—*Registration of the Marks.*

§ 9. The mark for which a trader wishes to secure to himself the exclusive right of use (§ 2) must be delivered in two copies to the Chamber of Commerce and Industry in the district whereof the industrial undertaking is situated, wherein use is to be made of it; one copy is to be inserted in the Register of Marks, which is to be kept by the Chamber of Commerce and Industry; the other is to be returned to the party, with the certification directed in the following section.

§ 10. The appointed functionary of the Chamber of Commerce and Industry is to set down on each copy—

(*a.*) The running number of the register.

(*b.*) The day and hour of delivery.

(*c.*) The name in which the mark has been registered.

(*d.*) The designation of the industrial enterprise for which it is intended.

And he is to sign this notification, and to affix the official seal thereto.

§ 11. The registration is subject to a duty of 5 fl., which goes into the chest of the Chamber of Commerce.

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§ 12. With the day and the hour of the delivery of the mark at the Chamber of Commerce and Industry, the sole right to the use of the mark begins for the depositor, and the priority of the claim will be adjudged according thereto, if the same mark should be deposited by several tradesmen at the same or at different Chambers of Commerce and Industry.

§ 13. To transfer the right to a mark, as mentioned in § 5, the applicant must produce proof of the acquisition of the industrial undertaking concerned.

The transfer is subject to the same duty as the first registration.

§ 14. The registers of marks are to be open to every one's inspection at the Chambers of Commerce and Industry.

III.—*Encroachments, Infringements, and Penalties.*

§ 15. Every encroachment on the right to a mark, whether by the illegal appropriation or imitation of a mark, or by the consumption of goods thus illegally marked, gives the injured party the right to insist on the stoppage of the further use of the illegal mark and on the removal thereof from the goods marked therewith, so far as they are intended for sale. He may also demand that the tools and apparatus exclusively or especially used for this purpose be made unserviceable.

Claims by the injured party for compensation for the injury suffered through the encroachment on his right in a mark, are to be decided according to the civil law.

§ 16. It is to be considered an imitation if the marks in question cannot be distinguished without more than the ordinary attention.

§ 17. The provisions contained in § 15, are also applicable to any one who—

(*a*) Illegally appropriates the name, style, arms, or the special designation of another inland trader or producer, for the denotation of goods intended for sale;

(*b*) Introduces into commerce productions or articles for sale which are furnished with an unauthorized denotation of this kind.

§ 18. If the encroachment (§§ 15 and 17) has been knowingly committed, a fine of from 25 to 500 fl. is to be imposed on the offender, besides any punishment incurred according to the general penal law.

§ 19. The punishment may be doubled on a repetition.

On a further repetition the offender is to be imprisoned for from a week to three months, besides the fine.

§ 20. If the fine should seriously affect the circumstances or the means of subsistence of the delinquent or his family, or prevent him

from making the compensation due for the criminal act, it is to be converted into one day's imprisonment for every 5 fl. Appendix.

§ 21. The punishing authority can also direct that the sentence be published.

§ 22. The amounts of the fines go to the Poor Fund of the place where the transgression has been committed.

IV.—*Authorities and Proceedings.*

§ 23. The procedure and decision respecting encroachments (§§ 15 and 17), as well as the investigation and punishment of the transgressions described in §§ 18 and 19, belong to the political administrative authorities of first instance, according to the existing regulations for the proceedings and the course from Court to Court in industrial disturbances and industrial transgressions.

The political authority also decides disputes respecting the right in marks, the priority and transfer thereof, and respecting the question of identity of marks.

But the decision of the claims for compensation mentioned in § 15 belongs to the Civil Judge.

§ 24. Criminal proceedings on account of the transgressions of law described in this law can only be commenced on the application of the injured party, unless there be a criminal act involved, which, according to the general criminal law, must be officially prosecuted by the Criminal Court.

If, however, the injured party withdraws his application for punishment before the official decision is made known to the defendant, then he has, without prejudice to his private claims to compensation, also to relinquish the demand for any punishment, as well as any further investigation for the purpose of punishment.

§ 25. Whenever the question of an encroachment rests on the comparison of two marks, the authority is to obtain a report from unprejudiced professional persons.

At the reception of the report the parties are also to be present and to be heard with their explanations and objections of any kind.

A report can only be opposed on account of objections against the professional persons, or on account of want of form. If it is deficient or indistinct, its completion may be insisted upon.

An inspection is not allowed.

§ 26. The injured party is entitled, even before the decision of his complaint, to require the seizure or other custody of the goods marked contrary to the provisions of this law, and the tools used for the purpose.

The political authority is immediately to order the same on

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production of the copy of the mark issued and attested according to § 10.

It is left, however, to the judgment of the said authority to require a preliminary security for the affront and damages to the defendant.

V.—*Transitory Provisions.*

§ 27. Even the traders who at present use a mark can only acquire the exclusive right to it on the conditions of this law.

§ 28. For this purpose the interval to the end of the month of June 1859 is granted to them, to the effect that by the registration of the mark during this interval the right is secured to every one of maintaining the priority of his mark used before the appearance of this law, even against any one who may have anticipated him in the registration of the said mark, but has not actually made use of it up to the introduction of this law.

§ 29. If, however, before the operation of this law, several have used the same mark, then of those who have this mark registered within the interval fixed in § 28, he acquires the exclusive right in the mark who proves that he has used it earlier than the rest. Any dispute is to be decided by the police authorities, after hearing the contending parties, on the evidence of the proofs brought forward by them as to the earlier commencement of the previous use of the mark.

In those provinces where mark-registers (sign-rolls, &c.) were kept with public attestation before the appearance of this law, the contents thereof, where no objection prevails to the contrary, are to settle the question.

If, however, none of the contending parties can produce proof of the longer use of such a mark than the rest, then the question must be decided by lot.

§ 30. With regard to marks that are first brought for registration after the 30th of June, 1859, no claim of priority can be derived from any application of them before the appearance of this law.

Belgium.

The laws at present in force are of a remote date and incomplete. It is under consideration to revise them. See Reports on Foreign Trade-mark Legislation, Parl. Pap. 1872 [c. 596], p. 8.

Denmark.

(See ante, p. 83.)

Loi sur les Marques de Fabrique et de Commerce, du 23 Juin, 1857.

Titre I.—*Du Droit de Propriété des Marques.*

Article I.—La marque de fabrique ou de commerce est facultative.

Toutefois, des décrets, rendus en la forme des règlements d'administration publique, peuvent exceptionnellement la déclarer obligatoire pour les produits qu'ils déterminent.

Sont considérés comme marques de fabrique et de commerce les noms sous forme distinctive, les dénominations, emblèmes, empreintes, timbres, cachets, vignettes, reliefs, lettres, chiffres, enveloppes, et tous autres signes servant à distinguer les produits d'une fabrique ou les objets d'un commerce.

Art. 2. Nul ne peut revendiquer la propriété exclusive d'une marque, s'il n'a déposé deux exemplaires du modèle de cette marque au greffe du Tribunal de Commerce de son domicile.

Art. 3. Le dépôt n'a d'effet que pour quinze années.

La propriété de la marque peut toujours être conservée pour un nouveau terme de quinze années au moyen d'un nouveau dépôt.

Art. 4. Il est perçu un droit fixe d'un franc pour la rédaction du procès-verbal de dépôt de chaque marque et pour le coût de l'expédition, non compris les frais de timbre et d'enregistrement.

Titre II.—*Dispositions relatives aux Etrangers.*

Art. 5. Les étrangers qui possèdent en France des établissements d'industrie ou de commerce jouissent, pour les produits de leurs établissements, du bénéfice de la présente Loi, en remplissant les formalités qu'elle prescrit.

Art. 6. Les étrangers et les Français dont les établissements sont situés hors de France jouissent également du bénéfice de la présente Loi, pour les produits de ces établissements, si, dans les pays où ils sont situés, des Conventions diplomatiques ont établi la réciprocité pour les marques Françaises.

Dans ce cas, le dépôt des marques étrangères a lieu au greffe du Tribunal de Commerce du Département de la Seine.

Titre III.—*Pénalités.*

Art. 7. Sont punis d'une amende de cinquante francs à trois mille francs et d'un emprisonnement de trois mois à trois ans, ou de l'une de ces peines seulement :

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1. Ceux qui ont contrefait une marque ou fait usage d'une marque contrefaite ;

2. Ceux qui ont frauduleusement apposé sûr leurs produits ou les objets de leur commerce une marque appartenant à autrui ;

3. Ceux qui ont sciemment vendu ou mis en vente un ou plusieurs produits revêtus d'une marque contrefaite ou frauduleusement apposée.

Art. 8. Sont punis d'une amende de cinquante francs à deux mille francs et d'un emprisonnement d'un mois à un an, ou de l'une des ces peines seulement :

1. Ceux qui, sans contrefaire une marque, en ont fait une imitation frauduleuse de nature à tromper l'acheteur, ou ont fait usage d'une marque frauduleusement imitée ;

2. Ceux qui ont fait usage d'une marque portant des indications propres à tromper l'acheteur sur la nature du produit ;

3. Ceux qui ont sciemment vendu ou mis en vente un ou plusieurs produits revêtus d'une marque frauduleusement imitée ou portant des indications propres à tromper l'acheteur sur la nature du produit.

Art. 9. Sont punis d'une amende de cinquante francs à mille francs et d'un emprisonnement de quinze jours à six mois, ou de l'une de ces peines seulement :

1. Ceux qui n'ont pas apposé sur leurs produits une marque déclarée obligatoire ;

2. Ceux qui ont vendu ou mis en vente un ou plusieurs produits ne portant pas la marque déclarée obligatoire pour cette espèce de produits ;

3. Ceux qui ont contrevenu aux dispositions des décrets rendus en exécution de l'Article 1 de la présente Loi.

Art. 10. Les peines établies par la présente Loi ne peuvent être cumulées.

La peine la plus forte est seule prononcée pour tous les faits antérieurs au premier acte de poursuite.

Art. 11. Les peines portées aux Articles 7, 8, et 9 peuvent être élevée au double en cas de récidive.

Il y a récidive lorsqu'il a été prononcé contre le prévenu, dans les cinq années antérieures, une condamnation pour un des délits prévus par la présente Loi.

Art. 12. L'Article 463 du Code Pénal peut être appliqué aux délits prévus par la présente Loi.

Art. 13. Les délinquants peuvent, en outre, être privés du droit de participer aux élections des Tribunaux et des Chambres de Commerce, des Chambres Consultatives des Arts et Manufactures, et des Conseils de Prud'hommes, pendant un temps qui n'excédera pas dix ans.

Le tribunal peut ordonner l'affiche du jugement dans les lieux qu'il détermine, et son insertion intégrale ou par extrait dans les journaux qu'il désigne, le tout aux frais du condamné.

Art. 14. La confiscation des produits dont la marque serait reconnue contraire aux dispositions des Articles 7 et 8 peut, même en cas d'acquittement, être prononcée par le tribunal, ainsi que celle des instruments et ustensiles ayant spécialement servi à commettre le délit.

Le tribunal peut ordonner que les produits confisqués soient remis au propriétaire de la marque contrefaite ou frauduleusement apposée ou imitée, indépendamment de plus amples dommages-intérêts, s'il y a lieu.

Il prescrit, dans tous les cas, la destruction des marques reconnues contraires aux dispositions des Articles 7 et 8.

Art. 15. Dans le cas prévu par les deux premiers paragraphes de l'Article 9, le tribunal prescrit toujours que les marques déclarées obligatoires soient apposées sur les produits qui y sont assujettis.

Le tribunal peut prononcer la confiscation des produits, si le prévenu a encouru, dans les cinq années antérieures, une condamnation pour un des délits prévus par les deux premiers paragraphes de l'Article 9.

Titre IV.—*Juridictions.*

Art. 16. Les actions civiles relatives aux marques sont portées devant les tribunaux civils et jugées comme matières sommaires.

En cas d'action intentée par la voie correctionnelle, si le prévenu soulève pour sa défense des questions relatives à la propriété de la marque, le tribunal de police correctionnelle statue sur l'exception.

Art. 17. Le propriétaire d'une marque peut faire procéder par tous huissiers à la description détaillée, avec ou sans saisie, des produits qu'il prétend marqués à son préjudice en contravention aux dispositions de la présente Loi, en vertu d'une ordonnance du Président du Tribunal Civil de première instance, ou du juge de paix du canton, à défaut de tribunal dans le lieu où se trouvent les produits à décrire ou à saisir.

L'ordonnance est rendue sur simple requête et sur la présentation du procès-verbal constatant le dépôt de la marque. Elle contient, s'il y a lieu, la nomination d'un expert, pour aider l'huissier dans sa description.

Lorsque la saisie est requise, le juge peut exiger du requérant un cautionnement, qu'il est tenu de consigner avant de faire procéder à la saisie.

Il est laissé copie aux détenteurs des objets décrits ou saisis, de

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l'ordonnance et de l'acte constatant le dépôt du cautionnement, le cas échéant ; le tout à peine de nullité et de dommages-intérêts contre l'huissier.

Art. 18. À défaut par le requérant de s'être pourvu, soit par la voie civile, soit par la voie correctionnelle, dans le délai de quinzaine, outre un jour par cinq myriamètres de distance entre le lieu où se trouvent les objets décrits ou saisis et le domicile de la partie contre laquelle l'action doit être dirigée, la description ou saisie est nulle de plein droit, sans préjudice des dommages-intérêts qui peuvent être réclamés, s'il y a lieu.

Titre V.—*Dispositions Générales ou Transitoires.*

Art. 19. Tous produits étrangers portant soit la marque, soit le nom d'un fabricant résidant en France, soit l'indication du nom ou du lieu d'une fabrique Français, sont prohibés à l'entrée et exclus du transit et de l'entrepôt, et peuvent être saisis, en quelque lieu que ce soit, soit à la diligence de l'administration des douanes, soit à la requête du ministère public ou de la partie lésée.

Dans le cas où la saisie est faite à la diligence de l'administration des douanes, le procès-verbal de saisie est immédiatement adressé au ministère public.

Le délai dans lequel l'action prévue par l'Article 18 devra être intentée, sous peine de nullité de la saisie, soit par la partie lésée ; soit par le ministère public, est porté à deux mois.

Les dispositions de l'Article 14 sont applicables aux produits saisis en vertu du présent Article.

Art. 20. Toutes les dispositions de la présente Loi sont applicables aux vins, eaux-de-vie et autres boissons, aux bestiaux, grains, farines, et généralement à tous les produits de l'agriculture.

Art. 21. Tout dépôt de marques opéré au greffe du Tribunal de Commerce antérieurement à la présente Loi aura effet pour quinze années, à dater de l'époque où la dite Loi sera exécutoire.

Art. 22. La présente Loi ne sera exécutoire que six mois après sa promulgation. Un règlement d'administration publique déterminera les formalités à remplir pour le dépôt et la publicité des marques, et toutes les autres mesures nécessaires pour l'exécution de la Loi.

Art. 23. Il n'est pas dérogé aux dispositions antérieures qui n'ont rien de contraire à la présente Loi.

THE GERMAN EMPIRE.

[Parl. Pap., 1872, C. 596.]

Art. 287 *of the Imperial Penal Code of May* 15, 1871.

Whoever fraudulently marks goods, or the covers in which they are packed, with the name or firm of a native manufacturer, producer, or merchant, or knowingly trafficks in goods so fraudulently marked, incurs a fine of from 50 to 1000 th., or imprisonment not exceeding six months.

A similar penalty is incurred when the Act is directed against the native of a foreign State, in which reciprocity is guaranteed either by public treaties or by law.

The penalty is not evaded if, in marking the goods, the name or firm is reproduced, with such slight alterations as to require particular attention to perceive them.

Art. 27 *of the Commercial Code of* 1869.

Whoever is injured by the unauthorised use of the name of his firm can demand from the person using it that he shall cease to do so, and claim damages therefor.

The Tribunal of Commerce decides according to its free judgment upon the question of infringement and on the amount of damages.

The Tribunal of Commerce can cause the decision to be published at the expense of the party cast in damages.

NETHERLANDS.

(See ante, p. 84.)

PORTUGAL.

[Parl. Pap., 1872, C. 596.]

(See ante, p. 83.)

Project of Portuguese Penal Code, volume 2, *page* 103, *book* 2, *part* 1, *chapter* 6 *of title* 2, *only section, articles* 296, 297, *and* 298.—*The counterfeiting, usurping, or imitation of manufacturers' or trade-marks, and of manufacturers' designs or models.*

Article 296. The counterfeiting, imitation, or use of any national or foreign mark, either imitated, or belonging to another person,

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with respect to commercial products or articles of trade, and the selling or holding up for sale of any product, or article, with a mark, either imitated, or belonging to another person, shall be punished with a fine from 10,000 reis (2*l.* 4*s.* 5*d.*) to 100,000 reis (22*l.* 4*s.* 2*d.*)

§ Manufacturers' or trade-marks are signs used for the purpose of distinguishing the products of a manufactory, or the articles of a certain trade, whether they be names under a distinguishing form, emblems, stamps, vignettes, letters, or anything else that may be intended to distinguish, or may really distinguish, in accordance with the customs of places, and the usages of any manufactory, or of trade, any product whatsoever, as well as the particular place whence it came.

Article 297. The imitation of a mark belonging to another person, but without counterfeiting the same, so that the purchaser may be deceived as to the origin of the product, or of the place whence it came from, the use of an imitated mark, and the selling or holding up for sale any products with imitated marks upon them, shall be punished with a fine from 10,000 reis (2*l.* 4*s.* 5*d.*) to 100,000 reis (22*l.* 4 . 2*d.*)

Art. 298. The counterfeiting, using, selling, or holding up for sale of any manufacturer's counterfeited designs or models belonging to others, either national or foreign, shall be punishable in accordance with the rule laid down in the 294th Article.

§ 1. A manufacturer's design is any invention of the mind or of taste, for the purpose of being reproduced in the manufacture by means of texture, printing, &c.

§ 2. A manufacturer's model is any invention of the mind or of taste, for the purpose of being reproduced in the manufacture by moulding, sculpture, chiseling, &c.

RUSSIA.

Declaration respecting Protection to British and Russian Trade-Marks.

Signed at St. Petersburgh, July 11, 1871.

The Government of her Majesty the Queen of the United Kingdom of Great Britain and Ireland, and the Government of his Majesty the Emperor of all the Russias, having recognised the necessity of defining and rendering more efficacious the stipulations contained in Article 20 of the Treaty of Commerce and Navigation between Great Britain and Russia, signed on the 12th January, 1859, the

undersigned, duly authorised to that effect, have agreed upon the following arrangements :—

Article 1. The offering for sale or the placing in circulation of goods bearing counterfeit British or Russian trade-marks, wherever fabricated, shall be considered as a fraudulent operation prohibited within the territory of the two States, and shall be liable in England to the penalties prescribed by the Act of Parliament of 1862, and in Russia to the penalties prescribed by Articles 173—176 and 181, inflicted by Judges of the Peace, and by Articles 1665—1669 and 1671—1675 of the Penal Code (edition 1861).

Such fraudulent operation shall give the right before the Tribunals, and according to the laws of the country where it shall have been proved, to an action for damages, at the suit of the injured party, against those who may have been guilty thereof.

Art. 2. British subjects who may desire to secure to themselves in Russia the proprietorship of their trade-marks, shall be bound to register them at St. Petersburgh at the Department of Commerce and Manufactures.

In case trade-marks should hereafter become subject to registration in England, the same rules shall be applied to Russian as to English trade-marks.

Art. 3. The present articles, which shall come immediately into operation, shall be considered as forming an integral part of the Treaty of the 12th January, 1859, and shall have the same force and duration as the said Treaty.

In witness, &c.

[Parl. Pap., 1872, C. 596].

Penalties under the Law of Russia referred to in the above Declaration. (a)

I. Under the Statute of Punishments inflicted by Justices of the Peace :—

§ 173. For giving false weight or measure in the sale, purchase, or barter of goods or other chattels, and likewise for other deceptions in the quality or quantity of goods, or in cash settlements, or in changing money, the guilty parties shall be condemned, if the value of the goods shall not exceed 300 r., to imprisonment for a term of one to three months.

§ 174. The punishment specified in § 173 shall also be inflicted on the following, viz. :—

1. On whoever shall exchange for other things intrusted to him for safekeeping, for carriage, transport, or any other means of delivery.

2. On whoever shall induce another person to make over to him

(a) Presented to Parliament on the 24th July, 1871.

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money or things by the communication of false intelligence, or by holding out the prospect of profitable enterprise by pretended expenses in any business, by obtaining donations for pretended benevolent purposes, or in any other fraudulent manner.

3. On whoever, having received payment, shall not return the promissory note, bill of exchange, or the account signed by the purchaser, or shall not acknowledge on the same the receipt of the money due thereon, with the intention of again claiming payment.

4. On whoever, after receiving payment in full of a debt, shall not return the security (or pledge) given by the borrower in respect of such debt, and

5. On whoever, not being fully empowered for the purpose, shall lend or give to others the gratuitous usufruct of moveable property, not belonging to himself, with the intention of benefiting by the money due for such loan, or with the intention of obtaining any other illegal advantage from such transaction.

§ 175. The punishment under § 173 may be increased to six months' imprisonment in the following cases:—

1. When the offence shall have been committed by a person who shall once before have been found guilty of robbery or fraud.

2. When the fraud shall have been committed by concert of several persons.

3. When, for the purpose of committing the fraud, certain special preparations shall have been made.

4. When the offender shall have inspired special confidence by his social condition, his occupation, or by the nature of his relations towards the defrauded party.

5. When the person defrauded shall have been a minor, or aged, blind, or deaf.

6. When superstitious rites shall have been employed in the commission of the fraud.

7. When the guilty party shall have represented himself to be the attorney or servant of any person, or when he shall have assumed a false name.

§ 176. The punishments under §§ 173-175, may be reduced by one-half when the offences enumerated therein shall have been accompanied by the circumstances indicated in § 171 (*b*). In the case of an attempt at fraud, or of participation in it, the rule laid down in § 172 shall be observed (*c*).

(*b*) The circumstances enumerated in § 171 are :—

1. Voluntary restitution.
2. Commission of the offence from absolute destitution or want of work.
3. When the value of the thing stolen, &c., does not exceed 50 copecks.

(*c*) Attempts at robbery or fraud, as well as participation in the same, are

§ 181. Punishment for robbery, fraud, or appropriation or dissipation of property, belonging to another person, shall be imposed by the superior tribunal in the following cases, viz. :—

1. When the criminal act shall have been committed by a person of the noble or ecclesiastical class, by a person belonging to the monkhood, or by an honorary citizen, in all cases without exception.

2. When the same shall have been committed by persons belonging to any other class for the third time ; or, if only for the first and second time, when the value of the property stolen, etc., shall exceed the sum of 300 r. ; or again, under the circumstances specified in §§ 254—262, 263 (part 2), 366, 268, 2,222—2,234, 2,240, 2,244, 2,253, (part 2), 2,254, 2,259, 2,269, and 2,263 of the Statutes of Punishments.

II. Under the Statute of Criminal and Correctional Punishments :

§ 1,665. Every abstraction of things, moneys, or other moveables belonging to other parties by means of any kind of deception, shall be considered as fraud.

§ 1,666. The punishment in cases of deception and fraud enumerated in §§ 173-176 of the Statute of Punishments inflicted by Justices of the Peace shall, when the value of the property exceeds 300 r., be as follows :—

1. For the first offence, deprivation of all special rights and privileges, whether personal or acquired by service, and deportation to Siberia, or imprisonment in a convict correctional establishment, in the 5th degree of § 31 of the Statute (*d*).

2. For the second offence, imprisonment in a convict correctional establishment in the 4th degree of § 31 (*e*).

3. For the third offence, in a convict correctional establishment in the 1st degree of § 31 (§ 698) (*f*).

§ 1,667. For the frauds and deceptions specified under §§ 173—176 of the Statute of Punishments inflicted by Justices of the Peace, when the value does not exceed 300 r. ; and when the offender belongs to the noble or ecclesiastical class, to the monkhood, or if he be an honorary citizen, the punishment shall be deprivation of all special rights and privileges, whether personal or acquired by service and punishment on the basis of the foregoing sections of the said Statute (§ 698).

punishable with the same severity as robbery or fraud actually committed, but the magistrate may reduce the punishment by one-half, according to the importance of the guilt of the parties.—Translator.

(*d*) Viz., deportation to the province of Tomsk or Tobolsk, or hard labour for 12 to 18 months.—Translator.

(*e*) Viz., deportation to Tomsk or Tobolsk for 1 or 2 years, or hard labour for 1½ to 2½ years.

(*f*) Viz., 3½ to 4 years' hard labour.—Translator.

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§ 1,558. If the person guilty of a fraud shall, for the purpose of committing the same, have represented himself as acting on behalf of any Government office, Court, or authority, or shall have assumed a rank to which he is not entitled, he shall be deprived of all special rights and privileges, whether personal or derived from his social condition, and be deported to Siberia; or he shall be imprisoned in a convict correctional establishment under the 5th degree of § 31 of the Statute of Punishments.

§ 1,669. If the person guilty of fraud shall, in representing himself to be an agent of the Government, or an officer of the Imperial or Municipal Service, and for the purpose of committing the fraud, have put on the uniform or any badge of distinction appertaining to the office which he shall have assumed, he shall be sentenced under the rules relating to cumulative crime (§§ 152, 189).

§ 1,671. The punishment to which a person guilty of fraud shall be liable may, at the discretion of the Court, be increased by one degree in the following cases.

(Here follow the cases specified under § 175 of this Statute of Punishments inflicted by Justices of the Peace.)

§ 1,672. For the commission, for the third time, of a crime recognised by law as a fraud, the guilty party shall be sentenced to a deprivation of all special rights and privileges, whether personal or acquired by service, and shall be deported to Siberia, or he shall be imprisoned in a convict correctional establishment under the 3rd degree of § 31 of the present Statute.

§ 1,673. Persons convicted of fraud more than three times shall be sentenced to a deprivation of all the rights and privileges appertaining to their social condition, and be deported to Siberia as colonists.

§ 1,674. The punishment to which a person found guilty of fraud shall be liable may, at the discretion of the Court, be mitigated not only by one or two degrees, but even by three degrees, if the crime shall have been accompanied by the circumstances specified in § 1,663 (*g*).

§ 1,675. Persons found guilty of fraud shall be bound to restore all that which they shall have fraudulently acquired, and shall pay damages, on the basis of § 1,664.

Observations.—Cases of fraud between parents and children, or between man and wife, can only be prosecuted at the suit of the person who shall have suffered loss by the commission of the crime.

(*g*) Identical with § 171 of the Statute of Punishments inflicted by Justices of the Peace.—Translator.

SPAIN. Appendix.

[Parl. Pap. 1872, C. 596].

(See ante, p. 83).

Royal Decree of November 20, 1850, laying down the Rules to which Manufacturers must conform in order to make legal the use of and Proprietary Right to the Trade Marks adopted by them with a view to distinguish their Manufactures.

Article 1. In order that manufacturers may make the usurpers of the trade-marks and distinctive signs of their goods responsible, they will in the first place apply to the several Governors of their provinces for a certificate of mark.

Art. 2. The petition of the manufacturer must be accompanied by an explanatory statement clearly setting forth in detail the class of stamp adopted, the figures and signs which it contains, the material of which it is made, the substance on which it is printed, and the name of its proprietor.

Art. 3. Should the manner of applying the mark be a secret, and the parties interested anxious that it should so remain, this must be stated in their petition, placing a statement of the procedure in a sealed cover, which will only be opened in the event of litigation.

Art. 4. The Provincial Governors will forward to the petitioners the certificates of presentation of their petitions, and within the period of six days, and on their responsibility, will forward them to the Ministry of Commerce, Instruction, and Public Works, together with all the documents sent in.

Art. 5. After a report from the Director of the "Conservatorio de Artes" as to whether the mark has already been used on articles of the same class, the manufacturer will receive a certificate, showing that he has presented and made good his claim to a distinctive mark, its form together with all other circumstances being mentioned minutely.

Art. 6. Within the period of three months, to count from the date of the presentation of the petition to the Governor of the province, the parties interested will pay the sum of 100 reals (*h*) to the Depositary of the University of Madrid, omitting which the certificate will not be forwarded to them. The Director-General of Agriculture, Industry, and Commerce, will sign this document, and a note shall be made thereof in the "Contabilidad" of the University.

(*h*) At present the same sum is paid, but in "papel de reintegro" which must be presented at the Ministry of Fomento.

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Art. 7. Manufacturers are at liberty to adopt any distinctive mark for their manufactures which they may deem proper, with the following exceptions:—

Firstly. The Spanish Royal Arms and Orders and Decorations, without they be duly authorised so to do.

Secondly. The distinctive marks which others may have obtained by a prior certificate.

Art. 8. Those manufacturers who are not provided with the certificate to which Article 1 refers, will not be able to prosecute those who make use of the distinctive mark employed by them in their manufactures; but should they have obtained it, not only will they be authorised to make reclamation before the law courts against the usurpers for the infraction of the penalty laid down in Article 217 of the Penal Code, but likewise to demand indemnification for all the damages and injuries done to them. With regard to this right the same rules are to be observed as with respect to movable property.

Art. 9. A mark will alone be considered in use for the effects of the present decree, of the existence of which the corresponding certificate has been obtained.

Art. 10. The authorised and recognised marks, of which certificates have been furnished to the parties interested, will be deposited in the "Conservatorio de Artes," those that have been granted in each quarter being published in the "Gazette" within the same period, and at the end of the year a general statement of all that have been granted in the course thereof.

Art. 11. In the event of litigation before the competent judge, a sketch of the mark, together with an attested copy of the statement mentioned in Article 2, will be brought forward.

Art. 12. Refers to rules of a transitory nature, the use of which expired on November 20, 1851.

TURKEY.

[Parl. Pap. 1872, C. 596].

Regulation concerning the Trade-mark of Manufactured Goods and Articles of Commerce.

Chapter I.—*Rights of Proprietors of Trade-marks.*

Article 1. THE names, seals, signs, letters, numbers, wrapping, and other things stamped or impressed upon manufactured goods and upon merchandise, for the purpose of publishing the place or name

of the manufacture, or the name of the manufacturer and address of the trader who sells them; in fact, all the sign and stamp marks intended for the purpose of distinction and speciality are named trade-marks.

Art. 2. There is no obligation to adopt trade-marks for manufactured goods and merchandize.

Still, the Government may, when necessary, order the adoption of trade-marks for any manufacture.

Art. 3. No one shall have the right of prosecuting any person for forging of the mark which he may describe as his exclusive property if previously he does not deliver and place two samples of the mark he may have adopted at the Civil Court of the principal district within which he resides, as is prescribed in the second chapter.

Art. 4. The marks officially placed and delivered, as mentioned in the 3rd Article, can only have a duration of fifteen years. The exclusive right of the mark, however, will be renewed if the samples of the marks are renewed every fifteen years.

Art. 5. A fee of one medjidié gold shall be charged for the certificate, to be delivered to the proprietors of the marks deposited. This fee shall be remitted to the local municipal fund.

Art. 6. Foreigners exercising any art or trade in the Ottoman Empire may avail themselves of the benefits and securities contained in the present regulation by adopting a special mark for their manufacture or their articles of commerce, provided they observe the present regulation; and any case arising out of this subject shall be tried by the local tribunals, in accordance with the Article II. of this Regulation.

Chapter II.—*Respecting the Formalities Required for the Deposit of Trade-marks.*

Art. 7. Any person desiring, as stated in the Article 3, to deposit his trade-mark at the Central Civil Court of his province may, if his mark can be stamped as a seal or a stamp mark, deposit two specimens of it; and if the mark is of a different nature, he must deposit two samples of it, exactly similar to the original, with the necessary explanations signed and noted by himself, or his attorney.

He must, moreover, remit to the Council himself or through his attorney, officially and properly named, any power of attorney or other document to be there kept.

Art. 8. The chief clerk of the Council shall enter one of the two samples in a sheet of a special book kept for that purpose, and shall register the day and hour of the deposit, the name of the attorney of

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the proprietor of the mark, if he has any, the profession and address of the proprietor of the mark, and the nature of productions or goods upon which the mark is to be used; he shall also number consecutively the said sheets. This registration will be sealed or signed by the President and the chief clerk of the Court, and by the proprietor of the mark, or his attorney.

The other sample shall be gummed to another sheet of paper upon which all the aforesaid registrations and numbers shall be transcribed, and the bottom of the sheet shall be signed and sealed by the aforementioned persons for transmission to the Supreme Council of Justice.

Art. 9. After the above-stated formalities shall have been executed, a provisional certificate, sealed by the Governor of the province, the President and chief clerk of the Council, shall be delivered to the proprietor of the trade-mark on payment of one medjidié gold fee, which certificate will remain in his hands until the arrival of the certificate which shall be forwarded from the Supreme Council of Justice.

Art. 10. A copy of the sample and of the registration to be sent to the Supreme Council of Justice, as stated in the eighth article, shall be forwarded (to the Supreme Council) by the Governor of the place by the first mail; the copy of the samples and registration shall be kept and registered in the Supreme Council of Justice, and a printed certificate shall be forwarded to the original place within one month.

Chapter III.—*Respecting Legal Procedure.*

Art. 11. All litigations arising with respect to trade-marks shall be forthwith tried before the judicial councils of the provinces or the central civil courts; criminal cases having connection with the trade-marks shall be tried at the criminal branches of the judicial councils of the provinces or the central civil courts.

But if in the course of the trying the defendant sets up a pretension respecting the property of the trade-mark in question, such a pretension shall also be decided by the criminal court before which the parties appear.

Art. 12. The proprietor of the trade-mark may ask for and obtain the registration of the nature, form, and quantity of the goods upon which he pretended that his own mark has been placed in contravention to the present regulation. He may also, if necessary, obtain an order for the seizure of the said goods.

Such an order may be granted on the petition of the plaintiff,

and on his exhibiting to the authorities the certificate of deposit of his mark.

Arbitrators may also be appointed, if necessary, to assist the officers of the Court.

When the seizure of the goods is applied for, the Court may, if it thinks proper, require a security in money from the proprietor of the mark.

The order of the Court and copies of the certificates made out for the delivery of the security money must be given to the party in whose possession the seized goods were found.

If a defect exists in this formality, viz., if the said copies have not been delivered, the steps already taken shall be null and void, and damages resulting in this case shall be charged upon the messenger who may have committed the mistake.

Art. 13. The distance between the domicile of the defendant and the place where the goods may have been registered or seized, shall be calculated (by hours) at the rate of one day for every six hours. If no action is brought within fifteen days beyond the time so calculated, the registration or seizure of the goods are considered null and void.

Any action for damages may, however, be brought on.

Chapter IV.—*Respecting Penalties for Forgery of Trade Marks, the samples of which may have been officially deposited.*

Art. 14. A fine of from one to fifty gold medjidiés shall be levied, or an imprisonment from one to six months, or both of these penalties, according to the degree of his culpability, shall be inflicted upon any person having forged the trade-marks of which the stamp samples or the printed likeness may have been deposited according to the present regulation, or upon any person having used such forged marks.

Secondly, upon those who may have fraudulently placed on their own goods the marks belonging to others.

Thirdly, upon any persons who may have sold or offered to sell the forged marks, or those who may have knowingly sold one or several sorts of manufactured goods or articles of commerce upon which the mark of some other person is fraudulently placed.

Art. 15. Shall be liable to a fine from two to thirty gold medjidiés and an imprisonment from one week to two months, or of both of these penalties

1. Any person having fraudulently changed the form of a mark, and all persons using such a mark :

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2. Any person having placed a mark appropriated to a certain quality of goods upon another quality with the object of cheating the buyer or the quality of the articles :

3. All persons knowingly selling or offering for sale such goods.

Art. 16. Shall be liable to a fine from one to ten gold medjidiés, or an imprisonment from twenty-four hours to one week, or to both of these punishments.

Any person who shall not place the trade-mark upon all kinds of manufactured goods or merchandize indicated by the Government, as stated in the 2nd Article, and all persons selling or offering to sell such goods not bearing the official mark.

Art. 17. If any person is under the charge of several of the crimes mentioned in the Article, the heaviest penalty applicable in any of the violated Articles shall be inflicted.

Art. 18. A second conviction shall be punished by double the penalty provided for a first offence. Any person being convicted of one of the crimes herein mentioned shall be considered as having been previously convicted under this regulation if in the course of five years from the date of his condemnation he again commits one of the said crimes.

Art. 19. As has been explained in the 14th and 15th Articles, the manufactured goods and the merchandize bearing forged marks, and the implements employed in making them shall be confiscated by order of the Court, even in case the party accused is convicted and punished. The forged marks or the goods seized as bearing marks adopted by other parties may be given to the proprietors of the genuine marks, or may also be taken on account of the indemnity allowed. All marks contrary to the purports of the Articles 14 and 15 may be abolished.

Art. 20. If goods on which it is obligatory to affix marks are found without any marks, those who sell or offer to sell such goods are to be dealt with as prescribed by the 16th Article, and, moreover, the placing of marks upon such goods is ordered.

Art. 21. If this crime is repeated in the course of five years from the date of the former judgment, or the name of the place where they have been manufactured is forged, or indicated by transposition of letters, all persons knowingly selling or offering to sell such goods may be liable to a fine of from two to fifty gold medjidiés, or to an imprisonment from one to six months, or may be condemned to both of these punishments, according to the degree of culpability.

Art. 22. All cases arising from the circumstances mentioned in the 21st Article shall be tried, as prescribed by this regulation respecting the trial of cases.

Special Article.

Art. 23. When according to the purport of the 21st Article goods bearing the name of a place of the Ottoman Empire, different from that of the place where they have been manufactured, or showing the same name by transposition of letters, and all goods of importation or exportation of this category, may be seized by the Customs authorities on their arrival.

The Report drawn out by the Customs authorities on this subject is without delay, to be sent to the Civil Court, and an action forthwith brought.

Such actions must be brought within the time prescribed in the 4th chapter; the prescriptions of the 19th Article are also adapted to the goods seized, according to the tenor of the present Article.

Art. 24. The present regulation shall be in vigour six months after the date of its promulgation.

11*th Djemazil Evel*, 1287 (*October* 6, 1870).

UNITED STATES.

THE statute law relating to trade-marks is here given, but it does not seem clear that it is in the present state of things applicable to British subjects. They are, however, entitled to the protection of the common law of the several States. See ante, p. 72.

The United States Statute concerning trade-marks (approved July 10, 1870.)
41st Congress, Sess. 2, c. 230.

§ 77. And be it further enacted, that any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any State or Territory thereof, and any person, firm, or corporation resident of or located in any foreign country which, by treaty or convention, affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark, for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements, to-wit:—

First. By causing to be recorded in the Patent Office, the names of the parties and their residences and place of business, who desire the protection of the trade-mark.

Second. The class of merchandise and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated.

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Third. A description of the trade-mark itself with fac-similes thereof, and the mode in which it has been or is intended to be applied and used.

Fourth. The length of time, if any, during which the trade-mark has been used.

Fifth. The payment of a fee of 25 dols., in the same manner and for the same purpose as the fee required for patents.

Sixth. The compliance with such regulations as may be prescribed by the Commissioner of Patents.

Seventh. The filing of a declaration, under the oath of the person or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark, has a right to the use of the same, and that no other person, firm, or corporation, has the right to such use, either in the identical form or having such near resemblance thereto as might be calculated to deceive, and that the description and fac-similes presented for record are true copies of the trade-mark sought to be protected.

§ 78. And be it further enacted, that such trade-mark shall remain in force for thirty years from the date of such registration, except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this Act, at the same time that it becomes of no effect elsewhere, and during the period that it remains in force it shall entitle the person firm, or corporation registering the name to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive upon substantially the same description of goods: Provided that six months prior to the expiration of the said term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the Commissioner of Patents, and the fee for such renewal shall be the same as for the original registration, certificate of such renewal shall be issued in the same manner as for the original registration, and such trade-mark shall remain in force for a further term of thirty years: And provided further, that nothing in this section shall be construed by any Court as abridging or in any manner affecting unfavourably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which such trade-mark was registered.

§ 79. And be it further enacted, that any person or corporation who shall reproduce, copy, counterfeit, or imitate any such recorded

trade-mark, and affix the same to goods of substantially the same description, properties, and qualities as those referred to in the registration, shall be liable to an action on the case for damages for such unlawful use of said trade-mark at the suit of the owner thereof in any Court of competent jurisdiction in the United States, and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark, and to recover compensation therefor in any Court having jurisdiction over the person guilty of such wrongful use. The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons, or which is identical with a trade-mark appropriated to the same class of merchandise and belonging to a different owner and already registered or received for registration, or which so nearly resembles such last mentioned trade-mark as to be likely to deceive the public: Provided, that this section shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this Act.

§ 80. And be it further enacted, that the time of the receipt of any trade-mark at the Patent Office for registration, shall be noted and recorded, and copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith under the seal of the Patent Office, certified by the Commissioner, shall be evidence in any suit in which such trade-mark shall be brought in controversy.

§ 81. And be it further enacted, that the Commissioner of Patents is authorised to make rules and regulations and to prescribe forms for the transfer of the right to use such trade-marks, conforming as nearly as practicable to the requirements of the law respecting the transfer and transmission of copyrights.

§ 82. And be it further enacted, that any person who shall procure the registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark in the Patent Office, under this Act by making any false or fraudulent representations or declarations verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case in any court of competent jurisdiction within the United States.

§ 83. And be it further enacted, that nothing in this Act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if this Act had not been passed.

§ 84. And be it further enacted, that no action shall be maintained

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under the provisions of this Act by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

ITALY.

Legge concernente i Marchi ed i Segni distintivi di fabbrica.

30 *agosto*, 1868.

Vittorio Emanuele II., per grazia di Dio e per volontà della Nazione Re D'Italia.

IL Senato e la Camera dei Deputati hanno approvato; Noi abbiamo sanzionato e promulghiamo quanto segue:

Art. 1.

CHIUNQUE adotta un marchio, o altro segno, per distinguere i prodotti della sua industria, le mercanzie del suo commercio, e gli animali di una razza a lui appartenente, ne avrà l'uso esclusivo, purchè adempia il deposito in questa Legge prescritto.

Il marchio, o segno distintivo deve esser diverso da quelli già legalmente usati da altri, e deve indicare il luogo di origine, la fabbrica ed il commercio, in modo da constatare il nome della persona, la *ditta* della società e la denominazione dello Stabilimento, da cui provengono i prodotti e mercanzie; trattandosi di animali e di piccoli oggetti, sarà proposta ed approvata una sigla speciale o un segno equivalente.

La firma di carattere del produttore, commerciante o proprietario, incisa sui prodotti o riprodotta mediante suggello o qualunque altro mezzo durevole, ovvero anche scritta a mano, può costituire un marchio o segno distintivo.

Art. 2.

L'avente causa, o il successore industriale o commerciale, che vorrà conservare il marchio del suo autore, dovrà farne in carta bollata, da lire una, l'immediata dichiarazione.

Art. 3.

Il commerciante non può sopprimere il marchio, o segno distintivo, del produttore delle sue mercanzie senza espresso consentimento di lui; può bensì aggiungere separatamente il proprio marchio, o il segno distintivo del suo commercio.

Art. 4.

I marchi e segni distintivi, già legalmente usati all' estero sopra prodotti e mercanzie di fabbriche e commerci stranieri, che si spacciano nello Stato, o sopra animali di razze straniere diramate nel Regno, sono riconosciuti e garantiti, purchè si osservino, a riguardo di tali marchi e segni, le prescrizioni stabilite pei nazionali.

Art. 5.

Ferma stante la generale proibizione di usurpare il nome o la firma di una Società o di un individuo, è anche proibito di appropriarsi la *ditta* commerciale, ovvero l'insegna del negozio, l'emblema caratteristico, la denominazione o titolo di una Associazione o di un Corpo morale, sieno stranieri, sieno nazionali, ed apporli sopra botteghe, sopra oggetti d'industria o di commercio, o sopra disegni, incisioni od altre opere d'arte ; anche quando la *ditta,* l'insegna, l'emblema, la denominazione o titolo anzidetto non facciano parte di un marchio o segno distintivo, o trovinsi comunque trascritti in conformità della presente Legge.

Art. 6.

L'Amministrazione finanziaria dello stato può adottare marche e segni, per assicurare i prodotti delle sue manifatture e lo spaccio dei generi di privativa, uniformandosi alle prescrizioni della presente Legge ; e ciò senza pregiudizio delle disposizioni vigenti, per l'Amministrazione dello Stato, nella Legge che riguarda la produzione e la specie di tali prodotti.

Art. 7.

Chi vuole assicurare a se medesimo l'uso esclusivo di un marchio, o segno distintivo, nel senso previsto agli articoli precedenti, deve presentare ad una delle Prefetture del Regno :

(A.) Due esemplare del marchio o segno distintivo che intende adottare ;

(B.) Dichiarazione in duplice originale, in cui, espressa la volontà di riservarsi i diritti che gli competono, sia indicata la specie degli oggetti su cui si vuole apporre il marchio o segno, annotando se il marchio o segno distintivo saranno apposti sopra oggetti prodotti dal dichiarante o sopra mercanzie del suo commercio ;

(C.) Descrizione in duplice originale del marchio o segno distintivo ;

(D.) Quietanza del Ricevitore demaniale locale, dalla quale apparisca essersi pagate lire quaranta, a titolo di tassa e spese, per ciascun segno o marchio distintivo. I successori, o aventi causa, pagheranno la tassa di lire due per la trascrizione della dichiarazione prescritta nell' articolo 2.

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Art. 8.

Sulla riconosciuta rigolarità della parte estrinseca degli esibiti documenti, l'Ufficio di Prefettura inscrive, sulla dichiarazione anzidetta, l'annotazione del giorno e dell'ora in cui vennero esibiti.

La Prefettura trasmette ogni cosa, nel termine non eccedente i cinque giorni, al Ministero di Agricoltura e Commercio, il quale, trascritti i documenti stessi sopra registri pubblici, rilascia, se ne è il caso, l'attestato di trascrizione.

Il Ministro, allorquando le formalità sono compiute, rinvia uno degli esemplari del marchio, o segno distintivo alla Prefettura affinchè sia custodito o presso di essa, o presso una Camera di commercio, e reso ostensibile al pubblico anche nella Provincia ove fu iniziata la concessione.

Art. 9.

L'attestato non guarantisce l'importanza o l'autorità del marchio o segno distintivo, o la bontà o la provenienza dei prodotti, o l'esistenza delle altre condizioni richieste perchè l'attestato sia valido ed efficace.

Art. 10.

Dalla data dell' annotazione fatta dall' Ufficio di Prefettura, comincia a competere, a favore del dichiarante, il diritto a fare uso esclusivo del marchio o segno distintivo. Ma, per gli effetti delle multe e dei danni, dovrà essere immediatamente pubblicata, nella Gazzetta ufficiale, la concessione dell' attestato di privativa.

Art. 11.

Le azioni civili, riguardanti la proprietà dei marchi ed altri segni distintivi, saranno esercitate dinanzi ai Tribunali civili e la causa sarà estruita e giudicata in via sommaria.

Le azioni penali sono esercitate dinanzi al Tribunale competente. A promuovere l'azione penale non è necessaria l'istanza privata.

Art. 12.

Sarà punita con multa estensibile a L. 2000 (duemila) anche quando non siavi danno del terzo :

1° Chi avrà contraffatto un marchio o segno distintivo, o chi ne avrà fatto uso scientemente ;

2° Chi avrà scientemente messo in circolazione, venduto o introdotto dall' estero, e per uso di commercio, prodotti con marchi o segni contraffatti ;

3° Chi avrà contravvenuto al disposto degli articoli 3, 5 e 6 della presente Legge ;

4° Chi senza aver propriamente contraffatto un marchio o segno distintivo, ne avrà fatto una fraudolenta imitazione, o chi avrà fatto uso scientemente di marchio o segno fraudolentemente imitati ;

5° Chi avrà scientemente posto in circolazione, venduto o introdotto dall' estero, e per uso di commercio, prodotti con marchio o segno fraudolentemente imitati ;

6° Chi avrà fatto uso scientemente di marchio o segno, insegna od emblema portante indicazione atta a trarre in inganno il compratore sulla natura del prodotti, o chi avrà venduti prodotti muniti di tali marchi o segni o emblemi.

Nel caso di recidiva, la multa sarà estensibile a lire 4000 (quattromila).

I marchi o segni contraffatti, gl' istrumenti che hanno servito alla frode, non che i prodotti e oggetti accreditati con tale contraffazione, saranno confiscati.

I marchi o segni, insegne od emblemi alterati saranno reintegrati a spese del delinquente.

Queste pene sono applicabili senza pregiudizio del risarcimento dei danni a chi di ragione, e di quelle maggiori, che sieno stabilite dal Codice penale nel caso di falsità.

Art. 13.

È abrogata qualunque Legge o Decreto contrario alle presenti disposizioni, che avranno effetto anche nelle Provincie Venete e Mantovana.

Art. 14.

Un Regolamento approvato con Decreto Reale provvederà più specialmente agli ordinamenti speciali, alla pubblicazione sommaria degli attestati rilasciati dal Governo, ed a quant' altro occorra per la esecuzione della presente Legge.

Ordiniamo che la presente, munita del sigillo dello Stato, sia inserta nella raccolta ufficiale delle leggi e dei Decreti del Regno d'Italia, mandando a chiunque spetti di osservarla e di farla osservare come Legge dello stato.

Dato a Torino addì 30 Agosto, 1868.

VITTORIO EMANUELE.

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THE

TRADE MARKS REGISTRATION ACTS,

1875 AND 1876.

THE

TRADE MARKS REGISTRATION ACTS 1875 & 1876:

TOGETHER WITH

THE RULES

MADE THEREUNDER FOR THE REGISTRATION OF TRADE MARKS

AND THE

INSTRUCTIONS

ISSUED BY THE REGISTRAR.

With an Introduction and Notes:

AND WITH NOTES OF RECENT CASES RELATING TO THE LAW OF TRADE MARKS.

BEING

A SUPPLEMENT TO MESSRS. LUDLOW AND JENKYNS' TREATISE ON THE LAW OF TRADE MARKS AND TRADE NAMES.

(CORRECTED UP TO MARCH, 1877.)

By JAMES BRYCE,

OF LINCOLN'S INN, BARRISTER-AT-LAW, AND FELLOW OF ORIEL COLLEGE OXFORD.

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In this edition of the recent Trade Marks Registration Acts, there are contained (1) an Introduction explaining the system of registration and its effects, (2) the two Acts of 1875 and 1876 for the Registration of Trade Marks, (3) the Rules for the registration of trade marks issued by the Lord Chancellor on four different occasions under the powers of the first Act, (4) Notes on these Acts and Rules, (5) the Instructions for registration issued by the Registrar, and (6) a list of the reported cases affecting the law of trade marks which have been decided since the publication of Messrs. Ludlow & Jenkyns' book on Trade Marks and Trade Names. The work is intended to serve, not only as a supplement to the treatise of those gentlemen (at whose request it was prepared), but also, independently, as a guide to the present registration system, under which so many perplexing questions are arising.

7, Stone Buildings, Lincoln's Inn,
March 12*th*, 1877.

INTRODUCTION.

CONCISE GENERAL VIEW OF THE PROVISIONS OF THE ACTS AND RULES.

The Trade Marks Registration Act, which received the Royal Assent on August 13th, 1875, is a much shorter measure than were the Bills for the same purpose brought into Parliament in several preceding sessions. Probably it owes its success to this brevity, for those Bills had to be abandoned for want of time to discuss them fully, and if all the administrative details that require to be dealt with had been dealt with in the Act, its loss, which at one time seemed probable, could hardly have been averted. The plan was therefore adopted of settling by the Act only the general principles which are to govern registration, leaving details and ancillary provisions to be filled in by Rules issued under the authority of the Lord Chancellor, but subject to be disallowed by the resolution of either House of Parliament. These Rules were published in the end of December, 1875: immediately before the establishment of the Registry Office. It was found

in the months that followed that the registration of the immense number of marks sent in could not be completed within the time originally fixed; and accordingly a second Act was passed in the Session of 1876 which extended the time for another year, viz., to July 1st, 1877. Difficulties which had arisen with respect to the marks used upon cotton piece goods were met by the issue of some further Rules (*those numbered 57 to 63*); the old Rules were revised, some important alterations being made in them, and the new code was then reissued in the autumn of 1876, together with full instructions for the guidance of persons desiring to register. Finally, two Supplemental Rules relating to cotton marks were issued in February, 1877.

It is proposed to give here a concise account of the joint effect of the two Acts and the Rules.*

The Acts do not alter the general law relating to trade marks, but merely provide for the registration of such marks as they include, giving certain advantages to proprietors who register, and debarring those who have not registered, or at least applied for registration, from suing in respect of an alleged infringement. It is only in this sense that registration is made compulsory.

A general registry of trade marks is established

* Where "the Act" is referred to, the Principal Act, that of 1875, is intended.

in London (at present at Quality Court, Chancery Lane), where any person (including foreigners and persons not actually engaged in any business) may register such marks as fall within the definition given in sect. 10 of the Act of 1875, upon furnishing a copy thereof to the Registrar (Rule 3), complying with certain other formalities, and paying certain fees (Rules 5—11). Due notice of the application to register is to be given by advertisement (Rule 13), and any person may oppose registration. If the mark is objectionable, *e.g.*, contains a scandalous design, or includes words which the courts would not have protected, on the ground of their containing some misrepresentation, the Registrar is altogether forbidden to register it. If it is identical with a mark already on the register, he is not to do so except by special leave of the Court (sect. 6, Rule 19); and if several persons claim it, and he does not choose to decide between them, he may decline to register any of them, in the meantime requiring them to submit their claims to the Court (some branch of the Chancery Division of the High Court of Justice) (Rule 18).

The effect of registration is to give the registered proprietor a *primâ facie* title for five years (sect. 3), that is, to throw on any one against whom he may proceed for infringement the *onus* of proving that

the mark ought not to have been registered as his, and to relieve him from the necessity of proving that he has actually used the mark, *i.e.*, has thrown upon the market goods bearing it (sect. 2). After the lapse of five years, the registered proprietor's title becomes absolute, that is to say, his exclusive right to the use of the mark cannot be disproved by any evidence. But it may still be alleged that the mark is one which ought never to have been registered at all, *e.g.*, that it does not come within the definition of a trade mark in sect. 10, or that it involves some fraudulent misrepresentation.

The omission to register a mark which is capable of registration under the Acts prevents the person claiming it from bringing any action to prevent or recover damages for the infringement of it (sect. 1 of Act of 1876). If the mark is incapable of registration, *e.g.*, if it is a personal name, not written or printed in any peculiar way, or a fancy name, and was not used as a trade mark before August 13th, 1875, the Act does not apply, and the claimant has his remedy, whatever it may be, under the general law.

In the case of old names or marks (*i.e.*, used before August 13th, 1876), the claimant who has been refused registration, may obtain a certificate stating the fact, and is then exempt from the prohibition to bring an action; having done all he

could to obtain registration, the passing of the Act is not to prejudice his pre-existing right.

For the purposes of registration, goods are distributed under fifty classes (enumerated in the first Schedule to the Rules), in one or more of which every mark must be registered, an additional fee of 2s. being charged for every class after the first. An old mark must, moreover, be registered with respect to a particular description or descriptions of goods in each class, that is, not for a class as a whole; and this applies, no matter how many classes it is registered in. In case of doubt, the registrar has power to decide to what class any particular goods belong. When a mark has been placed on the register for any class, no new mark identical with or very similar to it, will (except by leave of the Court) be registered in that class. Thus, if A. register a tomahawk as his mark upon knives (class 12), B. will not be permitted subsequently to register a similar mark, not being one which he has used before the 13th of August, 1875, upon scissors, or files, or any other goods whatever belonging to class 12. But there will be nothing to prevent C. from registering a tomahawk as his mark for whiskey (class 43), or D. as his mark for gunpowder (class 20), provided that that mark has not already been registered in these classes. He, there-

fore, who registers a mark upon any goods acquires not only the exclusive right to use it himself upon those particular goods, but also the right to prevent others from having a similar mark (not used by them before August, 1875) registered for any other goods in that class, however dissimilar in appearance such other goods may be.

Registration, when once effected, is valid for fourteen years, without the payment of any annual fee, after which time a fresh fee of 2*l.* must be paid for re-registration, which again is valid for fourteen years more, and so on. But if the registered proprietor should not be dealing in the goods with respect to which the mark is registered, he is liable, at any time after five years from the date of registration, to have his mark struck off by the Court (Rule 34), on the ground that he has not that "goodwill of a business" to which it is intended that a mark shall be attached. A registered proprietor's right will pass by assignment *inter vivos*, or by will, or on an intestacy, bankruptcy, or marriage, but only to some person to whom there also passes therewith the goodwill in the business to which the mark was attached, or at least some share in such goodwill (Sect. 2 of Act, and see Rules 23–27). Where a business is divided among several persons, as on the dissolution of a partnership, each of the persons

who retains a share in the goodwill may be registered separately, if the others consent: if not, the leave of the Court must be obtained (Rule 27).

Some special provisions are made regarding marks on cotton goods (classes 23, 24, and 25, in the first schedule), by Rules 57–63, and by two new Supplemental Rules. An office is established at Manchester, where all such "cotton marks" are to be exhibited; and to this office all persons who were using any cotton mark at the date of the passing of the principal Act (Aug. 13, 1875), are to send representations thereof. A committee, named by the Commissioners of Patents, is to arrange these marks in two classes, the first including those which they conceive to be trade marks within the meaning of the Act, the second including those which are not such trade marks, either because they have become common in the trade, or for any other reason: and no mark placed in this second list is to be registered except by the leave of the Court.

The Registrar is placed under the supervision of the Commissioners of Patents (the Lord Chancellor, Master of the Rolls, Attorney-General, and Solicitor-General); while a certain measure of control over the register is entrusted to the Chancery Division of the High Court of Justice (Sects. 5, 6, 10, of Act, Rule 42), which has power to rectify

the register, to give leave for registration or for alteration of a registered mark, and to decide questions of disputed right to registration between adverse claimants (as to all of which see note to Rule 43). The register is to be open for inspection at least three days in each week, on payment of a small fee, and copies of any entry in it, including copies of the marks registered, may be obtained from the officials who have charge of it.

Omitting some further details with which the Rules deal, these are the leading features of the system. There remain, however, several questions which seem to have caused some perplexity among mercantile men, and on which, therefore, a few words may profitably be said.

First, as respects the marks to which the Act applies.

The definition of a trade mark contained in Sect. 10 of the principal Act includes "a distinctive label or ticket." Now, if a manufacturer or merchant uses a variety of tickets or labels differing in some points, but agreeing in others, is it necessary for him to register each and every of them in order to acquire or preserve his exclusive right to them? Supposing an East India merchant to use three tickets, X., Y., Z., all bearing the figure of an

elephant, but differing from one another in size, or in the combination of colours used, or in the words printed on the ticket, or in the scroll which surrounds the main figure, must he register each one by itself, or will it be enough to register X., trusting to the similarity which it bears to Y. and Z., to prevent the infringement of the two latter? The answer which the Registrar gives (and, it is apprehended, rightly gives), is this, that a merchant may have registered as much or as little as he pleases, and that he will thereby obtain protection for that precise thing which he registers, but for nothing more. If the Registrar is asked to register the figure of an elephant as used in a ticket, he will register that figure simply, omitting all reference to size, or shape, or scroll, or accompanying words. If, on the other hand, he is requested to register the elephant with the scroll, or with the word "earth-shaker," or with both the scroll and the word, he will likewise comply. In either case the merchant will become entitled not only to restrain the imitation of what he has registered, but to prevent another merchant from registering any very similar ticket for goods in the same class. If he has registered nothing but the figure of an elephant he may object to any one else registering an elephant, but he cannot object to a rival's registering a ticket which imitates

his by having a similar scroll, or word or device formed, say, by a peculiar combination of lines, and having either no figure, or the figure of some other creature (say a lion), since such a word, or scroll, or device, were no part of the trade mark which he registered. If to prevent such imitation he registers not only his elephant, but also the other features of his ticket, he acquires a right to have all these features protected, but that protection will only apply to the precise design registered, and not to other tickets of his differing in the character of the scroll or other adjuncts. He must register these tickets also in order to protect them, unless he chooses to take his chance of the Registrar's thinking that an imitation by his rival of one of these unregistered tickets is too similar to his already registered ticket, that is, to the part of it which he has actually registered, to be admissible on the register.

The drawback, therefore, to registering the principal part only of the design of a label or ticket is that this will not preserve the adjuncts from imitation. The drawback to registering these adjuncts, also, is that in that case it may prove necessary to register many varieties of design in label or ticket—an expensive process. A merchant who uses many such varieties must, therefore, choose between expense on the one hand, and on the other hand the

risk of having a ticket imitated, which, as unregistered, he cannot protect.

Secondly, a question has been raised as to the applicability of the Act to India and the British colonies. It is clear that it applies only within the United Kingdom, and that a merchant will not be prevented from proceeding in the Indian Courts against an imitation of his mark, because he has not registered it in England, unless of course some Indian statute should be passed requiring him to do so. But as it is usually in works or in a warehouse in England that trade marks are put on, it will usually be in the Courts of England that a manufacturer or merchant will desire to bring his action for infringement, against persons resident here who have put on the marks complained of.

It has been suggested with regard to merchants' marks, that as it is only where they trade to the same market that there is any danger of the marks they use being confounded with one another, every such mark ought to be registered as intended to be placed on goods to be exported to some particular market; so that (for example) A.'s mark of an eagle being registered with respect to goods to be sent to Japan, there would be no objection to allowing B. to register a very similar eagle for the Portuguese

market. The Acts and Rules, however, recognise no such distinction. Under them, registration of a mark is perfectly general, giving the owner a general title irrespective of the market for which his goods may be destined. Although, therefore, in the case put, B.'s use of the eagle would not practically interfere with A.'s, and A. might, therefore, probably not care to oppose B.'s application to be registered, still the Registrar cannot look to any such facts; and finding A.'s eagle already on the register for goods in class 24, he will refuse to register B.'s (unless of course B. can obtain the leave of the Court under sect. 6 and Rule 19).

Lastly, with respect to what are called common marks. In some departments of business (and especially in the cotton piece-goods trade) there are many stamps, devices, headings, and other marks not the exclusive property of any one firm, but used indiscriminately by several, or even by many. If any one trader, A., attempts to appropriate such a common mark by applying to have it registered as his, it will be in the power of others, B., C., and D., either to give notice of opposition to the registration of A. (Rule 16), or themselves to apply severally in like manner to be respectively registered as owners of the same mark, upon proving that they, equally with A., have been accustomed to use the

mark. Two courses will then be open to the Registrar under Rule 18. He may register all four of them, or he may refuse to register any of them, and submit or require them to submit their rights to the Court. If, instead of doing so, he should register some one of the applicants only (say A., the first applicant), any of the others may apply to the Court for a rectification of the register, which the Court may grant either by striking A. off, or by directing the applicant, B. or C. or D., to be also entered on the register as a proprietor of the mark. As it would seem unjust to give these four merchants, after the lapse of five years, an absolute exclusive right to a mark which had really been openly in common use by many others, it is probable that the Registrar will in such a case prefer to register none of them. In that case, any one or more of them may either apply to the Court for an order directing the Registrar to register him, or may obtain from the Registrar a certificate of his refusal to register him; in which latter event, he will, as already observed, become exempt from the prohibition to bring an action in respect of an unregistered mark (sect. 1 of Act of 1876), and may take proceedings against any one else using it, although, of course, those proceedings will fail if the mark is proved to be a common one. If he does neither,

but simply acquiesces and gets no certificate, he will be unable to bring any action against any person for using the mark.

These general principles, which of course apply only to the case of marks now in use, since in future every inventor of a mark which he expects to be valuable will have it registered, are as respects cotton piece-goods modified by Rules 58—63 (*ante*, p. xiii.), which provide a means for determining what cotton marks are common, and forbid the Registrar to register any such common mark, except in pursuance of an order of the Court.

For some remarks upon the sorts of marks that will not be registered, see the instructions issued by the Registrar (*post*, pp. 75—77), and the notes to sect. 10 of the principal Act (*post*, p. 12).

REGISTRATION OF TRADE MARKS.

[38 & 39 Vict. c. 91.]

CHAPTER 91.

An Act to establish a Register of Trade Marks.

[13th August, 1875.]

38 & 39 Vict. c. 91.

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.*

The latter part of this section, after the word "Patents," is repealed by the Trade Marks Registration Amendment Act, 1876 (39 & 40 Vict. c. 33), which extends the period to 1st July, 1877. See *post*, p. 15—17, for the substituted provisions and notes thereon.

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Characteristics of registered trade-mark.

2. A trade mark must be registered as belonging to particular goods, or classes of goods (*a*); and when registered shall be assigned and transmitted only in connexion with the goodwill (*b*) 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 (*c*).

(*a*) See, respecting descriptions and classes of goods, the Introduction, and sect. 6, and Rules 1, 3, 6, 17, 19.

(*b*) See, respecting goodwill of business, s. 3, and Rules 27, 29, 34. Although by the Act and Rules a man cannot continue on the register as proprietor of a trade mark unless he has the goodwill of the business in the goods it is used for, nor transmit his mark to another person without such goodwill, he need not be carrying on such a business, nor indeed any business whatever, in order to claim registration in the first instance.

(*c*) This provision removes the necessity which previously existed of proving, in an action brought for the infringement of a trade mark, that goods bearing the trade mark which it was sought to protect had been actually thrown upon the market by the plaintiff or his predecessor in title.

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 connexion with the goodwill of a business.

That is, the registered proprietor has, during the first five years from registration, these two advantages—(1.) That he need not prove user; (2.) That he is relieved of the *onus* of proving that he is entitled to the exclusive use of the mark, it being thrown on the defendant to prove that he, the plaintiff, is not so entitled. After

the expiry of five years, the right of the registered proprietor becomes *absolute, and cannot be disputed by a defendant. But it is* apprehended that after, no less than before, the expiry of the five years, the right of the registered proprietor may be contested on any ground going to show that the mark ought never to have been registered at all, *e.g.*, that it is not a trade mark within the meaning of the Act, that it contains some fraudulent statement, or would for some other reason be "not deemed entitled to protection in a Court of Equity" (s. 6). In other words, the functions of the Registrar are purely ministerial, and he does not by registering a mark which ought never to have been registered at all, give it any validity which it would otherwise have lacked. 38 & 39 Vict. c. 91.

"Exclusive use" of course means exclusive as respects the class of goods in which the mark is registered. In the case of old marks, several persons may be registered.

Title of proprietor claiming by transmitted proprietorship.

4. Every proprietor registered in respect to a trade mark subsequently to the first registered proprietor (*a*) 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 (*b*).

(*a*) See Rules 23—29.

(*b*) The five years will, therefore, continue to run in favour of a subsequent proprietor as from the date of his predecessor's registration.

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 to 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

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may apply in the prescribed manner for an order of the court (*a*) 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 (*b*), 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.

(*a*) As to applications to the court, which is declared by Rule 42 to be the Chancery Division of the High Court of Justice, see Rules 42 to 45, and notes thereto, *post*, in which the various forms which applications to the court may take are classified.

(*b*) See end of sect. 10.

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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 (*a*).

It shall not be lawful to register as part of or in combination with (*b*) 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 (*c*); or any scandalous design.

(*a*) See Rule 18, and notes thereto, where the relation of that rule to this section is considered.

(*b*) As to words used in combination with a trade mark, see sect. 10.

(*c*) If such words are registered, the registration would be beyond the Registrar's power, and therefore null.

If the trade itself were fraudulent, the Court would not protect a mark used in it.

If the words are common terms of description (*e.g.*, "Nourishing Stout," Raggett *v.* Findlater, L. R. 17 Eq. 29), or common directions (*e.g.*, "Shake the bottle"), their *exclusive* use would not be protected by the Court. See Instructions, *infra*, pp. 74—76, *et passim*.

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

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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.

These Rules have been made, and are here printed. The Registrar is by Rule 68 subjected to the superintendence of the Commissioners of Patents, and directed to conform to any instructions issued by

them or any of them. As to his office, &c., see Instructions, *post*, p. 78. 38 & 39 Vict. c. 91.

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. Certificate of registrar to be evidence.

See Rule 41.

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: Provision as to Cutlers Company and Sheffield corporate marks.

See Rules 46 to 56.

(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:

Rule 46 prescribes March 1st, 1876: Rule 47 prescribes the manner.

(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

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time (*a*) and in the prescribed manner (*a*), 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 (*b*) 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 (*c*), notice of such application, with a copy of such trade mark, shall, within the prescribed time (*d*) and in the prescribed manner (*d*), be delivered to the Cutlers Company; and such trade mark shall not be registered until after the expiration of the prescribed period (*e*) from the giving of the last-mentioned notice:

(*a*) Rule 48 prescribes the time: Rule 49 the manner of giving notice by the Cutlers' Company.

(*b*) By Rule 50 the period is six weeks.

(*c*) These goods are knives, sheares, sciasors, razors, sickles, files, forks, saws, and other edge tools (all comprised in Class 12), other articles of steel or of steel and iron combined having a cutting edge (Classes 11, 12, 13, 19, possibly also Classes 6, 7, and 8), and steel (Class 5). It would seem, therefore, that notice must be given to the Cutlers' Company of every application to register a mark for any goods falling under any one of these classes above mentioned.

(*d*) Rule 51 prescribes the time: Rule 52 the manner of giving notice to the Cutlers' Company.

(*e*) By Rule 53 the period is six weeks. But, in fact, no trade mark (except a cotton mark) can be registered until three months have elapsed from the date of advertising the application: Rule 17.

(3.) Upon the assigning of any such mark or device, or the registration of any such trade mark as afore-

said, 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 : 38 & 39 Vict. c. 91.

Rule 54 fixes the time at fourteen days : Rule 55 prescribes the manner.

(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 :

A Sheffield corporate mark is assigned to its owner in respect of all and any goods whatever, whether actually made by him or not, and cannot be used by any one else in Hallamshire even upon goods which such owner does not in fact make. This sub-section, however, gives protection to such a mark not to the whole extent of its validity in Hallamshire, but only so far as (that is to say, in respect of goods on which) it has actually been used. But as no mark identical with or similar to one already registered is to be registered in respect of any goods belonging to the same class, this restriction is of practical importance only where a Sheffield manufacturer having got his corporate mark and using it on some goods belonging to one class, *e.g.*, knives (Class 12), thinks he may wish at some future time to use it for goods of another class, *e.g.*, steel (Class 5), or swords (Class 19). In this case he must register it in the London Registry in respect of some goods in such other class or classes.

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(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:

This section makes no restriction as to the class, but absolutely forbids the assignment by the Cutlers' Company of a mark similar to one registered in the London Registry under any of those classes to which sub-section (2) refers, and notified to the company.

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

The only advantages which the Act gives to the owner of a Sheffield mark consist in this—that he obtains through the Cutlers' Company, notice of any application to register a mark in respect of the goods he deals in, and that (by sub-section 4, *ante*) no mark identical with or very similar to a mark of his actually used on any goods, and notified to the registrar, can be entered in the London Registry in respect of goods belonging to the same class as that to which such last mentioned goods belong. He will not be entitled to have his mark registered in London in respect of all his goods, as he can register it in Sheffield, unless he makes an application as respects each particular class of goods in the manner prescribed by the Rules (Rule 4).

(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. 38 & 39 Vict. c. 91.

Apparently this exemption is to be read as if the words, "so far as it is a Sheffield corporate mark and protected by the special Acts relating thereto," were added at the end of the sub-section. This has been doubted: but the fact that the saving is in favour of the Sheffield mark only *qua* "corporate mark" (*i.e.*, not as an ordinary trade mark), while as a corporate mark it has no validity outside Hallamshire, and the provisions of sub-section 6 respecting registration, seem to establish this interpretation. The section in effect says:—The character or incidents of a Sheffield corporate mark shall, so far as Hallamshire is concerned, remain unaffected; but outside Hallamshire it shall be dealt with like any other mark, that is, it shall require registration in order to entitle its owner to bring an action against any infringer whom he cannot proceed against under the Cutlers' Company Acts. Now a Sheffield mark can, subject to the indefeasible life-interest of a widow, be bequeathed apart from the goodwill of a business, whereas by sect. 2 of the Act the right to a registered trade mark can be claimed only in connection with goodwill. It may, therefore, happen that a widow who has not the goodwill of her husband's business, or a legatee to whom the mark has been bequeathed without the goodwill, may have a good title to the mark in Hallamshire, and yet be unable to get registration in London.

10. For the purposes of this Act: Definitions.

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 (*a*); or

A written signature or copy of a written signature of an individual or firm; or

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A distinctive device, mark, heading, label, or ticket (*b*);

and there may be added to any one or more of the said particulars any letters (*c*), words, or figures, or combination of letters, words, or figures; also

Any special and distinctive word (*d*) 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 (*e*); 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 trades 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 (*f*).

(*a*) A name pure and simple of a person or firm is not registrable under the Act as a new mark, but will of course continue to be protected by the courts as heretofore. If it is sought to register it, it must be put into some peculiar and distinctive character, *e.g.*, by a distinctive form in the letters, or by their being printed in an uncommon figure, as a zigzag or waving line, or by drawing bars across, or placing spots within the letters, or possibly by adding flourishes,

or a scroll, or putting an entablature round the name, the Registrar being always the judge how far the style adopted is distinctive. The written signature would have fallen under this description, had it not been specially referred to. 38 & 39 Vict. c. 91.

(*b*) Some difficulty is likely to arise on this definition. A label or ticket usually contains the name of the maker or seller of the goods; if the ticket is registered containing the name, and another person seeks to register a ticket similar in design, but with his own name, will this constitute a sufficient difference? It is apprehended that as the design is the essential part, it will not do so. Again, will words of mere praise, or words directing some common operation (*e.g.*, "to be shaken before being used"), on the label of a sauce bottle, be capable of registration as part of a label? Apparently not; for by sect. 6, words whose exclusive use would not be entitled to protection in a Court of Equity are not to be registered. Where a ticket is printed with several different borders, or with the dealer's name in type of different styles, will each border and each style need separate registration? The question will probably be decided by seeing exactly what it is that is registered in each case. If the general design, style, and configuration of the label or ticket is registered, *e.g.*, its shape, its border, any device it may contain, not mentioning the particular words which are printed on it, then a variation in these words will not make separate registration necessary. So even as regards colour: if a man registering the figure of an elephant or an eagle upon a ticket is content to register simply that figure, not mentioning the colour in which it is stamped nor the ground-colour of the ticket, he may stamp it in any number of colours without needing to register afresh. Upon this point, see the concluding paragraphs of the Introduction, *ante*. It is understood that the Registrar (by the direction of the Commissioners of Patents) ignores colour; so that if a reference to colour is contained in the statement, it is treated as surplusage: while if an applicant seeks to register two marks differing only in colour, he is required to choose between them.

"Distinctive" means "sufficiently peculiar to be capable of distinguishing;" and has no reference to the question whether any particular device or word does in fact distinguish the goods it is placed on, *i.e.*, whether or not it is a mark used in common by a number of persons or firms. As to common marks, see Introduction.

(*c*) It would, therefore, appear that initials cannot be registered alone as a trade mark under the Act (unless used as such before its passing), though they may in combination with a device. They pro-

38 & 39 Vict. c. 91.

bably can, however, if treated as a monogram, *i.e.*, turned into a device, just as a name may be by being printed in a distinctive manner.

(*d*) Such fancy names as "Ozokerit," "Eureka,' "Glenfield," therefore, cannot be registered, unless of course they were used as trade marks before the 13th of August, 1875. So held by M. R. in *Ex parte Stephens*, L. R. 3 Ch. D. 659, where the word "Aeilyton" was refused registration. Inasmuch as they will not fall under the provisions of sect. 1 as to registration, they will retain such right to protection as the general law has hitherto given them, in the same way as names not registrable under the Act.

The registrar does not admit the word "registered" as part of a trade mark; and a motion to compel him to admit it was refused by V.-C. Hall, *In re Meikle's Trade Mark*, Weekly Notes, August 12, 1876.

On the question whether words or devices admittedly common to a trade will be registered as part of a trade mark, along with something which is private and distinctive, see *In re Barrows and Trade Marks Registration Acts*, Weekly Notes, March 10th, 1877; the decision in which case is understood to be now under appeal.

Whether a trade name used before the passing of the Act as a trade mark is registrable under this provision as a "special and distinctive word" may possibly be matter of question. It is understood that the registrar does, in fact, admit such names to registration: but, of course, this is without prejudice to the right of another trader to use such name if it happens to be his own.

(*e*) See Rule 42, which declares the Court to be the Chancery Division of the High Court of Justice.

(*f*) No power is given to a Scotch or Irish Court to make an order expressly rectifying the register (see, however, Rule 36 and note thereto). If, therefore, such courts conceive that they have not power to do so, but a decision is given in one of them the effect of which may be considered doubtful, and the Registrar alters or does not alter the register in a way which a party concerned conceives to be prejudicial to him, it is apprehended that he may apply to the English Court (the Chancery Division) under sect. 5 to have the register rectified, in which case it may be assumed that the English Court, if it interfered at all, would not review the decision of the Scotch or Irish Court, but confine itself to interpreting that decision and directing the Registrar how he should give effect thereto.

Short title of Act.

11. This Act may be cited for all purposes as the Trade Marks Registration Act, 1875.

TRADE MARKS REGISTRATION AMENDMENT.

[39 & 40 Vict. c. 33.]

An Act for the Amendment of the Trade Marks Registration Act, 1875.

[24th July, 1876.]

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: 39 & 40 Vict. c. 33.

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:

1. There shall be repealed so much of section one of *Amendment of s. 1*

39 & 40 Vict. c. 33. ——— of the principal Act.

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.

This section differs from section 1 of the principal Act in the following points :—

1. It extends the period after which proceedings, in respect of the infringement of an unregistered mark are forbidden, till July 1st, 1877.
2. It forbids actions to recover damages for infringement of an unregistered mark as well as proceedings for an injunction.
3. With regard to marks, &c., used as trade marks before August 13th, 1875, it allows proceedings to be taken in respect of any infringement of them in cases where an application to register them has been made and refused. It therefore so far exempts these old marks from the provisions of the section ; whereas new marks (those not used before August 13th, 1875) are exempt from those provisions only if they are not registrable at all, *i.e.*, if they are not trade marks within the meaning of the principal Act.

The power of instituting criminal proceedings under the Merchandize Marks Act (25 & 26 Vict. c. 88) in respect of the fraudu-

lent imitation of an unregistered mark does not seem to be taken away by this section. 39 & 40 Vict. c. 33.

On the strict construction of this section a man must not only have applied for registration, but be already registered as proprietor before he can issue his writ against an infringer of his trade mark. But it is presumed that he will be allowed to sue in respect of any infringement committed during the interval between his application and his registration (at least in cases where he proves *mala fides* in the infringer), as well as in respect of infringements committed before the 1st of July, 1877, where he has not issued his writ till after that day.

It is important to observe that the prohibition of this section applies only to marks which are trade marks under section 10 of the principal Act, and therefore not (a) to trade names, unless written or printed in some distinctive manner, nor (b) to fancy names (such as Eureka, Ozokerit, Excelsior, Belgravia). For such names, unless used as trade marks before the passing of the Act, are not registrable thereunder (s. 10).

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.

This provision is intended to prevent any owner of a trade mark used as such before August 13th, 1875, from being prejudiced by the Registrar's refusal to register him as owner thereof. If the Registrar refuses, such owner is to have exactly the same rights as he would have had if the principal Act had not been passed, *i.e.*, he may, on obtaining from the Registrar a certificate of refusal, bring his action against the infringer.

Short title.

3. This Act may be cited for all purposes as the Trade Marks Registration Amendment Act, 1876.

RULES

MADE BY THE LORD CHANCELLOR UNDER THE ACT OF 1875.

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SCHEDULES.

RULES.

WHEREAS by the Trade Marks Registration Act, 1875, the Lord Chancellor is authorised from time to time, with the assent of the Treasury as to fees, to make general rules as to the registry of trade marks, and other matters connected therewith, and also when made to alter, annul, or vary such rules, as is in the said Act mentioned:

Now, therefore, I, the Right Honourable Hugh Mac-Calmont Baron Cairns, of Garmoyle in the county of Antrim, Lord High Chancellor of Great Britain, in pursuance of the said Act, and of all other powers enabling me in this behalf, do hereby without prejudice to any proceedings that may have been taken under any former rules as to the registry of trade marks before made by me, annul all such rules, and do hereby make the following Rules:—

Preliminary.

Classification of goods in schedule.

1. For the purposes of these Rules goods are classified in the manner appearing in the first schedule hereto.

Fees.

2. The fees to be charged in pursuance of these Rules are the fees specified in the second schedule hereto.

Determination of doubt as to classes.

3. If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the registrar.

Registration of different

4. A trade mark or trade marks may be registered in pursuance of the same application by the same person in

respect of all or any goods, subject to the payment of the additional fees specified in the second schedule in respect of the registration of different trade marks or the extension of the same trade marks to goods in different classes.

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trade marks, or trade marks in different classes.

The effect of this is that a person may register the same mark at the same time in any number of classes by paying 2s. with his application and 2s. more on registration, in respect of each class after the first, for which of course he pays £1 on application and £1 on registration. As no provision is made for the case of a man desiring to register in another class a mark already registered, *i.e.*, subsequently to extend the same mark to goods in another class, it may be taken that in such a case no reduction of fees will be made, but the application be treated as a new one altogether. So any number of marks may be registered at the same time by payment with the application of 10s. for each additional one after the first, and 10s. more on registration; but if the registered owner of one mark afterwards wishes to have another mark registered, whether for the same or other goods, he must make an entirely new application and pay the regular fees thereon: viz., £1 with application and £1 on registration.

Application for Registry.

5. A person, whether a British subject or an alien, desiring to register a trade mark shall apply to the registrar by sending to him a statement accompanied by such declaration as is hereinafter mentioned and the prescribed fee.

Proceedings on application.

See Instructions, *post*, pp. 71–78.
"Person" includes body corporate.

6. The statement shall contain the following particulars:—

Contents of statement on application.

A. The name and address and calling (*a*) of the applicant: and

B. The description (*b*) or reference to a description of the trade mark to be registered: and

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C. The class or classes of goods (being some one or more of the classes mentioned in the first schedule) (*c*): and

D. In the case of a trade mark used before the passing of this Act, a description of the goods in respect of which it has been used and the length of time during which it has been so used.

(*a*) The "calling" is to be stated only for the purpose of identifying the applicant, not in order to show that he carries on a business concerned in the goods to which the mark is to be applied, since the Registrar is not entitled to refuse to register a person on the ground that he does not carry on such a business (see note to sect. 2 of Act), although he may be struck off the register if he is not carrying on such business five years after registration (Rule 34).

(*b*) For "description," see Rule 8.

(*c*) The applicant must name the class, and must also, according to the present practice of the office, in most cases enumerate the particular goods with respect to which he desires to register his mark; and such enumeration may be as comprehensive as he pleases, may exhaust, so far as this can be done, all the possible goods falling under the class in question. He is not, save in exceptional cases, such as marks in Class 13, allowed to register an old mark for the class as a whole, *i.e.*, for all goods whatsoever falling under it; but he may, it is understood, register a new mark for the whole class.

Requisites of statement.

7. The above statement must bear a date and be signed by the applicant. Subject to any other directions that may be given by the registrar, the statement sent to the registrar shall be upon foolscap paper of a size of thirteen inches by eight inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

The statement must be marked for identification by the person before whom the declaration is made as having been shown to the deponent at the time of declaring. See Form C in Third Schedule.

Nature and size of

8. Subject to any other directions that may be given

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representation of trade mark.

by the registrar, a description of a trade mark shall be given in writing, and shall be accompanied, when practicable, by a drawing or other representation, of a durable nature, in duplicate not less than three inches square, on foolscap paper of the size aforesaid, or by pasting or otherwise fastening on such paper a specimen of the trade mark.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as may be thought most convenient.

The registrar may, if dissatisfied with the representation of a trade mark, require a fresh representation either before he proceeds with the application or before he registers the trade mark.

The registrar may also, in exceptional cases, deposit in the Patent Museum a specimen or copy of a trade mark which cannot conveniently be placed on his register, and may refer thereto in his register in such manner as he thinks advisable.

Declaration to accompany application.

9. The declaration must be on foolscap paper of the above-mentioned size, and must verify the statement, and declare that, to the best of the applicant's knowledge and belief, he is lawfully entitled to use the trade mark, and must be made and subscribed as hereinafter mentioned.

The applicant is not required to declare that he is exclusively entitled to the mark, or that no one else in fact has used or uses it. Apparently the only case in which a man will be unable to make such a declaration, after the 1st of July, 1877, is where he knows that some one else is duly registered as owner of the mark, and even then he may sometimes be able to claim to be lawfully entitled.

As to making and subscribing, see next Rule and Rules 64—67.

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Application by company.

10. Where an application for the registry of a trade mark is made by or on behalf of a corporate body of persons, the statement and declaration shall be made by the secretary or other principal officer of the body of persons; and the registrar may require such proof as he thinks fit that the application made is duly authorised by such body of persons.

In the case of a company, proof of a resolution would no doubt be sufficient.

Application by firm.

11. Where an application for the registry of a trade mark is made by or on behalf of any firm or partnership, the statement and declaration may be made by any one member of such firm or partnership, or by any person duly authorised by such firm or partnership; and the registrar may require such proof as he thinks fit that the application made is duly authorised by such firm or partnership.

Acknowledgment of application by registrar.

12. On receipt of the application the registrar shall send to the applicant an acknowledgment thereof.

Advertisement of Application and Notice of Opposition.

Advertisement of application.

13. As soon as may be after the receipt of an application made as provided by these Rules, the registrar shall require the applicant to insert an advertisement of the application in the official paper, during such time, and in such form, and generally in such manner as the registrar may think desirable, and distinguishing whether the mark has or has not been used before the thirteenth day of August, one thousand eight hundred and seventy-five.

For instructions for advertising, see p. 79, *post*.

This and the 15th and 17th Rules, do not apply to cotton marks. See Supplemental Rules, p. 53.

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Definition of official paper.

14. The official paper for the purposes of these Rules shall be some paper published under the direction of the Commissioners of Patents, or such other paper as such Commissioners, or any one of them, may from time to time direct.

The official paper is a special journal, called "The Trade Marks Journal." See Instructions, *post*, p. 79.

Means of advertising trade mark to be supplied to official paper.

15. For the purposes of such advertisement the applicant may be required to furnish the printer of the official paper with a wood-block or electrotype of the trade mark, of such dimensions as may from time to time be directed by the registrar, or with such other information or means of advertising the trade mark as may be allowed by the registrar.

See Instructions, *post*, p. 75 and p. 79.

Not to apply to cotton marks; see p. 53.

Notice and proceedings for opposition.

16. A notice of opposition may be given by sending to the registrar, together with the prescribed fee, a written notice in duplicate, on foolscap paper of such size as aforesaid, stating the grounds of the opposition. The registrar shall acknowledge the receipt of such notice of opposition, and shall send one copy of such notice to the applicant.

Within three weeks after the receipt of such notice, or such further time as the registrar may allow, the applicant may send to the registrar, on foolscap paper of such size as aforesaid, a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so shall be deemed to have withdrawn his application.

If the applicant sends such counter-statement the registrar shall require the person who gave notice of op-

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position to give security, in such manner and to such amount as the registrar may require, for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made, or such further time as the registrar may allow, the opposition shall be deemed to be withdrawn.

If the person who gave notice of opposition duly gives such security as aforesaid, the registrar shall send him one copy of the counter-statement sent by the applicant, and thereupon the case shall be deemed to stand for the determination of the Court.

The person giving notice of opposition is not required by the Rules to show any interest of his own in the matter: the requirement to give security being relied on to prevent frivolous oppositions.

Registration of Trade Marks.

Time of registration of trade mark.

17. On the expiration of three months from the date of the first appearance of the advertisement in the official paper, the registrar may, if he is satisfied that the applicant is entitled to registration, register the trade mark in respect of the description of goods for which he may be entitled to be registered, and the applicant as the proprietor thereof, on payment of the prescribed fee.

See sect. 6 of Act, forbidding registration in certain cases. In case the mark is wrongly registered, it is apprehended that the registration may be overset at any time, even after the lapse of five years (see note to sect. 3 of Act).

The Registrar is not prevented from registering where he thinks proper to do so, by the mere fact of opposition.

This Rule does not apply to cotton marks. See p. 53 for Supplemental Rules.

Duty of registrar

18. Where each of several persons claims to be registered as proprietor of the same or a nearly identical

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in case of disputed claim.

trade mark, in respect of the same goods or goods belonging to the same class, the registrar shall use his discretion as to registering all or any of such trade marks, either unconditionally or on the condition of the introduction of such variations (if any) or otherwise as he thinks fit, or the registrar may, if in any case he thinks it expedient, submit or require the claimants to submit their rights to the court.

Explanatory of the second paragraph of sect. 3 of Act, and further defining the Registrar's discretion by permitting him to refuse to register where the marks are nearly identical, and also to insist on variations.

Under this provision he may apparently register any number of persons in respect of the same mark, if satisfied that they have an equal claim to it by user, but it is understood that he will do this only where the mark is an old one. Or he may refuse to register any.

Prohibition of registration of identical trade marks.

19. Where a trade mark has been already registered in respect of any goods or description of goods belonging to one particular class, a trade mark identical with such trade mark, or so nearly resembling the same as to be calculated to deceive, shall not, without leave of the Court, be registered in the name of another person as proprietor thereof with respect to any goods in that class.

See sect. 6 of Act, which forbids the Registrar to "register in respect of 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." This Rule, which otherwise merely repeats sect. 6, appears to permit him to register in this case with the leave of the Court, which sect. 6 allows in the case of an identical mark, but omits in the case of one "calculated to deceive." Thus the Rules appear to give a power to the Court which the Act has not given. The question whether the Court has such power will, of course, be the first point which will fall to be decided if an application is made for leave to register a mark very similar to one already on the register.

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The leave of the Court might be asked for on such grounds as that the applicant was as well entitled to the mark by previous use, as is the person already registered, although the latter may have managed to get first on the register, or that the goods on which the applicant purposes to use the mark differ so widely from those on which the mark is placed by the person already registered, that no confusion need be apprehended.

Entries to be made in register.

20. Upon registering any trade mark the registrar shall enter in the register the date on which the statement relating to the application for registry was received by the registrar (which day shall be deemed to be the date of the registry) and such other particulars as he may think necessary, including the name and address of the proprietor.

By Rule 39 registered owner may send to Registrar notice of change of address.

Notice of registration.

21. The registrar shall send notice to the applicant of the registration of his trade mark, together with a reference, where practicable, to the advertisement of such trade mark in the official paper.

A certificate is not to be given unless when required for some special purpose (see Rule 41).

Trust not to be entered in register.

22. There shall not be entered in the register, or be receivable by the registrar, any notice of any trust, expressed, implied, or constructive.

All proceedings will therefore be taken by or against the person whose name appears in the register as proprietor of the mark.

But the title of a registered proprietor will no doubt be subject to unregistered rights, interests, or equities, as was expressly provided by a clause which was in the Bill when it came from the Select Committee of the House of Commons, but seems to have eventually slipped out.

Registration of subsequent Proprietors.

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Registration of assignee or transmittee.

23. The person to whom any registered trade mark has been assigned or transmitted may apply to be registered as proprietor thereof.

Production of assignment, &c. by assignee.

24. Where the trade mark has been assigned the person claiming as assignee to be registered shall send to the registrar, with his application, an assignment by deed executed both by the assignor and assignee, and a declaration verifying the fact of such assignment having been made.

Application in this case of course does not require the statement and declaration which by Rule 5 are to accompany an original application to register.

By Rule 72 the deed of assignment may be in Form E in the third Schedule.

The accompanying declaration will simply state the fact of assignment, identifying the deed whereby such assignment was made, and will state that the assignee is entitled to the goodwill of the business. See Rule 27, *post*.

Right of transmittee or his assignee.

25. Where a trade mark has been transmitted by the death of the registered proprietor, the legal personal representative of such proprietor shall be recognised as having the title to the mark (*a*).

Where the trade mark has been transmitted by marriage, bankruptcy, or otherwise by operation of law, the person applying as the transmittee to be registered shall send to the registrar, together with his application, a statement of the manner in which such trade mark has been transmitted, and a declaration verifying such statement (*b*).

Any transmittee may assign his interest in the mark,

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notwithstanding that he has not been registered as proprietor thereof.

(*a*) That is, neither a legatee, nor a person claiming as next of kin of an intestate, shall be entitled to claim registration unless he can produce an assignment of the mark to him (together with the good-will of the business) from the executor or administrator; which assignment the executor may make, although he has not been himself registered as proprietor. He may, of course, have himself registered if he thinks fit.

(*b*) As to declaration, see Rules 64–67; and see also Form F in third Schedule, where a form is also given for the declaration by a personal representative.

Evidence to be produced on transmission.

26. Where the person applying to be registered claims as the transmittee of any registered proprietor, or as the assignee of a transmittee, there shall be produced to the registrar the following evidence:—

(1.) If the business concerned in the goods with respect to which the trade mark is registered is carried on in England or Ireland, then,

A. If such transmission has taken place by the death of any person, there shall be produced the probate of the will of such deceased person, or the letters of administration to his estate, or an official extract therefrom; and

B. If such transmission has taken place by the marriage of the female proprietor, there shall be produced a certified copy of the register of such marriage, or other legal evidence of the celebration thereof, and a declaration of the identity of such female proprietor; and

C. If such transmission has taken place by

Rules.

the bankruptcy of the registered proprietor, or otherwise by operation of law, there shall be produced to the registrar such evidence as may, for the time being, be receivable as proof of the title of the applicant; and

(2.) Where the said business is not carried on in England or Ireland,—

There shall be produced similar evidence to that hereinbefore prescribed, or such evidence as would be received as sufficient evidence in the courts of justice of the country or place at which the proprietor carries on business.

Declaration by assignee and transmittee.

27. Every declaration made by an assignee or transmittee shall state his name and address, and that he is entitled to the goodwill of the business concerned in the goods with respect to which the trade mark is registered, or to some part of such goodwill.

See sect. 2 of Act, and Forms in third Schedule.

Assignee, &c. of joint owners.

28. Where two or more persons are registered as joint proprietors of the same registered trade mark, those proprietors, or the survivors or survivor of them, or their or his assignee or transmittee, shall alone be recognized by the registrar as having any title to the mark.

That is to say, if one of two registered joint proprietors of a mark alone assigns, or dies, or becomes bankrupt, his assignee, or executor, or trustee, shall not be recognized as having any title to be registered

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as proprietor of the mark, the right whereto shall remain in the survivor or other joint proprietor; or in other words, the survivor of two or more jointly registered proprietors shall always be entitled, so far as the register is concerned, as against any person claiming through one of such proprietors only.

Registration of joint owners as separate owners of separate trade marks.

29. Where divers persons claim to be severally entitled to the goodwill of a business concerned in the goods with respect to which a trade mark has been registered, such persons, or any of them, may, if they all consent thereto, and on the production of the proper evidence, and on payment of the prescribed fee, be registered separately as separate proprietors of such trade mark.

If all of such persons so entitled do not so consent, the registrar shall not, without leave of the Court, register any of them as separate proprietors of such trade mark.

Thus, if on a dissolution of partnership the goodwill of the business is divided among three persons, or if a man dies having bequeathed his business to three sons equally, who propose to carry it on separately, having respectively taken assignments from the executor, none of the three can claim to be registered separately as a proprietor of a trade mark which was attached to the business without the consent of the other two, unless the leave of the Court for such separate registration has been obtained.

Continuance of a Trade Mark on the Register.

Removal of trade mark after fourteen years unless fee paid.

30. At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the registrar shall send a notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the registrar,

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before the expiration of such fourteen years (naming the date at which the same will expire), the prescribed fee, and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect, and if such fee be not paid before the expiration of such fourteen years the registrar may, after the end of three months from the expiration of such fourteen years, remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

Payment of additional fee after expiration of fourteen years.

31. If before the expiration of the said three months the registered proprietor pays the said fee, together with the additional prescribed fee, the registrar may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

Power of Commissioners to restore trade mark.

32. Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the Commissioners of Patents, or one of them, may, if they are satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee, and compliance with such conditions as they may think just.

Trade mark like one removed not to be registered for five years.

33. Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless for five years after the date of such removal be deemed for the purpose of section six of the Act, and not for any other purpose, to be a trade mark which is already registered.

Rules.

Sect. 6 of the Act of 1875 provides that a mark very similar to one already on the register shall not be registered, and that a mark identical with one already on the register shall only be registered if the leave of the Court has been obtained: the effect of this rule, therefore, is to prevent registration of a mark similar to or identical with (as the case may be) a mark which was on the register until five years have elapsed from the date of the removal of such mark therefrom. Thus one trader is prevented from taking up and getting a right to another trader's mark till five years after the latter has lost his right on the register.

Of course this provision does not apply to the case where the register is rectified by striking off the name of a person whose mark ought not to have been registered.

Removal of trade mark where no business in goods.

34. The Court may, on the application of any person aggrieved (*a*), 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 (*b*.)

(*a*) "Person aggrieved" (a term also used in sect. 5 of the Act of 1875) seems here to point to a person himself registered, and using a similar mark, which may be liable to be confounded with the mark sought to be removed, or using the same mark, having been registered as separate proprietor thereof; for there would be little use in a man's having a mark removed with the view of himself getting a similar one on the register, since by Rule 33 this could not be done for 5 years.

(*b*) The registered proprietor need not be engaged in such a business when he first registers the mark, but must take it up within 5 years' time. It does not appear to be necessary to show that the proprietor on the register whose mark it is sought to remove, has not been "engaged in the business" in question for any given length of time. The Court would no doubt refuse an application based merely on the fact that he had intermitted for some temporary reason to deal in the goods to which the mark is applied.

The registered proprietor need not be selling the precisely same goods as those in respect of which he is registered, but he must sell some goods belonging to that class.

Alteration and Rectification of Register.

Rules.

Alteration of non-essential parts of trade mark.

35. The registered proprietor of any registered trade mark may, by leave of the Court, alter such trade mark, so that he do not alter any one or more of the particulars in such mark which are declared by section ten of the Act to be the essential particulars of a trade mark (*a*), and the registrar shall, on payment of the prescribed fee (*b*) and compliance with the requisitions of the registrar as to the deposit of representations (*c*) of the trade mark as altered, alter the register accordingly.

(*a*) See sect. 10 of the Act. Any alteration in these essentials would constitute the mark a new mark, and require an original application in the manner prescribed in Rules 5–9.

(*b*) The fee is 10*s*.

(*c*) As to representations, see Rule 8.

Entry of rectification in register.

36. Where due notice of an order of any court rectifying the register has been given to the registrar, the registrar shall forthwith, upon an official copy of so much of the order as relates to such rectification being left with the registrar, and payment of the prescribed fee, rectify the register in accordance with the order.

It has already been intimated (see note to sect. 10 of Act) that the Act does not seem to empower a Scotch or Irish Court to make an order *expressly directing* the rectification of the register. If, however, such a Court does make such an order (and the use of the word "any" seems to imply that it may), the Registrar will no doubt obey it, and rectify accordingly. If such a Court merely makes an order from which the Registrar can clearly understand that a rectification is necessary, he will no doubt also rectify. If the effect of the order is doubtful, it will apparently be open to any party aggrieved to apply to the English Court under sect. 5 of the Act.

37. Whenever the register is rectified or altered in

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Publication of rectification or alteration of register.

any particular in respect to any trade mark, the registrar shall, if he thinks that such rectification or alteration should be made public, at the expense of any person interested publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or alteration of the register.

The power here given to the registrar is apparently intended to enable him to deal with cases where any person having wrongly got on the register, has made an improper use of his registration, or having obtained a certificate, has used it improperly, or has not delivered it up on being struck off the register.

Notice to registrar of opposition in any matter.

38. Any person may send, with the prescribed fee, notice to the registrar of his desire to oppose the registration of any assignee or transmittee, or any alteration of the register (*a*). The registrar shall give to the applicant for such registration or alteration the like notice, and may require security for costs in like manner as in the case of a notice of opposition to the original registration of a trade mark (*b*).

The registrar in such case may, if he think fit, require the parties interested to submit their claims to the court (*c*).

(*a*) A ground of opposition might be not only the denial of the title of the applicant, but a denial of his owning the goodwill of the business to which the mark in question was attached, or an allegation that a mark which was suitable for registration originally has now become incapable of registration, *e.g.*, if the word "patent" were part of it (supposing it to be an old mark, see *post*, p. 77), and the patent has now expired (as to which see Ludlow and Jenkyns, p. 54), or if the mark expressly represented the article to be made or sold by the particular person who formerly was the owner of the mark, so that such representation would now be misleading.

(*b*) See Rule 16.

(*c*) See Rule 44.

89. If the registered proprietor of a trade mark send to the registrar, together with the prescribed fee, notice of an alteration in his address, the registrar shall alter the register accordingly.

Rules.

Alteration of address, &c. in register.

It is not compulsory to send such notice, but having regard to the provisions of Rule 70, a registered proprietor will do well to send it.

Inspection of Register.

40. On such days and during such hours as the registrar may from time to time determine, not being less than three hours on three separate days in a week, any person may, on paying the prescribed fee, inspect the register of trade marks; and any person may, on paying the prescribed fee, obtain an office copy of any entry in the register.

Inspection and copies of register.

Copies are not to be taken by the person inspecting, but made by some person belonging to the office, and paid for by the person obtaining them at the rate of 2*d.* per folio, but never less than 1*s.* (Schedule II.). The word "entry" includes the representation of the mark itself which appears in the register.

41. The registrar when required for the purpose of any legal proceeding or other special purpose to give a certificate as to any entry, matter, or thing which he is authorised by the Act, or any of these rules to make or do, may, on payment of the prescribed fee, give such certificate, and shall specify on the face of it the legal proceeding or other purpose for which such certificate is granted.

Certificate by Registrar.

The Registrar therefore cannot be required to give a simple certificate of registration; and he is the judge of what is a "special

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purpose" within the meaning of the rule, subject, of course, to such directions as the Commissioners of Patents may give him.

By sect. 2 of the Act of 1876, the Registrar, when he has refused to register some mark used before the passing of the Act of 1875, must, upon request, give a certificate of such refusal.

Application to the Court.

Definition of Court.

42. The Court for the purposes of this Act is hereby declared to be the Chancery Division of Her Majesty's High Court of Justice.

See Supreme Court of Judicature Act, 1873, sects. 31, 34, 36, 39, 42, and Supreme Court of Judicature Act, 1875, sect. 11. The effect of this rule probably is to put applications to the Court under the Trade Marks Registration Act in the same position as if they had been specified among the "causes and matters" assigned to the Chancery Division of the High Court by sect. 34 of the Act of 1873; so that all the provisions respecting transfer, &c., of such causes or matters commenced in any other Division will apply. By sect. 42, a single judge of the Chancery Division is empowered to deal with business arising out of any cause or matter assigned to that Division, so that "the Court" here practically means any judge of that Division.

Application to Court.

43. An application to the Court under the Act and these Rules may, subject to rules of Court under the Supreme Court of Judicature Act, 1875 (*a*), be made by motion or by application in chambers (*b*), or in such other manner as the Court may direct (*c*).

(*a*) See Supreme Court of Judicature Act, 1875, sects. 17, 24, 25.

(*b*) Until or unless special rules are made for these applications, the ordinary practice as to motions and summonses will no doubt be followed.

(*c*) There are in all ten cases or purposes in or for which, under the Act and these Rules, an application may be made to the Court, viz.:—

1. To remove the name of a person registered as proprietor of a

trade mark, who is alleged not to be entitled to the exclusive use thereof : sect. 5 of Act. Rules.

2. To remove the name of person so registered, on the ground that he is not engaged in any business concerned in the goods with respect to which the mark is registered : Rule 34.

3. To enter on the register as proprietor the name of a person whom the Registrar refuses to enter: sect. 5 of Act. Under this falls the case of the claimant of a cotton mark placed by the committee in the second class of their list (Rules 59—62).

4. To remove from the register a mark not authorized to be registered under the Act : sect. 5 of Act.

5. To decide which of several persons claiming a mark is entitled to have himself registered as proprietor thereof : submission to Court of question may be made by Registrar, and may be by special case : sect. 5 of Act, Rules 18 and 44.

6. To decide question as to registration of assignee or transmittee, or as to any other alteration in the register, where such registration or alteration is opposed. Registrar may require parties to submit claims to Court : Rules 38 and 44.

7. To obtain the special leave of the Court for the registration in respect of the same class of goods of a trade mark identical with one already on the register as respects such class : sect. 6 of Act, Rule 19 ; or for the registration of a mark "so nearly resembling one already on the register, as to be calculated to deceive" (?) : Rule 19.

8. To obtain similar leave, which is to be given only where the applicant proves his right, for the registration of a mark identical with a Sheffield corporate mark assigned and actually used, or so nearly resembling the same as to be calculated to deceive : sec. 9 (4) of Act.

9. To obtain leave for the registration as separate proprietors of a trade mark, of divers persons who do not consent to the registration of one another : Rule 29.

10. To obtain leave for the alteration of a trade mark in any particulars except those declared essential by sect. 10 of the Act : Rule 35.

The first four of these are proceedings for the rectification of the register ; the remainder are preliminary to registration. The fifth and sixth are to take the form of a special case (Rule 44) ; all other applications, it would appear, may, until rules are issued otherwise directing, be made either by way of summons at Chambers, or motion in Court, according as the applicant pleases.

Rules.

Nothing is said as to the persons to be served on an application to the Court, but obviously all persons who are interested in opposing ought to be served, and if there is no person so interested, it may probably be proper to serve the Registrar or the Attorney-General, or at least to ask the directions of the Court as to whether or not either of those officers should be served. In the case of the applications for the rectification of the register, here numbered 1, 2, and 4, the person already on the register will of course be served. In case 5 the parties to the special case will, of course, be the several claimants, and in case 6 the applicant and opponent. In case 7, the proprietor of the already registered mark; in case 8, the proprietor of the Sheffield mark; and in case 9, all the non-consentient claimants, will be served, and it may be proper to consider whether under the circumstances it is or is not necessary or desirable to serve the Registrar also. In cases 3 and 10, as there is no hostile party to be served, it would seem necessary either to serve the Registrar, or to ask the Court to dispense with service on him. In those applications to the Court which have already been made under case 3, the Registrar has been served and appeared.)

Sub-mission to Court of conflicting claims.

44. Where the registrar refuses to comply with the claims of any persons until their rights have been determined by the Court, the manner in which the rights of such claimants may be submitted by the registrar, or, if the registrar so require, by the claimants, to the Court shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

As to a special case, see Order XXXIV., under the Judicature Act, 1875: see also, as to special cases at common law before 1875, the Act 3 & 4 Wm. IV., c. 42, s. 25, and the C. L. P. Act, 1852, sects. 46, 47, and 179; and as to special cases in equity before 1875, the Act 13 & 14 Vict. c. 35. The Registrar apparently need not be a party to the special case.

In *Ex parte Grimshaw* (L. R. Weekly Notes, Feb. 3rd, 1877),

V.-C. Hall refused to direct, under the above power to "otherwise order," that an opposed application for registration should be brought before the Court by motion instead of by special case. Rules.

45. The special case may be agreed to by the parties, or if they differ may be settled by the registrar. Settlement of special case.

For this the Registrar's fee is £2.

As to request to Registrar to settle special case, see Instructions, *post*, p. 81.

Cutlers' Company.

46. The time within which the Cutlers' Company are in pursuance of the Act to deliver to the registrar copies of all Sheffield corporate marks in force at the time of such delivery shall be the first day of March one thousand eight hundred and seventy-six, or such later day as the Lord Chancellor may fix. Time for delivery of old Sheffield marks.

This and the succeeding Rules down to the 56th, are to carry out the provisions of sect. 9 of the Act.

47. Subject to any other directions that may be given by the registrar the manner in which such copies are to be delivered shall be the sending to the registrar of copies as hereinafter defined of such marks, accompanied by a statement of the names, addresses, and callings of the persons to whom such trade marks have been assigned. Manner of delivery of old Sheffield marks.

48. The time within which the Cutlers' Company are to deliver to the registrar notice of an application to them for assigning any mark or device, with a copy of such mark or device, shall be as soon as practicable after the Time for delivery of new Sheffield marks.

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date at which such Company have determined on the mark or device to be assigned.

Manner of delivery of new Sheffield marks.

49. The manner in which such notice and copy shall be delivered to the registrar shall be the sending to the registrar a notice of the application, accompanied by a statement comprising the like particulars as a statement required to be made by an applicant for the registration of a trade mark by the registrar under the Act, so far as such particulars are known to the Cutlers' Company.

Period between notice to registrar and assignment of new Sheffield marks.

50. The period before the expiration of which such mark or device shall not be assigned by the Cutlers' Company, shall be six weeks from the date of sending the said notice to the registrar.

Time for notice of application to register new trade marks to Cutlers' Company.

51. The time within which notice of an application for the registration under the Act of a trade mark as belonging to any particular goods or class of goods specified in section two of the Cutlers' Company's Act, 1860, together with a copy of the trade mark, is to be delivered to the Cutlers' Company, shall be as soon as practicable after the receipt of the application by the registrar.

Manner of giving notice to Cutlers' Company of application.

52. The manner in which such notice is to be given shall be the sending to the Cutlers' Company a copy of the official journal containing the mark of which notice is required to be given, with a note distinguishing such mark.

Time between notice to Cutlers'

53. The period from the giving of such notice, before the expiration of which the trade mark is not to be regis-

tered, shall be six weeks from the date of sending such notice to the Cutlers' Company.

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Company and registration of trade mark.

54. The time within which notice of the assignment of any trade mark or device, or the registration of any trade mark, is to be given to the registrar or to the Cutlers' Company (as the case may be) shall be fourteen days after such assignment or registration.

Time for notice of assignment of mark or registration of mark.

55. The manner in which such notice shall be given shall be the sending a notice of such assignment or registration, with sufficient particulars to identify the mark, or device, or trade mark, to the registrar or Cutlers' Company, as the case may be.

Manner of giving notice of assignment or registration of mark.

56. A copy of a trade mark for the purpose of these Rules when sent by the Cutlers' Company shall be a drawing or representation of the trade mark, in duplicate, and, subject to any other directions that may be given by the registrar, shall be of a size of not less than three inches square, and shall be upon foolscap paper of such size as aforesaid.

Description of copies for purpose of Cutlers' Company.

See Rule 8.

Cotton Goods.

57. For the purpose of facilitating the granting of trade marks in respect of cotton goods in Classes 23, 24, and 25, there shall be established by the Commissioners of Patents, and subject to their control, an office at Manchester for the exhibition of all devices, marks, headings, labels, tickets, letters, words, or figures, or combinations of letters, words, or figures, used in the cotton trade, and

Establishment of office for exhibition of cotton trade marks at Manchester.

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in these rules included under the expression "cotton marks."

Representations of cotton marks to be sent to Manchester office on or before Dec. 1st, 1876.

58. Every person who at the date of the passing of the Act (August 13, 1875), used any cotton mark shall, if resident in the United Kingdom, on or before the first day of January one thousand eight hundred and seventy-seven, and if resident elsewhere, on or before the first day of March one thousand eight hundred and seventy-seven, send to the Manchester office three representations of such cotton mark, in such form and with such a description as may be from time to time required by the Commissioners of Patents.

This direction applies only to cotton marks used before August 13th, 1875. The registration of marks invented or first used since that date may be applied for at the London office in the usual way, and will then proceed according to the Supplemental Rules: see p. 53, *post*. See Instructions, *post*, p. 84.

Committee of experts to be appointed and to divide cotton marks into two classes.

59. A committee of persons versed in the usages of the cotton trade shall be appointed by the Commissioners of Patents, consisting of such number of persons as may from time to time be determined by them, and it shall be the duty of such committee, on or before the time to be named by the Commissioners of Patents, to divide the cotton marks, representations of which have been so sent in to the Manchester office, into two classes, the first class consisting of such of the said cotton marks as are, in the opinion of the committee, trade marks within the meaning of the Act, and the second class consisting of such of the said cotton marks as are not, in the opinion of the committee, trade marks within the meaning of the Act.

Committee to form list

60. The said committee shall form a list of the cotton

marks sent to the Manchester office in each of the aforesaid classes, and shall transmit such lists to the Commissioners of Patents, accompanied by two representations of each of the marks specified in the second class in such list.

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of marks sent in to Manchester office.

The third representation of each of the marks in the second class in such list shall be retained for reference in the Manchester office.

The main duty of the committee is to decide which of the marks submitted to them are common, *i.e.*, used by so many persons as no longer to distinguish the goods of any one in particular, and therefore in fact no longer any one's property. In the first class of their list they will place the marks which in their judgment are still "private," the property of some one or more persons; in the second those which have become common, or which for any other reason they consider not to be trade marks within sect. 10 of the principal Act.

61. The Commissioners of Patents may from time to time add to the aforesaid list any cotton marks as they may think just, and such addition shall be deemed to be part of the original list.

Marks may be added to list.

Under this rule any omissions in the original list may be supplied.

62. Any proprietor of a cotton mark not specified in the second class in such list may apply to be registered as proprietor of such cotton mark in manner and subject to the conditions in which he may apply to be registered as proprietor of any other trade mark, but it shall not be lawful for the registrar to register any person as proprietor of any cotton mark in the second class of the aforesaid list except in pursuance of an order of the Court.

Any person claiming to be the proprietor of a cotton mark in Class 1 may apply to be registered.

Rules.

When a man's mark is placed in the first class, his position is not affected: he must apply in the usual way for registration. But if a mark appears in the second class, the registrar cannot register it except under an order of the Court. Any person claiming it will therefore have no appeal to the Registrar from the decision of the committee, but must appeal at once to the Court, where the matter will be *res integra*, although, of course, very strong evidence that the committee were wrong will be needed to upset their finding.

Any one who claims a mark placed in the second class may obtain from the Registrar a certificate of his refusal to register, and will then be exempt from the prohibition to take proceedings in respect of the infringement of an unregistered mark (sects. 1 and 2 of Act of 1876), that is, he may bring his action and take his chance of proving that the mark is really his, though the committee pronounce it common.

Cotton mark not to be registered except in manner herein prescribed.

63. A cotton mark shall not be registered except in manner and subject to the conditions prescribed by these rules with respect to the registry of cotton marks.

See Supplemental Rules, p. 53, *post*.

Nothing is said as to sending newly invented marks to the Manchester office, so this Rule merely prevents any person from having an old mark registered unless he has obeyed the directions of Rule 58. It is understood, however, that the Manchester office will be kept up, and specimens of all cotton marks, new as well as old, be preserved there.

Declaration and Evidence.

Dispensing with declaration, evidence, &c.

64. In any case in which any person is required under this Act to make a declaration on behalf of himself, or of any body corporate, or any evidence is required to be produced to the registrar, the registrar, if satisfied that from any reasonable cause such person is unable to make the declaration, or that such evidence may be dispensed with, may, upon the production of such other declaration or evidence, and subject to such terms as he may think fit, dispense with any such declaration or evidence.

It is presumed that in case of the Registrar's hesitating to act upon

the power here given him, a memorial may be addressed by the applicant to the Commissioners of Patents, under whose direction the Registrar acts, asking them to authorise the indulgence here contemplated. Rules.

65. The declarations required by these Rules shall be made and subscribed in the United Kingdom under the authority of the Act of the fifth and sixth years of the reign of King William the Fourth, chapter sixty-two, "to "repeal an Act of the present session of Parliament, "intituled 'An Act for the more effectual abolition of "'oaths and affirmations taken and made in various "'departments of the State, and to substitute declarations "'in lieu thereof, and for the more entire suppression of "'voluntary and extrajudicial oaths and affidavits,' and "to make other provisions for the abolition of unnecessary "oaths," and may be made and subscribed before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding. Manner in which and persons before whom declaration is to be taken.

The declaration, when taken out of the United Kingdom, shall

(*a.*) If made in any part of Her Majesty's dominions be made and subscribed before some court, justice, or officer authorised by law in such part of Her Majesty's dominions to administer an oath for the purpose of a legal proceeding; and,

(*b.*) If made out of Her Majesty's dominions, be made and subscribed before a British consul, vice-consul, or other consular officer.

If there be no consular officer within reach of the person required to declare, the Registrar would be held empowered, under Rule 64, to dispense with such a declaration, and in lieu of it accept one made

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before some person having power in the country in question to administer an oath. See Instructions, *post*, p. 72.

If made within the United Kingdom, the declaration must bear a stamp of 2*s.* 6*d.*, unless made before a justice of the peace.

Notice of seal of officer taking declaration to prove itself.

66. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration, in testimony of such declaration having been made and subscribed before him, may be admitted by the registrar without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Declaration by infant, lunatic, &c.

67. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by the Act or these Rules to be made or done by such incapable person, then the guardian or committee, if any, of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purpose of the Act and these Rules be as effectual as if done by the person for whom he is substituted.

Although the language of this Rule is specially directed to cases arising under English law, no doubt its provisions will be held applicable in other countries also.

Commissioners of Patents.

Rules.

Registrar subject to Commissioners of Patents.

68. The registrar, in the exercise of his powers, duties, and discretion under the Act and these Rules, shall be subject to the superintendence of the Commissioners of Patents, and shall conform in every case to any instructions, directions, orders, or rules (general or special) that may be issued, given, or made by such Commissioners, or any one of them; and he shall in all cases of doubt be entitled to refer to the said Commissioners, or any of them, for instructions.

The Commissioners of Patents are the Lord Chancellor, the Master of the Rolls, the Attorney-General, and the Solicitor-General.

Notices.

Notices to be in writing and served by post.

69. Applications, statements, notices, and documents required by the Act or by these Rules to be served or sent shall be in writing or print, or partly in writing and partly in print, and may be delivered personally, or served and sent by post, and if sent by post shall be deemed to have been served and received respectively at the time when the letter containing the same would be delivered in the ordinary course of post; and in proving such service or sending it shall be sufficient to prove that the letter containing the notice was prepaid and put into the post properly addressed.

Mode of addressing notices.

70. Any application, statement, notice, and document to be served or sent on or to the registrar shall be deemed to be properly addressed if addressed to the registrar of trade marks at his office; and if required to be served

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on or sent to the proprietor of any trade mark shall be deemed to be properly addressed if addressed to the registered proprietor at his registered address.

Construction of Rules.

71. These Rules shall be construed as if they were part of the Trade Marks Registration Act, 1875, as amended by the Trade Marks Registration Amendment Act, 1876, and the said Trade Marks Registration Act, 1875, amended as aforesaid, is in these Rules referred to as "the Act."

Forms.

72. The forms in the third schedule to these Rules, or such other forms as the registrar may direct, may be used in all cases to which they are applicable.

CAIRNS, C.

August, 1876.

We, the Commissioners of Her Majesty's Treasury, do hereby assent to the above Rules so far as they relate to fees.

CRICHTON.

R. WINN.

September, 1876.

SUPPLEMENTAL RULES RELATING TO MARKS UPON COTTON GOODS (ISSUED IN THE END OF FEBRUARY, 1877.)

WHEREAS by the thirteenth, fifteenth, and seventeenth Rules of the Trade Marks Rules provision is made respecting the advertisement in the official paper of facsimiles of trade marks: And whereas such provisions

cannot conveniently be applied to cotton goods in Classes 23, 24, and 25, referred to in the said Rules. Rules.

Now, therefore, I, the Right Honourable Hugh MacCalmont, Baron Cairns, of Garmoyle, in the county of Antrim, Lord High Chancellor of Great Britain, in pursuance of the Trade Marks Registration Act, 1875, and of all powers enabling me in that behalf, do hereby direct that the above-mentioned Rules 13, 15, and 17 shall not apply to trade marks in respect of cotton goods in the said classes, and that, instead of such Rules, there shall apply to the goods aforesaid the Rules following:

Advertisement of cotton marks.

1. As soon as may be after the receipt of an application, made as provided by the Trade Marks Rules, for the registration of a mark in Classes 23, 24, 25 aforesaid, or in any one or more of such classes, the Registrar shall insert in the official paper an advertisement of such application, showing the name and address of the applicant, the class in which he applies, the number given to the mark by the Registrar, the places in London and Manchester respectively where a specimen of such mark is deposited for exhibition, and distinguishing whether the mark has or has not been used prior to the thirteenth day of August one thousand eight hundred and seventy-five.

Time of registration of cotton marks.

2. On the expiration of three weeks from the date of the first appearance of the advertisement of a mark in Classes 23, 24, 25, or in any one or more of such classes, in the official paper, the Registrar may, if he is satisfied that the applicant is entitled to registration, register such mark in respect of the description of goods for which he may be entitled to be registered, and the applicant as the proprietor thereof, on payment of the prescribed fee.

February, 1877.

SCHEDULES.

FIRST SCHEDULE.

Classification of Goods.

Schedules.		*Illustrations.*
		Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.
	Class 1.	
	Chemical substances used in manufactures, photography, or philosophical research and anti-corrosives.	Such as— Acids, including vegetable acids. Alkalies. Artists' colours. Pigments. Mineral dyes. Varnish.
	Class 2.	
	Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.	Such as— Artificial manure. Sheep washes. Deodorisers.
	Class 3.	
	Chemical substances not included in Class 1, used in medicine and pharmacy.	Such as— Tinctures. Extracts. Barks. Patent medicines. Cod-liver oil. Plasters. Lozenges.

Schedules.

Class 4.	
Raw or partly prepared vegetable, animal, and mineral substances used in manufactures not included in other classes.	Such as— Resins. Oils, 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. Glue. Bone. Sponge.
Class 5.	
Unwrought and partly wrought metals used in manufacture.	Such as— Iron and steel, pig or cast. „ rough. „ bar and rail, including rails for railways. „ bolt and rod. „ sheets, and boiler and armour plates. „ hoops. „ wire. Lead, pig. „ rolled. „ sheet. Copper. Zinc. Gold, in ingots.
Class 6.	
Machinery of all kinds, and parts of machinery, except agricultural machines and implements included in Class 7.	Such as— Steam engines. Boilers. Pneumatic machines.

Schedules.

Class 6—*continued.*	
	Hydraulic machines. Locomotives. Sewing machines. Weighing machines. Machine tools. Mining machinery. Fire engines.
Class 7.	
Agricultural and horticultural machinery and parts of such machinery.	Such as— Ploughs. Drilling machines. Reaping machines. Thrashing machines. Churns. Cyder presses. Chaff-cutters.
Class 8.	
Philosophical instruments, instruments and apparatus for useful purposes, or for teaching.	Such as— Gauges. School-desks. Logs.
Class 9.	
Musical instruments.	
Class 10.	
Horological instruments.	
Class 11.	
Instruments, apparatus, and contrivances for surgical or curative purposes, or in relation to health.	Such as— Bandages. Friction-gloves. Lancets.
Class 12.	
Cutlery and edge tools.	Such as— Knives. Forks. Scissors. Sheats. Files. Saws.

Schedules.

Class 13.	
Metal goods not included in other classes.	
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 for optical purposes.
Class 16.	
Porcelain and earthenware.	Such as— China. Stoneware. Terra-cotta. Statuary porcelain. Tiles. Bricks.
Class 17.	
Manufactures from mineral and other substances for building or decoration.	Such as— Cement. Plaster. Imitation marble.
Class 18.	
Engineering, architectural, and building contrivances.	Such as— Diving apparatus. Warming apparatus. Ventilating apparatus. Filtering apparatus. Lighting contrivances. Drainage contrivances. Electric and pneumatic bells.

Schedules.

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. Velocipedes. Bath-chairs.
Class 23.	
Cotton yarn and thread.	
Class 24.	
Cotton piece goods of all kinds.	

Schedules.

Class 25.

Cotton goods not included in Classes 23, 24, or 38.

Class 26.

Linen and hemp yarn and thread.

Class 27.

Linen and hemp piece goods.

Class 28.

Linen and hemp goods not included in Classes 26, 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 or stuffs of wool, worsted, or hair.

Class 35.

Woollen, worsted, and hair goods not included in Classes 33 and 34.

Schedules.

Class 36.	
Carpets, floor-cloth, and oil-cloth.	Such as— Drugget. Mats and matting. Rugs.
Class 37.	
Leather, and skins unwrought and wrought.	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 paper hangings), stationery, printing, and book-binding.	Such as— Envelopes. Sealing-wax. Pens (except gold pens). Ink. Playing cards. Blotting cases. Copying-presses.
Class 40.	
Goods manufactured from india-rubber and gutta-percha not included in other classes.	
Class 41.	
Furniture and upholstery.	Such as— Paper hangings. Papier-mâché. Mirrors. Mattresses.

Schedules.

Class 42.

Substances used as food or as ingredients in food.	Such as— Cereals. Pulses. Oils. Hops. Malt. Dried fruits. Tea. Sago. Salt. Sugar. Preserved meats. Confectionery. Oil cakes, &c. 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.

Schedules.

Class 47.

Candles, common soap, detergents, illuminating, heating, or lubricating oils, matches, starch, blue, and other preparations for laundry purposes.	Such as— Washing-powder. Benzine colas.

Class 48.

Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).	

Class 49.

Games of all kinds. Archery. Fishing tackle. Toys.	Such as— Billiard-tables. Roller-skates. Fishing-nets and lines.

Class 50.

Miscellaneous, including— (1.) Goods manufactured from ivory, bone, 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.	Such as— Cooper's wares.

Class 50—*continued.*

(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.

GENERAL NOTE.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the registrar may decide.

SECOND SCHEDULE.

Fees.

The following fees shall be payable to the registrar on or for the following occasions or purposes :—

	£	s.	d.
1. On application to register one trade mark for one or more articles included in one class	1	0	0
2. On application to register more than one trade mark for one or more articles included in one class, for each additional trade mark after the first . .	0	10	0
3. On application to register a trade mark in respect of goods in different classes, for every class after the first to which such trade mark is extended, an additional fee of	0	2	0
4. For registration of one trade mark	1	0	0
5. Where the same person is registered at the same time for more than one trade mark, for registration of each additional mark after the first . . .	0	10	0
6. Where the same person is registered at the same time for the same trade mark in respect of goods in different classes, for the registration of one mark in each class after the first an additional fee of . .	0	2	0
7. For entering notice of opposition	2	0	0
8. For registering subsequent proprietor	1	0	0
9. For altering address on the register	0	5	0
10. For every entry in the register of a rectification thereof, or an alteration therein, not otherwise charged	0	10	0
11. For continuance of mark at expiration of fourteen years	2	0	0
12. Additional fee where fee is paid within three months after expiration of fourteen years	1	0	0

	£	s.	d.	Schedules.
13. Additional fee for restoration of trade mark when removed for non-payment of fee	2	0	0	
14. For certificate	1	0	0	
15. For inspecting register, for every quarter of an hour .	0	1	0	
16. For office copy of documents, 2*d.* per folio, but never less than	0	1	0	
17. Settling a special case by registrar	2	0	0	

Note.

If a copy of a trade mark is required for any purpose, such copy shall be supplied by or at the expense of the applicant.

THIRD SCHEDULE.

FORM A.

FORM OF STATEMENT ON APPLICATION FOR REGISTRATION OF ONE TRADE MARK.

I,* [*John Jones, of Moon Street, in the city of Birmingham, pharmaceutical chymist,*] apply to be registered as proprietor of a trade mark† [*being a goat's head and neck with a gold collar attached thereto*], and which is represented in the paper annexed hereto.

I desire that the said trade mark may be registered in respect of the description of goods following, contained in [*Class I., that is to say,*‡ *acids, including pigments, mineral dyes*].

I have used the said trade mark in respect of the said goods for [*ten*] years before the 13th of August, 1875.§

|| The _____ day of _____ 187 .

(Signed) *John Jones.*¶

* *Here insert name, address, and calling of the applicant.*

† *Here insert in writing description of trade mark.*

‡ *Here insert description of the goods, and the class or classes under which the applicant desires to have them registered.*

§ *This paragraph may be omitted if the trade mark was not used before the 13th of August, 1875.*

|| *Here insert date.*

¶ *Here insert signature.*

FORM B.

FORM OF STATEMENT ON APPLICATION FOR REGISTRATION OF MORE THAN ONE TRADE MARK.

I,* [*John Jones, of Moon Street, in the city of Birmingham, pharmaceutical chymist,*] apply to be registered as proprietor of the following trade marks, numbered from "1" to .

The trade marks are described as follows; that is to say,

No. 1 is†

and is represented on paper 1 annexed hereto.

No. 2 is†

and is represented on paper 2 annexed hereto [*and so forth*].

I desire that the said trade marks may be registered in respect of the descriptions of goods following; that is to say,

* *Here insert name, address, and calling of the applicant.*

† *Here insert in writing description of trade mark.*

As to No. 1, in respect of the following goods contained in class ‡

As to No. 2, in respect of the following goods contained in class ‡ [*and so forth*].

§ I have used the trade marks numbered [*respectively*] and in respect of the goods for which I desire them to be registered for years before the 13th of August, 1875.

‖ The day of 187 .

(Signed) *John Jones.*¶

Schedules.

‡ *Here insert description of the goods and the class or classes under which the applicant desires to have them registered.*

§ *This paragraph may be omitted if the trade marks were not used before the 13th of August, 1875.*

‖ *Here insert date.*

¶ *Here insert signature.*

Form C.

Form of Declaration to accompany Statement on Application for Registration of one Trade Mark.

I, *A.B.*, of
do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows :—

(1.) The statement signed by me and dated the day of , and marked with the letter "A," and shown to me at the time of making this declaration is true :

(2.) The description of the trade mark in such statement is a true description of the trade mark for the registration of which I apply :

(3.) I am lawfully entitled to the use of the trade mark of which the said description is a true description.

And I make this declaration, conscientiously believing the same to be true, and by virtue of the provisions of an Act made and passed in the Session of Parliament, held in the fifth and sixth years of the reign of His late Majesty, King William the Fourth, intituled "An Act to repeal an Act of the present Session of Parliament, intituled 'An Act for the more effectual abolition of oaths and affirmations taken and made in various departments of the State, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits, and to make other provisions for the abolition of unnecessary oaths.'"

Signed *A.B.*

Declared before me

Note.—*The above Form will require to be altered so as to suit an application for the registration of more than one trade mark.*

Schedules.

FORM D.

FORM OF DECLARATION* TO ACCOMPANY STATEMENT ON APPLICATION FOR REGISTRATION OF ONE TRADE MARK.

I, *A. B.*, of do hereby solemnly and sincerely declare to the best of my knowledge and belief, as follows :—

(1.) The statement signed by me and dated the day , and marked with the letter "A," and shown to me at the time of making this declaration, is true :

(2.) The description of the trade mark in such statement is a true description of the trade mark for the registration of which I apply :

(3.) I am lawfully entitled to the use of the trade mark of which the said description is a true description.

Signed *A. B.*

Declared before me .

NOTE.—*The above Form will require to be altered so as to suit an application for the registration of more than one trade mark.*

* *This Form is to be used when the declaration is made out of the United Kingdom.*

FORM E.

FORM OF ASSIGNMENT OF TRADE MARK.

Trade mark, class *

Name

Place of business

I,† *A.B.*, of in the county of being registered proprietor of the trade mark above particularly described, in consideration of pounds paid to me by *E.F.*, carrying on business at in the county of under the firm of *F. & Co.*, hereby assign the said trade mark to the said *E.F.*, together with the goodwill of the business concerned in the goods with respect to which the trade mark is registered.

In witness whereof I have hereunto subscribed my name and affixed my seal, this day of 18 .

(Signed)

Executed by the above-named *A.B.*,
in the presence of
[*insert description and place of residence*].

Executed by the above-named *E.F.*,
in the presence of .

* *Here enter number or other means of identifying trade mark in register.*

† *Alter as necessary if there be more than one proprietor.*

FORM F.

Schedules.

DECLARATION BY TRANSMITTEE APPLYING TO BE REGISTERED AS PROPRIETOR.

Trade mark, class , No. *.

Name of owner

Firm

Place of business

(1.) I, † the undersigned *A.B.*, of in the county of , ‡ carrying on business at in the county of , declare as follows :

I declare that *A.B.*, the registered proprietor of the trade mark above described ‡ [died at in the county of , having first made his will, dated the day of whereby he appointed me executor and I proved [*or* confirmed] his said will on the day of in the Court of], *or* [died at in the county of on the day of , intestate, and letters of administration of his estate and effects were [confirmation as executor of the said was] on the day of duly granted to me by the Court of] :

Or,

I declare, that [the estate of] *C.D.*, the registered proprietor of the trade mark above described, was, on the day of duly§ [adjudged a bankrupt] [sequestrated], and that I was on the day of appointed trustee of the [sequestrated] estate of the said *C. D.*, and I am by law entitled to be registered as proprietor of the said trade mark in place of the said *C.D.* :

Or,

I declare, that on the day of I intermarried with and am now the husband of *C.D.*, the registered proprietor of the trade mark above described ; and *I declare that on such marriage the interest of the said *C.D.* in the said trade mark and in the goodwill of the business concerned in the goods with respect to which the trade mark is registered became by law vested in me, and that I am entitled to be registered as owner of the said trade mark in place of the said *C.D.*, and I declare that *C.D.* is the person referred to in the annexed certificate.

* *Here enter number or other means of identifying trade mark in register.*

† *Alter accordingly, if more than one person makes the declaration.*

‡ *Alter according to circumstances.*

§ *Alter according to circumstances.*

* *Alter according to circumstances.*

Schedules.

(2.) I am lawfully entitled to the goodwill† of the business concerned in the goods with respect to which the trade mark so transmitted to me is registered.

† *If the declarant is entitled only to some share in the goodwill, the share must be specified.*

And I make this declaration, conscientiously believing the same be true, and by virtue of the provisions of an Act made and passed in the Session of Parliament, held in the fifth and sixth years of the reign of His late Majesty, King William the Fourth, intituled "An Act to repeal an Act of the present Session of Parliament, intituled 'An Act for the more effectual abolition of oaths and affirmations taken and made in various departments of the State, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits, and to make other provisions for the abolition of unnecessary oaths.'"

(Signed)

Dated at the
day of 18 .

Made and subscribed by the above-named
A.B. in the presence of me,

(Signed)

INSTRUCTIONS

TO PERSONS APPLYING FOR REGISTRATION OF TRADE MARKS.

Instructions.

Forms of application will be found at page 66 of the Rules. The applicant will carefully read over Rules 4—7 and 9—11, relating to application for registry, and attend to the notes attached to the forms in the third schedule to the Rules.

All applications must be made in the English language.

Agents and other persons who may be interested in several applications should note that communications relating to different applications must be made in separate letters.

The attention of applicants is called to the following points:

The Declaration.

1. Declarations made *in the United Kingdom* are made under the authority of the Act 5 & 6 Will. IV. cap. 62 (*vide* Rule 65), and should conclude in the form set out in that Act,—"And I make this declaration conscien-"tiously believing the same to be true, and by virtue of "the provisions of an Act made and passed in the session "of Parliament held in the fifth and sixth years of the

Instructions.

" reign of His late Majesty King William the Fourth,
" intituled 'An Act to repeal an Act of the present session
" 'of Parliament, intituled "An Act for the more effectual
" 'abolition of Oaths and Affirmations taken and made
" 'in various departments of the State, and to substitute
" 'Declarations in lieu thereof, and for the more entire
" 'suppression of voluntary and extra-judicial oaths and
" 'affidavits, and to make other provisions for the
" 'abolition of unnecessary oaths."'"

2. The declaration must be made before a Justice of the Peace or before a Commissioner for administering oaths (*vide* Rule 65). If made before a Commissioner it should bear a 2*s*. 6*d*. Inland Revenue *impressed* stamp.

3. Declarations made *out of the United Kingdom* are not made under the authority of the Act 5 & 6 Will. IV. cap. 62, and should not conclude with the statutory termination above quoted, but should be made strictly in accordance with Form D. of the third schedule of the Rules; such declarations do not require an Inland Revenue stamp.

4. Declarations made out of Her Majesty's dominions may, in cases where it is impracticable to make them before a British consular officer, be subscribed before a mayor or other public official, whose signature or official seal must, however, be certified by a British consular officer, or by the consul of the respective foreign nation in London.

5. The declaration, and the statement on application, should bear the ordinary signature of the person or persons by whom made. The trading name under which

the business is carried on must also in every case be given. Instructions.

6. If the application is made by a partner, secretary, or manager of a firm, corporate body, or quasi-corporate body, the declaration and statement should be made as "on behalf of" such firm or body, and the capacity in which the person signing the documents is acting should be stated.

7. In filling up the first paragraph of the declaration the day of the month and the year should be stated.

The Statement on Application.

Form A or B. (*See* Rules, p. 25.)

1. The statement should be certified as an exhibit to the declaration by the authority before whom the latter document is declared.

2. It should give an accurate description of the mark, specifying any words, &c., forming a conspicuous part of the mark. It should also specify *separately for each class* the description or descriptions of goods in respect of which the mark is applied for.

3. Ornamental or coloured groundwork, such as plaids, checks, &c., cannot be claimed as part of a mark, unless such groundwork is included within the mark by some border or lines, which border or lines should be referred to in the description of the mark.

4. Where part of a label or mark consists of words or

Instructions.

figures which vary with the different goods or qualities of goods to which the mark is applied, these variable parts should not be set out in the description of the mark, but should be referred to in general terms as "printed matter," or as "other words referring to the goods to which the mark is applied," in which case these parts may appear in the representations in one variety, or the applicant may leave these parts of the mark or label blank, describing the blank spaces as "to be filled according to the quality or description of the goods with printed matter," or "to be filled with other words, &c.," as above.

5. Attention should further be paid to the following points :—

Applications for the registry of Trade Marks in Class 7 should only be made in respect of the larger kinds of agricultural and horticultural implements and machines; for all the smaller descriptions of metal implements, such as gardening, draining, excavating, and mining tools, other than with a cutting edge, application should be made in Class 13.

Marks for the under-mentioned goods should be claimed in Class 50:

Bags, sacks, tarpaulins, rick-cloths, tents, brattice cloth.

Brushes (except artists' brushes) and combs.

Buttons of all kinds, other than of precious metals or imitations thereof.

Cordage, rope, twine.

Coopers' wares.

Drinking flasks, not of precious metals or imitations thereof.

Fuel (patent and artificial).
Furniture cream, plate powder, polishing paste.
Grindstones, oilstones, hones, emery.
Hose.
Packing.

Representations.

1. The representations accompanying an application must be sent in duplicate, each representation upon a separate half sheet of foolscap paper, and with a margin of not less than one inch and a half on the left-hand side of the page.

2. Representations of a larger size than foolscap may be folded, but all such representations must be mounted on linen.

3. Representations should be not only of a durable nature, but of such a kind as will admit of their being preserved, bound together in volumes, as records of the property of the applicants.

4. No representation or part of a representation supplied for the purposes of registration should be in pencil, or be merely punched upon paper, or stamped or embossed.

5. The two representations must in all cases be exactly similar.

6. The words "Registered," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," will not be registered under the Trade Marks Registration

Instructions.

Act, 1875, and, therefore, should not appear upon the representations supplied for the purpose of registration, nor in the description of marks given in the statement on application.

7. Terms or symbols common to a trade, such as—in the iron trade—"best," "bloom," "plating," and representations of a crown, anchor, or horse-shoe, or, in Class 43, representations of grape clusters, stars, or diamonds, are not marks or parts of marks within the meaning of the Trade Marks Registration Act, 1875, and where they are shown in combination with old marks, must be described as being terms or symbols, as the case may be, common to the trade concerned in the goods.

Marks not used before the passing of the Trade Marks Registration Act, 1875.

1. The definition of a trade mark not used prior to the passing of the Trade Marks Registration Act, 1875, is given in the 10th section of that Act, as follows :—

"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;

All marks, therefore, which it is desired to register, and which were not used prior to the passing of that Act, must consist of one or more of the above essential particulars.

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The 10th section goes on—"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."

2. The following devices, designs, or words will not be registered as new marks or parts of new marks:

Representations of Her Majesty the Queen, or of any member of the Royal Family, or of foreign sovereigns.

Royal or national arms, crests, or mottoes.

Representations of the Royal Crown or of national flags.

Arms of counties, cities, and boroughs in the United Kingdom.

Prize or exhibition medals.

The words "trade mark," "patent," "warranted," "guaranteed."

Words implying a guarantee of the special quality of the goods to which the mark is applied, such as "pure," "genuine," "excellent," "unequalled," &c.

Fees.

Fees will not be received in cash. They may be paid by a Post Office Order payable to the Registrar at the General Post Office, London; or, if they exceed five pounds, may be paid by a cheque drawn to the "Registrar of Trade Marks or Bearer," and crossed "Bank of England."

Each application for the registry of a trade mark or marks must be accompanied by a statement, on foolscap paper, of the following particulars:—

Instructions.

1. Name and address of applicant.

(Example.) *John Jones,*
Moon Street,
Birmingham,
Pharmaceutical Chemist.

2. Account of fees for trade mark or marks required.

(Examples.)	£	s.	d.
One trade mark in class 4 . .	1	0	0
or			
Two trade marks in class 20 . .	1	10	0
or			
One trade mark in four classes . .	1	6	0

The Post Office Orders or crossed cheques enclosed for payment of fees should be fastened to the form of account of fees.

The abatement of fees is only allowed when more than one mark is applied for in pursuance of the *same* application (*see* Rule 4).

Applications may be made either on printed forms or altogether in writing, and must be addressed as follows:—

The Registrar,
Trade Marks Registry Office,
Quality Court,
47, Chancery Lane, W.C.

Printed forms are not supplied by the Registry Office, but may be obtained at law stationers. Applications may either be delivered by hand or sent prepaid by post, but an application will not be attended to unless it is accompanied by the proper fees specified in Schedule Two of the Rules.

ADVERTISEMENTS IN TRADE MARKS JOURNAL.

Instructions.

1. A wood-block or electrotype must be furnished for each mark in each class, even though the mark consists only of a word or words.

2. Great inconvenience and delay arise from neglect of the requirement that the wood-blocks or electrotypes furnished must correspond exactly with the representations accompanying the application, one of which is returned for the guidance of applicant along with the form for advertisement. The blocks must also afford distinct impressions of the marks.

3. The blocks and electrotypes need not be larger than is required to show the mark in a distinct manner and provided the mark is clearly represented, it is not necessary that it should be on a block two inches square. The largest space available for the representation of any single mark is nine inches broad by eight inches deep.

4. No block should exceed two inches in *breadth*, unless a larger size is necessary in order to show the mark distinctly.

5. The number given by the registrar should *not* be cut on the block or electrotype, but should only be marked upon the side in such a manner as to secure its identification.

6. A description of the manner in which the mark is applied should not be cut on the block.

7. All blocks should be sent to the office of the regis-

Instructions.

trar, together with the papers marked "Form 2," and the copy of the representation sent for the guidance of the applicant in preparing the wood-block.

8. It would greatly facilitate the compilation of the Trade Marks Journal if each applicant would affix an impression of the mark from the block, as cut for the Journal, to the Form 2 before forwarding it to the Trade Marks Registry Office.

N.B.—As three months must elapse after the advertisement of a mark in the Journal before such mark can be placed on the register, and as the first of July next has been fixed by Parliament as the date after which trade mark owners cannot proceed for infringement unless their marks have been registered, *it is particularly requested that applicants, on receipt of the form for advertisement, will at once fill it up and send it without delay to the registrar, accompanied with the block and the representation returned.*

Oppositions.

1. Any person who claims as his own or as part of his own mark a trade mark for which application has been made by another person, should, on seeing such application advertised in the Trade Marks Journal, send the registrar a notice of opposition under Rule 16, setting out the particulars indicated in the following forms, and paying the prescribed fee.

2. A separate notice of opposition is necessary in respect of *each* trade mark opposed and in respect of *each* class in which a trade mark is opposed.

3. When solvent security for costs has been given by

Instructions.

the opponent, the registrar suspends the application for a certain time, sufficient to enable the opponent to bring the matter in dispute before the Court.

4. The registrar is empowered under Rule 45, on receiving a notice from the parties that they wish to have a finding from him on certain matters of fact before taking the opinion of the Court on certain questions of law, and on payment of 1*l.* each by the parties, to examine the facts alleged in the presence of both parties or their agents, and to state a case on which to obtain the opinion of the Court.

5. The following Forms indicate the particulars which the registrar requires to be furnished in the case of opposed applications:—

Form of Opposition.

Trade Marks Registration Act, 1875.

In the matter of an application No. by
of

To the registrar.

I of hereby give notice that I oppose the registration of the trade mark advertised under the above number for Class , in the Trade Marks Journal of the day of , page .

The grounds of opposition are as follows:—

Form of Counter-statement.

Trade Marks Registration Act, 1875.

In the matter of an application No. , and of the opposition thereto No. .

Instructions.

To the Registrar.

In reply to the notice of opposition in this matter by of , I give notice by way of counter-statement that I rely for my application on the following grounds :—

Form of Bond.

The following is suggested as a form of bond such as the registrar would be able to accept from persons opposing applications, and who have been required to give security for costs :—

Trade Marks Registration Act, 1875.

In the matter of an application No. , and of the opposition thereto No. .

Know all men by these presents that we of and of manufacturers, are jointly and severally held, and firmly bound, to Henry Reader Lack, the Registrar of Trade Marks, in the penal sum of pounds, of good and lawful money of Great Britain, to be paid to the said Henry Reader Lack, or to other, the Registrar of Trade Marks, for the time being. For which payment, to be well and faithfully made, we bind ourselves, and each of us, our, and each of our heirs, executors, and administrators, firmly by these presents. Sealed with our Seals.

Dated this day of , 18 .

Whereas, pursuant to the provisions of the Trade Marks Registration Act, 1875, and the General Rules made thereunder by the Lord Chancellor, an application (No.) has been made by , of , manufacturers, to the Registrar of Trade Marks for the registration of a certain trade mark in

such application particularly described. And whereas the above-bounden have delivered a notice of opposition to such registration, and the said have sent to the said Registrar a counter-statement of the grounds on which they rely for their application. And whereas the said Registrar, pursuant to the said General Rules, hath required the said to enter into the above-written obligation (subject to the condition hereinafter contained) as security for such costs as may be awarded in respect of such opposition. Instructions.

Now the condition of the above-written obligation is such that if the said , or either of them, their, or either of their heirs, executors, or administrators, do and shall well and truly pay, or cause to be paid, to of, and on behalf of the firm of , manufacturers, all such costs, as the said Registrar or the High Court of Justice, shall think fit to award to the said of , in respect of the said opposition, then the above-written obligation is to be void, or else to remain in full force and virtue.

Signed, sealed, and delivered by the above-bounden and in the presence of .

Notice to have Case stated by Registrar under Rule 45.

In the matter of the opposition, No. , to the application, No. .

SIR,

NOTICE is hereby given that we the opponent in this matter, and , the

Instructions.

applicant, are unable to agree upon the facts on which the opinion of the Court is to be taken, in pursuance of Rule 44, and that we request you to fix a day on which we can attend before you, and obtain your finding on the matters of fact to be submitted to the Court as settled.

(*Signatures of the Parties or of their Solicitors.*)

To the Registrar of Trade Marks,
Trade Marks Registry Office,
Quality Court,
Chancery Lane.

Notice that Opposition is proceeding before the Court.

Trade Marks Registration Act, 1875.

In the matter of an application, No. , by of .

To the Registrar.

I, , of , hereby give notice that I have, in the above matter, on the day of , 18 ,

* .

* *Here state the nature of proceeding for obtaining the decision or direction of the Court.*

before , of the Chancery Division of the High Court of Justice, this day of , 187 .

(*Signature of the Opponent or of his Solicitor.*)

Registration of Trade Marks for Cotton Goods.

As numerous marks used in the cotton trade at the date of the passing of the Trade Marks Registration Acts (38 & 39 Vict. *c.* 91, and 39 & 40 Vict. c. 33), are, by reason of their common usage, excluded from the scope of that Act, the Rules, numbered 57—63 (see above, p. 45),* have been made for the guidance of persons desirous of registering trade marks for cotton goods :—

* See also Supplemental Rules, p. 52.

Instructions.

An office, as provided by Rule 57, was opened at 48, Royal Exchange, Manchester, on the 24th of October, 1876.

The following gentlemen have been appointed by the Commissioners of Patents to form the Committee of Experts under Rule 59 :—

Edmund Ashworth, Esq., President of the Chamber of Commerce, Manchester.
John Cheetham, Esq., Vice-President of the Chamber of Commerce, Manchester.
B. Davies, Esq.
S. A. Fulda, Esq.
P. Goldschmidt, Esq.
A. J. Hunter, Esq.
H. J. Leppoc, Esq.
G. Lord, Esq.
E. Crompton Potter, Esq.
F. Reiss, Esq.
H. M. Steinthal, Esq.
E. H. Sykes, Esq.

Mr. Joseph Fry has been appointed by the Commissioners of Patents as keeper of the Manchester office.

Each representation required to be furnished by Rule 58, should be attached to a separate half-sheet of foolscap paper, on which should be written,—*a*, the name and address of the applicant; *b*, the number of the class in which registration is desired; and *c*, the length of time the mark has been in use. If it be desired to register a mark in more than one class, three representations in each class must be furnished. No fee will be required, nor will any formal declaration or statement be necessary.

Instructions.

In the case of a combined stamp the applicant should state whether it is desired to protect the whole combination or only a part of it; in which case a line should be drawn round the part which it is desired to protect.

Representations of marks, considered by the owners as private, should be marked with the letter "P."

When application has been already made to the principal registry in London, the Registrar's number must be quoted in the Manchester application.

Owners of marks placed upon the second class specified in Rule 59, although not entitled to registration except by an order of the Court, may obtain from the Registrar a certificate of refusal to register, as provided by sect. 2 of 39 & 40 Vict. c. 33.

It is intended that all marks for cotton goods made in the piece should be claimed in class 24.

These regulations do not apply in the case of marks not used prior to the 13th of August, 1875. Application to register such marks must be made in the usual way to the Trade Marks Registry in London.

The representations retained in the Manchester office will be open for inspection as soon as the other cotton marks have been advertised in the Trade Marks Journal.

Assignment of Registered Marks.

1. If the assignees reside within the United Kingdom the deed of assignment should be sent or left for inspection at the Trade Marks Registry Office, and application should be made by the assignee to be registered as proprietor.

2. The following form gives the particulars the Registrar would require.

Form of Application by Assignee of registered Trade Mark applying to be registered as Proprietor.

Instructions.

Trade mark, No.* . Class .

Name of owner.

Firm.

Place of business.

I, the undersigned *A.B.*, of , in the county of , carrying on business at , in the county of , apply to be registered as proprietor of the trade mark above described, in succession to the said .

The said , by deed dated the day of , 18 , and made between

assigned me the the said trade mark, together with the good-will of the business concerned in the goods with respect to which the mark is registered.

The day of , 18 .

(Signed) *John Jones.*

* *Here enter number or other means of identifying Trade Mark on Register.*

3. This form should be verified by a declaration, as in Form D in the schedule to the Rules, omitting paragraphs (2) and (3) in that form, and sent to the Trade Marks Registry, accompanied by the fee for registering a subsequent proprietor, as prescribed in the second schedule to the Rules, item 8.

Trade Marks Registry Office,
4, Quality Court,
Chancery Lane,
London, W.C.

15th of January, 1877.

H. Reader Lack,
Registrar.

RECENT CASES

ON THE LAW OF TRADE MARKS.

Recent Cases.

THE following are the chief cases reported since the publication of Messrs. Ludlow and Jenkyns' book which seem to affect or illustrate the law regarding trade marks and trade names.

Cope v. *Evans*, L. R. 18 Eq. 138.

In an application for an injunction the Court must be satisfied either that the defendant adopted the plaintiff's mark with an intent to deceive purchasers, or that some purchaser has in fact been deceived, or that the similarity of the defendant's mark to the plaintiff's is such that there is a probability or likelihood of deception. Consideration of the question as to what degree of similarity is calculated to deceive: bill dismissed on the ground that such likelihood of deception had not been proved.

Cotton v. *Gillard*, 44 L. J. Ch. 90.

Plaintiff alleged himself to have acquired the right to use a label containing a certain fancy name for a sauce from a person entitled to use that label; and sought to restrain the defendant, who had in-

vented both the name and the composition of the sauce, and had retained the secret of the composition, from using that label with the name aforesaid. It was proved that plaintiff's sauce was very similar to defendant's. Bill dismissed on the ground that the plaintiff could have no right to the use of a name as a trade mark on an article which was not in fact the article known by that name to the public: but that the plaintiff was in fact using the name to deceive the public into buying the article sold by him as the original sauce.

Estcourt v. *Estcourt Hop Essence Company*, L. R. 10 Ch. 276.

Consideration of amount of delay or laches which will disentitle a plaintiff to relief in respect of the infringement of a trade name. Where both plaintiff and defendant are carrying on a trade whose object is to deceive the public, no costs will be given to a successful defendant.

Fisher v. *Apollinaris Company*, L. R. 10 Ch. 297.

There is nothing illegal or improper in a compromise of criminal proceedings taken under the Merchandize Marks Act (25 & 26 Vict. c. 88.)

Hirst v. *Denham*, L. R. 14 Eq. 542.

A manufacturer who had invented a particular pattern of cloth and sold it under a fancy name is entitled, though he may have no exclusive right to the pattern itself, to have other persons restrained from using the same name to describe similar goods

Recent Cases.

sold by them, notwithstanding an alleged usage of trade making such names common property; and is also entitled to have others restrained from using a ticket very similar to his upon similar goods.

Harter v. *Souvazoglu*, Weekly Notes, Jan. 30 and May 22, 1875 (V.-C. Hall and LL. JJ.)

A heading (*i.e.*, stripes of coloured thread woven into the end of a piece of calico,) may be a trade mark, whether or not used in combination with other marks.

Milner v. *Reed*, (decided by V.-C. Wickens when Vice-Chancellor of the Chancery Court of the County Palatine of Lancaster, Feb. 3, 1870).

A designation by which a person has in fact become known may be a trade name entitled to protection, even although the person claiming it is not the person it was originally applied to, and though the facts which caused it to be applied to him no longer exist. A surgeon, T., who resided in Oldfield Lane, and had acquired great fame under the name of the Oldfield Lane Doctor, took an assistant, M., into partnership: the assistant practised for some years in his master's surgery after the death of the latter, and passed by the name of Oldfield Lane Doctor. He was subsequently turned out by T.'s representatives who leased the surgery to R., another surgeon who practised there. On bill by M. against R., R. restrained from calling himself by the name of "Oldfield Lane Doctor."

Ragget v. *Findlater*, L. R. 17 Eq. 28.

A mere English word denoting quality cannot be

a trade mark. There can be no exclusive right to the use of such a mere common descriptive term as "Nourishing" applied to stout. The unreported case of *Broadhurst* v. *Barlow* (before V.-C. Wickens in 1872,) where the words "exactly twelve yards" stamped on long cloths for the Turkish market in the Turkish, Armenian, and modern Greek languages, were held to be a trade mark, stated and approved.

Richards v. *Williamson*, 30 L. T. 746.

Plaintiff held entitled to restrain defendant from selling guns into which there had been made up lock-plates bearing plaintiff's name and taken from guns originally made by plaintiff and sold by him to the Government who afterwards sold them as old stores. Although plaintiff's name was placed upon these lock-plates by himself no one else had a right to use such name to promote the sale of a complete article not really made by the plaintiff.

Singer Manufacturing Company v. *Wilson*, L. R. 1 Ch. D. 434.

A manufacturer may describe and advertise goods made by himself by the name of another manufacturer, under whose name the goods have become known, but who has no patent for them, so long as he makes no false representation regarding them, but, in fact, states them to be of his own making, and does not place on them the name of the other manufacturer. Though there may be a right of property in a trade mark when it is used on goods

Recent Cases.

intended to come into the hands of third parties (*i.e.*, persons to whom the defendant does not immediately sell,) in cases where it is not so used, fraud or misrepresentation by the defendant to the persons to whom he does actually sell must be proved. Consideration of the meaning of the doctrine that there is a right of property in a trade mark or name.

The only Statute passed since the publication of Messrs. Ludlow and Jenkyns' treatise which appears to affect trade marks (besides the two preceding Registration Acts) is 39 & 40 Vict. c. 36, the Customs Consolidation Act, 1876.

Sect. 42.

"The goods enumerated and described in the following table of prohibitions and restrictions inwards are hereby prohibited to be imported or brought into the United Kingdom, save as thereby excepted, and if any goods so enumerated and described shall be imported or brought into the United Kingdom contrary to the prohibitions or restrictions contained therein, such goods shall be forfeited, and may be destroyed or otherwise disposed of as the Commissioners of Customs may direct.

(The list of goods prohibited to be imported includes): "Articles of foreign manufacture and any packages of such articles bearing any name, brand, or mark being or purporting to be the name, brand, or mark of manufacturers resident in the United Kingdom, or any name, brand, or mark which states or implies that such articles were manufactured at any place in the United Kingdom.

"Any name, brand, or mark which states or implies that any such articles were manufactured at a town or place having the same name as a place in the United

Kingdom shall, unless accompanied by the name of the country in which such place is situate, be deemed, for the purposes of this Section, to state or imply that such articles were manufactured at a place in the United Kingdom.

Customs Consolidation Act, 1876.

"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."

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