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THE

LAW OF TRADE MARKS

AND THEIR REGISTRATION,

AND MATTERS CONNECTED THEREWITH;

INCLUDING

A CHAPTER ON GOODWILL.

TOGETHER WITH

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883-8,

AND THE TRADE MARKS RULES AND INSTRUCTIONS THEREUNDER;

FORMS AND PRECEDENTS;

THE MERCHANDISE MARKS ACT, 1887,

AND OTHER STATUTORY ENACTMENTS;

THE UNITED STATES STATUTES, 1870-81,

AND THE RULES AND FORMS THEREUNDER;

AND THE TREATY WITH THE UNITED STATES, 1877.

BY

LEWIS BOYD SEBASTIAN, B.C.L., M.A.,

OF LINCOLN'S INN, ESQ., BARRISTER-AT-LAW;

AUTHOR OF "A DIGEST OF CASES OF TRADE MARK, TRADE NAME, TRADE SECRET, GOODWILL," &c.

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TO

The Memory of

THE RIGHT HON. SIR GEORGE JESSEL,

MASTER OF THE ROLLS,

TO WHOM,

BY HIS KIND PERMISSION,

THE

FIRST EDITION OF

This Work

WAS MOST RESPECTFULLY DEDICATED.

PREFACE

TO

THE THIRD EDITION.

DURING the six years which have passed since the second edition of this book was submitted to the profession, many new cases have been decided with respect to the registration and the infringement of trade marks, various amendments have been made in the Act of 1883, and the important Merchandise Marks Act, 1887, has become law. These additions to, and alterations in, the law, together with other new matter, account for the expansion of the book from 500 pages to 650. The cases cited have increased in number by nearly one-half.

The Trade Marks Registration Acts, 1875-7, are reprinted; since, though they are repealed, the validity of trade marks registered under them still depends upon the terms of the Acts in force at the date of registration, and a reference to those Acts is frequently necessary in order to correctly appreciate the bearing of the earlier decisions.

In this edition, as in former editions, a large number of American and colonial decisions are cited, both because of the sale which this book has obtained in the United States and the Colonies, and also because of the increasing extent to which such decisions are cited in this country. "Although," as Cockburn, C.J., said (*a*), "the decisions of the American Courts are, of

(*a*) *Scaramanga* v. *Stamp*, 5 C. P. D. 295—303.

course, not binding on us, yet the sound and enlightened views of American lawyers in the administration and development of the law—a law, except so far as altered by statutory enactment, derived from a common source with our own—entitle their decisions to the utmost respect and confidence on our part." These decisions are, it is admitted, "intrinsically entitled to the highest respect" (*a*), having been delivered by acute and practised judges, after full consideration of English as well as American authorities; and it may reasonably be anticipated that English judges will in similar circumstances arrive at similar conclusions.

The author's thanks are due to various friends at the Bar and at the Patent Office, for useful hints and assistance, in particular to Mr. C. C. HENSLEY, of Lincoln's Inn, and Mr. ARNOLD GLOVER, of the Inner Temple, who have given much valuable help.

The English cases are brought down to the present month. It should be observed that the decision in *In re Dunn*, 41 Ch. D. 439, has been reversed by a majority in the House of Lords (*Eno* v. *Dunn*, June 19th, 1890).

L. B. S.

13, NEW SQUARE, LINCOLN'S INN,
June, 1890.

(*a*) See per Patteson, J., in *Beverley v. Lincoln Gas Light and Coke Co.*, 6 Ad. & Ell. 829-37, and Bacon, V.C., in *Dawson v. Bank of Whitehaven*, 4 Ch. D. 639-48.

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Dreyfus—Funke *v.*
Dubbins—Patching *v.*
Du Boulay—Du Boulay *v.*
Duncan—Hoffman *v.*
Dundas—R. *v.*
Dunn—Thompson *v.*
D'Utassey—Faber *v.*

EASTERBROOK—Saxby *v.*
Edelsten—Edelsten *v.*
Edgington—Edgington *v.*
Edgington (J.) & Co.—Edgington (B.), Limited *v.*
Edmonton—Clegg *v.*
Edwards—Apollinaris Co. *v.*
Ehlers—Siegert *v.*
Ehrhart—Lee *v.*
Eichele—Peltz *v.*
Elkan—Edwards *v.*
Elkan—Upmann *v.*
Ellinger & Co.—Twentsche Stoom Bleekery Goor *v.*
Elliott—Whitstable (Free Fishers and Dredgers of), *v.*
Elsworth—R. *v.*
Elvery—De la Branchardière *v.*
Emery—Mickle *v.*
Emmott—Jaffray *v.*
Emmott—Walter *v.*
Erhard—Zimmerman *v.*
Ertheiler—Carroll *v.*
Escobal—Lacroix *v.*
Estcourt Hop Essence Co.—Estcourt *v.*
Esterbrook—Gillott *v.*

Evans—Brook *v.*
Evans—Cope *v.*
Evans—Rose *v.*
Evans—Turner *v.*
Evening Post, Limited—Borthwick *v.*
Everett—Smith *v.*

FABER—Faber *v.*
Fair—Smith *v.*
Farlow—Bozon *v.*
Farren—New Haven Patent Rolling Spring Bed Co., *v.*
Fassett—Filley *v.*
Fawcus—Dixon *v.*
Feltham & Co.—Slazenger & Sons *v.*
Fenwick—Featherstonhaugh *v.*
Field—Bonner *v.*
Finch—Day *v.*
Findlater—Raggett *v.*
Findlater—Siegert *v.*
Finlay—Robinson *v.*
Finzer—Liggett & Myers Tobacco Co. *v.*
Fisher—People *v.*
Fisher—Seeley *v.*
Fitzgerald—R. *v.*
Flanagan—Matsell *v.*
Fleming—McLean *v.*
Fleming—Ralli *v.*
Flint—Leidersdorf *v.*
Floyd—Bowman *v.*
Folgham—Green *v.*
Footman—Blank *v.*
Footman, Pretty & Co.—Symington & Co. *v.*
Forester—Upmann *v.*
Foster—Burrows *v.*
Foster—Ford *v.*
Foster—R. *v.*
Fox—Millington *v.*
Français—Hobbs *v.*
Franks—Pierce *v.*
Frazer Lubricator Co.—Frazer *v.*
Freeman—Browne *v.*
Freeman—Clark *v.*
Fries—Hostetter *v.*
Fullwood—Fullwood *v.*

GANTON—Lemoine *v.*
Gardner—Harrison *v.*
Garlick—R. *v.*
Garner—Amoskeag Manufacturing Co. *v.*
Garner—Merrimack Manufacturing Co. *v.*
Garnhart—McCartney *v.*
Gaubert—Ansell *v.*
Gebhardt—Farina *v.*

Geisendorf—Sohl *v.*
General Newspaper Co.—Dale *v.*
General Reversionary Co., Limited—Bumsted *v.*
German Mutual Fire Insurance Co.—Clark *v.*
Gertcken—Cory *v.*
Gibbons' Frame—Wilcox & Gibbs' Sewing Machine Co. *v.*
Gibbs—Missouri (State of) *v.*
Gibson—Banks *v.*
Gillard—Cotton *v.*
Gillies—Taylor *v.*
Gladstone—Steuart *v.*
Glenn—Dunbar *v.*
Godts—Nichol *v.*
Goetze—Carter *v.*
Gomm—Barrett *v.*
Goodwin—Lever *v.*
Goodyear India Rubber Glove Manufacturing Co.—Goodyear Rubber Co. *v.*
Goss—Carey *v.*
Goss—R. *v.*
Goulard—Wolfe *v.*
Graham—Ransome *v.*
Grand Junction Railway Co.—Pickford *v.*
Grant, Smith & Co.—Orr-Ewing *v.*
Graves—Smale *v.*
Gray—Bullock, Lade & Co. *v.*
Gray—Wotherspoon *v.*
Gray & Gosling—R. *v.*
Great Northern Railway Co.—North London Railway Co. *v.*
Green—Duke *v.*
Greene—Symonds *v.*
Griffith—Chappell *v.*
Griffiths—Chubb *v.*
Griffiths—Corns *v.*
Grocer Publishing Co.—American Grocer Publishing Association *v.*
Grosvenor—Seabury *v.*
Grosvenor Gallery Co.—Hoby *v.*
Guardian and General Assurance Co. Limited—Guardian Fire and Life Assurance Co. *v.*
Guénin—Grillon *v.*
Guggenheim—Dixon Crucible Co. *v.*
Guggenheimer—Parlett *v.*
Guittard—Pierce *v.*
Guy—Bunn *v.*

Haish—Washburn and Moen Manufacturing Co. *v.*
Haley—Lee *v.*
Hall—Gillis *v.*
Hall—Glen & Hall Manufacturing Co. *v.*
Hall—Hall *v.*
Hall—Morse *v.*
Hall—R. *v.*
Hall & Co.—Perks *v.*
Hallam—Vernon *v.*
Hamblin—Lehigh Valley Coal Co. *v.*
Hamel—Sarazin *v.*
Hamilton—Cooper *v.*
Hamilton—Dwight *v.*
Hampshire and North Wilts Bank—London and County Banking Co. *v.*
Hanbury—Liebig's Extract of Meat Co. *v.*
Hand—Worral *v.*
Harper—Blackwell *v.*
Harris—Godillot *v.*
Harris—Keene *v.*
Harris—Palmer *v.*
Harris—Smith *v.*
Harrison—Flavel *v.*
Hart—Colley *v.*
Hart—Low *v.*
Hart—Wolfe *v.*
Hart-Davies—Hill *v.*
Hately—Burgess *v.*
Hawkins—Marshall *v.*
Hawley—Fielding *v.*
Hawxhurst—Walker *v.*
Hayward—Parsons *v.*
Hayward & Sons—Hayward & Co. *v.*
Hazard—Electro-Silicon Co. *v.*
Hazard—Godillot *v.*
Head—Walter *v.*
Heap—Guinness *v.*
Hegeman—Hegeman & Co. *v.*
Heisel—Adams *v.*
Helleley—Johnson *v.*
Helmbold Manufacturing Co.—Helmbold *v.*
Hemmons—Weston *v.*
Hendrickx—Laferme (Compagnie) *v.*
Henley—Rose *v.*
Henriques—Howard *v.*
Henry—Mitchell *v.*
Henshaw—Ihlee *v.*
Henshaw—Steinway & Sons *v.*
Herbert & Co.—Upper Assam Tea Co. *v.*
Herrfeldt—Apollinaris Co. *v.*
Hertz—Salomon *v.*
Heyde—Bryant & May *v.*
Hickling—Whitney *v.*
High Rocks Congress Spring Co.—Congress and Empire Spring Co. *v.*
Highmoor—Caruncho *v.*
Hill—Batty *v.*
Hill—Blanchard *v.*
Hills—Burgess *v.*
Hine—Portal *v.*

Hink—Eggers *v.*
Hinks—Rollins *v.*
Hirsch & Co.—Hirsch *v.*
Hirschfeld—Leather Cloth Co. *v.*
Hitchcock—Hopkins *v.*
Hodge & Co,—Williams *v.*
Hodgson—Davies *v.*
Hodgson—Matthews *v.*
Hoffman—Sanders *v.*
Hogan—Hennessy *v.*
Hoge—Moorman *v.*
Hogg—Clowes *v.*
Hogg—Harrison *v.*
Hogg—Maxwell *v.*
Holbrook—Coats *v.*
Holden—Dixon *v.*
Hollender—Luyties *v.*
Hollins—Campbell *v.*
Holloway—Holloway *v.*
Holmes, Booth & Atwood Manufacturing Co.—Holmes, Booth & Haydens *v.*
Holt—Aubin *v.*
Holt—Ryder *v.*
Home and Colonial Assurance Co.—Colonial Life Assurance Co. *v.*
Hood—Cooper *v.*
Hooper—Kelly *v.*
Hooper—Lavergne *v.*
Hoopes—Merry *v.*
Hoosier Drill Co.—Julian *v.*
Horn—Sawyer *v.*
Horowitz—Van Wyck *v.*
Horton Manufacturing Co.—Horton Manufacturing Co. *v.*
Houghton—Rowley *v.*
How—Pidding *v.*
How—Southern *v.*
Howe—Whittaker *v.*
Howe Machine Co.—Howe *v.*
Hoxie—Chaney *v.*
Hubbard—Sawyer Crystal Blue Co. *v.*
Hughes—Evans *v.*
Hulme—Heathcote *v.*
Hulton—Cowen *v.*
Humphrey—Peterson *v.*
Hunkele—Enoch Morgan's Sons' Co. *v.*
Hunnewell—Gilman *v.*
Hunt—Richards *v.*
Hunter—R. *v.*
Huntington—Rudderow *v.*
Hutton—Kelly *v.*
Hynes—Liggett & Myers' Tobacco Co. *v.*

Imperial French Dye Cleaning and Dyeing Co., Limited—Thompson *v.*
Imus—Smith *v.*
Ingels—Hoosier Drill Co. *v.*
Isaacson—Chatteris *v.*

Jackson—Dicks *v.*
Jackson—Dixon *v.*
Jacobus—Fairbanks *v.*
James—James *v.*
James—Newbery *v.*
James—Oldham *v.*
James—Spicer *v.*
Jaques—Jollie *v.*
Jarrett—Booth *v.*
Jebsen & Co.—Vulcan Match Manufacturing Co. *v.*
Jeffery—Spratt *v.*
Jenkins—Wade *v.*
Johnson—Kidd *v.*
Johnson—Solner *v.*
Johnson—Williams *v.*
Johnson & Co.—Ascough *v.*
Johnson & Co.—Barlow & Jones, Ld. *v.*
Johnston—Byron (Lord) *v.*
Johnston—Wheeler *v.*
Johnston & Co.—Orr-Ewing & Co. *v.*
Jonas—Hirsch *v.*
Jones—Canham *v.*
Jones—R. *v.*
Jones, Brothers & Co.—Young *v.*
Jorss—Henderson *v.*
Joseph Uhrig Brewing Co.—Conrad *v.*
Judges—Talbot *v.*
Junior Army and Navy Stores, Limited—Army and Navy Co-operative Society, Limited *v.*

Kahn—Cohn *v.*
Kalamazoo Buggy Co.—Myers *v.*
Kass—Hawloetz *v.*
Kaufmann—Hazzopulo *v.*
Keating—Stevens *v.*
Keen—Mellersh *v.*
Kellogg—Sawyer *v.*
Kendall—Davis *v.*
Kennedy—Davis *v.*
Kennett—Hennessy *v.*
Kerr, Davis & Co.—Graham & Co. *v.*
Ketcham—Weston *v.*
Kettle—Gillott *v.*
Kilburn & Co.—Balfour & Co. *v.*
Kimball—Singer Manufacturing Co. *v.*
Kimpton—Nicholls *v.*
Kinahan—Kinahan *v.*
King & Co.—Strachan & Co. *v.*
King & Co.—Wallace & Co. *v.*
Kinney—Hornbostel *v.*

Kinney Tobacco Co.—Ginter *v.*
Kirby—Hogg *v.*
Klapproth—Lewis *v.*
Kleinhaus—Armstrong *v.*
Knight—Barrows *v.*
Knight, Stocks & Co.—Berliner Brauerei Gesellschaft Tivoli *v.*
Knos & Co.—Vulcan Match Manufacturing Co. *v.*
Knott—Prudential Assurance Co. *v.*
Knott—Welch *v.*
Knowles—Primrose Press Agency *v.*
Koch—Gray *v.*
Kraft, Meyer & Co.—Curtis, Harvey & Co. *v.*

LABBOT—Pepper *v.*
Ladler—Jay *v.*
Laidlaw—Bass, Ratcliff & Gretton, Ld. *v.*
Laight—Shrimpton *v.*
Lamar—Brewer *v.*
Lamb—Deiz *v.*
Lambert—Wood *v.*
Landgraff—Stokes *v.*
Landreth—Landreth & Sons *v.*
Lang & Co.—Wolfe *v.*
Langdon—Lewis *v.*
Langford & Co.—Great Tower Street Tea Co. *v.*
Larned—Lowell Manufacturing Co. *v.*
Larsen—Singer Manufacturing Co. *v.*
Lart—Hine *v.*
Latham & Co.—Blakey & Sons *v.*
Latimer—Carmichel *v.*
Lawes Chemical Manure Co.—Western Counties Manure Co. *v.*
Lawrence—Siegert *v.*
Lazar—Woodward *v.*
Lazarus—Rock *v,*
Lazenby—Lazenby *v.*
Lea—Foot *v.*
Leach—Clark *v.*
Le Barron—Magee Furnace Co. *v.*
Le Boutillicre—Jaeger's Sanitary Woollen System Co. *v.*
Lee—Kennedy *v.*
Lee—R. *v.*
Le Page—Russia Cement Co. *v.*
Leslie—Estes *v.*
Leuchars—Barnett *v.*
Levine & Wood—R. *v.*
Levinstein—Renard *v.*
Levy—Electro-Silicon Co. *v.*
Levy—Fenton *v.*
Lewis—Field *v.*
Lewis—Larrabee *v.*
Lewis—R. *v.*
Libby—Harrington *v.*
Libby—Hilsen *v.*
Liebig's Extract of Meat Co.—Anderson *v.*
Lincoln Gas Light and Coke Co.—Beverley *v.*
Liverpool Vinegar Co., Ld.—Birmingham Vinegar Brewery Co., Ld. *v.*
Lloyd—Hovenden *v.*
Lloyd—R. *v.*
Locke—Bell *v.*
Lockett—Lockett *v.*
Lockwood—Hill *v.*
Loftus—Rose *v.*
London and Provincial Joint Stock Life Assurance Co.—London and Provincial Law Assurance Society *v.*
London and Provincial Provident Association, Ld.—Provident Association of London, Ld. *v.*
London and Westminster Assurance Corporation—London Assurance *v.*
Loog—Singer Manufacturing Co. *v.*
Lopes & Co.—Jacoby & Co. *v.*
Lorsont—Leather Cloth Co. *v.*
Low—Benbow *v.*
Lowell—Lawrence Manufacturing Co. *v.*
Lucy—Falkinburg *v.*
Ludemann—Glen Cove Manufacturing Co. *v.*
Luke—Hop Bitters Manufacturing Co. *v.*
Lumphinnans Iron Co.—Lochgelly Co., Limited *v.*
Lund—Axmann *v.*
Lyc—Cruttwell *v.*

MCADAM—Morgan *v.*
McArthur—Lehmann *v.*
McCubbin—McCormick *v.*
McCulloch—Wilkie *v.*
McGowan—McGowan Brothers' Pump and Machine Co. *v.*
McKernan—Howe *v.*
McMaster & Co.—Dickson *v.*
McNulty—Powell *v.*
McPherson—Potter *v.*
Macarthy—Allen *v.*
Mack—Shaw Stocking Co. *v.*
Mackinnon—Thompson *v.*
Mackintosh—Scott *v.*
Macrae—Young *v.*
Maddick—Clement *v.*
Mahalaxmi Spinning and Weaving Co., Limited—Manockji Petit Manufacturing Co. *v.*

Major—Turner *v.*
Malings—Slazenger *v.*
Maniere—Hunt *v.*
Marble—United States *v.*
Marsh—Post *v.*
Marshall—Gillespie & Co. *v.*
Marshall—Marshall *v.*
Martin—Morse *v.*
Mason—Dence *v.*
Mason—Mossop *v.*
Mason—Smith *v.*
Massam—Thorley's Cattle Food Co. *v.*
Masury—Brooklyn White Lead Co. *v.*
Mathie—Boswell *v.*
Maxfield—Wilson *v.*
Maxwell—Hogg *v.*
May—Cartier *v.*
May—Lacroix *v.*
Mayer—Del Valle *v.*
Mayo—Chase *v.*
Mège—Hatchard *v.*
Megevand—Foster *v.*
Meikle—Avery *v.*
Melachrino Egyptian Cigarette Co.—Melachrino (M.) & Co. *v.*
Melachrino (R.) & Co.—Melachrino (M.) & Co. *v.*
Mellis—Lichtenstein *v.*
Menck—Partridge *v.*
Meneely—Meneely *v.*
Menendez—Holt *v.*
Mercer—Brown *v.*
Merchant—Fetridge *v.*
Merchants' Joint Stock Bank, Limited—Merchant Banking Co. of London *v.*
Meriden Britannia Co.—Boardman *v.*
Meriden Britannia Co.—Goodman *v.*
Merkel—St. Louis Piano Manufacturing Co. *v.*
Merrick Thread Co.—Coats *v.*
Metcalf—Anglo-Swiss Condensed Milk Co. *v.*
Metcalf—Cassidy *v.*
Metropolitan Board of Works—Cooper *v.*
Metropolitan Collar Co.—Union Paper Collar Co. *v.*
Meyer—India Rubber Comb Co. *v.*
Micalovitch, Fletcher & Co.—Société Anonyme de la Distillerie de la Bénédictine *v.*
Middleton—Vogeler Co. *v.*
Midland Railway Co.—King *v.*
Milbourn—Bond *v.*
Millar—Lea *v.*
Miller & Co.—Hurricane Patent Lantern Co. *v.*
Mills—Tweed *v.*
Mills, Johnson & Co.—Kidd & Co. *v.*
Mitchell—Condy *v.*
Mitchell—Rammelsberg *v.*
Moat—Morison *v.*
Moffatt & Paige—Besant *v.*
Monne—Portuondo *v.*
Montague—Hendriks *v.*
Montgomery—Thompson *v.*
Moonelis—Strasser *v.*
Moore—Montague *v.*
Moore—Tallcott *v.*
Morgan—Knott *v.*
Morgan—R. *v.*
Morris—R. *v.*
Morris—United States *v.*
Morse—Alexander *v.*
Morson—Carnrick *v.*
Mortimer—Prowett *v.*
Moss—Boon *v.*
Moss—Morris *v.*
Mottram—Walker *v.*
Mowling—Neva Stearine Co. *v.*
Mudie—Avanzo *v.*
Mulligan—Littlejohn & Son *v.*
Munro—Bain *v.*
Munsford & Gorman—Porter *v.*
Murphy—Christy *v.*
Myer—Brown Chemical Co. *v.*
Myers—Cave *v.*

NAIRN—Linoleum Manufacturing Co. *v.*
Napper—Jackson & Co. *v.*
Neale—Day *v.*
New York Publishing Co.—England *v.*
Newton—Fleming *v.*
Noah—Snowden *v.*
Norfolk—Peabody *v.*
Norman—Radde *v.*
Norris—Rivero *v.*
Norrish—Apollinaris Co. *v.*
Norton—Bradley *v.*
Norton—Geary *v.*
Nowill—Rodgers *v.*

OAKES—Skinner *v.*
O'Brien—R. *v.*
O'Byrne—Hegeman & Co. *v.*
O'Connor—Wolmershausen *v.*
Ogden—R. *v.*
Ogg—Harris *v.*
O'Hanlon—Watt *v.*
O'Meara—Reed *v.*
Oppenheim—Wittman *v.*
Oregon Central Railway Co.—Newby *v.*
Orr-Ewing & Co.—Johnston & Co. *v.*

Osborne—Hudson *v.*
Osborne—Williams *v.*
Osgerby —Hudson *v.*
Owens—Bodega Co., Limited *v.*

PAINE—Stevens *v.*
Pape—Curtis, Harvey & Co. *v.*
Parker—Meriden Britannia Co. *v.*
Parry—James *v.*
Parton, Son & Co.—Osborne, Garrett & Co. *v.*
Payne—Blofeld *v.*
Peacock—Richardson *v.*
Peake—Boulnois *v.*.
Pearce—Farr *v.*
Pearson—Harper *v.*
Pearson—Pearson *v.*
Peck—Jarvis *v.*
Peck—McCardel *v.*
Peek Bros. & Co.—Adee *v.*
Peel—Stephens *v.*
Pelsall Coal and Iron Co.—Barrows *v.*
Pemberton—R. *v.*
Percival—Bassett *v.*
Perhamus—Morgan *v.*
Peters—Swift *v.*
Peterson—Weed *v.*
Peto—Ponsardin *v.*
Petter—Crookes *v.*
Petter—Mack *v.*
Phalon—Burnett *v.*
Philp—Rodgers *v.*
Photographic Co.—Pollard *v.*
Pickering—Moet *v.*
Pile—Pile *v.*
Pillow—Barnard *v.*
Pinkham—Marshall *v.*
Pinto—Newman *v.*
Pinto-Leite—Carver *v.*
Piper—Aikins *v.*
Pirie & Sons, Limited—Towgood Bros. *v.*
Piza -Anheuser Busch Brewing Association *v.*
Plate—Derringer *v.*
Plate—Graham *v.*
Pollard, Graham & Co.—Derby Photographic Dry Plate Co. *v.*
Ponce—Stachelberg *v.*
Pond—Stimpson *v.*
Porter—Hecht *v.*
Pottage—Hookham *v.*
Potter—Heywood *v.*
Powell—Seltzer *v.*
Prescott—Van Beil *v.*
Price—Henry *v.*
Pride—Lorillard *v.*
Priestley—R. *v.*
Prince—Goodfellow *v.*
Pritchard—Gee *v.*
Provezende—Seixo *v.*
Pullar—Pullar *v.*

QUEEN—Mason *v.*
Quiddington—Robertson *v.*

RABBITS & Son—Fennessy *v.*
Ragg—R. *v.*
Ratcliff—Woollam *v.*
Ray—Ledger *v.*
Raylton—Johnson *v.*
Read—Giblett *v.*
Read—Mitchell *v.*
Reed—Connell *v.*
Reed—Milner *v.*
Reeves—Collins Co. *v.*
Reeves—Peru (Republic of) *v.*
Registrar of Trade Marks—Orr-Ewing *v.*
Rehder & Co.—Compania General de Tabacos *v.*
Reid—Davis *v.*
Reynolds—Smith *v.*
Reynolds—Southorn *v.*
Richards—Allen *v.*
Richardson—McDonald *v.*
Richardson & Co.—Read Brothers *v.*
Ridgway—R. *v.*
Riley—Singer Manufacturing Co. *v.*
Riley—Springhead Spinning Co. *v.*
Roberts—Briton Life Association, Ld. *v.*
Roberts—R. *v.*
Robertson—Thompson & Co. *v.*
Robinson—Atlantic Milling Co. *v.*
Robinson—Ward *v.*
Roche—United States *v.*
Rockwood—Osgood *v.*
Rodgers—Rodgers *v.*
Roebuck—R. *v.*
Roffey—Nixey *v.*
Rogers—Morgan *v.*
Rogers—Rogers *v.*
Rogers & Spurr Manufacturing Co.—Rogers Manufacturing Co. *v.*
Rohmann, Osborne & Co.—Hennessy *v.*
Rolfe—Rolfe *v.*
Rooke—Green *v.*
Ross—Marshall *v.*
Rottgen—Rodgers & Sons, Limited *v.*
Rouch—Burfield *v.*
Rowland—Atlantic Milling Co. *v.*
Rowland—Scott *v.*
Royden—Clover *v.*

Rubber Comb and Jewelry Co.—India Rubber Comb Co. *v.*
Ruffner—Dausman & Drummond Tobacco Co. *v.*
Rushton—Ayer *v.*
Russell—Londonderry (Marquis of) *v.*
Rutherford—Llewellyn *v.*
Ruthin Soda Water Co.—Ellis & Sons *v.*
Rylands—Davenport *v.*

Salem Flouring Mills—Oliphant *v.*
Salmon—Morison *v.*
Samson—Steinthal *v.*
Sanders—Kochler *v.*
Sands—Woods *v.*
Sanitary Engineering and Ventilation Co.—Weaver *v.*
Sargood, Ewen & Co.—Moses *v.*
Saunders—Correspondent Newspaper Co. *v.*
Savournin—Tetlow *v.*
Schembri—Somerville *v.*
Scherer—Apollinaris Co. *v.*
Schlecht—White *v.*
Schmincke—Schove *v.*
Schuckmann—Fleischmann *v.*
Schultz & Co.—Lautz Brothers *v.*
Schuyler—Morgan *v.*
Schwachhofer—Enoch Morgan's Sons' Co. *v.*
Schwenke—Schumacher & Ettlinger *v.*
Scott—Insurance Oil Tank Co. *v.*
Scott—Scott *v.*
Scottish Val de Travers Paving Co., Limited—Stuart & Co. *v.*
Searing—Howe *v.*
Sellers—Fulton *v.*
Senate—Sedon *v.*
Sewage Manure Co.—Native Guano Co., Limited *v.*
Shakespear—Wheeler & Wilson Manufacturing Co. *v.*
Shaver—Shaver *v.*
Shaw—Delondre *v.*
Shaw—Farina *v.*
Sheard—Chappell *v.*
Sheard—Hutchings *v.*
Sheffield Gas Consumers' Co.—Attorney-General *v.*
Sheldon—Roberts *v.*
Shepherd—Green *v.*
Sheppard—Chance *v.*
Sherrill—Royal Baking Powder Co. *v.*
Sherwood—R. *v.*
Shove—Thynne *v.*
Shuttock—Crawford *v.*
Sibbald—Reid *v.*
Silverlock—Farina *v.*
Silversides—R. *v.*
Simms—Colburn *v.*
Simpson—Rogers Manufacturing Co.
Simpson—Wright *v.*
Sims—Coles *v.*
Singer Manufacturing Co.—Brill *v.*
Singer Manufacturing Co.—Wilson *v.*
Sixbury—Smith *v.*
Slack—Ellen *v.*
Slade—Jeudwine *v.*
Sleep—R. *v.*
Smith—Dale *v.*
Smith—Evans *v.*
Smith—Glenny *v.*
Smith—Gray *v.*
Smith—Great Tower Street Tea Co. *v.*
Smith—Hargreaves *v.*
Smith—Helmore *v.*
Smith—Holt *v.*
Smith—Liverpool Household Stores Association *v.*
Smith—McMurdo *v.*
Smith—R. *v.*
Smith—Russell & Sons, Limited *v.*
Smith—Smith *v.*
Smith—Wedgwood *v.*
Smithson—Dale *v.*
Smithson—Stewart *v.*
Soares, Beazley *v.*
Sœurs de l'Asile de la Providence—Kerry *v.*
Somborn—Actien Gesellschaft Apollinaris Brunnen *v.*
Souvazoglu—Harter *v.*
Spalding—Reinhardt *v.*
Spear—Amoskeag Manufacturing Co. *v.*
Spear—Fowle *v.*
Spence—Williams *v.*
Stanage—Singer Manufacturing Co. *v.*
Starkey—Fleischmann *v.*
Starkweather—Cook *v.*
Steffens—United States *v.*
Stephens—Eno *v.*
Stephenson—Caruncho *v.*
Stephenson—Gamble *v.*
Stetson—Town *v.*
Stevens—Hunt *v.*
Stevens—R. *v.*
Stiff—Ingram *v.*
Stiff & Sons—Weaver *v.*
Stock—Blair *v.*
Stoddart—Champlin *v.*
Stonebraker—Stonebraker *v.*
Strange—Albert (Prince) *v.*

Stratton—Burton *v.*
Stribolt & Co.—Davis & Co. *v.*
Stuart & Peterson—Sheppard & Co. *v.*
Such—Clement *v.*
Sullivan—Byass *v.*
Sunley—R. *v.*
Suter & Coulson—R. *v.*
Sweet—Archbold *v.*
Swezey & Dart—Josselyn *v.*
Swinborne—Gridley *v.*
Swiss Condensed Milk Co.—Anglo-Swiss Condensed Milk Co. *v.*
Sykes—Sykes *v.*
Symonds—Thompson *v.*

Taintor—Rogers *v.*
Taper Sleeve Pulley Works—Gray *v.*
Tate—Burnett *v.*
Taylor—Backus *v.*
Taylor—Harrison *v.*
Taylor—Taylor *v.*
Taylor & Co.—Condy & Mitchell *v.*
Taylor Drug Co.—Humphries *v.*
Teede—India & China Tea Co. *v.*
Tennessee Manufacturing Co.—Lawrence Manufacturing Co. *v.*
Thalheimer—Sternberger *v.*
Theal—McCall *v.*
Thomas—Chinn *v.*
Thomas—Colton *v.*
Thompson—Carbolic Soap Co. *v.*
Thompson—Crawshay *v.*
Thompson—Isaacson *v.*
Thompson—Mackinnon *v.*
Thorley's Cattle-Food Co.—Massam *v.*
Till—Coslake *v.*
Todd—Partlo *v.*
Toland—Scoville *v.*
Tonnelierre—Oakes *v.*
Townsend—Page *v.*
Trainer—Amoskeag Manufacturing Co. *v.*
Trask—Electro-Silicon Co. *v.*
Trester—Labbatt *v.*
Tripp—Longman *v.*
Troxell—Enoch Morgan's Sons' Co. *v.*
Truefitt—Perry *v.*
Trust—Gouraud *v.*
Trustees of Port of Bombay—Shepherd *v.*
Tudor—Tudor *v.*
Turner—Beard *v.*
Turpin—Dent *v.*
Turton—Turton & Sons, Limited *v.*
Tussaud—Tussaud *v.*
Tylor—Davis *v.*
Tynberg—Messerole *v.*

Uhler—Glendon Iron Co. *v.*
Ullmer—Guinness *v.*
Union Bank of Spain and England—Street *v.*
Union Playing Card Co.—New York Consolidated Card Co. *v.*
United States—Woodman *v.*

Valencia Cigar Factory—McVeagh *v.*
Van Nostrand—Dougherty *v.*
Van Schaick—Marten *v.*
Venning—Goodwin *v.*
Vick—Edelsten *v.*
Vining—Nuthall *v.*
Virasami—Taylor *v.*
Von Laer—Evans *v.*

Wackerbarth—Gail *v.*
Wagner—Lumley *v.*
Walker—Allsopp *v.*
Walker—Cheavin *v.*
Walker—Collins Co. *v.*
Walker—Levy *v.*
Walker—Reynolds & Son *v.*
Wallis—R. *v.*
Wallis—Wallis *v.*
Walls—Day *v.*
Walmsley—Ainsworth *v.*
Walter—Pollill *v.*
Ward—Colnaghi *v.*
Ward—Idris & Co. *v.*
Ward—Mulkern *v.*
Ward—Tonge *v.*
Ward & Co.—Spratt's Patent *v.*
Waring—Wason *v.*
Warner—Warner *v.*
Warren Thread Co.—Warren *v.*
Waters—Buckingham *v.*
Watson—Cooper *v.*
Watson—Marshall *v.*
Wattles—Binninger *v.*
Weaver—Franks *v.*
Webber—Angier *v.*
Webley—Talbot *v.*
Webster—Lucke *v.*
Webster—Routh *v.*
Webster—Webster *v.*
Wedderburn—Wedderburn *v.*
Weild—Wren *v.*
Welch—Vickery *v.*
Weller—Fradella *v.*
Wells—Fetridge *v.*
Wells & Co.—Leonard & Ellis *v.*
Welsh—Sorg *v.*

Wenz—Humphreys' Specific Homœopathic Medicine Co. *v.*
Westcott—Hanford *v.*
Western Electric Co.—Leclanche Battery Co. *v.*
Westhead—Cartier *v.*
Westlake—Watson *v.*
Wharton—Hop Bitters Manufacturing Co. *v.*
Wheatcroft—Allsopp *v.*
Wheeler—Hennessy *v.*
Wheeler—Lafferty *v.*
Whitaker—Darbey *v.*
White—Barrett *v.*
White—Comstock *v.*
White—Hennessy *v.*
White—Lazenby *v.*
White—R. *v.*
White's Golden Lubricator Co.—Leonard & Ellis *v.*
Whitehead—Bryson *v.*
Whiteman—Degraves *v.*
Whitmore—Jacoby *v.*
Whitwell—Standish *v.*
Wight—Lorillard *v.*
Wilcox—Popham *v.*
Wilder—Laird *v.*
Wilder—Wilder *v.*
Wilkes—Dayton *v.*
Wilkes—Roworth *v.*
Williams—Elsas *v.*
Williams—Estes *v.*
Williams—McCord *v.*
Williams—Schneider *v.*
Williams—Thomas *v.*
Williams—Williams *v.*
Williamson—Richards *v.*
Willis—R. *v.*
Willmett—R. *v.*
Wilson—Apollinaris Co. *v.*
Wilson—Singer Manufacturing Co. *v.*
Wilson—Williams *v.*
Winchester—Graveley *v.*
Winchester—Longman *v.*
Winchester—Thomson *v.*
Winkup—Showell *v.*
Winsor—Stetson *v.*
Winyard—Youatt *v.*
Witteman—De Kuyper *v.*
Wittkowski—Heyde *v.*
Wood—Manhattan Medicine Co. *v.*
Wood—Metzler *v.*
Woodhouse—Green *v.*
Woodruff—Smith *v.*
Woodside—Alleghany Fertiliser Co. *v.*
Woolf—Lea *v.*
Worrell—Morse *v.*
Worth—Pierce *v.*
Worthington—Estes *v.*
Wright—Blackwell *v.*
Wright—Heath *v.*
Wright—Martin *v.*
Wright—Phalon *v.*
Wright—Simpson *v.*

YALE—Yale Cigar Manufacturing Co. *v.*
Yates—Dicks *v.*
Young—Dreydoppel *v.*
Young & Sons—Dunnachie *v.*

ZEILEN & CO.—Ellis *v.*

TABLE OF ABBREVIATIONS.

A. J.	Australian Jurist.
Abb. N. C.	Abbott's New Cases (New York).
Abb. Pr.	Abbott's Practice Reports (New York).
Act. Comm.	Acting Commissioner.
Ad. & E.	Adolphus and Ellis.
Alb. L. J.	Albany (New York) Law Journal.
Allen	Allen (Massachusetts).
Am. L. Reg.	American Law Register.
Am. L. Rev.	American Law Review.
Am. L. T.	American Law Times.
Amer. Dec.	American Decisions.
Amer. Rep.	American Reports.
Amer. St. Rep.	American State Reports.
App. Cas.	Appeal Cases.
Asst. Comm.	Assistant Commissioner.
Atk.	Atkins.
B. & Ad.	Barnewall and Adolphus.
B. & Cr.	Barnewall and Cresswell.
Barb. Ch.	Barbour's Chancery Reports (New York).
Barb. S. C. or Barb.	Barbour's Supreme Court Reports (New York).
Barnard.	Barnardiston.
Beav.	Beavan.
Bell	Bell's Crown Cases.
Beng. L. R. App.	Bengal Law Reports, Appendix.
Biss.	Bissell (U. S. Circuit Court).
Bl. C. C.	Blatchford (U. S. Circuit Court).
Bomb.	Bombay.
Bond	Bond (U. S. Circuit Court).
Bos.	Bosworth (New York).
Bos. & P. N. R.	Bosanquet and Puller New Reports.
Brews.	Brewster (Pennsylvania).
Browne	Browne (Massachusetts).
Bush	Bush (Kentucky).
C. A.	Court of Appeal.
C. B.	Common Bench.
C. C. C.	Central Criminal Court.
C. C. C. Sess. Pap.	Central Criminal Court Sessions Papers.

C. C. R.	Court of Crown Cases Reserved.
C. & M.	Carrington and Marshman.
C. &. P.	Carrington and Payne.
C. P.	Common Pleas.
C. P. Div.	Common Pleas Division.
Cab. & Ell.	Cababé and Ellis (Nisi Prius.)
Cal.	California.
Calc.	Calcutta.
Can.	Canada.
Cass. Dig.	Cassell's Canadian Digest.
Ch. D.	Chancery Division.
Chitty Gen. Pr.	Chitty's General Practice.
Cinc.	Cincinnati.
Cinc. L. B.	Cincinnati Legal Bulletin.
Codd. Dig.	Coddington's American Digest of Trade Mark Cases.
Comm.	Commissioner.
Comm. of App.	Commission of Appeals (New York).
Conn.	Connecticut.
Coop.	Cooper.
C. P. Coop.	C. P. Cooper.
Cor.	Coryton (Bengal).
Cox	Cox's Criminal Cases.
R. Cox	R. Cox's American Trade Mark Cases.
Cro.	Croke.
Ct. of App.	Court of Appeal.
Ct. of Cl.	Court of Claims (U. S.).
Ct. of Sess. Cass.	Court of Session Cases (Scotch).
Curtis	Curtis (U. S. Circuit Court).
Cush.	Cushing (Massachusetts).
D. & B.	Dearsley and Bell.
D. & R.	Dowling and Rylands.
Daly	Daly (New York).
Deady	Deady (U. S. Circuit Court).
De G. F. & J.	De Gex, Fisher and Jones.
De G. & J.	De Gex and Jones.
De G. J. & S.	De Gex, Jones and Smith.
De G. M. & G.	De Gex, Macnaghten and Gordon.
De G. & Sm.	De Gex and Smale.
Den.	Denison, Crown Cases
Dig.	Sebastian's Digest of Cases of Trade Mark, &c.
Dill.	Dillon (U. S. Circuit Court).
Dorion	Quebec Q.B. Reports.
Doug.	Douglas.
Dr.	Drewry.
Dr. & Sm.	Drewry and Smale.
Duer	Duer (New York).
E. & B.	Ellis and Blackburn.
East P. C.	East's Pleas of the Crown.
Ell. & Ell.	Ellis and Ellis.
Eq. Rep.	Equity Reports.
Esp. N. P. C.	Espinasse, Nisi Prius Cases.

Ex.	Exchequer.
F. & F.	Foster and Finlason.
Fed. Rep.	Federal Reporter (U. S.).
Foster Cr. Cas.	Foster, Crown Cases.
Ga.	Georgia.
Giff.	Giffard.
Grant, Up. Can. Ch.	Grant, Upper Canada, Chancery.
Green	Green, New Jersey.
H. & M.	Hemming and Miller.
H. & N.	Hurlstone and Norman.
H. & Tw.	Hall and Twells.
H. & W.	Harrison and Wollaston.
H. L.	House of Lords.
H. L. C.	House of Lords Cases.
Hand	Hand (New York).
Hilt.	Hilton (New York).
Hoff.	Hoffman (New York).
Holmes	Holmes (U. S. Circuit Court).
Hopk.	Hopkins (New York).
How. App. Cas.	Howard's Appeal Cases (New York).
How. Pr.	Howard's Practice Cases (New York).
Hughes	Hughes (U. S. Circuit Court).
Hun	Hun (New York).
Hyde	Hyde (Bengal).
Ill.	Illinois.
Ind.	Indiana.
Ind. L. R.	Indian Law Reports.
Iowa	Iowa State Reports.
Ir. Ch.	Irish Chancery.
Ir. Eq.	Irish Equity.
Ir. Jur.	Irish Jurist.
J. & H.	Johnson and Hemming.
J. & S.	Jones and Spencer (New York).
J. P.	Justice of the Peace.
Jac.	Jacob.
Jac. & W.	Jacob and Walker.
Johns.	Johnson.
Journ. of Jurisp.	Journal of Jurisprudence (Scotch).
Jur.	Jurist.
K. & J.	Kay and Johnson.
Keyes	Keyes (New York).
Ky.	Kentucky.
Kyshe	Straits Settlements Reports.
L. C.	Lord Chancellor.
L. JJ.	Lords Justices.
L. J. Bkptcy.	Law Journal, Bankruptcy.
L. J. Ch.	Law Journal, Chancery.
L. J. C. P.	Law Journal, Common Pleas.
L. J. Ex.	Law Journal, Exchequer.
L. J. K. B.	Law Journal, King's Bench.
L. J. M. C.	Law Journal, Magistrate's Cases.
L. J. N. of C.	Law Journal, Notes of Cases.

L. J P. C.	Law Journal, Privy Council.
L. J. Q. B.	Law Journal, Queen's Bench.
L. R. Ch.	Law Reports, Chancery Appeals.
L. R. C. P.	Law Reports, Common Pleas.
L. R. Eq.	Law Reports, Equity.
L. R. Ex.	Law Reports, Exchequer.
L. R. H. L.	Law Reports, House of Lords (English and Irish).
L. R. I. R.	Irish Law Reports.
L. R. P. C.	Law Reports, Privy Council.
L. R. Q. B.	Law Reports, Queen's Bench.
L. T.	Law Times Reports.
L. T. (Journal)	Law Times Notes of Unreported Cases .
L. & C.	Leigh and Cave, Crown Cases.
La. Ann.	Louisiana Annual Reports.
Lans.	Lansing (New York).
Lath.	Lathrop (Massachusetts).
Leach	Leach, Crown Cases.
Leg. Obs.	Legal Observer.
M. M. A.	Merchandise Marks Act, 1887.
M. & Rob.	Moody and Robinson.
Mac. & G.	Macnaghten and Gordon.
McCrary	McCrary (U. S. Circuit Court).
McLean	McLean (U. S. Circuit Court).
Mad.	Madras.
Madd.	Maddock.
Man & G.	Manning and Granger.
Mass.	Massachusetts.
Md.	Maryland.
Me.	Maine.
Mer.	Merivale.
Mich. C. C.	Michigan Circuit Court.
Mich. N. P.	Michigan Nisi Prius.
Minn.	Minnesota.
Mo.	Missouri.
Mo. App.	Missouri Appeals.
Mod.	Modern Reports.
Mont. D. & De G.	Montague, Deacon and De Gex.
Monthly L. R.	Monthly Law Reports.
Moo. P. C.	Moore's Privy Council Cases.
My. & Cr.	Mylne and Craig.
N. Car.	North Carolina.
N. J. (Eq.)	New Jersey (Equity).
N. P.	Nisi Prius.
N. R.	New Reports.
N. S.	New Series.
N. S. W. Rep. (E.).	New South Wales Reports, Equity.
N. Y.	New York.
N. Z.	New Zealand.
N. & M.	Neville and Manning.
N. & P.	Neville and Perry.
Neb.	Nebraska.

O. S.	Old Series.
Ohio St.	Ohio State Reports.
Ont.	Ontario.
Oreg.	Oregon.
P. R.	Patent Office Reports.
Pac. C. L. J.	Pacific Coast Law Journal.
Paige	Paige (New York).
Peake	Peake, Nisi Prius Cases.
Pemb.	Pemberton on Judgments.
Penn. St.	Pennsylvania State Reports.
Penn. L. J.	Pennsylvania Law Journal.
Ph.	Phillips.
Phila.	Philadelphia.
Pick.	Pickering (Massachusetts).
Post	Post (Missouri).
Q. B.	Queen's Bench.
R. I.	Rhode Island.
Robertson	Robertson (New York).
Russ.	Russell.
Ry. Cass.	Railway Cases.
S. & S.	Simons & Stuart.
Sandf. Ch.	Sandford's Chancery Reports (New York).
Sandf. S. C.	Sandford's Supreme Court Reports (New York).
Sawy.	Sawyer (U. S. Circuit Court).
Scot. L. Rep.	Scottish Law Reporter.
Scott, N. R.	Scott's New Reports.
Seton	Seton on Decrees.
Sickels	Sickels (New York).
Sim.	Simons.
E. D. Smith.	E. D. Smith (New York).
Sol. J.	Solicitor's Journal.
St. Dig.	Stephens' Digest of Canadian Cases.
Story	Story (U. S. Circuit Court).
Sup. Ct.	Supreme Court.
Super. Ct.	Superior Court.
Swanst.	Swanston.
T. M. A.	Trade Marks Registration Act.
T. R.	Term Reports.
Thomp. & C.	Thompson and Cook (New York).
Trade Marks	British and Foreign Journal of Commerce, Trade Marks, and International Exhibitions.
Trans. App.	Transcript Appeals (New York).
U. S. C. C., Dt. of —	United States Circuit Court, District of —.
U. S. Pat. Comm. Decis.	Decisions of the U. S. Commissioner of Patents.
U. S. Pat. Gaz.	United States Official Patent Gazette.
U. S. Rep.	United States Supreme Court Reports.
U. S. Sup. Rep.	United States Supreme Court.
V. & B.	Vesey and Beames.
V.-C.	Vice-Chancellor.

V. R. Eq.	Victoria Reports (First Series Equity.
Va.	Virginia.
Ves.	Vesey.
Vict. L. R. Eq.	Victoria Law Reports (New Series) Equity.
Vt.	Vermont.
W. N.	Weekly Notes.
W. R.	Weekly Reporter.
W. Va.	West Virginia.
W. & W. (I. E. & M.)	Wyatt and Webb's Victoria Reports (Insolvency, Ecclesiastical and Matrimonial).
W. W. & A'B. Eq.	Wyatt, Webb and A'Beckett's Victoria Reports (Equity).
W. A'B. & W. Eq.	Webb, A'Beckett and Williams' Victoria Reports (Equity).
Wallace	Wallace (U. S. Supreme Court).
Wall., Jr.	Wallace, Junior (U. S. Circuit Court).
Washb.	Washburn (Vermont).
Webs. P. C.	Webster, Patent Cases.
Wend.	Wendell (New York).
West. L. J.	Western Law Journal.
Wils.	Wilson.
Wils. (Ind.)	Wilson's Indianapolis Reports.
Wisc.	Wisconsin.
Wood. & M.	Woodbury and Minot (U. S. Circuit Court).
Y. & C. Ch.	Younge and Collyer's Chancery Reports.

THE LAW OF TRADE MARKS.

CHAPTER I.

GENERAL INTRODUCTION.

General principle of trade-mark law.

THE general principle upon which the Courts exercise jurisdiction in the case of trade marks is, that "a manufacturer who produces an article of merchandise which he announces as one of public utility, and who places upon it a mark by which it is distinguished from all other articles of a similar kind, with the intention that it may be known to be of his manufacture, becomes the exclusive owner of that which is henceforth called his trade mark. By the law of this country—and the like law prevails in most other civilised countries—he obtains a property in the mark which he so affixes to his goods. The property thus acquired by the manufacturer, like all other property, is under the protection of the law, and for the invasion of the right of the owner of such property the law affords a remedy similar in all respects to that by which the possession and enjoyment of all property is secured to the owners" (*a*). "A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practise such a deception, nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters, or other *indicia* by which he may induce purchasers to believe that the goods which

(*a*) Per Bacon, V.-C., in *Ransome* v. *Graham*, 51 L. J. Ch. 897.

he is selling are the manufacture of another person" (*a*). "Supposing the rival trader to have obtained celebrity in his manufacture, he is entitled to all the advantages of that celebrity, whether resulting from the greater demand for his goods, or from the higher price which the public are willing to give for them, rather than for the goods of other manufacturers whose reputation is not so high. Where, therefore, a manufacturer has been in the habit of stamping the goods which he has manufactured with a particular mark or brand, so that thereby persons purchasing goods of that description know them to be of his manufacture, no other manufacturer has a right to adopt the same stamp. By doing so he would be substantially representing the goods to be of the manufacture of the manufacturer who had previously adopted the stamp or mark in question, and so would or might be depriving him of the profit he might have made by the sale of the goods which, *ex hypothesi*, the purchaser intended to buy. The law considers this to be wrong towards the person whose mark is thus assumed, for which wrong he has a right of action, or, which is the more effectual remedy, a right to restrain by injunction the wrongful use of the mark thus pirated" (*b*).

Function of trade mark.

The function of the trade mark is to give the purchaser a satisfactory assurance of the make and quality of the article he is buying. Thus, it was said by Lord Cottenham, C. (*c*), "take a piece of steel: the mark of the manufacturer from whom it comes is the only indication to the eye of the customer of the quality of the article; so it is of

(*a*) Per Lord Langdale, M. R., in *Perry* v. *Truefitt*, 6 Beav. 66.

(*b*) Per Lord Cranworth, C., in *Seixo* v. *Provezende*, L. R. 1 Ch. 192. And see per the United States Supreme Court in *Canal Co.* v. *Clark*, 13 Wall. 311; *McLean* v. *Fleming*, 96 U. S. Rep. 245, and *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; and per Molesworth, J., in the Supreme Court of Victoria in *In re Brebner*, 2 W. & W. 12; and per Levinge, J., in the High Court of Bengal, in *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde 185.

(*c*) In *Spottiswoode* v. *Clarke*, 2 Ph. 154; and see *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Kidd* v. *Johnson*, 100 U. S. Rep. 617.

blacking, or any other article of manufacture the particular quality of which is not discernible by the eye." It is on the faith of the mark being genuine, and representing a quality equal to that which he has previously found a similar mark to indicate, that the purchaser makes his purchase. "That, in truth," said James, L. J. (*a*), "is the meaning and object of a trade mark. It indicates this—that you may take this as a warranty that it has come from the particular manufacturer of the goods with which you have been hitherto pleased." So again, it was said by Kay, J. (*b*) —"What does a trade mark mean? It means the mark under which a particular individual trades, and which indicates the goods to be his goods—either goods manufactured by him, or goods selected by him, or goods which in some way or other pass through his hands in the course of trade. That is the meaning of a trade mark. It is a mode of designating goods as being the goods which have been, in some way or other, dealt with by the person who owns the trade mark."

Mere statement of quality, no trade mark.

Yet, while the object of the trade mark is to indicate quality, a mere English adjective, or word in common use (*c*), which indicates quality and nothing more, not serving to connect the goods with any particular manufacturer or seller, cannot be appropriated as a trade mark; for no person can be permitted to exclude others from the use of words common to all, even in their application to goods; and without such exclusive appropriation, the mark is a mere statement, offering no guarantee, and making no one responsible for its correctness. And in the same way the use of a mark which has for its object the enabling purchasers

(*a*) *Massam* v. *J. W. Thorley's Cattle Food Co.*, (2) 14 Ch. D. 748; and see *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; *Liggett and Myers Tobacco Co.* v. *Hynes*, 20 Fed. Rep. 883; *Holt* v. *Mendez*, 128 U. S. Rep. 182.

(*b*) *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278.

(*c*) *Braham* v. *Bustard*, 1 H. & M. 447; *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *In re Barrows*, 5 Ch. D. 353; *Spottiswoode* v. *Clarke*, 1 Coop. 264; *Gillott* v. *Esterbrook*, R. Cox, 353; *Osgood* v. *Allen*, 1 Holmes 185; *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981.

to divide into equal pieces the substance to which it is applied, cannot deprive other makers of the right to use other somewhat similar marks with the same object (*a*).

Exception.

Marks, however, which do serve to indicate the production of a certain manufacturer, though at the same time subject to variation for the purpose of denoting different qualities, are entitled to protection (*b*). And it may be observed that a symbol or word indicating quality in one class of goods need not necessarily do so in another (*c*).

Trade mark not always indicative of actual manufacturer.

The use of the trade mark is not in all cases to designate the maker of the substance to which it is attached (*d*), though that is usually so; it may indicate some other person who has expended labour on the article, so that, as finished, it owes some portion of its value to him. Thus, in a case in the Supreme Court of New York (*e*) it was held that, where one person manufactured cotton cloths, and another printed them, the mark was indicative of the printer and not of the original manufacturer. So a trade mark has been recognised as indicating the bleacher who finished the goods which another person had manufactured (*f*); and in the same way, one may serve to denote the importer (*g*) or exporter (*h*) of manufactured goods.

(*a*) *Dausman and Drummond Tobacco Co.* v. *Ruffner*, 15 U. S. Pat. Gaz. 559.

(*b*) *Hirst* v. *Denham*, L. R. 14 Eq. 542; *Ransome* v. *Graham*, 51 L. J. Ch. 897; *Moses* v. *Sargood*, Dig. 636; *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Godillot* v. *Harris* (per Danforth, J.), 81 N. Y. 263. See *Stokes* v. *Landgraff*, 17 Barb. 608; R. Cox, 137; *Gillott* v. *Kettle*, 3 Duer, 624; R. Cox, 148; *Gillott* v. *Esterbrook*, 47 Barb. 455; R. Cox, 340; 48 N. Y. 374; *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; *Merry* v. *Hoopes*, 111 N. Y. 415; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417. And see *Wood* v. *Lambert*, 32 Ch. D. 247.

(*c*) *In re English*, U.S. Pat. Comm. Decis. 1870, 142; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538.

(*d*) See per Bacon, V.-C., in *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*e*) *Amoskeag Manufacturing Co.* v. *Garner*, 55 Barb. 151; R. Cox, 541. See *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298, and *Wamsutta Mills* v. *Allen*, 12 Phila. 535.

(*f*) *In re Sykes*, 43 L. T. N. S. 626.

(*g*) *Godillot* v. *Hazard*, 44 N. Y. Super. Ct. 427; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Taylor* v. *Virasami*, Ind. L. R. 6 Mad. 108.

(*h*) *Robinson* v. *Finlay*, 9 Ch. D 487, though it was held on appeal that in that particular instance this was not the case.

May be indicative of selector.

Again, a trade mark may be so composed as to indicate that the goods have been examined and selected by a person of known ability, so that they have attributed to them such value as his approval can give, and his reputation depends upon their corresponding to their alleged quality. In such a case, therefore, the trade mark belongs to the selector and not to the manufacturer (*a*).

May indicate natural products.

To go farther, it is not necessary that the goods to which the mark is affixed should be manufactured goods at all; it is sufficient if the vendors, whose property the trade mark is, have alone the opportunity of procuring the article in question, so that the trade mark indicates accurately the source from which the article is derived. This is particularly the case with mineral waters and similar productions (*b*). A mere name, however, for a natural product which is available by all the world, cannot be exclusively appropriated by an individual, who possesses no exclusive access to its source (*c*).

Advantages of use of trade marks.

The benefits derivable from the recognition of the exclusive right of a trader to his trade mark are apparent from the consideration that the "trade mark is both a sign of the quality of the article and an assurance to the public that it is the genuine product of his manufacture. It thus often becomes of great value to him, and in its exclusive use the Court will protect him against attempts of others

(*a*) *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Re Australian Wine Importers, Ld.*, 41 Ch. D. 278; *Thomson & Co.* v. *Robertson*, Ct. Sess. Cas. 4th Ser. XV. 880; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183; *Holt* v. *Menendez*, 128 U. S. Rep. 182. And see *Wood* v. *Lambert*, 32 Ch. D. 247.

(*b*) *Apollinaris Co.* v. *Norrish*, 33 L. T. N. S. 242; *Apollinaris Co.* v. *Edwards*, Seton, 4th ed. 237 (Apollinaris Water); *Radde* v. *Norman*, L. R. 14 Eq. 348 (Leopoldshall Kainit); *Congress and Empire Spring Co.* v. *High Rock Congress Spring Co.*, 57 Barb. 526; R. Cox, 599 (Congress Spring Water); *Wheeler* v. *Johnston*, 3 L. R. Ir. 284 (Cromac Springs Water); *Dunbar* v. *Glenn*, 42 Wisc. 118 (Bethesda Mineral Water); and see the coal cases—*Braham* v. *Beachim*, 7 Ch. D. 848; *Davis* v. *Tylor*, M. R., April 24th, 1879; *Lochgelly Co. Ld.* v. *Lumphinnans Iron Co.*, Ct. Sess. Cas., 4th Ser. VI. 482.

(*c*) *Young* v. *Macrae*, 9 Jur. N. S. 322 (Paraffin Oil); *Canal Co.* v. *Clark*, 13 Wall. 311 (Lackawanna Coal); *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas. 4th Ser. XI. 506 (Water of Ayr Stone).

to pass off their products upon the public as his. This protection is afforded, not only as a matter of justice to him, but to prevent imposition upon the public" (*a*).

The protection of trade marks is, therefore, beneficial to the public, since it enables them to buy with confidence that they are getting what they require; while at the same time it is beneficial to the manufacturer, since it affords him the means of securing the benefit of the custom which he deserves and which is intended for him. When the owner of a trade mark is asserting his exclusive rights, "monopoly is not the thing for which the one party struggles and which the other resists. On the contrary, fair trading is all for the protection of which the law is invoked; and the public, as well as the manufacturer or merchant, are concerned that infringement of trade marks and trade designations should be prevented. For there is a double wrong: the public are or may be deceived, and the trader whose trade mark or trade designation is infringed is or may be injured" (*b*). So advantageous did the adoption of a trade mark speedily prove to be that, in 1742, Lord Hardwicke, C., said that "every particular trader had some particular mark or stamp" (*c*).

Southern v. *How.*

In the earliest case on record (*d*) damages were given for the infringement of a mark on cloth, though it is not clear from the reports whether the plaintiff was a clothmaker whose mark had been pirated, or a purchaser who had been deceived into buying the wrong goods.

Blanchard v. *Hill.*

In *Blanchard* v. *Hill* (*e*), however, in 1742, Lord Hardwicke refused to protect the "Great Mogul" stamp on cards, deciding, in effect, that there was no right of

(*a*) *Per* U. S. Sup. Ct. in *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; and see *Amoskeag Manufacturing Co.* v. *Spear*, 2 Sandf. S. C. 599.

(*b*) Per Lord Craighill in *Dunnachie* v. *Young & Sons*, Ct. Sess. Cas. 4th Ser. X. 874; and see *State of Missouri* v. *Gibbs*, 56 Mo. 133; and *Blackwell* v. *Wright*, 73 N. Car. 310.

(*c*) *Blanchard* v. *Hill*, 2 Atk. 484, 485.

(*d*) *Southern* v. *How*, Poph. 144; 3 Cro. 471; 2 Rolle 28.

(*e*) 2 Atk. 484.

property in a trade mark, though actual fraud might be restrained or punished, as in *Southern* v. *How* (*a*). The decision seems in great measure to have been founded upon a dread of setting up a monopoly, the distinction between a trade mark and a patent not being clearly present to his lordship's mind.

Singleton v. Bolton.

In *Singleton* v. *Bolton* (*b*), in the Court of King's Bench (1783), Lord Mansfield, C. J., 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 the name of an original inventor being the trade mark in question, evidence was necessary of the medicine having been sold as if prepared by the plaintiff, a distinction being thus drawn between the transmissibility of a name and that of other trade marks, which has since been removed (*c*).

Sykes v. Sykes.

In Scotland an interdict was granted in 1823 to restrain the infringement of a trade mark (*d*), but in England it was for the first time perceived, in 1824, that goods sold with a pirated mark attached, though they might not deceive an immediate purchaser, yet might deceive an ultimate purchaser, who might have no notice of the fraud (*e*).

Requisites to entitle to damages at Common Law.

This case marks the last stage of development in the law of trade marks as recognised at Common Law (*f*); and the requisites necessary to entitle a plaintiff to recover damages were, in accordance with the judgment of Sir T. Wilde, C. J., in *Rodgers* v. *Nowill* (*g*), that he should have been accustomed to use a certain mark upon goods of his manufacture to denote that that was so, that that mark

(*a*) Poph. 144.

(*b*) 3 Doug. 293.

(*c*) See *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523, and other cases.

(*d*) *Wilkie* v. *McCulloch*, Ct. Sess. Cas., 1st Ser. II. 413.

(*e*) *Sykes* v. *Sykes*, 3 B. & Cr. 541.

(*f*) See per Sir G. Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434—454.

(*g*) 5 C. B. 109.

was known in the trade (*a*), and that the defendant had imitated the mark and sold goods bearing it, as and for the plaintiff's goods, with intent to defraud (*b*).

Lord Blackburn in *Singer Manufacturing Co.* v. *Loog*.

Lord Blackburn, discussing the history of trade-mark law in *Singer Manufacturing Co.* v. *Loog* (*c*), said: "The original foundation of the whole law is this—that when one, knowing that goods are not made by a particular trader, sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established, alike at law and in equity, that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior. The modes in which goods may be passed off as and for the plaintiff's vary. The most usual is where a particular mark on the goods, or on the packages in which they are sold, has been used to denote that they are made by a particular firm to such an extent that it is understood in the market to bear that meaning. The law as to those trade marks is now regulated by statutes, but before there was any legislation on the subject it was well settled that when any one adopted a mark so closely resembling the trade mark of the plaintiff that it would be likely to be mistaken for it, and put it on his goods and sold them, knowing that though the persons to whom he sold them were well aware that they were not the plaintiff's make, yet that they were meant to be sold to others who would see only the trade mark, and were likely to be deceived by its resemblance to that of the plaintiff, he might be properly found to have knowingly and fraudulently sold the goods

(*a*) Application for registration, provided the connection with the goodwill of the business is observed, is now equivalent to public use of a mark: Patents Act, 1883, § 75, as amended by the Act of 1888; and see Trade Marks Act, 1875, § 2. This was held to be so also in America under the U. S. Statute of 1870: *In re The Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248. And see § 7 of the U. S. Act of 1881.

(*b*) See, however, the Judicature Act of 1873, § 25, by which the rules of equity prevail.

(*c*) 8 App Cas. 29.

as and for the plaintiff's goods. And, so far, there was no difference between law and equity.

"But at law it was necessary to prove that an injury had been actually done; in equity it was enough to show that the defendant threatened to do, and would, if not prevented, do that injury. But there is a further question on which there may be a difference between law and equity."

Equity—*Millington* v. *Fox*.

The difference to which allusion is here made arises from the fact that in equity the protection to the manufacturer and the public was carried a stage farther in 1833 by the decision of Lord Cottenham, C., in *Millington* v. *Fox* (*a*), since which time it has not been necessary to prove an actual fraudulent intention, the remedy being obtainable if the defendant's conduct has been such as to produce the effects of fraud, though he may, in fact, have acted in perfect innocence.

Limits to Court's interposition.

It is, however, "no part of the duty of the Court to enforce the observance of the dictates of morality" (*b*), and therefore, if a defendant "has an abstract right to do what he has done, the Court must permit it, however opposed to one's moral sense" (*c*). The Court will not interfere, simply on the ground that there is a misrepresentation, unless some right belonging to the plaintiff has been interfered with (*d*).

Acquisition of trade marks.

The mode of acquiring a right to a trade mark was, from 1875 to 1883, regulated by the Trade Marks Registration Acts, 1875-7 (*e*). The trade mark was required to accord with the definition contained in section 10 of the Act of

(*a*) 3 My. & Cr. 338. In *Gout* v. *Aleploglu*, 5 Leg. Obs. 496, the Vice-Chancellor of England held that "the plaintiff had acquired by long previous usage *the exclusive right*" to his trade marks, but the report is too brief to show whether that expression was employed in its full meaning. *Lugg* v. *Kirby*, 8 Ves. 215 (1803); and *Day* v. *Binning*, C. P. Cooper, 489, and 1 Leg. Obs. 205 (1831), were cases of fraudulent competition; and in *Henry* v. *Price*, 1 Leg. Obs. 364 (1831), there were circumstances of fraud.

(*b*) Per Wood, V.-C., in *Batty* v. *Hill*, 1 H. & M. 264. And see *Roper's, &c., Co.* v. *Copeman's, &c., Association, Limited*, 28 Sol. J. 218; *Schneider* v. *Williams*, 44 N. J. (Eq.) 391.

(*c*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*d*) See *Batty* v. *Hill*, *ubi suprà*.

(*e*) 38 & 39 Vict. c. 91; 39 & 40 Vict. c. 33; 40 & 41 Vict. c. 37.

1875 (*a*), and not to be obnoxious to the restrictions of section 6; and it had to be registered, or, if it had been used before the passing of the Act, application must have been made for registration, and have been refused, in which case a certificate of refusal could be obtained from the registrar (*b*), unsuccessful applicants thus retaining whatever rights might have been theirs before the Act. For a mark to have been used before the Act, it was sufficient for a vendible article to have been actually in the market, bearing the mark in question; it was not necessary for this to have been the case for any length of time, so long as there was some user (*c*).

The Trade Marks Acts, 1875-7, are now repealed, and replaced by the Patents Acts, 1883-8 (*d*), which contain a wider and more comprehensive definition of a trade mark (*e*), but are in other respects substantially identical, so far as concerns the acquisition of trade marks, with the repealed Acts (*f*).

Appropriation to special classes of goods.

A trade mark must, under the present Acts, as under the repealed Acts, be registered as belonging to particular goods or classes of goods (*g*), according to the classification of goods contained in the Rules; and trade marks used before the Act of 1875 can only be protected in respect of the same classes of goods as those to which they have been habitually applied, for no man could be so deceived as to suppose that he was buying A's linen because he saw the same mark as A's on B's iron (*h*).

(*a*) Which was so restricted as to exclude from registration some marks previously recognised: *Ex parte Stephens*, 3 Ch. D. 659; *In re Mitchell* (1), 7 Ch. D. 36. See *Rose* v. *Evans*, 48 L. J. Ch. 618.

(*b*) § 2 of Amendment Act, 1876.

(*c*) Per Lord Westbury, C., in *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *In re Simpson, Davies & Sons*, M. R., Jan. 12, 1881; *Somervillo* v. *Schembri*, 12 App. Cas, 453; and other cases.

(*d*) 46 & 47 Vict. c. 57; 48 & 49 Vict. c. 63; 51 & 52 Vict. c. 50.

(*e*) See § 64 of the Act of 1883 as amended by § 10 of the Act of 1888.

(*f*) See §§ 62—74.

(*g*) Trade Marks Act, 1875, § 2; Patents Act, 1883, § 65.

(*h*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *Merchant Banking Co.* v. *Merchants' Bank*, 9 Ch. D. 560; *Société Anonyme* v. *Baxter*, 14 Bl. C. C. 261; *Colman* v. *Crump*, 70 N. Y. 573; *Hart* v. *Colley*, 44 Ch. D. 193.

A trade mark is assignable and transmissible, but only in connection with the goodwill of the business concerned with the goods or classes of goods to which it relates (*a*). A trade mark cannot exist in gross and unattached to specific articles (*b*), for, if that could be so, the mark might come to be an instrument of deception, instead of a guarantee of genuineness (*c*). In an assignment of the business and goodwill, the trade mark passes as a matter of course (*d*), or, if specially excepted, must cease to be available by the vendor. On the death of a registered proprietor, his legal personal representative acquires the title to the mark. Subsequent registered proprietors stood in the same position, under § 4 of the Trade Marks Act of 1875, as if their title were a continuation of the title of the first registered proprietor (*e*). And this will still be so, though the section has not been re-enacted in the new Acts. Assignment and transmission.

It has been held in bankruptcy that a trade mark passes to a trustee in bankruptcy, as being "goods and chattels" within § 15, subs. 5, of the Bankruptcy Act, 1869 (*f*). Bankruptcy.

Apart from the special provisions of the Patents Act, 1883, a trade mark may be lost, as by its coming to be Trade mark lost.

(*a*) Patents Act, 1883, § 70, and see Trade Marks Act, 1875, § 2; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews., 321; R. Cox, 159; *In re Wellcome*, 32 Ch. D. 213; *Smith* v. *Fair*, 14 Ont. Rep. 729; *McVeagh* v. *Valencia Cigar Factory*, 32 U. S. Pat. Gaz. 1124.

(*b*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Leather Cloth Co.* v. *American Leather Cloth Co.*, *ib.* 137; 11 H. L. C. 523; *Dixon* v. *Guggenheim*, *ubi suprà*; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Kidd* v. *Johnson*, 100 U. S. Rep. 617; *Weston* v. *Ketcham*, (1) 39 N. Y. Super. Ct. 51; *S. C.* (2) 51 How. Pr. 455.

(*c*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90; see *Witthaus* v. *Braun*, 44 Md. 303.

(*d*) *Shipwright* v. *Clements*, 19 W. R. 599.

(*e*) And see *Walton* v. *Crowley*, 3 Bl. C. C. 440; R. Cox, 166.

(*f*) *Ex parte Young*; *Re Lemon Hart & Son*, Dig. 537; and see *Kelly* v. *Hutton*, L. R. 3 Ch. 703; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; and cases at p. 115, note (*a*); also the Bankruptcy Act, 1883, § 44 (iii). In America it has been considered a disputable question whether property in a trade mark is the subject of attachment or levy under execution (*Hegeman & Co.* v. *Hegeman*, 8 Daly 6), or whether it will pass under a general assignment (*Milliken* v. *Dart*, 33 N. Y. Sup. Ct. 24).

commonly applied to a special article, in which case it becomes *publici juris*; thus "Worcestershire sauce," which might at one time have been protected, could no longer be so when it had come into common use (*a*). But for general user to render a mark of common right, it must be user on the same goods as those for which an exclusive right to it is claimed (*b*). It was also held, before the passing of the Registration Acts, that if a person abandons a suit which he has undertaken to restrain infringement, he abandons his exclusive right (*c*).

Infringement.

When once a person has acquired a right in the trade mark, any infringement of that right will form a ground for the interference of the Court. For the Court to interfere there must be fraud, for where there is no fraud there is no wrong to be redressed and no remedy applicable. But it is not necessary that there should be fraud in the sense that the infringer knowingly and wilfully makes a fraudulent attempt to appropriate to himself the fruits of another's reputation: if he acts so that custom intended for another is diverted to himself, and that the public buy and pay for one thing while intending to buy and pay for another, so that both vendor and purchaser are injured, there is fraud, and the animus of the infringer is unimportant (*d*). Even if the purchaser is told that the goods are the goods of the actual seller, but the imitated mark is upon them, there is ground for interference, since the goods may be resold bearing the mark, but without the information necessary to correct the statement thereby made (*e*). There is infringement if ordinary purchasers

(*a*) *Lea* v. *Millar*, Dig. 513. And so 'Kaiser' spring water—*Luyties* v. *Hollender*, (2) 24 Bl. C. C. 353; "Gold Leaf" Tobacco—*Partlo* v. *Todd*, 12 Ont. Rep. 171; "Imperial Cough Drops"—*Watson* v. *Westlake*, 12 Ont. Rep. 449; and see per Sir G. Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. 611. Also *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. Eq. 98; *Portuondo* v. *Monne*, 28 Fed. Rep. 16; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776.

(*b*) *Somerville* v. *Schembri*, 12 App. Cas. 453.

(*c*) *Browne* v. *Freeman*, 12 W. R. 305.

(*d*) See cases collected at p. 183, note (*c*).

(*e*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; and cases at pp. 175, 176.

purchasing with ordinary caution, are likely to be misled (*a*): on the one hand, the Court will not strain its jurisdiction to protect fools and idiots (*b*); on the other hand, it will not require such minuteness of imitation as to deceive persons of unusual sagacity and information.

Remedies for infringement.

Infringement is criminally punishable under an indictment for obtaining money by false pretences (*c*), or in accordance with the special provisions of the Merchandise Marks Act, 1887 (*d*), expressly enacted to prevent such practices. The Common Law remedy is by an action on the case for damages caused by the offender's fraud (*e*). The equitable remedy is by injunction, together with an account, or damages, if preferred. The greater suitability of this form of remedy has occasioned the adjudication in Chancery of the great majority of trade-mark cases, and the carrying into operation of the Trade Marks Registration Acts was specially entrusted to the Chancery Division (*f*).

Fraudulent intention.

At Common Law, at all events until the Judicature Acts, it was necessary to prove knowledge of the plaintiff's rights and intentional deception on the part of the defendant (*g*); to obtain an injunction in Chancery this has not been required since *Millington* v. *Fox* (*h*), in 1833. It may, however, be material with reference to the extent of the relief to be granted, since a plaintiff is only entitled to an account in respect of such user of his trade mark by the defendant as has been subsequent to the latter becoming aware of the prior ownership, or at least of the prior existence as a trade mark of the mark used by him (*i*).

(*a*) *Seixo* v. *Provezende*, L. R. 1 Ch. 192.

(*b*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-47; *Blackwell* v. *Wright*, 73 N. Car. 310.

(*c*) See Ch. 5.

(*d*) 50 & 51 Vict. c. 28.

(*e*) An injunction may now form part of the relief.

(*f*) Trade-marks Rule 42 of 1876.

(*g*) *Rodgers* v. *Nowill*, 5 C. B. 109.

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

(*i*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Cartier* v. *Carlile*, 31 Beav. 292; *Moet* v. *Couston*, 33 Beav. 578.

Plaintiff disentitled to relief.

A plaintiff who in other respects would be entitled to obtain a remedy against an infringer may yet be deprived of his right by reason of some fraudulent statement contained in his own trade mark (*a*), for "*ex turpi causâ non oritur actio*, and if the trade mark contains a false representation calculated to deceive the public, a man cannot by using that which is in itself a fraud obtain any right at all in the mark" (*b*).

When not disentitled.

A mere collateral misrepresentation, not contained in the trade mark itself, and therefore not repeated at every transfer of the article, is not sufficient to disentitle the trade mark to protection (*c*).

Unauthorised use of word "patent," &c.

A particular form of misstatement which has proved fatal in several cases has been the insertion or retention in a trade mark of the words "patent" or "patented," so as to indicate the protection of an existing patent, to which the article bearing the trade mark is not in fact entitled (*d*).

Distinction between trade mark and patent.

"Trade marks have sometimes been likened to letters patent and sometimes to copyrights, from both of which they differ in many respects" (*e*). "There is this difference between the case of a trade mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say—'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee" (*f*). In the case of a trade mark, "the property and right to protection is in the device or symbol which is invented and

(*a*) See *Pidding* v. *How*, 8 Sim. 477; *Perry* v. *Truefitt*, 6 Beav. 66; and other cases in Ch. 7.

(*b*) Per Sir G. Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*c*) *Ford* v. *Foster*, *ubi suprà*.

(*d*) See the cases in Ch. 7.

(*e*) Per Lord Blackburn, in *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219—228.

(*f*) Per Wood, V.-C., in *Davenport* v. *Rylands*, L. R. 1 Eq. 302.

adopted to designate the goods to be sold, and not in the article which is manufactured and sold" (*a*). The broad difference between a patent and a trade mark is, therefore, that the public are prohibited and restrained from manufacturing any article protected by the former, so long as the protection exists, whereas the public are at full liberty to manufacture an unpatented article (*b*), and that according to the identical original process, and to say that they are so doing, and this is so whether the original makers use, or do not use, a trade mark upon their goods. What the subsequent manufacturers may not do is to put upon their goods the mark used by the original makers, so as to represent that such goods are the actual goods of the original makers, and not merely equivalent goods made by others. The benefit conferred upon the public by the communication of a new invention, which after a limited period all can use, is the consideration in respect of which a monopoly of the invention is granted to the inventor for that limited period (*c*). Any attempt, therefore, to prolong the term of the patent by means of a trade mark will be discouraged (*d*).

Trade mark distinguished from copyright.

As a trade mark is not the same thing as a patent, so it is not the same as a copyright (*e*). The difference between

(*a*) Per Monell, C. J., in *Godillot* v. *Hazard*, 49 How. Pr. 5; and see *McLean* v. *Fleming*, 96 U. S. Rep. 245; and *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110.

(*b*) This is quite clear in America as well as in this country. See *Thomson* v. *Winchester*, 19 Pick. 214; R. Cox, 7; *Coffeen* v. *Brunton*, 4 McLean, 516; R. Cox, 82; *Davis* v. *Kendall*, 2 R. I. 566; R. Cox, 112; *Comstock* v. *White*, 18 How. Pr. 421; R. Cox, 232; *Phalon* v. *Wright*, 5 Phila. 464; R. Cox, 307; *Falkinburg* v. *Lucy*, 35 Cal. 52; R. Cox, 448; *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392; *Godillot* v. *Hazard*, 44 N. Y. Super. Ct. 427; *Hardy* v. *Cutter*, 3 U. S. Pat. Gaz. 468; *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *Manhattan Medicine Co.* v. *Wood*, 4 Cliff. 461. So also in Scotland, *Singer Manufacturing Co.* v. *Kimball and Morton*, Ct. Sess. Cas., 3rd Ser. XI. 267.

(*c*) *Cheavin* v. *Walker*, 5 Ch. D. 850-63.

(*d*) See per Sir G. Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-56.

(*e*) *Farina* v. *Silverlock*, 6 De G. M. & G. 214; *Collins Co.* v. *Cowen*, 3 K. & J. 428; *Correspondent Newspaper Co.* v. *Saunders*, 11 Jur. N. S. 540; *Kelly* v. *Hutton*, L. R. 3 Ch. 703; *Dicks* v. *Yates*, 18 Ch. D. 76; *Taylor* v. *Carpenter*, 11 Paige, 292; 2 Sandf. 603; R. Cox, 45; *Wolfe* v. *Barnett*, 24 La. Ann. 97; 13 Amer. Rep. 111.

them is in fact so wide that the United States statute of 1870, by which the registration of trade marks was authorised and regulated, was held to be unconstitutional and invalid on the express ground that the clause in the Constitution empowering the Legislature to regulate patents and copyrights conferred upon it no authority to make a statute for the regulation of trade marks. A copyright, like a patent, relates to the substance of an article, but differs in that it has reference to a literary instead of a material production. A trade mark does not protect the substance of the article to which it is attached from being imitated, but it identifies an article and indicates the source to which that article is to be attributed. Trade mark not being copyright, registration of a trade mark, or, what comes to be much the same thing, a title of a book or paper, under the Copyright Acts, is unnecessary and useless (*a*).

Trade marks of aliens protected.

Since trade marks are recognised throughout the world, and not merely in the manufacturer's own country, as indicative of his goods, so that the subjects of any country are liable to be defrauded by goods bearing an imitation of a foreign trade mark, and any manufacturer is liable to suffer by the forgery of his marks abroad, the right of property in a trade mark is not limited by territorial bounds (*b*), though a limitation may be imposed by means of an exception of specified places by the assignor of a trade mark on assignment (*c*), and aliens' marks are protected in the English Courts in precisely the same manner as if they belonged to British subjects (*d*). The same is the case in the United States (*e*), in India (*f*), Canada (*g*), and elsewhere.

(*a*) *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Kelly* v. *Hutton*, L. R. 3 Ch. 703; *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Scoville* v. *Toland*, 6 West. L. J. 84.

(*b*) *Derringer* v. *Plate*, 29 Cal. 292; R. Cox, 325.

(*c*) *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218.

(*d*) *Collins Co.* v. *Cowen*, 3 K. & J. 428; and cases at p. 92, note (*a*).

(*e*) *Taylor* v. *Carpenter*, 3 Story, 458; R. Cox, 14; and cases at p. 92, note (*a*).

(*f*) *Orr-Ewing* v. *Chooneeloll Mullick*, Cor. 150.

(*g*) *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523.

Conflict of laws.

No direct conflict of laws has as yet arisen in the English Courts with respect to trade marks, though on some occasions such has appeared likely to be the case. In *Farina* v. *Cathery* (*a*) the question was raised whether a Prussian manufacturer could be restrained in this country from using a trade mark which he was entitled to use under Prussian law. It was held, however, that the mark was not identical with that to which a right had been acquired in Prussia. In *Compagnie Laferme* v. *Hendrickx* (*b*) there was a question whether a German manufacturer could acquire a right in England to the exclusive use of a trade mark consisting of the word "Laferme," a mere word not being allowed in Germany to constitute a trade mark; but as the plaintiff failed to satisfy the Court that he had been the first to use the word in Germany, no decision was given on the point. In *In re Farina* (2) (*c*), registration was refused to a German mark on the ground of too great a similarity existing between it and a previously registered German mark, notwithstanding that the German Court of Appeal, reversing the decision of the Court of First Instance, had held that there was no such similarity as to prevent the registration in that country of the second mark. And in *Rodgers & Sons, Ld.* v. *Rottgen* (*d*), a German defendant was restrained from using a trade mark which he had registered in Germany, but which resembled the plaintiff's mark. It has also been held that user abroad is not such user as will bring the person using within the three-mark rule (*e*), and that a person who has not even an intention of using a trade mark in England cannot be a person aggrieved by a wrongful entry on the register (*f*); but the latter decision was

(*a*) L. J. N. of C., 1867, p. 134.
(*b*) Dig. 512.
(*c*) 27 W. R. 456.
(*d*) 5 Times L. R. 678.
(*e*) *In re Münch*, 50 L. T. N. S. 12. And see *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.), and the Canadian case of *Smith* v. *Fair*, 14 Ont. Rep. 729.
(*f*) *In re Riviere & Co.*, 53 L. J. Ch. 455.

reversed (*a*). Sections 103 and 104 of the Patents Act provide for the grant of privileges to foreigners and colonists in cases in which their governments give protection to British subjects.

Cases analogous to trade-mark cases.

Besides cases of infringement of trade marks proper, there are some other classes of cases nearly akin to the former, but differing from them in some important particulars, which yet require notice in connection with the subject of trade marks, as where there is an unfair competition in trade contrived, not by imitation of trade marks, but by other forms of representation that one man's goods are another's. Such cases are governed by substantially identical principles with those which regulate the law of trade marks, the decision of the Court of Appeal to the contrary (*b*) having been overruled by the House of Lords (*c*).

Trade names.

In imitations of trade names, again, used as such and not as trade marks on goods, there is a difference from trade-mark cases proper: there is a false representation, but it is a representation, not that certain goods are certain other goods, but that a certain establishment is a certain other establishment, the object being that the one establishment should obtain custom intended for the other. Such cases are not cases of trade mark, not being concerned with marks placed on vendible articles in the market (*d*), but still the Court has to proceed on much the same lines.

Goodwill.

All such cases, whether of trade mark, or trade name, or other unfair use of another's reputation, are concerned with an injurious attack upon the goodwill of a rival business; customers are diverted from one trader to another, and orders intended for one find their way to the other. Trade marks are really a branch of the goodwill of the

(*a*) 26 Ch. D. 48.
(*b*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434.
(*c*) S. C. 3 App. Cas. 376.
(*d*) *M'Andrew* v. *Bassett*, 4 De G. J. & S. 380.

business with which they are connected, representing it in the market, while the trade name over the shop represents it to the passer-by. It is by the devolution of the goodwill that that of the trade marks is regulated (*a*); they are in fact included in, and valued as part of, the goodwill (*b*); severed from it they cannot exist.

(*a*) § 70 of Patents Act, 1883; and see Rule 38, also § 2 of Trade Marks Act, 1875, and Rule 27 of the Trade Marks Rules, 1876.

(*b*) *Hall* v. *Barrows*, 4 De G. J. & S. 150.

CHAPTER II.

WHAT IS A TRADE MARK?

What is a trade mark?

THE first point which has to be considered in regard to the law of trade marks is, "What is a trade mark?" With what class of objects is this branch of law concerned? On the answer to this question must necessarily depend the principles to be applied in any given case.

A true trade mark must be affixed to the article.

The most important criterion by which a case of trade mark may be distinguished from a case of false representation not amounting to an infringement of trade mark, was thus described by Sir G. Jessel, M. R. (*a*): "The cases which have come before the Courts may, I think, be conveniently divided into two classes. The first class, which is the more numerous, consists of cases where the goods manufactured are distinguished by some description or device in some way or other affixed to the article sold. It may be descriptive—that is, it may consist of a name or names or a lengthy description consisting of names with superadded words—and that description may be either affixed to, or impressed upon, the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods (*b*).

"An illustration of the first class would be the common trade mark, which is either the name or the image of some known or unknown thing, actually impressed upon, or worked into, the material, or made to adhere to the surface

(*a*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-40.

(*b*) See the definition by the V.-C. of Ireland in *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; also *Jay* v. *Ladler*, 40 Ch. D. 649; *St. Louis Piano Manufacturing Co.* v. *Merkel*, 1 Mo. App. 305.

of the material; or it may be not what is commonly known as a trade mark, a distinguishing mark which, perhaps, to a legal mind would be a trade mark, but some form of the material itself." His lordship then instanced a case recently before him in which the trade mark consisted of certain lines woven into the fringe of a certain make of cloth, and continued:—

"Sometimes you do not find anything put on the goods themselves, the reason often being that the goods are not capable of it: for instance, when these are liquids, upon which, of course, you cannot put a mark, and therefore a mark is put on the bottle containing the liquid, or on the cork which is in the bottle and helps to retain the liquid. These are again true trade marks, whether affixed in the shape of a label on a bottle of liquid, or in the shape of a device on the cork, or in the case of other goods, such as cigars, affixed to the box which contains the cigars, or the string which encircles them,—they are in some way or other attached to the goods, and go along with the goods on sale. That I call the first class."

As to the second class, his lordship said that "they are cases where the defendant, without putting any trade mark at all on his goods, or putting a trade mark which is admittedly different in substance from the trade mark, if any, of the plaintiff on the goods, has represented the goods as being goods manufactured by the plaintiff. Here, again, the Court has to try the question of representation. What the defendant has said or has done must amount to a representation that the goods to be sold are the goods of the plaintiff, or that they are manufactured by the plaintiff. What amount of representation will be sufficient for that purpose must again depend, of course, on the facts of each particular case."

Registration equivalent to public use.

For a trade mark to be entitled to protection, it must therefore not only be applicable, but be actually applied to

a "vendible article" (*a*) in the market; the registration, however, of a trade mark under the Patents Acts, 1883–8, as under the Trade Marks Acts of 1875–7, is equivalent to public use of the same (*b*).

Not every mark applied can be a trade mark.

But it is not everything that can be marked on goods that will constitute a valid trade mark: a mere descriptive adjective, for instance, cannot be appropriated from the rest of the world (*c*). It is necessary, therefore, to distinguish true trade marks from other marks, which, though affixed to goods, yet cannot be claimed as the exclusive trade marks of any individual.

Name and address of proprietor need not be stated.

In some American cases (*d*) a difficulty has been raised with regard to a supposed requirement for a trade mark to contain an indication of the name and address of its proprietor. This requirement, however, which appears to have been based on a misconstruction of the language of Duer, J., in *Amoskeag Manufacturing Co.* v. *Spear* (*e*),

(*a*) See per Lord Westbury, C., in *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; also *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512; *In re Simpson, Davies & Sons*, M. R., Jan. 12th, 1881; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Candee* v. *Deere*, 54 Ill. 439; *Avery & Sons* v *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027.

(*b*) 38 & 39 Vict. c. 91, § 2; 46 & 47 Vict. c. 57, § 75. By 51 & 52 Vict. c. 50, § 17, application for registration is substituted for actual registration, but it would appear that this must be followed by registration. See § 77 of the Act of 1883. See also *Edwards* v. *Dennis*, 30 Ch. D. 454. And this is so also in the United States: see *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248.

(*c*) Cf. *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *Braham* v. *Bustard*, 1 H. & M. 447; *In re Brandreth*, Dig. 626; *Fulton* v. *Sellers*, 4 Brews. 42, and other cases. As to trade marks composed of an essential particular with an addition varied to indicate different qualities or other matters, and how such marks should be registered, see *infrà*.

(*d*) *E.g.*, *Ferguson* v. *Davol Mills*, 2 Brews. 314; *Dixon Crucible Co.* v. *Guggenheim*, 7 Phila. 408; *White* v. *Schleet*, 14 Phila. 88.

(*e*) 2 Sandf. S. C. 599; R. Cox, 87. The passage alluded to runs thus:—"The owner of an original trade mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to an exclusive use of any words, letters, figures, or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their name or quality. He has no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose."

has in practice been disregarded, and the reasoning of the U. S. Commissioner of Patents, when admitting the number "140" to registration as a trade mark for umbrellas (*a*), seems to be conclusive. "A trade mark," he says, "must be of such a character as, when attached to the applicant's goods in the market, will distinguish t' em as to origin from other goods of the same class. To do this, it need not necessarily give the name of the person owning the said mark, nor the place where the goods are made or sold. It is enough if the mark is of such a character as to indicate to the purchaser that all articles bearing it come from one and the same source. The object a man has in view in adopting a trade mark is to secure to himself the benefits arising from the superior merits of his goods over others of the same class. To do this he puts upon them a peculiar mark, that purchasers may be able to distinguish them in the market. It matters not to him nor to others whether the purchasers know either his name or place of business, provided that his goods have some mark by which they may be designated and inquired for." Again, "If a trade mark possesses the evidence upon its face that it is put forth or given out as a distinguishing mark of the goods to which it is attached—that is, distinguishing as to origin, and not as to kind or quality—it may have all the requisites of a valid trade mark without naming the person or place whence it came" (*b*). In short, if a trade mark is properly distinctive—a condition which is indispensable (*c*) —no further particularity can be required, unless under the provisions of some statutory enactment.

Non-restraint of mark, no presumption in favour of mark.

The fact that an action to restrain the use of a particular trade mark has been successfully defended raises no presumption that the defendant's mark is a valid trade mark or capable of registration, for the action may have failed

(*a*) *Ex parte Daves & Fanning*, 1 U. S. Pat. Gaz. 27.

(*b*) Per U. S. Commissioner in *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248.

(*c*) See *Lavergne* v. *Hooper*, Ind. L. R. 8 Mad. 149, and many other cases.

on such grounds as, *e.g.*, that the plaintiff's and defendant's marks were alike descriptive (*a*).

Definition of trade mark in Merchandise Marks Act, 1862.

For the purposes of the Merchandise Marks Act, 1862 (*b*), a very wide definition was adopted for the words "trade mark," a definition too little precise to be of much practical use outside of that Act, although it was adopted by the V.-C. of Ireland in *Wheeler* v. *Johnston* (*c*). The Merchandise Marks Act, 1887 (*d*), extends to all trade marks registered under the Patents Act, 1883.

Definition in Patents Acts, 1883-8.

The Trade Marks Registration Act of 1875 (*e*), however, contained a definition, which was not only valuable in itself, but was of great practical importance, qualifying, as it did, for registration and the accompanying advantages, all marks which satisfied its requirements. This definition was repeated, in a somewhat amplified form, in the Patents Act, 1883 (*f*), and has been still further enlarged by the Patents Act, 1888 (*g*).

The definition in question, as it now stands, is as follows:—

"(1) For the purposes of this Act a trade mark must consist of or contain at least one of the following essential particulars:—

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

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

(*c*) A distinctive device, mark, brand, heading, label, or ticket; or

(*d*) An invented word or invented words; or

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

(*a*) *In re Anderson*, 26 Ch. D. 409; 54 L. J. Ch. 1084 (App.).
(*b*) 25 & 26 Vict. c. 88, § 1.
(*c*) 3 L. R. Ir. 284.
(*d*) 50 & 51 Vict. c. 28.
(*e*) § 10. (*f*) § 64. (*g*) § 10.

(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them; but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3) Provided as follows:—

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures (*a*), or of letters and figures, used as a trade mark before the 13th day of August, 1875, may be registered as a trade mark under this part of this Act" (*b*).

And by § 74 further provision is made for the registration of additions to registered trade marks.

Effect of this definition.

The effect of this definition is to restrict the variety of marks now capable of adoption for the first time by a manufacturer, for he cannot register or obtain protection under the Act for a new mark which does not comply with this definition by containing some one of the five first-mentioned essential particulars, although previously to the Act it would have been perfectly good. "There was considered that it was the essential elements that constituted the trade mark, not the whole label with all the minor and immaterial additions: *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479.

(*a*) "Figures" means "numerals." *Ex parte Stephens*, 3 Ch. D. 659.

(*b*) And see the definitions in *McLean* v. *Fleming*, 96 U. S. Rep. 245, and *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027. The House of Lords appears to have

obviously much more difficulty," said Lord Blackburn (*a*), referring to the Act of 1875, "in dealing with existing trade marks, in which there was a vested right of property, than in dealing with new trade marks, as to which no one as yet had a vested right. According to the usual course of legislation in this country, vested rights of property are to be respected, and not interfered with farther than is necessary; but as to rights to be acquired hereafter, it is merely a question of expediency what conditions the Legislature may think fit to attach to the acquiring of those rights." The Act of 1883 went beyond the Act of 1875 in admitting to registration as a new trade mark "a fancy word or fancy words,"—an expression for which sub-clauses (*d*) and (*e*) of the amended § 64 (1) have now been substituted,—but there are still some marks incapable of registration as new ones which would have been protected before the Act of 1875. However, a manufacturer is entitled under § 64 to register any distinctive mark used as such *before* the passing of the Act of 1875, and which is within the wording of § 64 (*b*), so obtaining for it the benefits of the Act, or, in case of registration being refused, to demand a certificate of such refusal (*c*), the possession of which will place him in a position to exercise whatever rights he may have had before and independently of the Acts.

First class of trade marks. —A name.

In accordance with the above definition, the first species of trade marks consists of a name of an individual or firm, printed, impressed, or woven in some particular and distinctive manner, to which essential particular may be added any letters, words, or figures, or combination of letters, words, or figures, or of any of them.

How names differ from

There is between a name of an individual or firm used

(*a*) *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 495.

(*b*) This is wider than the wording of § 10 of the Act of 1875, and a single distinctive letter or figure may now be registered as an old trade mark, though this was not so under the Act of 1875: *In re Mitchell* (1), 7 Ch. D. 36.

(*c*) Patents Act, 1883, § 77.

as a trade mark, and a fancy name or arbitrary symbol used for the same purpose, a broad distinction, which was early perceived, and which caused some difficulty in the universal acceptance of a name as an efficacious trade mark. This difference is that a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate. The addition of the Christian to the surname does, indeed, diminish the number of persons to whom the appellation belongs; but the Christian name is commonly abbreviated to an initial letter, and, in any case, the surname is the important part of the name, beyond which many persons do not care to investigate.

other trade marks.

The impossibility of a single manufacturer being allowed to arrogate to himself the exclusive use of a name which he shares in common with many other persons is apparent; and from this circumstance the rule was deduced that while, as against persons bearing a different name, a manufacturer's right in his name trade mark is absolute and exclusive, as against persons bearing the same name no such exclusive right can be set up (*a*). Thus in *Dence* v. *Mason* (*b*), Malins, V.-C., held that during the continuance of the partnership between two persons named Mason and Brand they could not be prevented from using the

Consequently the right in a name used as a trade mark is less complete.

(*a*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896, and *infrà*, p. 29; *Faber* v. *Faber*, 49 Barb. 357; R. Cox, 401; *Meneely* v. *Meneely*, 62 N. Y. 427. See *Howe* v. *Howe Machine Co.*, 50 Barb. 236; R. Cox, 421; *Kazenby* v. *White* (1), 41 L. J. Ch. 354; *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *Turton* v. *Turton*, 42 Ch. D. 128; *Tussaud* v. *Tussaud*, 38 W. R. 503; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Binninger* v. *Wattles*, 28 How. Pr. 206; *Gilman* v. *Hunnewell*, 122 Mass. 139; *Prince Metallic Paint Co.* v. *Carbon Metallic Paint Co.*, Dig. 573; *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Aikins* v. *Piper*, 15 Grant Up. Can. Ch. 581; *Decker* v. *Decker*, 52 How. Pr. 218; *Hardy* v. *Cutter*, 3 U. S. Pat. Gaz. 468; *In re Consolidated Fruit Jar Co.*, 14 U. S. Pat. Gaz. 269; *Marshall* v. *Pinkham*, 52 Wisc. 572; *Frazer* v. *Frazer Lubricator Co.*, 121 Ill. 147; *Brown Chemical Co.* v. *Myer*, 31 Fed. Rep. 453; *Pratt's Appeal*, 117 Penn. St. 401. And in the same way it seems that a manufacturer may put his address, the name of his mill, on his goods, though it may resemble the address on another man's goods: *Carmichel* v. *Latimer*, 11 R. I. 395.

(*b*) Dig. 534.

latter's name in their business, notwithstanding that it was well known in connection with a similar old-established business; and the Court of Appeal held (*a*) that the same would be the case if a new *bonâ-fide* partnership should be formed. This rule must, however, be qualified by the statement that where a person uses his own name for the purpose of fraud, and satisfactory evidence of fraudulent intention can be produced, such unfair conduct will be restrained, even though the free use of the man's own name may be thereby hindered (*b*). And the Criminal Law also admits of the punishment of such fraudulent user of a man's own name (*c*).

Statements on this point.

A valuable statement of the law was made by Lord Craighill in the Scottish Court of Session, in *Dunnachie* v. *Young & Sons* (*d*), in which he said:—"The name of a person may be a trade mark; there may be other manufacturers of goods of the same description, and the latter are not precluded from placing their own names on their goods by reason of the fact that this name has already become the trade mark of another manufacturer. The only condition they must fulfil is that the name as used by them shall be accompanied with something which shall be a distinction, if the bare name would lead to the deception of the public and the injury of the trader on whose goods the name first appeared as a trade mark." And in the New York case of *England* v. *The New York Publishing*

(*a*) 41 L. T. N. S. 573.

(*b*) *Holloway* v. *Holloway*, 13 Beav. 209, and *infrà*; *Rodgers* v. *Nowill*, 6 Hare, 325; 5 C. B. 109; *Taylor* v. *Taylor*, 23 L. J. Ch. 255; *James* v. *James*, L. R. 13 Eq. 421; *Fullwood* v. *Fullwood*, W. N. 1873, pp. 93-185; *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176; *Massam* v. *Thorley's Cattle Food Co.* (2), 14 Ch. D. 748; *Pullar* v. *Pullar*, Fry, J., April 9th, 1883; *Warner* v. *Warner*, 5 Times L. R. 359; *Tussaud* v. *Tussaud*, 38 W. R. 503; *Gillis* v. *Hall*, R. Cox, 596; *Stonebraker* v. *Stonebraker*, 33 Md. 252; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Devlin* v. *Devlin*, 69 N. Y. 212; *Wilder* v. *Wilder*, Dig. 372; *Peltz* v. *Eichele*, 62 Mo. 171; *Rogers* v. *Taintor*, 97 Mass. 291; *In re Consolidated Fruit Jar Co.*, 14 U. S. Pat. Gaz. 269; *Shaver* v. *Shaver*, 52 Iowa, 208; *India Rubber Comb Co.* v. *Rubber Comb & Jewelry Co.*, 45 N. Y. Super. Ct. 258.

(*c*) *R.* v. *Dundas*, 6 Cox, 380.

(*d*) Ct. Sess. Cas. 4th Ser. X. 874.

Co. (*a*), Daly, C. J., said:—"The fact that a man has used his own name to designate the article he produces, and that the name has become valuable to him through the article becoming extensively known, gives him no right to exclude any other man of the same name from affixing his name upon the same kind of article, if he manufactures it. The test is whether he uses the name honestly and fairly in the ordinary prosecution of his business, or dishonestly, to palm off his own commodity as the production of another."

Holloway v. *Holloway*.

In *Holloway* v. *Holloway* (*b*), the defendant, Henry Holloway, sold pills and ointment in packets and pots, similar to those in which his brother, the plaintiff, Thos. Holloway, sold his, and the defendant also affixed to his packets and pots similar labels and wrappers, but with "H. Holloway," instead of simply "Holloway." Thomas Holloway having filed a bill for an injunction, Lord Langdale, M. R., granted the injunction, saying, on the evidence, that it was as clear and as plainly avowed a fraud as he ever knew. He, however, expressly stated that, "the defendant's name being Holloway, he had a right to constitute himself a vendor of Holloway's pills and ointment," and that he, the M. R., "did not intend to say anything tending to abridge such right"; the defendant had, nevertheless, no right to do so with such additions to his own name as to deceive the public and make them believe that he was selling the plaintiff's pills and ointment.

Burgess v. *Burgess*.

The case of *Burgess* v. *Burgess* (*c*) was somewhat similar. There the plaintiff's father, to whose business the plaintiff had succeeded, had invented "Burgess' Essence of Anchovies." He employed his two sons as his assistants, and the business was conducted by him and them at 107, Strand. After a time one of the sons, W. H.

(*a*) 8 Daly, 375.
(*b*) 13 Beav. 209.
(*c*) 3 De G. M. & G. 896.

Burgess, took a house in King William Street, and setting up for himself, put on his shop front, "W. H. Burgess, late of 107, Strand." He also headed his labels, "36, King William Street, City, London (Royal Arms), late of 107, Strand, Burgess' Essence of Anchovies"; plaintiff's labels being headed, "107 (Royal Arms), Strand, corner of the Savoy Steps, John Burgess and Son, Original and Superior Essence of Anchovies." Sir R. T. Kindersley, V.-C., granted an injunction as to "late of 107, Strand," and the continuance on the sides of the defendant's shop door of a plate with the words "Burgess' Fish Sauce Warehouse, late of 107, Strand"; but the part of the motion which referred to the use of the words "Burgess' Essence of Anchovies" being refused, the plaintiff appealed, and the Lords Justices then distinctly refused to deny a man the use of his own name. Sir J. L. Knight-Bruce, L. J., said, "All the Queen's subjects have a right to sell their articles in their own names, and not the less so that they bear the same name as their fathers (*a*). The defendant carries on business in his own name, and sells his essence of anchovies as 'Burgess' Essence of Anchovies,' which, in truth, it is;" and Sir G. Turner, L. J., added that, "where a person was selling goods under a particular name, and another person, not having that name, was using it, it might be presumed that he so used it to represent the goods sold by himself as the goods of the person whose name he used (*b*); but that where the defendant sold goods under his own name, and it did happen that the plaintiff had the same name, it did not follow that the defendant was selling his goods as

(*a*) And see *Hardy* v. *Cutter*, 3 U. S. Pat. Gaz. 468. However, a son has no right to deceive the public by using his father's new name, after the father has assumed a different name from that to which the son is entitled: *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627; but if the son has assumed the same fictitious name with the father, by the father's desire, the latter cannot afterwards interfere with the honest use of the fictitious name by the son: *England* v. *New York Publishing Co*, 8 Daly, 375.

(*b*) See *Perks* v. *Hall & Co.*, W.N. 1881, p. 111.

the goods of the plaintiff" (*a*); if, however, a fraudulent intention had been proved, both judges agreed that the case would have been different.

Ainsworth v. *Walmsley.*

The fact that according to these cases a man might with impunity, in the absence of proof of actual fraud, sell the same goods as another, under the same name, provided that his own name was the same as that of the rival manufacturer, who had been in the habit of using his name as his trade mark, not unnaturally produced doubts whether a trade mark which was not capable of protection against infringement in all cases could rightly be termed a trade mark at all; and in *Ainsworth* v. *Walmsley* (*b*), where the defendant had affixed to thread not of the plaintiff's make labels with the words "Ainsworth's Thread," it was argued that such a case was no case of trade mark, and that, this being so, it became necessary for the plaintiff to prove the *scienter* on the part of the defendant. Sir W. P. Wood, V.-C., however, declined to adopt that argument, and intimated that in his opinion a man's name was "as strong an instance of trade mark as could be suggested," adding that it was subject "only to this inconvenience—that if a Mr. Jones or a Mr. Brown relied on his name, he might find it a very inadequate security, because there might be several other manufacturers of the same name."

A name may be a true trade mark.

The decision in this case finally established the principle that the name of an individual or firm duly appended to the vendible article is a valid trade mark (*c*), subject to the inconvenience mentioned above.

A name now first used as a

That inconvenience has now been removed as to new

(*a*) In *Massam* v. *J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748, James, L. J., expressed the opinion that the language of Turner, L. J., was to be preferred to that of Knight-Bruce, L. J., the terms used by the latter being somewhat calculated to mislead; but see the judgments of the Court of Appeal in *Turton* v. *Turton*, 42 Ch. D. 128.

(*b*) L. R. 1 Eq. 518.

(*c*) See per Lord Kingsdown, in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523, where he treats a name as a good trade mark.

trade mark must be in a distinctive form.

marks by the requirement for the name claimed as a trade mark to be "printed, impressed, or woven in some particular and distinctive manner" (*a*). For the future, a new trade mark consisting of a name will be available against all the world, without exception, for with the mere collocation of letters there is to be combined some further element, in respect of colour, pattern, or some other such differentia, which shall effectually distinguish the trade mark from even a similar succession of letters from which that further characteristic shall be absent (*b*). The effect of this provision is to render necessary for the future a precaution which many manufacturers have already voluntarily adopted; and the employment of a mode of printing, the imitation of which would furnish an almost irrefutable presumption of fraud, may be instanced from *Stephens* v. *Peel* (*c*), in which case the labels on the bottles containing the plaintiff's ink were printed in letters which are described as being in part white on a red ground, in part white on a blue ground, and in part blue on a white ground.

The name need not be that of the actual manufacturer.

There is no provision in the Act which requires that the name selected as the trade mark shall be the name of the individual or firm by whom the goods to which the trade mark is to be attached are actually manufactured. Neither was this the case before the passing of the Act. In many instances, it is true, the name was that of the actual

(*a*) Patents Acts, 1883-8, § 64; Trade Marks Act, 1875, § 10; and see *In re Gianaclis*, 58 L. J. Ch. 782; *In re Hannay*, 7 P. R. 46. Also *In re Price's Patent Candle Co.*, 27 Ch. D. 681.

(*b*) See per Jessel, M.R., in *In re Horsburgh & Co.*, 53 L. J. Ch. 237. In the same way, the United States Statute of 1870, § 79, provided that the Commissioner of Patents should not receive and record any proposed trade mark which was 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. And the Statute of 1881, now in force, provides by § 3, that "no alleged trade mark shall be registered which is merely the name of the applicant." See the decisions in *In re India Rubber Comb Co.*, 8 U. S. Pat. Gaz. 905, and *In re Roue & Post*, 9 U. S. Pat. Gaz. 496, under the Act of 1870, and other cases noted against the Act.

(*c*) 16 L. T. N. S. 145. See *Royal Baking Powder Co.* v. *Davis*, 26 Fed. Rep. 293.

manufacturer: thus, the words "Ainsworth's Thread" (*a*) and "Taylor's Persian Thread" (*b*) were used as trade marks on thread produced by those makers, "Ramsay' was used on bricks by G. H. Ramsay (*c*), Thomas Holloway placed "Holloway's Pills" and "Holloway's Ointment" on his boxes and pots (*d*), and so in many cases more (*e*).

A name become a trade mark may pass with the business.

But where a name has once become a trade mark by registration, or, if used before the passing of the Trade Marks Registration Act of 1875, by actual user on a vendible article (*f*), since followed by registration or the procurement of a certificate of refusal to register, it is assignable (*g*), subject to a connection with the goodwill of the business (*h*), and may easily pass to and become the property of a person or firm whose own name is widely different. Thus, the trade mark "William Ash" in *Bury* v. *Bedford* (*i*), "1847, Rogers Bros. A. 1," in *Meriden Britannia Co.* v. *Parker* (*k*), "Thorley's Cattle Food" in *Massam* v. *J. W. Thorley's Cattle Food Co.* (2) (*l*), "D. Simmons" in *Weed* v. *Peterson* (*m*), "Pepper's Signal Oil" in *Weston* v. *Ketcham* (1), (2) (*n*), "Dr. C. McLane's Pills" in *McLean* v. *Fleming* (*o*), "Smith, Snyder & Co." in *Young* v. *Jones Bros. & Co.* (*p*), "Oakes' Candies" in *Probasco* v. *Bouyon* (*q*). But it is a fraudulent act to purchase the right to use the name of a small maker

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

(*b*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255.

(*c*) *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537.

(*d*) *Holloway* v. *Holloway*, 13 Beav. 209.

(*e*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Wedgwood* v. *Smith*, Dig. 96; *Collins Co.* v. *Brown*, 3 K. & J. 423; *Stephens* v. *Peel*, 16 L. T. N. S. 145, &c.

(*f*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380.

(*g*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *The Leather Cloth Companies' case*, 1 H. & M. 271 (V.-C. Wood), and 11 H. L. C. 523 (Lords Cranworth and Kingsdown); *Rogers* v. *Taintor*, 97 Mass. 291; *Emerson* v. *Badger*, 101 Mass. 82.

(*h*) Trade Marks Registration Act, 1875, § 2. Patents Act, 1883, § 70.

(*i*) 32 L. J. Ch. 741, and 4 De G. J. & S. 352.

(*k*) 39 Conn. 450; 12 Amer. Rep. 401.

(*l*) 14 Ch. D. 748.

(*m*) 12 Abb. Pr. N. S. 178.

(*n*) 39 N. Y. Super. Ct. 54; 51 How. Pr. 455.

(*o*) 96 U. S. Rep. 245.

(*p*) 3 Hughes, 274.

(*q*) 1 Mo. App. 241.

because it happens to be identical with that of a maker of reputation (*a*).

Names of fancy personages.

Among trade marks used before the passing of the Trade Marks Act of 1875, instances are not unusual of marks consisting of a name which neither is nor ever has been borne by the present or any past manufacturer, but which either belongs to some person who actually exists or has existed, or to some imaginary or symbolical personage, or character from a book. Thus, the names "Victoria," "Albert," &c., are very commonly used on a great variety of articles; thus "Bismarck" denoted paper collars (*b*), and "Roger Williams" long cloth (*c*), "Dave Jones" whisky (*d*), "Lone Jack" tobacco (*e*); so too "Britannia," "Dolly Varden," &c. All such names, whether of real or fictitious characters, will properly be classed under sub-clause (*e*) of the amended § 64 (1 .

Name sometimes used alone.

In some cases the name constituting the trade mark is used alone, as "Wilkie" in *Wilkie* v. *McCulloch* (*f*), "Dent" in *Dent* v. *Turpin* (*g*), "Ramsay" in *Dixon* v. *Fawcus* (*h*), "Howe" in *Howe* v. *Howe Machine Co.* (*i*), "Wedgwood" in *Wedgwood* v. *Smith* (*k*), "Derringer" in *Derringer* v. *Plate* (*l*), "Jules Jurgensen" in *Jurgensen* v. *Alexander* (*m*), "A. W. Faber" in *Faber* v. *Faber* (*n*).

(*a*) *Perks* v. *Hall & Co.*, W. N. 1881, p. 111.

(*b*) *Messerole* v. *Tynberg*, 4 Abb. Pr. N. S. 410; R. Cox, 479. In the U. S. Patent Office it has been held that one man may register as his trade mark another man's name with the latter's written consent: *Ex parte Sullivan & Burke*, 16 U. S. Pat. Gaz. 765; *Ex parte Puce, Talbott & Co.*, *ib.* 909.

(*c*) *Barrows* v. *Knight*, 6 R. I. 434; R. Cox, 238.

(*d*) *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337.

(*e*) *Carroll* v. *Ertheiler*, 1 Fed. Rep. 688.

(*f*) Ct. Sess. Cas., 1st Ser. II. 413.

(*g*) 2 J. & H. 139.

(*h*) 3 Ell. & Ell. 537.

(*i*) 50 Barb. 236; R. Cox, 421.

(*k*) Dig. 96.

(*l*) 29 Cal. 292; R. Cox, 324.

(*m*) 24 How. Pr. 269; R. Cox, 298.

(*n*) 49 Barb. 357; R. Cox, 401. And see *Richards* v. *Williamson*, 30 L. T. N. S. 746; *Fullwood* v. *Fullwood*, W. N. 1873, pp. 93-185; *Tonge* v. *Ward*, 21 L. T. N. S. 480; *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176; *Bowman* v. *Floyd*, 85 Mass. 76; *Rogers* v. *Taintor*, 97 Mass. 291; *Emerson* v. *Badger*, 101 Mass. 82; *Sohier* v. *Johnson*, 111 Mass. 238; *Sherwood* v. *Andrews*, 3 Am. L. Reg. N. S. 588; *In re India Rubber Comb Co.*, 8 U. S. Pat. Gaz. 905; *India Rubber Comb Co.* v. *Meyer*, *ib.* 905; *India Rubber Comb*

In other cases the name is used in combination with other letters, words, or figures, or combinations of letters, words, or figures; and the name of an inventor, discoverer, manufacturer, &c., "may make words distinctive which, without the name, would not be so" (*a*). Thus "Chubb's Patent-Lock Fire-proof Safe" (*b*), "Collins & Co. Hartford Cast Steel, Warranted" (*c*), "Taylor's Persian Thread" (*d*), "Stephens' Blue Black Writing Fluid" (*e*), "Thorley's Cattle Food" (*f*), "Coe's Super-phosphate of Lime" (*g*), "Wolfe's Aromatic Schiedam Schnapps" (*h*), "Mrs. Winslow's Soothing Syrup" (*i*), "1847, Rogers Bros., A 1" (*k*), "Meneely's West Troy, N.Y." (*l*). Again, "J. Rodgers & Sons" was coupled with a crown between the initials of the sovereign (*m*), and "Ransomes & Co." was followed by "H. H. 6" (*n*). Sometimes in combinations.

Co. v. Rubber Comb & Jewelry Co., 45 N.Y. Super. Ct. 258; *In re Rubber Clothing Co.*, 10 U. S. Pat. Gaz. 111; *In re Coggin, Kidder & Co.*, 11 U. S. Pat. Gaz. 1109; *In re Hall & Co.*, 13 U. S. Pat. Gaz. 229; *Carmichel* v. *Latimer*, 11 R. I. 395.

(*a*) *Fulton* v. *Sellers*, 4 Brews. 42.

(*b*) *Chubb* v. *Priest*, 1 L. T. 142.

(*c*) *Collins Co.* v. *Brown*, 3 K. & J. 423; *Collins Co.* v. *Coven*, *ib.* 428.

(*d*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255.

(*e*) *Stephens* v. *Peel*, 16 L.T. N.S. 145.

(*f*) *Massam* v. *J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748.

(*g*) *Bradley* v. *Norton*, 33 Conn. 157; R. Cox, 331.

(*h*) *Burke* v. *Cassin*, 45 Cal. 467; 13 Amer. Rep. 204.

(*i*) *Curtis* v. *Bryan*, 2 Daly, 212; R. Cox, 434.

(*k*) *Meriden Britannia Co.* v. *Parker*, 39 Conn. 450; 12 Amer. Rep. 401.

(*l*) *Meneely* v. *Meneely*, 62 N. Y. 427.

(*m*) *Rodgers* v. *Nowill*, 6 Hare, 325; 5 C. B. 109; 3 De G. M. & G. 614.

(*n*) *Ransome* v. *Bentall*, 3 L. J. Ch. 161. And see *Green* v. *Folgham*, 1 S. & S. 398; *James* v. *James*, L. R. 13 Eq. 421; *Lazenby* v. *Lazenby*, Dig. 160; *Gillis* v. *Hall*, R. Cox, 596. Also *Wilder* v. *Wilder*, Dig. 372 ("J. B. Wilder & Co.'s Stomach Bitters"); *Weston* v. *Hemmons*, 2 Vict. L. R. Eq. 121 ("Weston's Wizard Oil"); *Filkins* v. *Blackman*, 13 Bl. C. C. 440 ("Dr. J. Blackman's Genuine Healing Balsam"); *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627 ("Gouraud's Oriental Cream, or Magical Beautifier"); *Weston* v. *Ketcham* (1) and (2), 39 N. Y. Super. Ct. 54; 51 How. Pr. 455 ("Capt. S. Pepper's Extra Signal Oil"); *In re Rohland*, 10 U. S. Pat. Gaz. 980 ("Dr. Lobenthal's Essentia Antiphthisica"); *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110 ("The John C. RagsdaleAmmoniated Dissolved Bone"); *McLean* v. *Fleming*, 96 U. S. Rep. 245 ("Dr. C. McLane's Liver Pills"); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 ("Perry Davis' Vegetable Pain-Killer"); *Fulton* v. *Sellers*, 4 Brews. 42 ("Dr. J. M. Lindsey's Improved Blood Searcher"); *Manhattan Medicine Co.* v. *Wood*, 4 Cliff. 461 ("Atwood's Physical

Second class of trade marks.—A signature.

The second class of trade marks to which the Act allows registration is really little else than a subdivision of the first class, consisting, as it does, of "a written signature, or copy of a written signature of the individual or firm applying for registration thereof as a trade mark," to which there may be added, as before, "any letters, words, or figures, or combination of letters, words, or figures, or of any of them." The signature of an individual or firm is in fact the name of the individual or firm printed or written in a "particular and distinctive manner," and as such, even before the Registration Acts, necessarily exhibited characteristics which could hardly be copied without the presumption being irresistible that the imitation was fraudulent and intended to invade the rights of the person whose signature was in question. In the cases of *Farina* v. *Silverlock* (*a*) and *Welch* v. *Knott* (*b*) the signature formed an important part of the trade mark concerned, and in America the signatures of individuals and firms have been admitted to registration on the same principle. Under the Act of 1875, § 10, there was no necessity for the signature to be that "of the individual or firm applying for registration thereof as a trade mark," but that is now required by § 64, both as originally contained in the Act of 1883, and as amended by the Act of 1888; so that an individual or firm will not in the future be able to register the signature of the person or firm to whose business he or they succeeded,

Vegetable Jaundice Bitters"); *Hostetter* v. *Vowinkle*, 1 Dill. 329, and *Hostetter* v. *Anderson*, 1 V. R. Eq. 7 ("Hostetter's Celebrated Stomach Bitters"); *Radway* v. *Coleman*, 15 Grant Up. Can. Ch. 50 ("Radway's Ready Relief"); *Chinn* v. *Thomas*, 5 Vict. L. R. Eq. 188 ("Hood & Co.'s Soluble Sheep Dip"); *Hanford* v. *Westcott*, 16 U. S. Pat. Gaz. 1181 ("Hanford's Chestnut Grove Whiskey"); *Morgan* v. *Rogers*, 26 *ib.* 1113 ("Dr. Haynes' Arabian Balsam"); *Funke* v. *Dreyfus*, 34 La. Ann. 80 ("Boker's Stomach Bitters"); *Hoxie* v. *Chaney*, 143 Mass. 592 ("A. N. Hoxie's Mineral Soap"), ("A. N. Hoxie's Pumice Soap").

(*a*) 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650.

(*b*) 4 K. & J. 747. See *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *In re Farina* (2), 27 W. R. 456; *In re Farina* (3), Dig. 654; *In re Maignen*, 28 W. R. 759.

unless that is an old mark, having been used as such before the passing of the Act of 1875. However, when the signature is once registered as a trade mark, whether with or without additions, it will descend and be assignable just as any other trade mark, without its new owner being liable to any imputation of representing the person whose signature is employed to be still in charge of the business, although formerly the use of a mark of this description might not improbably have been held to convey some such representation to the public. To a case of this description Lord Cranworth's observations very directly apply, when, speaking of a buyer of a business using the name of a former maker, he said (*a*), "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. In such a case I see nothing to make it improper for the purchaser to use the old trade mark, as the mark would in such a case indicate only that the goods so marked were made at the manufactory which he had purchased." The provision in the Acts of 1875 (*b*) and 1883 (*c*) that a trade mark "shall be assigned and transmitted only in connexion with the goodwill of the business" will enable the purchaser to use the trade mark so acquired by him without his motives being open to question, and will at the same time insure that marked goods purchased by the public shall, except in cases of punishable infringement, be produced at the works from which they purport to have come.

Third class of trade marks.—A distinc-

The third class of marks comprises "a distinctive device, mark, brand, heading, label, or ticket," to which again

(*a*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523.

(*b*) § 2.

(*c*) § 70.

tive device, &c.

may be added "any letters, words, or figures, or combination of letters, words, or figures, or of any of them."

Distinctiveness required.

The important feature which is absolutely necessary in all the varieties of trade marks included in this class is that of distinctiveness (*a*): each mark must be such that, if a question of infringement arises, it shall be perfectly clear what it is that is being infringed, and that this something is quite different from all other marks used upon the same class of goods.

Composition of trade mark, and manner of use alluded to.

Of the words "device, mark, brand, heading, label, or ticket," some point more directly to the matter of which the trade mark is composed, others to the manner in which it is affixed to the vendible article.

"Device" and "mark."

"Device" and "mark" seem, at first sight, wide enough to include any of the symbols or combinations of which a trade mark could consist. It has, however, been held, under the Act of 1875, that they do not include a mere word, or collocation of letters or figures, however strangely combined, or singular in their application (*b*), and the decision seems to be equally applicable to the Acts of 1883-8.

Mode of application indicated by them.

When used as indicative of the mode of application of the trade mark, these words will include such cases as where the mark is stamped on shirts (*c*) or other cotton goods (*d*), or imprinted on sticks of liquorice (*e*) or sealing-wax (*f*), and, generally, any cases which do not come within the remaining and more exact terms.

"Brand."

"Brand" refers to cases in which the trade mark is

(*a*) See per Cotton, L. J., in *Waterman* v. *Ayres*, 39 Ch. D. 33, and per Chitty, J., in *Burland & Co.* v. *Broxburn Oil Co. Ld.* (2), 42 Ch. D. 274.

(*b*) *Ex parte Stephens*, 3 Ch. D. 659.

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

(*d*) *Henderson* v. *Jorss*, Dig. 198; *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90; *Broadhurst* v. *Barlow*, W. N. 1872, p. 212; *Carver* v. *Bowker*, Dig. 581.

(*e*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380.

(*f*) *In re Hyde & Co.*, 7 Ch. D. 724.

branded on metal goods (*a*), or on wine-casks (*b*), or corks (*c*).

"Heading." "Heading" possibly applies to cases where, in addition to the ordinary label on the goods, there is a separate label affixed above it, on which the special mark is exhibited (*d*). But it more especially applies to the kind of marks applicable to the case of textile fabrics, in which a heading of special pattern is inwoven into the edge of the goods (*e*).

"Label." "Label" indicates an impression of a trade mark upon a piece of paper, or some other thin substance, which is made to adhere to the goods to which it is applied, or to the vessel containing them. Thus, in *Wotherspoon* v. *Currie* (*f*), the label was affixed to packets of starch; in *Bass* v. *Dawber* (*g*) to bottles of beer; in *Blackwell* v. *Crabb* (*h*), *Cocks* v. *Chandler* (*i*), *Cotton* v. *Gillard* (*j*), and other cases, to bottles of pickle.

"Ticket." "Ticket" points to a mark also impressed upon a separate material, but only loosely attached to the goods the make of which it indicates. Thus the trade mark of a wire manufacturer consisted of an anchor stamped on the tallies, or metal labels, attached to the bundles of his wire (*k*); the trade mark of a clothier was imprinted on a ticket pinned on to his wares (*l*). Mere words do not constitute a distinctive heading (*m*), or label, or ticket (*n*).

(*a*) *Motley* v. *Downman*, 3 My. & Cr. 1; *Millington* v. *Fox*, *ib.* 338; *Crawshay* v. *Thompson*, 4 M. & G. 357; *Hall* v. *Barrows*, 32 L. J. Ch. 548; and 4 De G. J. & S. 150, &c.

(*b*) *Seixo* v. *Provezende*, L. R. 1 Ch. 192; *Moet* v. *Couston*, 33 Beav. 578; *Ponsardin* v. *Peto*, 33 Beav. 642, &c.

(*c*) *Moet* v. *Clybouw*, Dig. 533; *Moet* v. *Pickering*, 8 Ch. D. 372.

(*d*) *Ex parte Stephens*, 24 W. R. 963.

(*e*) *Harter* v. *Souvazoglu*, W. N. 1875, pp. 11-101; *Carver* v. *Bowker*, Dig. 581; *Robinson* v. *Finlay*, 9 Ch. D. 487; and see per Sir G. Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434.

(*f*) L. R. 5 H. L. 508. See *Gilman* v. *Hunnewell*, 122 Mass. 139.

(*g*) 19 L. T. N. S. 626.

(*h*) 36 L. J. Ch. 504.

(*i*) L. R. 11 Eq. 446.

(*j*) 44 L. J. Ch. 90.

(*k*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185.

(*l*) *Hirst* v. *Denham*, L. R. 14 Eq. 542.

(*m*) *Leonard and Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

(*n*) *Great Yever St. Tea Co.* v. *Smith*, 6 P. R. 165.

Composition of trade mark.

The question, "What is a trade mark?" is, however, less directed to the manner in which the trader's symbol is attached to his goods than to its composition, and the varieties of mark which will merit and receive protection.

"Device."

The original form of trade mark was probably the representation of some animal, or other natural object, or mathematical figure, as the Hall mark of the lion or leopard's head, the Freemasons' square and compasses (*a*), or the Government broad arrow. Such a mark would be independent of language, and would serve to distinguish goods of a certain make, even for the illiterate.

Examples.

Such marks are still frequently employed, and this clause specially includes them. To this class belong the marks of an anchor (*b*), an eagle (*c*), a lion (*d*), an elephant (*d*), a cross (*e*), a pyramid (*f*), a bell (*g*), a hand (*h*), a cock (*i*), a rising sun (*k*), or a triangle (*l*).

A crest.

A crest is just as capable of becoming a trade mark as any other arbitrary device (*m*). In *Beard* v. *Turner* (*n*)

(*a*) As to this Freemasons' emblem, it has been held in the United States that it is so generally appropriated to a special purpose as not to be registrable by a private firm, even in combination: *In re Tolle*, 2 U. S. Pat. Gaz. 415. But this decision was not followed in *In re Thomas*, 14 U. S. Pat. Gaz. 821, or *Ex parte King* (2), 46 U. S. Pat. Gaz. 119, though in *Ex parte Smith* (3), 16 U. S. Pat. Gaz. 764, registration was refused to the word "Masonic."

(*b*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185.

(*c*) *Standish* v. *Whitwell*, 14 W. R. 512.

(*d*) *Henderson* v. *Jorss*, Dig. 198.

(*e*) *Cartier* v. *Carlile*, 31 Beav. 292; *Cartier* v. *Westhead*, Dig. 199; *Cartier* v. *May*, Dig. 200.

(*f*) *Bass* v. *Dawber*, 19 L. T. N. S. 626.

(*g*) *Bell* v. *Bell*, Dig. 514.

(*h*) *Allsopp* v. *Walker*, Dig. 545.

(*i*) *In re Walkden Aërated Waters Co.*, 54 L. J. Ch. 314.

(*k*) *Morse* v. *Worrell*, 10 Phila. 168.

(*l*) *In re Worthington*, 14 Ch. D. 8.

(*m*) In *Steinthal* v. *Samson*, Dig. 546, the trade mark consisted of the crest, arms, and motto of the plaintiff's family. See *Robinson* v. *Finlay*, 9 Ch. D. 487; *Hargreaves* v. *Smith*, Dig. 338; *In re Rosing*, 54 L.J. Ch. 975; *In re Farina* (1), 26 W. R. 261; *In re Farina* (3), Dig. 654; *Godillot* v. *Hazard*, 81 N. Y. 263; *Mackinnon* v. *Thompson*, 5 Can. Leg. News 396, also Instructions, as to royal, national, municipal, &c., arms.

(*n*) 13 L. T. N. S. 746. In *Standish* v. *Whitwell*, 14 W. R. 512, the defendant was restrained from using what he alleged to be his own crest as his trade mark. So in *Mackinnon* v. *Thompson*, 5 Can. Leg. News 396, where the trade mark, consisting of the defendant's name and arms, had been sold to the plaintiff.

Sir W. P. Wood, V.-C., said, "I am not prepared to say or hold that a man putting his crest should not so put it as to establish his right to say, 'Nobody shall use my crest.' It is incumbent on him, as on every plaintiff, to show that the crest is an essential part of his trade mark." The readiest way of proving this is now by reference to the Register of Trade Marks.

Portrait. The portrait of a person whose name has become descriptive of the goods, is not sufficiently distinctive to be registered as a good trade mark (*a*); but the portrait of a public character has been allowed to be registered in America (*b*).

Initials. Before the Trade Marks Act of 1875 a trade mark might consist of initials, either alone or in combination with other ingredients (*c*). Now, however, it would be difficult to assert that initials alone, printed in the usual manner, and without any distinguishing peculiarities of shape, colour, &c., could be described as "a distinctive device, mark, brand, heading, label, or ticket." Where the letters are combined together into the form of a monogram, or enclosed within a distinctive border, or are in any other way used in such a combination as to be distinguishable from the same letters used in the plain ordinary way, it might have been supposed that a device or mark would be constituted capable of registration; but in *Lucke* v. *Webster* (*d*), the late Master of the Rolls, while admitting to registration as an old mark a monogram on a shield, suggested that he could not have done so if it had been a new mark. In the American case of *United States* v. *Marble* (*e*), the Commissioner of Patents considered that the letters "W. G." in a monogram were registrable as a trade mark.

Marks with a Marks which have a mechanical purpose, *e.g.*, to serve

(*a*) *In re Anderson*, 26 Ch. D. 409; 54 L. J. Ch. 1084 (App.).

(*b*) *Ex parte Sullivan & Burke*, 16 U. S. Pat. Gaz. 765; *Ex parte Pace, Talbott & Co.*, *ib.* 909.

(*c*) See p. 83 *infrà*.

(*d*) M. R., April 4th, 1879.

(*e*) 22 U. S. Pat. Gaz. 1366.

mechanical purpose.

as guides for the equal division of the article to which they are applied, cannot deprive other manufacturers of the right to use somewhat similar marks for the same purpose (*a*).

Marks representing the article.

In some American cases it has been held or suggested that a device which represents the article to which it is intended to be applied must be treated as descriptive and incapable of appropriation, in the same way as words which are descriptive of the article to which they are applied are refused recognition as distinctive names. Thus the representation of a pig, attached to packages of lard (*b*), the representation of a fish, for fishing-lines (*c*); the representation of a bed made under a special patent, for beds so made (*d*); the representation of a barrel composed of alternate light and dark staves, for barrels of flour so made up (*e*); the representation of a twig with three leaves and a plum, for medicated prunes (*f*). But there is no English authority in favour of such devices being incapable of appropriation, and it is very doubtful whether the principle would be recognised in this country. In the case of the descriptive name, the right to use it could hardly be separated from the right to make and sell the article; but there is no imperative necessity that every one who has the latter right should also be entitled to sell the article under a mark containing a representation of it. If the trade are entitled to sell the article, and to sell it by its appropriate name, their requirements appear to be satisfied. However, the question would probably be treated as being, to some extent at least, one of degree. In *In re James* (*g*) an application was made for the removal from the register of a trade mark for black lead, which consisted of the representation of a dome-shaped cylinder of black lead, on the

(*a*) *Dausman and Drummond Tobacco Co.* v. *Ruffner*, 15 U. S. Pat. Gaz. 559.

(*b*) *Popham* v. *Wilcox*, 66 N. Y. 69.

(*c*) *In re Pratt & Farmer*, 10 U. S. Pat. Gaz. 866.

(*d*) *Tucker Manufacturing Co.* v. *Boyington*, 9 U. S. Pat. Gaz. 455.

(*e*) *Ex parte Halliday Brothers*, 16 U. S. Pat. Gaz. 500.

(*f*) *Ex parte Smith* (2), 16 U. S. Pat. Gaz. 679.

(*g*) 33 Ch. D. 392.

ground that the trade mark was simply a pictorial description of the goods in the form in which they were usually sold; but the decision of Pearson, J., allowing the application, was reversed by the Court of Appeal. This was principally on the ground that the black lead was not necessarily sold in that shape, and that the mark had sometimes been applied and might properly be applicable to blocks of black lead in any shape; and the Court did not actually decide what would be done if the trade mark had consisted of a pictorial representation of the goods in the only shape in which they could be made, but the inclination of the Court of Appeal would appear to have been rather in the direction above suggested. The Comptroller-General has now signified his intention not to accept as trade marks pictorial representations of the goods to which they are to be applied.

"Heading." *Harter* v. *Souvazoglu.*

In *Harter* v. *Souvazoglu* (*a*) the trade mark consisted of a certain combination of purple, pink, and green threads, nine stripes in three gradations, which were woven as a heading into cotton goods, which were forwarded to the markets of Turkey and the Levant. The owners of this mark having filed a bill for an injunction against a rival trader who had copied the mark, Sir C. Hall, V.-C., held "that a heading could be the subject of a trade mark, that the evidence in the case showed that this heading was distinguished from others in Turkey, and that it had become a trade mark, although it was sometimes associated with stamps on the goods, of the lion and the sun, and other devices. Customers had bought goods because of this particular heading, and he therefore considered that the plaintiffs who had adopted it were entitled to the protection they asked, and that no other persons could use it" (*b*).

(*a*) W. N., 1875, pp. 11-101.

(*b*) And see per Sir G. Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434. Also *Carver* v. *Bowker*, Dig. 581, and *Robinson* v. *Finlay*, 9 Ch. D. 487, where a heading of coloured threads formed a part of the combination mark, though not mentioned in the report.

Fancy words.

Besides the varieties of marks to which reference has already been made, the third class of registrable trade marks under § 64 of the Patents Act, 1883, before its amendment by the Act of 1888, also included "a fancy word or words not in common use." This was not so under the Trade Marks Registration Act, 1875-7, which entirely excluded fancy words from registration as new marks, and only admitted such as had been used before the Act of 1875. This exclusion was, however, found to cause great annoyance and inconvenience, since a fancy name is of all trade marks the most useful, seeing that it affords so easy a mode of inquiring for and obtaining goods produced by the precise manufacturer whose production is desired. For this reason the use of such words as trade marks has been more general than that of any other description of mark, and during the period of exclusion from registration recourse was had to all kinds of contrivances for obtaining the registration and at least partial protection of fancy names.

Requirements.

For words to be capable of exclusive appropriation under this provision of the Act of 1883, they had to comply with three requirements. First, they had to be fancy words; secondly, they had to be distinctive; and, thirdly, they had to be not in common use. Each of these requirements has been the subject of decision under the Act.

Fancy words *defined*.

As to what is meant by "a fancy word or fancy words," it was at first very generally supposed, and was so held by Chitty, J. (*a*), and Bacon, V.-C. (*b*), that the term would include any word fancifully applied, such as would have been protected by the Courts irrespective of any registration Act. The Court of Appeal, however, took a more stringent view of the meaning of the phrase, and the

(*a*) *In re Stapley & Smith*, 29 Ch. D. 877.
(*b*) *In re Van Duzer*, 34 Ch. D. 623; *In re Leaf, Sons & Co.*, 34 Ch. D. 632.

effect to be given to it is now ascertained with reasonable clearness. Thus, in the leading case on the subject (*a*), Cotton, L. J., said, "To be registered, the word must be a 'fancy word'; and in order to come within that description it must be a word which obviously cannot have reference to any description or designation of where the article is made, or of what its character is"; and Lindley, L. J., said, "To be a 'fancy word' the word must either have to ordinary English people, to whom the Act is addressed, no meaning, like the word 'Eureka,' or the word 'Aeilyton,' or, if it has any meaning at all, it must be obviously [non-descriptive] (*b*) when used as a trade mark." And Lopes, L. J., added, "A word to be a 'fancy word' must be obviously meaningless as applied to the article in question. It must be a word fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as neither to be deceptive nor descriptive, nor calculated to suggest deception or description. Further than that, the word must have an innate and inherent character of fancifulness, which must not depend on evidence, and cannot be supported by evidence, to show that in fact it is neither deceptive nor descriptive, nor calculated to be deceptive or descriptive. A fancy word must speak for itself: it must be a fancy word of its own inherent strength." Again, in *Waterman* v. *Ayres* (*c*), Fry, L. J., after expressing his concurrence in the definitions given above, added further, "That which is the only name of a thing cannot, it seems to me, be a fancy word with regard to it. The word 'spade' describes the thing. You can never take the word 'spade' and call it a fancy word for the thing." And in another case (*d*) Chitty, J., said that, "in reference to an article

(*a*) *In re Van Duzer*, 34 Ch. D. 623.
(*b*) See 34 Ch. D. 645.
(*c*) 39 Ch. D. 29.
(*d*) *In re Davis & Co.*, 59 L. T. N. S. 854.

produced in a foreign country and imported into England, where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy word within the meaning of the Act."

The effect of these statements has been so to narrow and restrict the meaning of the phrase that in nearly all the cases in which the question of "fancy word" has been brought before the Court the decision has been adverse to the claimant. In fact, in only three cases (*a*), one of which has since been disapproved (*b*), has the word been upheld; whereas in many cases it has been disallowed on the ground of descriptiveness or suggestion of descriptiveness (*c*).

"Distinctive."

As to the requirement that a fancy word shall be distinctive, it seems that the meaning to be placed

(*a*) *In re Stapley & Smith*, 29 Ch. D. 877 ("Alpine" cotton); *Slazenger* v. *Malings*, W. N. 1885, p. 124 ("The Lawford" racquet); *In re Burgoyne*, 61 L. T. N. S. 39 ("Oomoo" wine).

(*b*) *In re Stapley & Smith* in *In re Van Duzer*, 34 Ch. D. 623.

(*c*) Words which have been held not to be "fancy words": *In re Price's Patent Candle Co.*, 27 Ch. D. 681 ("National Sperm" candles); *In re Friedlander*, W. N. 1885, p. 95 ("Zephyr Asiatic Walnut Pipe"); *In re Harden Star &c. Co., Ld.*, 55 L. J. Ch. 596 ("Hand Grenade Fire Extinguisher"); *In re Van Duzer*, 34 Ch. D. 623 ("Melrose Favourite Hair Restorer"); *In re Leaf, Sons & Co.*, 34 Ch. D. 632 ("Electric Velveteen"); *In re Arbenz*, 35 Ch. D. 248 ("Gem" air-guns); *Lever* v. *Goodwin*, 36 Ch. D. 1 ("The Self-Washer"); *Tongood Bros.* v. *Pirie & Sons, Ld.*, 56 L. T. N. S. 394 ("The Jubilee Note" paper); *In re Ainslie & Co.*, 4 P. R. 212 ("Ben Ledi" whiskey); *In re Laing*, L. J. N. of C., 1887, p. 102 ("Glengowrie Blend of Fine Old Highland Whiskey"); *In re Hanson*, 37 Ch. D. 112 ("Red, White, and Blue" label tea); *In re Sanitas Co., Ld.*, 58 L. T. N. S. 166 ("Sanitas" medicines); *In re Waterman*, 39 Ch. D. 29 ("Reversi" game); *In re Davis & Co.*, 59 L. T. N. S. 854 ("Boköl" beer); *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820 ("Herbalin" medicine); *In re Californian Fig Syrup Co.*, 40 Ch. D. 620 ("Syrup of Figs"); *In re Jackson & Co.*, 60 L. T. N. S. 93 ("Kokoko" cotton piece goods); *In re Thompson & Co.*, 6 P. R. 213 ("Manor" tin plates); *In re Grossmith*, 60 L. T. N. S. 612 ("Emollio" toilet cream); *Great Tower Street Tea Co.* v. *Smith*, 6 P. R. 165 ("Tower Tea"); *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274 ("Washerine" soap); *In re Vignier*, 6 P. R. 490 ("Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" iron); *In re Hannay*, 7 P. R. 46 ("Electroid" anti-fouling composition"); *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser XIII., 1 ("Granolithic" artificial stone).

upon this is that the word must be one which serves to distinguish the goods of one maker or dealer from the goods of all others (*a*), and that it cannot be distinctive if a word of similar sound, though different in spelling, is in use in the trade (*b*).

"Not in common use."

The further requirement that fancy words shall be "not in common use" has been interpreted by Chitty, J. (*c*), to mean that they must not be in common use in the trade with respect to which it is sought to appropriate them; and though other judges have rather avoided expressing an opinion as to the meaning of the phrase, it would appear that this is the true meaning to be attached to it. The fact that a word may have been generally used and have acquired a descriptive signification in one trade may well leave it "obviously meaningless" in another. In Scotland, Lord Craighill (*d*) seems to have taken substantially the same view as Chitty, J., for he says that the term "'common use,' as employed in the statute, does not necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. What is enough, in my opinion, to establish common use, in the sense of the statute, is this: if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less directly with the use of the commodity to which the word has been applied."

Fourth class of trade marks.—Invented words.

The fourth class of marks comprises "an invented word or invented words," to which, as in other cases, additions may be made. The introduction of this expression into

(*a*) See *Wood* v. *Lambert*, 32 Ch. D. 257; *Waterman* v. *Ayres*, 39 Ch. D. 29; *In re Jackson & Co.*, 60 L. T. N. S. 93.

(*b*) Per Kay, J., in *In re Jackson & Co.*, 60 L. T. N. S. 93.

(*c*) *In re Stapley & Smith*, 29 Ch. D. 877; *In re Burgoyne*, 61 L. T. N. S. 39. Compare *Great Tower Street Tea Co.* v. *Smith*, 6 P. R. 165.

(*d*) In *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser. XIII. 1.

the Act appears to be intended to bring within its scope, and to render registrable as new marks, such words as "Washerine" (*a*) and "Monobrut" (*b*), which were rejected as fancy words, or as "Pectorine" (*c*), "Lacto-peptine" (*d*), "Valvoline" (*e*), which were not submitted to that test. It has, however, been held that "Satinine" was not registrable for starch, soap, blue, and similar goods, as being descriptive of the effect produced (*f*).

Fifth class of trade marks.—Non-descriptive words.

The fifth class of marks comprises "a word or words having no reference to the character or quality of the goods, and not being a geographical name, with or without additions." This seems designed to include such terms as "Pharaoh's Serpents" toys (*g*), "United Service" soap (*h*), and "Charter Oak" stoves (*i*). Geographical words remain excluded, as they had already been under the meaning given by the Courts to the term "fancy words."

Sixth class of trade marks.—Old marks.

Marks which come within any of the above five classes are capable of registration, whether they were used before the passing of the Trade Marks Registration Act, 1875, or not; but many valuable trade marks adopted and used before any precise definition was provided are not included in any of these five classes, and would consequently be deprived of the benefits of the Act, unless some special provision were made for their protection. To meet this case it is provided, by § 64 (3) (ii), that "any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark before the 13th day of August, 1875, may be registered as a trade mark under this part of this Act."

(*a*) *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274.
(*b*) *In re Vignier*, 6 P. R. 490.
(*c*) *Smith* v. *Mason*, W. N. 1875, p. 62.
(*d*) *Carnrick* v. *Morson*, L. J. N. of C. 1877, p. 71.
(*e*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.
(*f*) *In re Meyerstein & Co.*, 43 Ch. D. 604.
(*g*) *Barnett* v. *Leuchars*, 13 L. T. N. S. 495.
(*h*) *Field* v. *Lewis*, Seton, 4th Ed. 237.
(*i*) *Filley* v. *Fassett*, 44 Mo. 173.

Old word-marks.

By far the most important description of marks included in this class is that defined as "any special and distinctive word or words used as a trade mark before the 13th day of August, 1875," which brings within the scope of the Act the numerous varieties of words which were used as old marks, whether they come within the definitions applicable to new marks or not. With respect to them, two conditions are prescribed. First, the word or words must be "special and distinctive"; and, secondly, they must have been used as a trade mark before the passing of the Act of 1875.

"Used as a trade mark."

Passing over for the moment the question what words can be properly regarded as special and distinctive, it seems convenient first to consider here the further requirement that the word or words shall have been "used as a trade mark before the 13th day of August, 1875," a requirement which, it will be observed, applies also to the other varieties of old marks comprised in § 64 (3) (ii). There must, then, have been user of the word or other mark before August 13th, 1875, and such user must have been user as a trade mark, and not as a descriptive term relating to the character or pattern of the goods or the like (*a*). The word or other mark must have been used *per se*, and not as part of a mark which included other elements (*b*); and if it has always been used with such other elements, it cannot, apart from them, be claimed as an old mark, even though in some cases some of the elements comprising the entire trade mark have been used on one side of the article and the remainder on the other side (*c*). Moreover, it is not sufficient that there has been user on price lists, bill heads, or other trade documents; for user as a trade mark there must have

(*a*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288; *In re Harrison, M'Gregor & Co.*, 42 Ch. D. 691.

(*b*) *In re Palmer* (3), 24 Ch. D. 504; *In re Royal Baking Powder Co.*, W. N. 1880, p. 49; *In re Hayward & Sons*, 54 L. J. Ch. 1003; *In re Chorlton & Dugdale*, 53 L. T. N. S. 337; *In re Perry Davis & Son*, 58 L. T. N. S. 695; *In re Grossmith*, 60 L. T. N. S. 612; *In re Dunn*, 41 Ch. D. 439.

(*c*) *In re Spencer*, 54 L. T. N. S. 659.

been user on the goods themselves (*a*), or on the boxes or wrappers containing them (*b*),—though slight user is sufficient (*c*), unless the claim is for registration under the three-mark rule (*d*),—and the user before August 13th, 1875, must have been within the United Kingdom; for foreign user is immaterial (*e*), and the mere passage through England of marked goods, without any sale or exposure for sale, is not user of the mark (*f*). And even if all these conditions have been complied with, the old user only gives a right to registration in respect of the goods with relation to which the old user existed, and not to registration as an old mark in respect of any other goods (*g*).

"Special and distinctive."

As to the requirement that the word or words shall be "special and distinctive," it has been said by an Irish judge (*h*) that "special" means that the words must not ordinarily be applied to goods of the class in respect of which they are used, and that "distinctive" means that they must be suitable for distinguishing the particular goods as to which they are used from other goods of the same class. And in *Wood* v. *Lambert* (*i*), Fry, L. J., said, "It appears to me that to satisfy the requirements of the definition (*k*), the word or words must be distinctive

(*a*) *In re Palmer* (3), 24 Ch. D. 504; *In re Chorlton* v. *Dugdale*, 53 L. T. N. S. 337; *In re Perry Davis & Son*, 58 L. T. N. S. 695; *Thompson* v. *Montgomery*, 41 Ch. D. 35.

(*b*) *Jay* v. *Ladler*, 40 Ch. D. 649.

(*c*) *In re Chorlton & Dugdale*, 53 L. T. N. S. 337.

(*d*) *In re Hodson & Co.*, 26 Sol. J. 43.

(*e*) *In re Münch*, 50 L. T. N. S. 12; *In re Riviere & Co.*, 26 Ch. D. 48; *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 (per Fry, L. J.); *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Smith* v. *Fair*, 14 Ont. Rep. 729. But see *In re Eastman*, W. N. 1880, p. 128.

(*f*) *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.).

(*g*) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Edwards* v. *Dennis*, 30 Ch. D. 454, and see per Pearson, J., in *In re Lyndon*, 32 Ch. D. 109.

(*h*) Chatterton, V.-C. of I., in *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371.

(*i*) 32 Ch. D. 247.

(*k*) The definition there referred to is that contained in T. M. A. 1875, § 10 (3), with which, for this purpose, the present words are identical.

in this sense, that they distinguish the manufacture of the person who has registered the trade mark from the manufacture of all other persons. I say 'manufacture,' but of course there may be cases in which they distinguish, not the manufacture, but the selection, or some other operation upon the goods. But in all cases the word or words must distinguish the product of the person claiming the trade mark from the product of all other persons, and it appears to me that it must have that distinctive character at the time of the registration" (*a*). And in the same case Lindley, L. J., said, "What is meant by a 'distinctive' trade mark? It must mean some mark which distinguishes the goods to which it is attached as those made or sold by the person who uses the mark." So in *In re Perry Davis & Son* (*b*) Lopes, L. J., stated that "the authorities are clear to show that it" (*i.e.*, a word claimed as an old mark) "must be a word distinguishing the article manufactured by one person from a similar article manufactured by another person, and not a word that is merely descriptive of the article itself" (*c*).

Wood v. *Lambert.*

In *Wood* v. *Lambert* (*d*) the word "Eton," which was registered as a trade mark by the plaintiffs, had been habitually used by them in conjunction with names of imaginary firms; and the Court of Appeal held that such user had destroyed whatever distinctiveness the word might otherwise have possessed. Fry, L. J., in whose views the other Lords Justices concurred, laid down that "when a person uses a name and represents that name to be applicable to the product of a manufacturer or manufacturers other than himself, so as to induce the belief that the goods are the manufacture of that third person or persons, he cannot say that the word is distinctive

(*a*) This definition Fry, L. J., repeated in substance in *In re Perry Davis & Son*, 58 L. T. N. S. 695.

(*b*) 58 L. T. N. S. 695.

(*c*) And see per Fry, L. J., in *Waterman* v. *Ayres*, 39 Ch. D. 29.

(*d*) 32 Ch. D. 247.

of his own manufacture. Nor do I think that that principle applies the less because the plaintiff may be false in the assertion that there is any such firm or firms as the manufacturer represents. He who has made the goods has taken upon himself to represent two things: in the first place, that they are not his manufacture, but somebody else's; in the second place, that a firm exists which does not exist at all."

Leniency of courts.

In the majority of the cases in which the validity and right to registration of a word claimed as an old mark has been considered, the question has turned on the user or non-user as a trade mark before the 13th August, 1875; but when the question has turned on the words being distinctive or otherwise, the Courts have shown themselves far more leniently disposed than in the case of "fancy words," and words which must have been refused registration as "fancy words" have been recognised as registrable in the character of "special and distinctive words" (*a*). In fact, in some of these cases the words have been so far descriptive as to cause a reasonable doubt whether the leniency shown was not excessive.

Descriptiveness fatal.

Although there may be questions as to the application of the principle in particular cases, there can be no doubt that, as was clearly laid down in *Wood* v. *Lambert* (*b*), descriptiveness is fatal to a word claimed as an old trade

(*a*) The following words have been recognised as special and distinctive words: *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Talbot* v. *Webley*, 3 P. R. 276 ("Baffle" stoves); *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 ("Valvoline" oil); (but compare *In re Horsburgh*, 53 L. J. Ch. 237); *In re Eastman*, W. N. 1880, p. 128 ("Kitchen Crystal Soap"); *Blair* v. *Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey); *Compania General de Tabacos* v. *Rehder & Co.*, 5 P. R. 61 ("Cavite" cigars); *Free Fishers and Dredgers of Whitstable* v. *Elliott*, W. N. 1888, p. 27 ("Whitstable native oysters"); *B. Edgington, Ld.* v. *J. Edgington & Co.*, 6 P. R. 513 ("Frigi Domo" canvas); and see *Evans* v. *Smith*, 3 Times L. R. 390 ("Montserrat" lime-juice); *In re Grossmith*, 60 L. T. N. S. 612 ("Emollio" toilet cream); *Thompson* v. *Montgomery*, 41 Ch. D. 35 ("Stone Ales"). In *In re Perry Davis & Son*, 58 L. T. N. S. 695, the term "Pain-Killer" medicines seems to have been thought too descriptive, though there were other reasons for invalidating the trade mark.

(*b*) 32 Ch. D. 247.

mark, though it will not be invalidated for such a mere suggestion or suspicion of descriptiveness as has in some instances proved fatal to words claimed as "fancy words" (*a*) The intention of the proviso admitting old word marks to registration is evidently to give protection to words used as trade marks, and which would have been protected as such before the first Trade Marks Registration Act; and it may probably be said that words which would have been recognised as trade marks before 1875 will now be recognised as coming within the statutory proviso in favour of old marks.

Descriptive words.

It appears, then, that a word may be purely descriptive, that is to say, it may express accurately and appropriately the material or mode of composition of the goods to which it is affixed, and unless the exclusive manufacture of such goods is protected by a patent, and the same result cannot be attained without infringement of the patent, all the world has the right to make and sell such goods; and further, when the goods are manufactured and in course of sale, not only has the right, but is in duty bound to describe them, for the proper information and protection of the public, in such manner as will convey the most correct idea. Hence the original maker can claim no exclusive right in the properly descriptive name; nor would it be in accordance with the principles of equity that he should be able to do so, for, as was well said by Mr. Justice Strong, in the Supreme Court of the United States (*b*), "Equity will not enjoin against telling the truth."

Young v. *Macrae*.

The reasoning of Wood, V.-C., in *Young* v. *Macrae* (*c*), affords a good example of the just way of considering cases of this description. In that case the plaintiffs,

(*a*) *E.g.*, in *Waterman* v. *Ayres*, 39 Ch. D. 29; *In re Sanitas Co., Ld.*, 58 L. T. N. S. 166; *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch D. 274; *In re Vignier*, 61 L. T. N. S. 495; *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser. XIII. 1.

(*b*) *Canal Co.* v. *Clark*, 13 Wall. 311

(*c*) 9 Jur. N. S. 322.

who held a patent for manufacturing a kind of oil which they called "Paraffin oil," filed a bill against the defendant, who sold a substance which he styled "Kerosene oil," or "American Paraffin oil." The case coming on on motion for injunction, the Vice-Chancellor said, "In the patent the process is described as 'a distillation of coal so as to obtain oil containing paraffin, and from this oil I obtain paraffin.' So he calls it paraffin oil because it contains paraffin. Here is a well-known substance called 'paraffin.' A chemist discovers that by the same process by which paraffin is produced, an oil containing paraffin, and from which paraffin can again be produced, is obtainable. Therefore, it being an oil containing paraffin, and producing paraffin, he calls it 'paraffin oil.' It is not a fanciful or whimsical name, but it describes the thing which he has produced. A man cannot take out a patent for a natural substance, but he can take out a patent for arriving at that natural substance, and he may christen it, putting aside all other people, having called it by that name." The Vice-Chancellor then put the case of a man extracting sugar from beet-root by a patented process, and calling the extract "beet-root sugar" for a period of ten years. In such a case, when beet-root sugar was asked for, it would be known that his was meant, because he was the only man who made it. "The name," the Vice-Chancellor said, "does not become a trade mark, but it gets fixed to his sugar simply because nobody else could make it. Then, suppose that another man found out another method of making sugar from beet-root, and so extracted it, not wanting to patent it, and described it as 'beet-root sugar,' may he not call it 'beet-root sugar' because the other gentleman for ten years has been the manufacturer of it, and sold it as such? I think the question of the fancifulness of the name is a question whether it is taken by way of trade mark or not. All he (*i.e.* the plaintiff) has done here is this: he has found out an article which is

a natural product, and he has given that natural product a name." "This is not like the case of the 'Medicated Mexican Balm,' which is a name extravagantly ridiculous. I therefore should not assume *mala fides* against a person who calls the thing what it is. It is paraffin and it is oil, therefore paraffin oil. There is paraffin in it, and paraffin to be obtained from it, and it is American." Injunction refused.

In a later case (*a*) the same Vice-Chancellor referred to the above case of *Young* v. *Macrae* (*b*), and remarked that "if the evidence had gone to show that the plaintiff had been the first to apply the name 'paraffin' to the oil, he would have granted an injunction (*c*); but that he had there had it proved that the name 'paraffin oil' had long been known as the scientific name of the article, and that the defendant could not well have called it anything else."

Name become *publici juris*.

Again, a word which was first applied to, or was even invented for the sole and express purpose of designating a substance or composition may prove, on investigation, to have ceased to retain the characteristic, which it once possessed, of conveying the idea of the goods being of a particular manufacture; in which case the person who first used the word, though its inventor, will cease to have any exclusive rights in it, since it will have become purely descriptive of an article which all may freely make (*d*). The name thus becomes *publici juris*, and

(*a*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*b*) 9 Jur. N. S. 322.

(*c*) So in *Eno* v. *Stephens*, Dig. 609, the term "Fruit Salt" was protected at the instance of the person who was the first to use it; but compare *In re Eno*, 41 Ch. D. 439, and see *Siegert* v. *Findlater*, 7 Ch. D. 801; *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834; and *Canal Co.* v. *Clark*, 13 Wall. 311, as to a name which is appropriated to an article.

(*d*) *E.g.*, "Worcestershire Sauce" —*Lea* v. *Millar*, Dig. 513; *Lea* v. *Deakin*, 11 Biss. 23; "Gem" airguns, *In re Arbenz*, 35 Ch. D. 248; "Neva Stearine" candles, *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. 98; "Calhoun Plough," *In re Hall & Co.*, 13 U. S. Pat. Gaz. 229; "Holbrook's School Appuratus," *Sherwood* v. *Andrews*, 3 Am. L. Reg. N. S. 598.

not only can be, but ought to be, employed by all who manufacture and sell an article which they are at perfect liberty to manufacture and sell, and of which the name in question is generally recognised as the appropriate designation. This point is well stated by Lord Selborne, C., in *Singer Manufacturing Co.* v. *Loog* (3) (*a*), where he says, "The reputation acquired by machines of a particular form or construction is one thing; the reputation of the plaintiffs, as manufacturers, is another. If the defendant has no right under colour of the former to invade the latter, neither have the plaintiffs any right under colour of the latter to claim (in effect) a monopoly of the former. If the defendant has a right to make and sell, in competition with the plaintiffs, articles similar in form and construction to those made and sold by the plaintiffs, he must also have a right to say that he does so, and to employ for that purpose the terminology common in his trade, provided always that he does this in a fair, distinct and unequivocal way."

Effect of registration.

The registration as a trade mark of a name of this description will somewhat complicate the question, as registration of a trade mark is *primâ-facie* evidence, and, after five years' registration, conclusive evidence of the right of the registered owner to the exclusive use of such trade mark (*b*); but the wording of the Act is entirely directed to the registration of "a trade mark," the exclusive use of "a trade mark," &c., and since a name which has become *publici juris*, whether registered or not, cannot be a "trade mark" within the definition section of the Act, because it contains nothing distinctive, it seems that, at all events within the five years, this enactment does not preclude a defence on the ground that the name so registered is in fact no trade mark, and was registered, or is continued on the register, by error. However,

(*a*) 8 App. Cas. 27; and see per Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-56.

(*b*) Patents Act, 1883, § 76.

whether that be so or not, it has been repeatedly decided that five years' registration cannot protect a mark which has been registered as a trade mark, but is invalid by reason of its being descriptive or otherwise, from being removed from the register (*a*); and the remarks of Mellish, L. J., in *Ford* v. *Foster* (*b*), appear to be equally applicable since the Act as before it. "There is no doubt, I think, that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successor in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been instanced of Harvey's Sauce (*c*). Then, what is the test by which a decision is to be arrived at whether a word which was originally a trade mark has become *publici juris*? I think the test must be, whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent a trader from being cheated by other persons' goods being sold as his

(*a*) *In re Palmer* (1) and (3), 21 Ch. D. 47; 24 *ib.* 504; *In re Lloyd & Sons*, 27 Ch. D. 646; *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Wragg*, 29 Ch. D. 551; *Wood* v. *Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659. And it has been so held also in Victoria: *Lewis* v. *Klapproth*, 11 Vict. L. R. 214; *Wolfe* v. *Alsop* (2), 12 Vict. L. R. 421; *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 752. The wisest course to take in such a case is no doubt to apply to rectify the register by the removal of the offending mark—*e.g.*, *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

(*b*) L. R. 7 Ch. 611.

(*c*) With respect to this example, an injunction was granted by Sir J. Romilly, M. R., in 1858, to restrain a representation that the defendant's sauce was that of the inventor's successor in business. See *Lazenby* v. *Lazenby*, Dig. 160. But in *Lazenby* v. *White*, 41 L. J. Ch. 354, it was admitted that the name was common to the trade.

goods through the fraudulent use of the trade mark, the right to the trade mark must be gone" (*a*).

The three-mark rule.

When the Trade Marks Registration Act, 1875, first came into operation, it was found that in many trades application was made by two or more traders for the registration of substantially identical marks—the fact being that the marks had not previously come into collision on account of their being used in different parts of the country—without any suspicion of want of *bona fides* on the part of any of the rival applicants. If the strict letter of the Act and Rules had been adhered to, much injustice would have been done to the later applicants, whose applications must have been refused; and the Commissioners of Patents therefore framed the rule that identical or similar *old* marks—*i.e.*, marks used before the 13th August, 1875—might be registered by different persons in the same trade up to the number of three, but not more; the rule providing that if the mark had been used *bonâ fide* by more than three persons it must be treated as common to the trade, and no registration at all be allowed. This rule was recognised by Courts of First Instance in numerous cases (*b*); and in one case (*c*) three substantially identical marks, of which two were old and one was new, and in another case (*d*) three substantially identical *new* marks, were allowed to be registered for the same goods by different traders with consent of all the parties concerned. A provision derived from this rule is now to be found in § 74 of the Patents Act, 1883, by which it is enacted that any device which

(*a*) For instances of marks proved to be common to particular trades see Note (*c*) to § 74 of the Patents Act, 1883, *infra*.

(*b*) *In re Walkden Co.*, 54 L. J. Ch. 394; *In re Powell*, Dig. 589; *In re Hyde & Co.*, 54 L. J. Ch. 395; *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Ex parte Sales, Pollard & Co.*, Dig. 620; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Brook*, 26 W. R. 791; *In re Hudson & Co.*, 26 Sol. J. 43; *Benbow* v. *Low* (4), 44 L. T. N. S. 875; *In re Sone & Fleming Manufacturing Co.*, 30 Ch. D. 505; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *In re Bancroft & Co.*, 5 P. R. 209.

(*c*) *In re Walkden Co.*, 54 L. J. Ch. 394.

(*d*) *In re Vergaras*, V.-C. H., June 3rd, 1881.

was before August 13th, 1875, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of the section (*i.e.*, for the purpose of registration as an addition to a trade mark, exclusive rights therein being disclaimed) be deemed common to the trade in such goods (*a*).

Name indicative of a principle of construction.

In the majority of cases in which the question has been raised whether a word was descriptive of the article to which it was applied, or distinctive of the maker by whom that article was made, the question has been whether the word, according to the ordinary usage of the English language, indicated correctly the nature or origin of the article. Thus, "Porous Plasters" (*b*), "Croup Tincture" (*c*), and so on. But in a considerable number of instances the question has been whether a word, which had no descriptive signification to persons unacquainted with the particular trade, did or did not indicate to persons versed in the trade an article prepared according to a definite process, or a machine constructed on a definite principle, the rule being that if the word indicates such a process or principle it is descriptive and incapable of exclusive appropriation.

Articles made according to a patented process.

This difficulty has especially arisen with respect to articles made under a patent, which can only be made by the patentee during the existence of the patent, and to which, consequently, his name or some other special name usually becomes attached. "Where a patented article is known in the market by any specific designation, whether of the name of the patentee or otherwise, every person at the expiration of the patent has a right to manufacture and vend the same under the designation thereof by which it was known to the public. . . . . The original patentee or his assignees have no right to the exclusive

(*a*) Common user is not proved by the books containing applications for registration: *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434.

(*b*) *In re Brandreth*, Dig. 626.

(*c*) *In re Roach*, 10 U. S. Pat. Gaz. 333.

use of the designation as a trade mark. Their rights were under the patent, and expired with it" (*a*).

The sewing-machine cases.

Thus, in the case of *The Wheeler & Wilson Manufacturing Co.* v. *Shakespeare* (*b*), James, V.-C., and in that of *The Singer Manufacturing Co.* v. *Wilson* (*c*), Jessel, M. R. (affirmed by the Court of Appeal), refused to assist an attempt at continuing the monopoly in sewing machines which had been patented, after the expiration of the patent, by a claim to the exclusive use, by way of trade mark, of the name by which the peculiar principle of construction had come to be generally known. In the latter case the House of Lords declined to decide whether the name "Singer" was indicative of a maker or of a principle of construction, the defendant's evidence being incomplete; but it was assumed that if the latter had been proved, the defendant would have succeeded (*d*), and that result actually took place in *Singer Manufacturing Co.* v. *Loog* (3) (*e*). So in America, in *Singer Manufacturing Co.* v. *Larsen* (*f*), *Singer Manufacturing Co.* v. *Stanage* (*g*),

(*a*) Per Treat, J., in *Singer Manufacturing Co.* v. *Stanage*, 2 McCrary 512; and see *Edelsten* v. *Vick*, 11 Hare, 78; *Young* v. *Macrae*, 9 Jur. N. S. 322; *Green* v. *Rooke*, W. N., 1872, p. 49; *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298; *Same* v. *Anderson*, W. N., 1883, p. 185; *Lazenby* v. *White*, 41 L. J. Ch. 354; *Condy* v. *Mitchell*, 37 L. T. N. S. 766; *James* v. *James*, L. R. 13 Eq. 421; *Cheavin* v. *Walker*, 5 Ch. D. 850; *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *Siegert* v. *Findlater*, 7 Ch. D. 801; *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834; *In re Ralph*, 25 Ch. D. 194; *In re Leonard & Ellis*, 26 Ch. D. 288; per Cotton, L. J.; *Native Guano Co., Ld.* v. *Sewage Manure Co.*, 4 Times L. R. 372; *In re Richardson*, 3 U. S. Pat. Gaz. 120; *Tucker Manufacturing Co.* v. *Boyington*, 9 U. S. Pat. Gaz. 455; *Canal Co.* v. *Clark*, 13 Wall. 323, per Strong, J.; *In re Kane & Co.*, 9 U. S. Pat. Gaz. 105; *In re Consolidated Fruit Jar Co.*, 14 U. S. Pat. Gaz. 269; *Ex parte Consolidated Fruit Jar Co.*, 16 *ib.* 679; *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337; *Burton* v. *Stratton*, 12 Fed. Rep. 696; *Green* v. *Woodhouse*, 38 U. S. Pat. Gaz. 1491; *Galley* v. *Colt's Patent Fire Arms Manufacturing Co.*, 30 Fed. Rep. 118; *Goodyear Rubber Co.* v. *Goodyear India Rubber Glove Manufacturing Co.*, 128 U. S. Rep. 598; *Adee* v. *Peck Bros. & Co.*, 48 U. S. Pat. Gaz. 823; *Leclanche Battery Co.* v. *Western Electric Co.*, 21 Fed. Rep. 538; *Goodyear Rubber Co.* v. *Day*, 22 Fed. Rep. 44. See *In re Eastman*, W. N. 1880, p. 128, in which registration was granted to a name which had been used for soap made under a patent.

(*b*) 39 L. J. Ch. 36.
(*c*) 2 Ch. D. 434.
(*d*) 3 App. Cas. 376.
(*e*) 8 *ib.* 15.
(*f*) 8 Biss. 181.
(*g*) 2 McCrary, 512.

Singer Manufacturing Co. v. *Riley* (*a*), and *Brill* v. *Singer Manufacturing Co.* (*b*), though in the earlier Scotch case of *Singer Manufacturing Co.* v. *Kimball & Morton* (*c*), the decision was in favour of the company. Where, during the continuance of a patent granted to one Foley the defendants had made articles in accordance with the patent and called them "Foley's Patent Valves," it was held in America that they had infringed the patent, but not any trade-mark rights (*d*).

And it has further been decided in America that a patented instrument for distinguishing a manufacturer's goods—*e.g.*, a special tin tag or ticket—cannot be recognised as a trade mark during the continuance of the patent (*e*), and that the special shape of an article made under a patent is similarly incapable of individual appropriation (*f*).

New name for new article.

And even where no patent is obtained, "it is to be observed that the person who produces a new article, and is the sole maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from" (*g*). Thus it was held by the Court of Appeal that a firm who invented a new description of oil, and called it "Valvoline," had no right of trade mark in the word (*h*); and so where the word "Albion" had been used to indicate metal goods of a particular pattern, and not to indicate a particular manufacturer (*i*). But where the article is not

(*a*) 11 Fed. Rep. 706.
(*b*) 41 Ohio St. 127.
(*c*) Ct. Sess. Cas., 3rd Ser. XI., 267.
(*d*) *Adee* v. *Peck Bros. & Co.*, 48 U. S. Pat. Gaz. 823.
(*e*) *Lorillard* v. *Pride*, 28 Fed. Rep. 434.
(*f*) *Wilcox & Gibbs Sewing Machine Co.* v. *Gibbon's Frame*, 21 Bl. C. C. 431; *Brill* v. *Singer Manufacturing Co.*, 41 Ohio St. 127.
(*g*) Per Fry, J., in *Siegert* v. *Findlater*, 7 Ch. D. 801; and see *Linoleum Manufacturing Co.* v. *Nairn*, *ib.* 834; and *Waterman* v. *Ayres*, 39 Ch. D. 29. So also in United States: *Leclanche Battery Co.* v. *Western Electric Co.*, 21 Fed. Rep. 538; and New Zealand: *Marshall* v. *Hawkins*, 4 N. Z. L. R. Sup. Ct. 59.
(*h*) *In re Leonard & Ellis*, 26 Ch. D. 288. See *Leonard & Ellis* v. *White's Golden Lubricator Co.*, 48 U. S. Pat. Gaz. 1401.
(*i*) *In re Harrison, M'Gregor & Co.*, 42 Ch. D. 691.

a new article, but only an improved form of an old article, the same considerations do not apply (*a*).

Actual fraud.

Of course, in any case which arises, any element of actual intentional fraud will be taken into consideration, and the Court will, in the exercise of its general jurisdiction for the repression of fraud, award an injunction or damages in a case in which, but for the fraud, no remedy would have been given. Thus, for instance, in a case in which the infringer might have taken with impunity the name of an article invented by another, but, not content with so doing, described his own manufacture as "the original" article, he was restrained by injunction from the use of that misleading epithet (*b*).

Name merely descriptive cannot be protected.

The general principle, however, is that where a name used by way of a trade mark either was originally, or has since come to be, merely descriptive of the article to which it is attached, so that while serving to indicate what the article is, it does not serve to connect it with any particular manufacturer or manufacturing establishment, that name cannot be protected as a trade mark (*c*) or registered as special and distinctive. The Act establishing registration "takes nothing away from

(*a*) *Barlow & Jones, Ld.* v. *Johnson & Co.*; 34 Sol. J. 298; affirmed by C. A., W. N. 1890, p. 110.

(*b*) *Cocks* v. *Chandler*, L. R. 11 Eq. 446. The presumption of fraud may, however, be refuted, as by a fair statement of the maker's own name: *Browne* v. *Freeman*, 12 W. R. 305.

Descriptive words.

(*c*) The following are cases in which words have been held to be descriptive:—*Thomson* v. *Winchester*, 19 Pick. 214 ("Thomsonian Medicines"); *Fetridge* v. *Wells*, R. Cox, 180 ("Balm of Thousand Flowers"); *Wolfe* v. *Goulard*, 18 How. Pr. 64 ("Schiedam Schnapps"); *Burke* v. *Cassin*, 45 Cal. 467 (do.); *Wolfe* v. *Hart*, 4 Vict. L. R. Eq. 125 (do.); *Wolfe* v. *Alsop* (1), 10 Vict. L. R. Eq. 41 (do.); (2) 12 Vict. L. R. 421 (do.); *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 752 (do.); *Corwin* v. *Daly*, 7 Bos. 222 ("Club House Gin"); *Young* v. *Macrae*, 9 Jur. N. S. 322 ("Paraffin Oil"); *Phalon* v. *Wright*, 5 Phila. 464 ("Extract of Night-Blooming Cereus"); *Binninger* v. *Wattles*, 28 How. Pr. 206 ("Old London Dock Gin"); *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298 ("Liebig's Extract of Meat"); *Same* v. *Anderson*, W. N. 1883, p. 185 (do.); *Caswell* v. *Davis*, 58 N. Y. 223 ("Ferrophosphorated Elixir of Calisaya Bark"); *Town* v. *Stetson*, 4 Abb. Pr. N. S. 218 ("Desiccated Codfish"); *Canal Co.* v. *Clark*, 13 Wall. 311 ("Lackawanna" coal); *Choynski* v. *Cohen*, 39 Cal. 501 ("Antiquarian Book Store"); *Gray* v. *Koch*, 2 Mich. N. P. 119 ("Mammoth Wardrobe"); *In re Hauthaway* (1 and

anybody. It confers, upon certain conditions and under particular circumstances, rights which, but for the Act of Parliament, would not be as clearly asserted, but it takes

2), U. S. Pat. Comm. Decis. 1871, 97, 284 ("Beeswax Oil"); *In re Roberts* (4), *ib.* 100 ("Razor Steel"); *In re Blakeslee & Co.*, *ib.* 284 ("Cundurango Ointment. C. O."); *Ex parte Palmer*, *ib.* 289 ("Invisible Face Powder"); *Rowland* v. *Breidenbach*, Dig. 386 ("Macassar" oil); *James* v. *James*, L. R. 13 Eq. 421 ("Lieut. James' Horse Blister"); *Green* v. *Rooke*, W. N. 1872, p. 49 ("Golden Ointment"); *In re Johnson & Co.*, 2 U. S. Pat. Gaz. 315 ("Parsons' Purgative Pills, P. P. P." and "Johnson's American Anodyne Liniment, Established A.D. 1810"); *In re Graham*, 2 *ib.* 618 ("New Manny Harvester"); *In re Richardson*, 3 *ib.* 120 ("Richardson's Patent Union Leather-splitting Machine"); *In re The American Sardine Co.*, 3 *ib.* 495 ("American Sardines"); *Hardy* v. *Cutter*, 3 *ib.* 468 ("Old Bourbon" whiskey); *Tucker Manufacturing Co.* v. *Boyington*, 9 *ib.* 455 ("Tucker Spring Bed"); *Browne* v. *Freeman*, 12 W. R. 305 ("Chlorodyne"); *Bulloch, Lade & Co.* v. *Gray*, 19 Journ. of Jurisp. 218 ("Loch Katrine" whiskey); *Godillot* v. *Hazard*, 81 N. Y. 263 ("Julienne" soup); *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538 ("Tasteless" drugs); *In re Lawrence & Co.*, 10 *ib.* 163 ("Für Familien Gebrauch," and "Lawrence Feiner Familien Flannel"); *In re Roach*, 10 *ib.* 333 ("Croup Tincture"); *Gilman* v. *Hunnewell*, 122 Mass. 139 ("Cough Remedy"); *In re Goodyear Rubber Co.*, 11 U. S. Pat. Gaz. 1062 ("Crack-proof" indiarubber); *In re Warburg & Co.*, 13 *ib.* 44 ("Cachemire Milano"); *Ayer* v. *Rushton*, 7 Daly, 9 ("Cherry Pectoral"); *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453 ("Highly Concentrated Compound Fluid Extract of Buchu"); *In re Dole Brothers*, 12 U. S. Pat. Gaz. 939 ("Egg Macaroni"); *Siegert* v. *Findlater*, 7 Ch. D. 801 ("Angostura Bitters"); *In re Horsburgh*, 53 L. J. Ch. 237 ("Valvoline" oil); but see *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288; *In re Rader & Co.*, 13 U. S. Pat. Gaz. 596 ("Ironstone" water-pipes); *In re Saunion & Co.*, Dig. 625 ("Anglo-Portugo" oysters); *In re Brandreth*, Dig. 626 ("Porous" plasters); *Ex parte Safety Powder Co.*, 16 U. S. Pat. Gaz. 136 ("Safety" powder); *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337 ("Fairbanks' Patent"); *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834 ("Linoleum"); *Lazenby* v. *White*, 41 L. J. Ch. 354 ("Harvey's Sauce"); *Wotherspoon & Co.* v. *Gray & Co.*, Ct. Sess. Cas., 3rd Ser. II. 38 ("Victoria" lozenges); *Popham* v. *Wilcox*, 66 N. Y. 69 ("Prime Leaf" lard); *Sherwood* v. *Andrews*, 3 Amer. L. Reg. N. S. 588 ("Holbrook's School Apparatus"); *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115 ("Ammoniated Bone Superphosphate of Lime"); *Frese* v. *Bachof* (2), 14 Bl. C. C. 432 ("Hamburg" tea); *Ex parte Alden*, 15 U. S. Pat. Gaz. 389 ("Evaporated" articles of food); *Ex parte Marsching & Co.*, 15 *ib.* 294 ("French" paints); *Ex parte Cohn* (1), 16 *ib.* 680 ("Standard A" cigars); *Ex parte Cohn* (2), 16 *ib.* 680 ("Druggists' Sundries" cigars); *Ex parte Smith* (2), 16 *ib.* 679 ("Medicated Prunes"); *Ex parte Thompson, Derby & Co.*, 16 *ib.* 137 ("Swing" scythe-sockets); *Ex parte Smith* (3), 16 *ib.* 764 ("Masonic" cigars); *Ex parte Waeferling*, 16 *ib.* 764 ("Granulated Dirt-killer Soap"); *Lamplough* v. *Beedzler*, C. A., Nov. 12th, 1880 ("Pyretic Saline"); *Day* v. *Neale*, V. C. B., May 24th, 1881 ("White Chemical Extract," "Brown Chemical Extract," "Red Paste," "Red Drench," "Gaseous Fluid," etc.); *In re Price's Patent Candle*

nothing away. Any man who has a right to a trade mark has his trade mark just the same after the passing of the Trade Marks Registration Act as he had before. Only, if

Co., 27 Ch. D. 681 ("National Sperm" candles); *In re Hudson*, 32 Ch. D. 311 ("Carbolic Acid Soap Powder"); *In re Athins Filter & Engineering Co., Ld.*, 3 P. R. 164 ("The Sanitary Filter, easily cleaned"); *Native Guano Co., Ld.* v. *Sewage Manure Co.*, 4 Times L. R. 372 ("Native Guano"); *Schove* v. *Schmincke*, 33 Ch. D. 546 ("Castle Album"); *Watt* v. *O'Hanlon*, 4 P. R. 1 ("Old Innishowen" whiskey); *Symington & Co.* v. *Footman, Pretty & Co.*, 56 L. T. N. S. 696 ("Guaranteed Corset"); *In re Perry Davis & Son*, 58 L. T. N. S. 695 ("Pain-Killer" medicines); *In re Dunn*, 41 Ch. D. 439 ("Fruit Salt"); *In re Ralph*, 25 Ch. D. 194 ("The Homewasher"); *Roberts* v. *Sheldon*, 8 Biss. 398 ("Parabola"—eye needles); *Van Beil* v. *Prescott*, 82 N. Y. 630 ("Rye and Rock" liquor); *Marshall* v. *Pinkham*, 52 Wisc. 572 ("Old Dr. S. Marshall's Celebrated Liniment"); *Hostetter* v. *Adams*, 20 Bl. C. C. 326 ("Celebrated Stomach Bitters"); *Ex parte Brigham*, 20 *ib.* 891 ("Satin Polish" boots and shoes); *Ex parte Ams*, 23 *ib.* 344 ("Albany Beef"); *Ex parte Strasburger & Co.*, 20 *ib.* 155 ("Time-keeper" watches); *Ex parte Kipling*, 24 *ib.* 899 ("Cristalline" brilliants); *Electro Silicon Co.* v. *Levy*, 59 How. Pr. 469 ("Silicon" polishing powder); *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1 ("Hegeman's Ferrated Elixir of Bark, or Elixir of Calisaya Bark with Iron," "Hegeman's Compound Fluid Extract of Buchu," "Hegeman's, formerly Velpeau's, Celebrated Remedy for Diarrhœa"); *Goodyear Rubber Co.* v. *Goodyear India-rubber Glove Manufacturing Co.*, 128 U. S. Rep. 598 ("Goodyear Rubber"); *Moxie Nerve Food Co.* v. ——, 43 U. S. Pat. Gaz. 888 ("Nerve Food"); *Kerry* v. *Les Sœurs de l'Asile de la Providence*, 2 St. Dig. 726 ("Syrup of Red Spruce Gum"); *McCail* v. *Theal*, 28 Grant Up. Can. Ch. 48 ("Bazaar Patterns" for clothing); *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas. 4th Ser. XI. 506 ("Water of Ayr" stone); *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser. XIII. 1 ("Granolithic" artificial stone); *Lewis* v. *Klapproth*, 11 Vict. L. R. 214 ("Borax Soap"); *Dreydoppel* v. *Young*, 14 Phila. 226 (do.); *Hop Bitters Manufacturing Co.* v. *Luke*, 10 Vict. L. R. (Eq.) 234 ("Hop Bitters," said to be no more distinguishing than "Olive Oil" or "Buttermilk"); *Hop Bitters Manufacturing Co.* v. *Wharton*, 10 Vict. L. R. (L.) 377 (do.); *Larrabee* v. *Lewis*, 67 Ga. 561 ("Snowflake" biscuits); *Eggers* v. *Hink*, 63 Cal. 445 ("Philadelphia Beer"); *Ball* v. *Siegel*, 116 Ill. 137 ("Health Preserving" corset); *Humphreys' Specific, &c., Co.* v. *Wenz*, 14 Fed. Rep. 250 ("Homœopathic Specifics"); *Brown Chemical Co.* v. *Myer*, 31 Fed. Rep. 453 ("Iron Bitters"); *Carbolic Soap Co.* v. *Thompson*, 25 Fed. Rep. 625 ("Cresylic Ointment"); *Pratt Manufacturing Co.* v. *Astral Refining Co., Ld.*, 27 Fed. Rep. 493 ("Astral Oil"); *Alden* v. *Gross*, 25 Mo. App. 123 ("Fruit" vinegar); *Trask Fish Co.* v. *Wooster*, 28 Mo. App. 408 ("Selected Shore Mackerel"); *Rumford Chemical Works* v. *Muth*, 35 Fed. Rep. 524 ("Acid Phosphate"); *Colgan* v. *Danheim*, 35 Fed. Rep. 150 ("Toffy Tolu"). And see cases as to "fancy words," *supra*, p. 46.

Distinctive words.

In the following cases descriptiveness has either not been alleged or has been held not to be established, and the words have been treated as distinctive words:—*Pidding* v. *How*, 6 Sim. 477 ("Howqua's Mixture"); *Perry* v. *Truefitt*, 6 Beav. 66 ("Medicated Mexican

the persons enjoying the trade mark have been so numerous that it is impossible to say that any of them, or all of them together, had an exclusive right to it, then they

Balm"); *Taylor* v. *Carpenter* (1), 3 Story, 458 ("Persian Thread"); S. C. (2) 2 Wood. & M. 1 (do.); S. C. (3) 2 Sandf. Ch. 603 (do.); *Taylor* v. *Taylor*, 2 Eq. Rep. 290 (do.); *Hine* v. *Lart*, 10 Jur. 106 ("Ethiopian" stockings); *Fowle* v. *Spear*, 7 Penn. L. J. 176 ("Wistar's Balsam of Wild Cherry"); *Coffeen* v. *Brunton* (1), (2), 4 McLean, 516; 5 *ib.* 256 ("Chinese Liniment"); *Davis* v. *Kendall*, 2 R. I. 566; ("Pain-Killer" medicine); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 (do.), (but see *In re Perry Davis & Son*, 58 L. T. N. S. 695); *R.* v. *Dundas*, 6 Cox, 380 ("Everett's Premier" blacking); *Heath* v. *Wright*, R. Cox, 154 ("Kathairon"); *Fetridge* v. *Merchant*, 4 Abb. Pr. 156 ("Balm of Thousand Flowers"); *Williams* v. *Johnson*, 2 Bos. 1 ("Yankee Soap"); *Williams* v. *Spence*, 25 How. Pr. 366 (do.); *Williams* v. *Adams*, 8 Biss. 452 (do.); *Comstock* v. *White*, 18 How. Pr. 421 ("Dr. Morse's Indian Root Pills"); *Braham* v. *Bustard*, 1 H. & M. 447 ("Excelsior" soap); *McAndrew* v. *Bassett*, 4 De G. J. & S. 380 ("Anatolia" liquorice); *Faber* v. *Hovey*, Dig. 481 ("Star" pencils); *Billet* v. *Carlier*, 61 Barb. S. C. 435 ("Grenade" syrup); *Smith* v. *Woodruff*, 48 Barb. 438 ("Sweet Opoponax of Mexico" perfume); *Burnett* v. *Phalon*,, 3 Keyes, 594 ("Cocoaine" hair oil); *Messerole* v. *Tynberg*, 4 Abb. Pr. N. S. 410 ("Bismarck" collars); *Rowley* v. *Houghton*, 2 Brews. 303 ("Hero" jars); *Palmer* v. *Harris*, 60 Penn. St. 156 ("Golden Crown" cigars); *Filley* v. *Fassett*, 44 Mo. 173 ("Charter Oak" stoves); *Filley* v. *Child*, 16 Bl. C. C. 376 (do.); *Lockwood* v. *Bostwick*, 2 Daly, 521 ("Bovilene" pomado); *Congress & Empire Spring Co.* v. *High Rock Congress Spring Co.*, 45 N. Y. 291 ("Congress Spring" water); *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115 ("Eureka" manure); *Ford* v. *Foster*, L. R. 7 Ch. 611 ("Eureka" shirts); *Seltzer* v. *Powell*, 8 Phila. 296 ("Silver Grove" whiskey); *In re Francis & Mallon*, U. S. Pat. Comm. Decis. 1871, 283 ("Beaverine" boots); *Blackwell* v. *Armistead*, 5 Am. L. T. 85 ("Durham" tobacco); *Armistead* v. *Blackwell*, 1 U. S. Pat. Gaz. 603 (do.); *Blackwell* v. *Wright*, 73 N. Car. 310 (do.); *Blackwell* v. *Dibrell*, 14 U. S. Pat. Gaz. 633 (do.); *Hirst* v. *Denham*, L. R. 14 Eq. 542 ("Turin," "Sefton," "Leopold," "Liverpool," cloth); *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120 ("Centennial" clothing); *In re Bush & Co.*, 10 *ib.* 164 ("Centennial" wines); *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 *ib.* 337 ("Magnolia," "Dave Jones" whiskey); *Morse* v. *Worrell*, 10 Phila. 168 ("Rising Sun" stove polish); *Cotton* v. *Gillard*, 44 L. J. Ch. 90 ("Licensed Victuallers' Relish"); *Smith* v. *Mason*, W. N. 1875, p. 62 ("Pectorine" medicine); *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627 ("Gouraud's Oriental Cream"); *In re Glines*, 8 U. S. Pat. Gaz. 435 ("Slate Roofing Paint"); *In re Green*, 8 *ib.* 729 ("German Sirup"); *In re Weaver*, 10 *ib.* 1 ("Lion" goods); *Grillon* v. *Guénin*, W. N. 1877, p. 14 ("Tamar Indien" lozenges); *Carnrick* v. *Morson*, Dig. 543 ("Lactopeptine" medicine); *In re Cornwall* (2), 12 U. S. Pat. Gaz. 312 ("Dublin" soap); *Eno* v. *Stephens*, Dig. 609 ("Fruit Salt"), but see *In re Dunn*, 41 Ch. D. 439; *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Rosing* v. *Athinson*, 27 Sol. J. 534 ("Edelweiss" perfume); *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70 ("Tivoli" lager beer); *In re Porter Blanchard's Sons*, U. S. Pat. Comm. Decis. 1871, 97 ("Blanchard Churn"); *In re Rohland*, 10 U. S. Pat. Gaz. 980 ("Dr. Lobenthal's Essentia Anti-

shall not have the benefit of the registration, which would give an exclusive right" (*a*). Common marks may, however, now be registered as additions to good trade marks, if an exclusive right in them is disclaimed (*b*). If the name is descriptive, the addition of "new" or "improved" does not better the case (*c*), nor that of initials representing the name of the goods (*d*), or of a mere oval border (*e*).

Name not distinctive.

Again, where a mark, though not descriptive, yet does not serve to distinguish the person using it from a number of other persons who use or are entitled to use it, it cannot be a valid trade mark, since it is common, if not to the whole world, at all events to a class of persons. Thus "prize medal" (*f*), "gold

phthisica"); *Sorg* v. *Welsh*, 16 U. S. Pat. Gaz. 910 ("Tidal Wave" tobacco); *In re Eastman*, W. N. 1880, p. 128 ("Kitchen Crystal Soap"); *Burton* v. *Stratton*, 12 Fed. Rep. 696 ("Twin Brothers" yeast); *Hier* v. *Abrahams*, 82 N. Y. 519 ("Pride" cigars); *Insurance Oil-tank Co.* v. *Scott*, 33 La. Ann. 946 ("Insurance" oil); *Smith* v. *Sixbury*, 32 N. Y. Sup. Ct. 232 ("Magnetic Balm"); *Ex parte Heyman*, 18 U. S. Pat. Gaz. 922 ("Invigorator" spring bed-bottoms); *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 ("Valvoline" oil); *Leonard & Ellis* v. *White's Golden Lubricator Co.*, 48 U. S. Pat. Gaz. 1401 (do.), (but see *In re Horsburgh*, 53 L. J. Ch. 237); *Atlantic Milling Co.* v. *Robinson*, 20 Fed. Rep. 217 ("Champion" flour); *Ex parte Wiesel*, 36 U. S. Pat. Gaz. 689 ("Kollerina"); *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183 ("Grand Master" cigars); *Holt* v. *Menendez*, 128 U. S. Rep. 182 ("La Favorita" flour); *Lyman* v. *Burns*, 47 U. S. Pat. Gaz. 660 ("Pigs in Clover" game); *Selchow* v. *Baker*, 93 N. Y. 59 ("Sliced Animals" toys); *Electro-Silicon Co.* v. *Hazard*, 36 N. Y. Sup. Ct. 369 ("Electro-Silicon" polishing powder); *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576 ("Anti-Washboard" soap); *Funke* v. *Dreyfus*, 34 La. Ann. 80 ("Boker's Stomach Bitters"); *Hoxie* v. *Chaney*, 143 Mass. 592 ("A. N. Hoxie's Mineral Soap," "A. N. Hoxie's Pumice Soap"); *Hecht* v. *Porter*, 9 Pac. C. L. J. 569 ("Ironclad" boots); *Sheppard & Co.* v. *Stuart & Peterson*, 13 Phila. 117 ("Excelsior" stoves); *Lafferty* v. *Wheeler*, 63 How. Pr. 488; 11 Daly, 194 ("Alderney" oleo-margarine).

(*a*) Per Bacon, V.-C., in *Benbow* v. *Low* (4), 44 L. T. N. S. 875.

(*b*) Patents Act, 1883, § 74.

(*c*) *In re Graham*, 2 U. S. Pat. Gaz. 618. See *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306; *Russia Cement Co.* v. *Le Page*, 147 Mass. 206; *Alexander* v. *Morse*, 14 R. I. 153; *Humphreys' Specific, &c., Co.* v. *Wenz*, 14 Fed. Rep. 250.

(*d*) *In re Blakeslee & Co.*, U. S. Pat. Comm. Decis. 1871, 284; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538.

(*e*) *In re Rader & Co.*, 13 U. S. Pat. Gaz. 596.

(*f*) *Batty v. Hill*, 1 H. & M. 264. See *Roper's, &c., Co.* v. *Copeman's, &c., Association, Ld.*, 28 Sol. J. 218. And see *Schneider* v. *Williams*, 44 N. J. (Eq.) 391, and *Ex parte Cigar Makers' Association*, 16 U. S. Pat. Gaz. 958, with which compare *Strasser* v. *Moonelis*, 108 N. Y. 611;

medal" (*a*). The objection, however, will not prevail where the class is very limited (*b*).

Adjective denoting quality only, no trade mark.

"Terms which designate merely the name, quality, kind, size, number, or elements of an article, or have become its proper appellation, or that merely describe it, or direct the mode of its use, purely generic and geographical terms, and the necessary and common uses in which the English language and arabic numerals are employed by people to express their ideas and feelings and to tell the truth, are common property which all may use, but which none may exclusively appropriate as a trade mark, or acquire as absolute individual property" (*c*). Consequently, an ordinary adjective in the common language of the country, descriptive of the quality of the article, and not designating it to be of the manufacture of a certain individual or establishment, as "superior" (*d*), "superfine" (*d*), "nourishing" (*e*), cannot be exclusively appropriated as a trade mark. And the same is the case with a word or symbol which is understood generally, or in the trade, to indicate quality and not a special manufacturer. Thus "A, No. 1," "A X, No. 1" (*f*), "A 1" (*g*), "Best six-cord"—"200 yds." (*h*).

Allen v. *Macarthy*, 37 Minn. 347, and *People* v. *Fisher*, 57 N. Y. Sup. Ct. 552.

(*a*) *Taylor* v. *Gillies*, 59 N. Y. 331.

(*b*) *Dent* v. *Turpin*, 2 J. & H. 139. And see p. 118, note (*g*).

(*c*) Per Kentucky Court of Appeal in *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027.

(*d*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*e*) *Raggett* v. *Findlater*, L. R. 17 Eq. 29; and see *Spottiswoode* v. *Clarke*, 1 Coop. 254; *Gillott* v. *Esterbrook*, R. Cox, 353; *Ex parte Palmer*, U. S. Pat. Comm. Decis. 1871, 289; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538; *In re Goodyear Rubber Co.*, 11 *ib.* 1062; *Fulton* v. *Sellers*, 4 Brews. 42; *Ex parte Cohn* (1), 16 U. S. Pat. Gaz. 680; *Royal Baking Powder Co.* v. *Sherrill*, 93 N. Y. 331; *Smith* v. *Imus*, 32 Alb. L. J. 455; *Smith* v. *Walker*, 37 Mich. 456.

(*f*) *Candee, Swan & Co.* v. *Deere & Co.*, 54 Ill. 439; 5 Amer. Rep. 125; and see *Amoskeag Manufacturing Co.* v. *Spear*, 2 Sand. S. C. 599; R. Cox, 87; *Same* v. *Trainer*, 101 U. S. Rep. 51; *Burke* v. *Cassin*, 45 Cal. 467; 13 Amer. Rep. 204; *Stokes* v. *Landgraff*, 17 Barb. 608; R. Cox, 137; *Kinney* v. *Allen*, 1 Hughes, 106; *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981; *Osgood* v. *Allen*, 1 Holmes, 185; *Carver* v. *Bowker*, Dig. 581; *Avery* v. *Meikle*, 27 U. S. Pat. Gaz. 1027; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776.

(*g*) *Rogers* v. *Rogers*, 53 Conn. 121.

(*h*) *Coats* v. *Merrick Thread Co.*, 45 U. S. Pat. Gaz. 347.

Marks denoting maker as well as quality.

But in some of the American cases this principle appears to have been carried to an extent which is unreasonable, and which has not been and would not be recognised in this country, the rule having been laid down too generally that every word or symbol which serves to indicate quality is incapable of appropriation as a trade mark, the qualification being omitted that, if such word or symbol also serves to indicate a particular manufacturer, the mark may be a good trade mark. In *Amoskeag Manufacturing Co.* v. *Trainer* (*a*) the Supreme Court of the United States itself appears to have decided in favour of the wider rule. There the plaintiff company manufactured cotton tickings, and sold the different qualities under different labels, of which the one affixed to the best quality of the goods bore a combination device, in which the prominent and conspicuous feature consisted of the letters "A. C. A." Those letters had for many years been recognised as indicating that the goods to which they were attached were of the plaintiff company's manufacture, and also of the best quality of the goods so manufactured, and the plaintiffs' user of the letters had been substantially exclusive. In an action, however, brought against defendants who had sold similar goods of their own make under a label containing the same letters in a conspicuous place, the Supreme Court held that, the letters being indicative of quality, no protection could be given. All trade marks, however, which are of any value at all, denote that the goods to which they are attached are of good quality, and by far the greater number of large manufacturing firms use a variety of trade marks, which they apply to goods of different descriptions or qualities, or intended for different markets; and possibly the explanation of the decision may be that the Court really considered that the letters, though

(*a*) 101 U. S. Rep. 51. And see *Royal Baking Powder Co.* v. *Sherrill*, 93. N. Y. 331.

only used by the plaintiffs, indicated nothing beyond quality (*a*).

Such marks valid.

It seems clear that the English rule that combinations of letters, or words, or symbols, which indicate that the goods to which they are applied have been manufactured by a particular person or firm, may constitute valid and registrable trade marks, notwithstanding that they also indicate the quality or pattern of the goods as compared with other goods of the same makers (*b*), is preferable to that which appears to have been formulated in some of the American Courts. Thus, in *Hirst* v. *Denham* (*c*), different fancy patterns of the plaintiff's cloth were marked with different names, each of which was protected; in *Moses* v. *Sargood, Ewen & Co.* (*d*), the plaintiff's clothing was marked with a number of crowns, varying from one to six, according to quality; in *Ransome* v. *Graham* (*e*) the plaintiff's ploughs were marked with the letters "R. N." and an additional letter or numeral, varied according to pattern and quality (*f*). In the Indian case of *Taylor* v. *Virasami* (*g*) the plaintiffs' shirtings were marked with scimitars, varying in number from two to five, according to quality. Even in some of the American Courts the English rule has been recognised, and it was well stated by the Supreme Court of Rhode Island (*h*) as follows:—"Undoubtedly, if it be assumed that a given mark indicates quality only, and not origin, it will follow that purchasers of goods so marked have not been misled thereby into the supposition that they were

(*a*) See *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338.

(*b*) *Ransome* v. *Graham*, 51 L. J. Ch. 897.

(*c*) L. R. 14 Eq. 542.

(*d*) Dig. 636.

(*e*) 51 L. J. Ch. 897.

(*f*) And see *In re Brook*, 26 W. R. 791; *Mitchell* v. *Henry*, 15 Ch. D. 181; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Barlow & Jones, Ld.* v. *Johnson & Co.*, 34 Sol. J. 298; affirmed by C. A., W. N., 1890, p 110; and per Pearson, J., in *Wood* v. *Lambert*, 32 Ch. D. 247; and the American cases of *Lawrence Manufacturing Co.* v. *Lowell*, 129 Mass. 325; *Godillot* v. *Hazard*, 81 N. Y. 263, per Danforth, J.; *Sohl* v. *Geiscndorf*, 1 Wils. (Ind.) 60; *Merry* v. *Hoopes*, 111 N. Y. 415.

(*g*) Ind. L. R. 6 Mad. 108.

(*h*) In *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338.

buying a plaintiff's goods, and hence he would show no cause for relief. . . . But it by no means follows as a rule of law that marks indicating style or quality may not also indicate origin, and thus be a subject of trade mark. . . . A person may have different symbols for different grades of goods, which will indicate both quality and origin with respect to the goods so marked. A manufacturer may adopt such symbols, not simply to mark a style or quality, but *his* style and *his* quality as well. He is entitled to have his style and his quality protected from misrepresentation, and to have the benefit of any favourable reputation they may have gained."

Marks denoting quality in only one trade.

If a word or symbol is only indicative of quality in a particular trade, it seems that it may be used as a trade mark in a different trade (*a*).

Deceptive marks.

Again, a trade mark which contains false representations, so as to deceive the public, will not be protected in equity as a valid trade mark (*b*), and cannot be registered as such under the Patents Acts, 1883-8 (*c*). In short, as was said by Wallace, J., in *Ginter* v. *Kinney Tobacco Co.* (*d*), "no principles are better settled in the law of trade marks than that a generic name, or a name merely descriptive of the ingredients, quality, or characteristics of an article of trade, cannot be the subject of a trade mark; and that the use of a name or term which is likely to deceive the public in reference to the components or nature of the article to which it is applied will not be tolerated." But mere collateral misrepresentations do not disqualify (*e*).

Marks which are either descriptive or deceptive.

An attempt has occasionally been made to meet the contention that a word claimed as a trade mark is incapable of appropriation by reason of its descriptiveness,

(*a*) *In re English*, U. S. Pat. Comm. Decis. 1870, 142.

(*b*) *Pidding* v. *How*, 8 Sim. 477; *Perry* v. *Truefitt*, 6 Beav. 66; *Flavel* v. *Harrison*, 10 Hare, 467; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; *Morgan* v. *McAdam*, 36 L. J. Ch. 228; *Connell* v. *Reed*, 128 Mass. 477; and see c. 7, *infrà*.

(*c*) See § 73.

(*d*) 12 Fed. Rep. 782.

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

by the allegation that the goods to which it is applied do not answer the description imported by the word, and therefore that the word is not, in fact, descriptive of the goods. But in cases where a word is used which is descriptive of qualities which the goods might reasonably be supposed to possess, if the goods do not possess those qualities the use of the word is deceptive, so that *quâcunque viâ* the claim fails. Thus, in *In re Saunion & Co.* (*a*), the late Master of the Rolls refused registration to the words "Anglo-Portugo Oysters," on the ground that if the oysters were Anglo-Portuguese the use of the term was descriptive, while, if they were not, it was deceptive. And the same view was adopted by Lopes, L. J., in *In re Van Duzer* (*b*). There are many American authorities to the same effect (*c*). But if the term claimed is one which is notoriously inappropriate to the article, it will not be treated as deceptive. Thus the name "Edelweiss" was allowed to be appropriated to scent not derived from that flower, it being well known that the edelweiss yields no perfume (*d*).

Extravagance an advantage in word trade marks.

It may be stated as a general rule that the more extraordinary and extravagant the name that is adopted by way of trade mark, the better will the object be attained, and the protection of the Courts and of the Registration Office secured; for the more uncommon the designation is, the less obnoxious is the exclusive claim of the manufacturer, and the more conclusive the evidence of fraud supplied by an infringement. Thus, Wood, V.-C., said, "I have

(*a*) Dig. 625.

(*b*) 34 Ch. D. 631. Compare *Free Fishers & Dredgers of Whitstable* v. *Elliott*, W. N. 1888, p. 27.

(*c*) *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337 ("Fairbanks' Patent"); *In re American Sardine Co.*, 3 U. S. Pat. Gaz. 495 ("American Sardines"); *In re Dole Brothers*, 12 *ib.* 939 ("Egg Macaroni"); *In re Warburg & Co.*, 13 *ib.* 44 ("Cachemire Milano" silks); *Ex parte Marsching & Co.*, 15 *ib.* 294 ("French" paints); *Ex parte Knapp*, 16 *ib.* 318 ("London" animal foods); *Ex parte Farnum & Co.*, 18 *ib.* 412; ("Lancaster" tickings); *Ginter* v. *Kinney Tobacco Co.*, 12 Fed. Rep. 782 ("Straight-cut" cigarettes). With which compare *In re Green*, 8 U. S. Pat. Gaz. 729 ("German Sirup"); *In re Cornwall* (2), 12 *ib.* 312 ("Dublin" soap).

(*d*) *Rosing* v. *Atkinson*, 27 Sol. J. 534.

not the least doubt that if the plaintiff (if I doubted I should be going quite contrary to the Mexican Balm case and other cases in which ridiculous names have been used) had invented a fanciful and ridiculous name—and the more ridiculous, the better it is for his purpose—and had used it for eight or ten years in his trade, the Court would take care that nobody else should use that absurd name; for such user could only be a user for the express purpose of imitating the plaintiff's, and so defrauding the plaintiff, by representing goods manufactured by one person to be goods manufactured by another" (*a*).

Words specially invented.

In many cases the word used as a trade mark is an entirely new word, invented for the occasion by the manufacturer of the material or composition to which it is applied, and such a name may be registered and otherwise treated as a valid trade mark (*b*). Thus "Pectorine" (*c*) and "Lactopeptine" (*d*) were protected as names for medical compounds; "Cocoaine" (*e*) and "Bovilene" (*f*) for pomades. "Chlorodyne" (*g*) was only not protected because the proprietor, on a mistaken view of his rights, consented to have his bill for an injunction dismissed with costs. Invented words (*h*) were, however, occasionally refused registration as "fancy words" under § 64 of the Act of 1883, where they were considered to suggest a description of the article—*e.g.*, "Washerine"

(*a*) *Young* v. *Macrae*, 9 Jur. N. S. 322; and see *Ketridge* v. *Merchant*, 4 Abb. Pr. 156; R. Cox, 194.

(*b*) See Patents Act, 1883, § 64, as amended by the Act of 1888.

(*c*) *Smith* v. *Mason*, W. N. 1875, p. 62.

(*d*) *Carnrick* v. *Morson*, L. J. N. of C. 1877, p. 71.

(*e*) *Burnett* v. *Phalon*, 9 Bos. 192; R. Cox, 376.

(*f*) *Lockwood* v. *Bostwick*, 2 Daly, 521; R. Cox, 555.

(*g*) *Browne* v. *Freeman*, 12 W. R. 305.

(*h*) *In re Francis & Mallon*, U. S. Pat. Comm. Decis. 1871, 283 ("Beaverine" boots and shoes); *Enoch Morgan's Sons' Co.* v. *Schwachhofer*, 55 How. Pr. 37, and *same* v. *Hunkele*, 16 U. S. Pat. Gaz. 1092 ("Sapolio" soap); *Electro-Silicon Co.* v. *Trask*, 59 How. Pr. 189 ("Electro-silicon"); *Electro-Silicon Co.* v. *Hazard*, 36 N. Y. Sup. Ct. 369 (do.) And see *Young* v. *Macrae*, 9 Jur. N. S. 322, in which "Paraffin Oil," *Lamplough* v. *Balmer*, W. N. 1867, p. 293, in which "Pyretic Saline," and *Wolfe* v. *Goulard*, 18 How. Pr. 64, R. Cox, 226, in which "Schiedam Schnapps," was not protected for special reasons only.

soap (*a*), "Monobrut" champagne (*b*); and Jessel, M. R., treated "Valvoline" oil as descriptive (*c*), though Lord Selborne (*d*) and a United States circuit judge (*e*) have thought differently.

Existing words composing a word trade mark.

In many other cases the trade mark consists, not of a newly coined word, but of a word, or a combination of words, already in common use, but which for the purpose of the trade mark is or are used and applied in a manner quite different from the ordinary use and application, so different that it is seen at the first glance that the word or combination of words is or are being used quite out of the common signification, and in the nature of a fancy name designatory of the goods (*f*). Thus, "Pharaoh's Serpents" (*g*), applied to a toy; "The Licensed Victuallers' Relish" (*h*), to a sauce; "Turin," "Sefton," "Leopold," and "Liverpool" (*i*), to cloth; "United Service" (*k*) and "Genuine Yankee" (*l*), to soap; "Sweet Opoponax of

(*a*) *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274.

(*b*) *In re Vignier*, 61 L. T. N. S. 495.

(*c*) *In re Horsburgh*, 53 L. J. Ch. 237.

(*d*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

(*e*) *Leonard & Ellis* v. *White's Golden Lubricator Co.*, 48 U. S. Pat. Gaz. 1401.

(*f*) See *Newman* v. *Alvord*, R. Cox, 413, in which Daniels, J., said that "any member of the community, whose interests and business may be promoted by doing so, should be at liberty to apply even names and words in common use to the products of his industry, in such a manner as to indicate their origin or particular manufacture, where such application will not intrench upon and will be in no way included in their use by the public. By doing so, the rights of no member of the community can be in any manner infringed, and no public inconvenience whatever can be occasioned by it. The public will still be left at full liberty to use such words or terms as they were used before; while for a special purpose a new office or purpose may be imposed upon them;" *Osgood* v. *Allen*, 1 Holmes, 185, in which Shepley, J., said that "words or devices may be adopted as trade marks, which are not original inventions of the one who adopts and uses them. Words in common use may be adopted, if at the time of adoption they were not used to designate the same or similar articles of production;" and *Lea* v. *Wolff*, 15 Abb. Pr. N. S. 1; *Ex parte Palmer*, U. S. Pat. Comm. Decis. 1871, 289; *M'Lean* v. *Fleming*, 96 U. S. Rep. 245; *Smith* v. *Woodruff*, 48 Barb. 438; and *Ex parte Halliday Brothers*, 16 U. S. Pat. Gaz. 500.

(*g*) *Barnett* v. *Leuchars*, 13 L. T. N. S. 495.

(*h*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90.

(*i*) *Hirst* v. *Denham*, L. R. 14 Eq. 542.

(*k*) *Field* v. *Lewis*, Dig. 280.

(*l*) *Williams* v. *Johnson*, 2 Bos. 1; R. Cox, 214; *Williams* v. *Spence*, 25 How. Pr. 366; R. Cox, 305.

Mexico" (*a*) and "Balm of Thousand Flowers" (*b*), to perfume; and "Charter Oak" to stoves (*c*).

Inscriptions or advertisements.

Occasionally it has been sought to protect as a trade mark, and to claim exclusive rights in, an inscription or advertisement composed of ordinary English words, used in their ordinary sense, and only peculiar from the length of the sequence. Usually, indeed, there is in such cases some feature which might be really distinctive, but of which the plaintiff, for some reason or other, is unable to avail himself; this failing, the whole inscription is claimed. Such cases, however, are in fact "advertisements of the character and quality of the goods" (*d*), in which advertisements no exclusive rights can be claimed, as was expressly decided by the Court of Appeal in *Cheavin* v. *Walker* (*e*),

(*a*) *Smith* v. *Woodruff*, 48 Barb. 438; R. Cox, 373.

(*b*) *Fetridge* v. *Merchant*, 4 Abb. Pr. 156; R. Cox, 194; but see *Fetridge* v. *Wells*, 13 How. Pr. 385; R. Cox, 180.

(*c*) *Filley* v. *Fassett*, 44 Mo. 173; R. Cox, 530; *Filley* v. *Child*, 16 Bl. C. C. 376. And see *Weston* v. *Hemmons*, 2 Viet. L. R. Eq. 121 ("Wizard" oil); *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120 ("Centennial" clothing); *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 *ib.* 337 ("Magnolia" whiskey); *Kidd* v. *Johnson*, 100 U. S. Rep. 617 (do.); *In re Glines*, 8 U. S. Pat. Gaz. 435 ("Slate Roofing Paint"); *In re Kimball*, 11 *ib.* 1109 ("Vanity Fair" cigarettes); *Marcovitch* v. *Bramble, Wilkins & Co.*, Dig. 595 (do.); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 ("Pain-Killer" medicine); *Faber* v. *Hovey*, Dig. 481 ("Star" pencils); *Ex parte Peper*, 16 U. S. Pat. Gaz. 678 ("Corn" tobacco); *Wright* v. *Simpson*, 15 *ib.* 968 ("Pond Lily Wash"); *Crawford* v. *Shuttock*, 13 Grant Up. Can. Ch. 149 ("Imperial" soap); *Degraves* v. *Whiteman*, 5 Viet. L. R. Eq. 304 ("Cascade" ale); *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183 ("Grand Master" cigars); *Hecht* v. *Porter*, 9 Pac. C. L. J. 569 ("Ironclad" boots). But where the name "Astral Lamp" had been long in use for a particular kind of oil lamp, it was held that no exclusive right could be acquired in the word "Astral" as applied to oil. *Pratt Manufacturing Co.* v. *Astral Refining Co., Ld.*, 27 Fed. Rep. 493.

(*d*) Per Lord Westbury, C., in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523, which see.

(*e*) 5 Ch. D. 850. And see *Blackwell* v. *Crabb*, 36 L. J. Ch. 504; *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115 ("Ammoniated Bone Superphosphate of Lime"); *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453 ("Highly Concentrated Compound Fluid Extract of Buchu"); *In re Johnson & Co.*, 2 U. S. Pat. Gaz. 315 ("Johnson's American Anodyne Liniment, Established A.D. 1810"); *Gilman* v. *Hunnewell*, 122 Mass. 139 ("A sure remedy for chronic or common cough, sore throat, and other minor throat complaints, so often by neglect the forerunner of consumption").

where the inscription was "G. Cheavin's improved patent, gold-medal, self-cleaning, rapid water filter, Boston, England," the name Cheavin having become indicative of a principle of construction. In *Shrimpton* v. *Laight* (*a*), the use of the words "graduated, grooveless, drill-eyed, ground-down" needles was also accompanied by that of the maker's name, and this being obviously imitated by the defendant, the injunction was granted.

Words taken from the dead languages.

Sometimes a word taken from a dead language has been applied to goods and protected as a valid trade mark, as the Latin word "Excelsior" in respect of soap (*b*), or stoves (*c*); or the Greek word "Eureka" on shirts (*d*), or on an agricultural compost (*e*).

Or from modern foreign languages.

In some instances words taken from modern foreign languages have been protected, though the precise extent to which trade marks so composed will be acknowledged has not yet been authoritatively decided. Where the name employed is a fancy name which happens to be in a foreign language, or framed in imitation of the forms of a foreign language, there is no doubt that there is just as good a trade mark as if it had been in English or framed on English forms; thus, "Flor Fina Prairie Superior Tabac" (*f*) was allowed to be a good trade mark, though the defendant was held not to have infringed; and "Tamar

(*a*) 18 Beav. 164. And see *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402; R. Cox, 490, where an injunction was given. In *Roberts* v. *Sheldon*, 8 Biss. 398, the plaintiffs used the words "Roberts' Parabola Gold-Burnished Sharps" on his needles, and the defendant was restrained from using the words "William Clark & Sons' Parabola Gold-Burnished Sharps." In *In re Roberts* (1), (2), (3), U. S. Pat. Comm. Decis. 1871, 113, 100, 101, the following were registered as trade marks:—"A luxury—R. J. Roberts' Razor-Steel Scissors. The best in the world. The best is the cheapest. For sale here;" "An exquisite pleasure to shave with R. J. Roberts' Diamond-Edged Razors;" "R. J. Roberts' Diamond-Edge Razor. Every razor warranted."

(*b*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*c*) *Sheppard & Co.* v. *Stuart & Peterson*, 13 Phila. 117.

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

(*e*) *Allegheny Fertiliser Co.* v. *Woodside*, 1 Hughes, 115. See *Raggett* v. *Findlater*, L. R. 17 Eq. 29.

(*f*) *Cope* v. *Evans*, L. R. 18 Eq. 138.

Indien" (*a*) was actually protected. In *In re Rotherham* (*b*), an Arabic word, used by way of a pun, was held to be entitled to registration as a good trade mark, though the Commissioners of Patents had directed the registrar to the contrary.

Foreign words in their ordinary signification. *Gout* v. *Aleploglu*.

When, however, the foreign words are used in their ordinary sense, or in a sense not widely remote therefrom, the case is different. In *Gout* v. *Aleploglu* (*c*), the plaintiff was a maker of watches for the Turkish market. These watches he marked in Turkish with his own name (Ralph Gout) with the word "Pessendede," "warranted"), with his initials "R. G." and a crescent, and also with a sprig and crescent. The defendant procured watches to be made, in which the minor features of the marks used by the plaintiff were omitted, but in which the main characteristics, the name ("Ralph Gout") and the word "Pessendede," in Turkish characters, were reproduced, the style of engraving being copied. Such watches were then sent by the defendant to Constantinople, and there sold, to the prejudice of the plaintiff's business. This was a clear case of fraud, and so it was held to be by the Vice-Chancellor of England, Sir L. Shadwell, who, however, did express an opinion that the plaintiff had acquired an exclusive right in the word "Pessendede" (*d*). But the point that had to be decided was not simply whether the word "warranted," in Turkish, could be protected; and indeed, when it is considered that the watches were to be sold in Turkey, the case does seem to be just the same as if the word had been engraved in English on watches to be sold in this country, when such a proposition would be clearly untenable. But not only the word, but the manner of engraving it was copied, and not only that word,

(*a*) *Grillon* v. *Guénin*, W. N. 1877, p. 14; and see *Caruncho* v. *Stephenson*, 25 Sol. J. 929 ("Intimidad" cigars); *Holt* v. *Menendez*, 128 U. S. Rep. 182 ("La Favorita" flour).

(*b*) 14 Ch. D. 585.

(*c*) 6 Beav. 69; 5 Leg. Obs. 496.

(*d*) 5 Leg. Obs. 496.

but the name of the maker; and what the Vice-Chancellor actually decided was that here there was a clear case of attempted fraud, which was quite sufficient ground for the issue of an injunction, without its being necessary to consider whether the imitation of one single feature would have been sufficient to entitle the plaintiff to that remedy. The use of the name "Ralph Gout" alone by the defendant, whose own name was entirely different, would indeed have been sufficient to entitle the plaintiff to an injunction (*a*), but the case with respect to "Pessendede" was different.

Broadhurst v. *Barlow*.

In *Broadhurst* v. *Barlow* (*b*), the case was again a far more complicated one than that of a single foreign word, or even a succession of words taken from the same foreign language. Here the plaintiffs were spinners and manufacturers at Manchester and Bolton, who exported to the East large quantities of pieces of Spanish shirting, which they marked with their proper trade mark, a lion in a border, and with the words "Spanish shirting" in a scroll, and "No. 120." To this they had added "exactly 12 yards," in Turkish, Armenian, and Greek, the same statement being repeated in the three languages, placed one below the other (*c*). The defendants were discovered to be preparing Spanish shirting for export, similarly marked, except that there were five lines instead of four, and that an elephant was used in place of the lion. Wickens, V.-C., held that "though an elephant was used by the defendants, the three sentences in the same languages in the same order was an infringement of the plaintiffs' rights," and he therefore granted the injunction to restrain the use of the words in the three languages in the order used by the plaintiffs.

(*a*) See per Sir G. Turner, L. J., in *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Perks* v. *Hall & Co.*, W. N. 1881, p. 111.

(*b*) W. N. 1872, p. 212; and L. J. N. of C., 1872, p. 183.

(*c*) In *Curtis* v. *Bryan*, 2 Daly, 212; R. Cox, 434, a label was used, with an inscription in English, French, German, and Spanish; and see *Siegert* v. *Findlater*, 7 Ch. D. 801, and *Siegert* v. *Ehlers*, Dig. 432.

Conclusion.

The true principle appears to be that, while foreign words employed in their ordinary signification may, even when used on goods intended for consumption in the country where that foreign language is spoken, form a part of a combination trade mark, the infringement of which will be restrained, the exclusive use of such words themselves, apart from fraud, will not be protected in this country, any more than that of an ordinary English adjective (*a*). In an American registration case (*b*) it was sought to register the German words "Für Familien Gebrauch," and "Lawrence Feiner Familien Flannel," meaning respectively "For Family Use" and "Lawrence Fine Family Flannel"; but the application was refused, on the ground of descriptiveness. In *Rillet* v. *Carlier* (*c*) it was indeed held that an American maker of pomegranate syrup had acquired an exclusive right in America to the term "Grenade Syrup," though "Grenade" was the ordinary French word for pomegranate, and the term "Grenade Syrup" was in common use in France. In this case, however, there were elements of fraud, and actual fraud will always be restrained.

Geographical names.

Under the head of "distinctive words" should be included trade marks consisting of geographical names. For registration, it is indispensable to prove user as a trade mark before August 13th, 1875, for such words have never been allowed to be registered as new marks. This was so under the Act of 1875, because that Act did not allow any mere words to be registered as new marks (*d*); under the Act of 1883, because the construction placed on the term "fancy word" was such as to exclude geographical names (*e*); and under the Act of 1888, because such names

(*a*) This was so laid down with respect to words claimed as fancy words under P. A. 1883, § 64, by Chitty, J., in *In re Davis & Co.*, 59 L. T. N. S. 854.

(*b*) *In re Lawrence & Co.*, 10 U. S. Pat. Gaz. 163.

(*c*) 61 Barb. S. C. 435.

(*d*) T. M. A. 1875, § 10.

(*e*) *In re Van Duzer*, 34 Ch. D. 623 ("Melrose Favourite Hair Restorer"); *In re Ainslie & Co.*, 4 P. R. 212 ("Ben Ledi" whiskey); *In re Laing*, L. J. N. of C. 1887, p

are expressly excluded from registration as new marks (*a*). But it seems that where a geographical name has been used *per se* as a trade mark before August 13th, 1875, and is not in common use, it will be recognised as a "special and distinctive" word (*b*). When geographical names are used as trade marks they are in that application to be understood, not as ascribing the goods to which they are affixed to any special section of the earth's surface, but as expressing the works at which, or the manufacturer by whom, those goods have been produced. So Wood, V.-C., in the "Anatolia" liquorice case (*c*), said that "the plaintiffs had established beyond all doubt the connection of their name with that mark, that was beyond dispute," and that "he could not treat the word as being otherwise than a designation mark, which the plaintiffs had caused to be attached to that particular article of liquorice which they so manufactured, and which they had a right to consider, in that qualified sense, property." Lord Westbury, C., in that case strongly confirmed the opinion of the Vice-Chancellor; and in the later case of *Wotherspoon* v. *Currie* (*d*), where the subject of dispute was the word "Glenfield" applied to starch, he stated that that word had acquired a secondary signification or meaning in connection with a particular manufacture: in short, it had become the trade designation of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which

102 ("Glengowrie Blend of Fine Old Highland Whiskey"); *In re Thompson & Co.*, 6 P. R. 213 ("Manor" tin plates); *Great Tower Street Tea Co.* v. *Smith*, 6 P. R. 165 ("Tower Tea"); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" iron goods).

(*a*) P. A. 1888, § 64 (1) (e).

(*b*) *In re Van Duzer*, 34 Ch. D. 623 (per Cotton, L. J.); *Compania General de Tabacos* v. *Rehder*, 5 P. R. 61 ("Cavite" cigars); *Evans* v. *Smith*, 3 Times L. R. 390 ("Montserrat" lime juice). See *Thompson* v. *Montgomery*, 41 Ch. D. 35.

(*c*) *McAndrew* v. *Bassett*, 33 L. J. Ch. 561; 4 De G. J. & S. 380 (App.).

(*d*) L. R. 5 H. L. 508. See also the very recent case of *Thompson* v. *Montgomery*, 41 Ch. D. 35 ("Stone Ales").

he had referred. The word "Glenfield," therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch.

Rules as to geographical names.

In some cases there is no pretence for saying that the name is used in its ordinary geographical sense. Thus no one could affirm that the use of the names "Persian thread" (*a*) or "Ethiopian stockings" (*b*) had induced him to suppose that the articles in question were imported from those countries. In other cases, however, the name is less purely arbitrary, and was originally, at least, indicative of local origin. For instance, the pipes marked with "E. Southorn, Broseley" (*c*), were manufactured at a village of that name; Glenfield starch (*d*), in the same manner, came from Glenfield; Anatolia liquorice (*e*), and Leopoldshall Kainit (*f*), from those respective places. This fact, however, does not deprive the trade mark of the right to protection. It is true that the name of an existent place cannot for all purposes be appropriated (*g*),

(*a*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255.

(*b*) *Hine* v. *Lart*, 10 Jur. 106; and see *In re Cornwall* (2), 12 U. S. Pat. Gaz. 312 ("Dublin" soap); *Fleischmann* v. *Schuckmann*, 62 How. Pr. 92 ("Vienna" bread); *Lauferty* v. *Wheeler*, 63 *ib.* 488; 11 Daly, 194 ("Alderney" oleo-margarine).

(*c*) *Southorn* v. *Reynolds*, 12 L. T. N. S. 75.

(*d*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508.

(*e*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380.

(*f*) *Radde* v. *Norman*, L. R. 14 Eq. 348; and see *Apollinaris Co.* v. *Edwards*, Seton, 4th ed. 237; and *Apollinaris Co.* v. *Norrish*, 33 L. T. N. S. 242 ("Apollinaris Water"); *Congress and Empire Spring Co.* v. *High Rock Congress Spring Co.*, 57 Barb. 526, R. Cox, 599 ("Congress Spring Water"); *Amoskeag Manufacturing Co.* v. *Garner* (1), 55 Barb. 151; R. Cox, 541, and S.C. (2), 54 How. Pr. 298 ("Amoskeag" cloths); *Newman* v. *Alvord*, 51 N. Y. 189 ("Akron"); *Lea* v. *Millar*, Dig. 513 ("Worcestershire Sauce"); *Powell* v. *McNulty*, Dig. 526 ("Yorkshire Relish"); *Siegert* v. *Findlater*, 7 Ch. D. 801 ("Angostura Bitters"); *Kinney* v. *Basch*, Dig. 542 ("St. James' Cigarettes"); *Wheeler* v. *Johnston*, 3 L. R. Ir. 284 ("Cromac Springs"); *Davis* v. *Tylor*, M. R., April 24th, 1879 ("Ferndale" coal); *Lochgelly Co., Ld.* v. *Lumphinnans Iron Co.*, Ct. Sess. Cas., 4th Ser. VI., 482 ("Lochgelly" coal); *Blair* v. *Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey).

(*g*) "Property in the word for all purposes cannot exist:" per Lord Westbury, C., *McAndrew* v. *Bassett*, 4 De G. J. & S. 380. In *Watt* v. *O'Hanlon*, 4 P. R. 1, the words "Old Innishowen" were held to be descriptive of a particular quality of whiskey, and an injunction was refused.

and that any one who manufactures at a place the name of which has become another's trade mark, indicative of that other's productions, may still describe his goods as made on that spot (*a*). But by English law he cannot stamp that name on his goods in the character of a trade mark of his own. In *Seixo* v. *Provezende* (*b*), where it was urged by the defendants that parts of their vineyards were known by the name of Seixo, the Lord Chancellor (Lord Cranworth) said that even assuming that to be true, "that did not justify the defendants in adopting a device or brand, the probable effect of which was to mislead the public, when purchasing their wine, to suppose that they were purchasing wine produced from the vineyards, not of the defendants, but of the plaintiff. Cases might be imagined, though very unlikely to arise, in which a person bringing into the market for the first time the produce of a newly established manufacture, to come into competition with one already established, might really be embarrassed as to the mode in which he should describe it, so as not to interfere with the description adopted by a manufacturer who had been before him." And he added that if such a case should arise, it would have to be dealt with on its own merits.

McAndrew v. *Bassett*.

Again, in *McAndrew* v. *Bassett* (*c*), Lord Westbury, C., said, "I am told that the word 'Anatolia,' being a general geographical expression—being, in point of fact, the geographical designation of a whole country—is a word common to all, and that in it, therefore, there can be no property. That is nothing in the world more than a

(*a*) Thus in *Braham* v. *Beachim* (1), 7 Ch. D. 848, an injunction was only granted to restrain the defendants from describing their coal as "Radstock" until they had some justification for so describing it, and when that justification could be produced, no relief was granted against them. And so in *Free Fishers & Dredgers of Whitstable* v. *Elliott*, W. N. 1888, p. 27. But this course was not taken in *Thompson* v. *Montgomery*, 41 Ch. D. 35, *q.v.* See *Braham* v. *Beachim* (2), Dig. 633, and *Siegert* v. *Findlater*, 7 Ch. D. 801.

(*b*) L. R. 1 Ch. 192.

(*c*) 4 De G. J. & S. 380; See *Wheeler* v. *Johnston*, 3 L. R. Ir. 284.

repetition of the fallacy which I have frequently had occasion to expose. Property in the word for all purposes cannot exist; but property in that word, as applied by way of stamp upon a stick of liquorice, does exist the moment the liquorice goes into the market so stamped, and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstances that render the article so stamped acceptable to the public."

Geographical names in America.

In America, the rule prohibiting the appropriation of geographical names as trade marks appears to be more stringent than in England, as the Courts there deny that such names can constitute trade marks (*a*), and registration is, as a rule, refused to them (*b*); and the Scotch Courts appear inclined to take the same course (*c*). Where, however, the use of a geographical name is clearly fraudulent (*d*), or where it is used by a defendant whose residence

(*a*) Thus, in *Canal Co.* v. *Clark*, 13 Wall. 311, the Supreme Court of the United States allowed the defendants to use the name "Lackawanna" on coal produced in that district, though the defendants had previously so used it; and see *Candee, Swan & Co.* v. *Deere & Co.*, 54 Ill. 439; 5 Amer. Rep. 125 ("Moline" ploughs); *Glendon Iron Co.* v. *Uhler*, 75 Penn. St. 467; 15 Amer. Rep. 599 ("Glendon" iron); *Carmichel* v. *Latimer*, 11 R. I. 395 ("Stillman Mill"); *Eggers* v. *Hink*, 63 Cal. 445 ("Philadelphia Beer"); *Evans* v. *Van Laer*, 32 Fed. Rep. 153 ("Montserrat" lime juice); *Osgood* v. *Allen*, 1 Holmes, 185; *Dunbar* v. *Glenn*, 42 Wisc. 118; *Burton* v. *Stratton*, 12 Fed. Rep. 696; *Anheuser Busch Brewing Association* v. *Piza*, 23 Bl. C. C. 245; *Lea* v. *Deakin*, 11 Biss. 23; *Pratt's appeal*, 117 Penn. St. 401; *Smith* v. *Imus*, 32 Alb. L. J. 455; *Smith* v. *Walker*, 37 Mich. 456. But see Mr. R. Cox's note to *Glendon Iron Co.* v. *Uhler*, at 13 Am. L. Reg. N. S. 543, in which he disputes the decision that a geographical name cannot be a trade mark.

(*b*) *Armistead* v. *Blackwell*, 1 U.S. Pat. Gaz. 603 ("Durham" tobacco); *Blackwell* v. *Dibrell*, 14 *ib.* 633 (do.); *In re Tolle*, 2 *ib.* 415 ("Cherry St. Mills," "Market St. Mills"); *In re American Sardine Co.*, 3 *ib.* 495 ("American Sardines"); *In re Warburg & Co.*, 13 *ib.* 44 ("Cachemire Milano"); *Ex parte Marsching & Co.*, 15 *ib.* 294 ("French" paints); *Ex parte Knapp*, 16 *ib.* 318 ("London" animal foods); *Ex parte Farnum & Co.*, 18 *ib.* 412 ("Lancaster" tickings); *Ex parte Oliver*, 18 *ib.* 923 ("Raleigh" tobacco).

(*c*) *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas., 4th ser. XI., 506 ("Water of Ayr" stone).

(*d*) *Kinney* v. *Basch*, Dig. 542 ("St. James' Parish" cigarettes); *Dunbar* v. *Glenn*, 42 Wisc. 118 ("Bethesda" mineral water); *Anheuser Busch Brewing Association* v. *Piza*, 23 Bl. C. C. 245; *Southern White Lead Co.* v. *Carey*, 25 Fed. Rep. 125; *Pike Manufacturing Co.* v. *Cleveland Stone Co.*, 25 Fed. Rep. 896.

and works are not situate in the locality the name of which he seeks to employ (*a*), relief may be obtained; and registration has also been effected in cases where there was a plausible ground for the assertion that the name was selected and used in a purely arbitrary way (*b*).

Words disentitled to protection.

In addition to deceptive words, no other words, the use of which would be deemed disentitled to protection in a court of justice, can be registered (*c*).

Letters and figures.

The provision inserted in favour of old marks in § 64 of the Patent Acts, 1883-8, also includes "any special and distinctive letter, figure (*d*), or combination of letters or figures, or of letters and figures, used as a trade mark before August 13th, 1875." It will be observed that the wording of this part of the section differs considerably from that of the corresponding part of § 10 of the Registration Act, 1875, the object being to bring all old trade marks composed of letters, figures, or combinations within the scope of the provisions for registration, an object which the old section had failed to achieve (*e*).

Letters.

Letters, generally in the form of initials, have, with or without additions, frequently been treated as trade marks. Among the earliest of these cases are *Motley* v. *Downman* (*f*) and *Millington* v. *Fox* (*g*); in the first of which cases "M. C.," and in the second "J. H.," was branded on iron. Still earlier than these cases, in the year 1834, "H. H. 6" formed part of a trade mark protected by injunction (*h*).

(*a*) *Lea* v. *Wolff*, 15 Abb. Pr. N. S. 1 ("Worcestershire Sauce"); *Anheuser Busch Brewing Association* v. *Piza*, 23 Bl. C. C. 245; *Southern White Lead Co.* v. *Carey*, 25 Fed. Rep. 125; *Pike Manufacturing Co.* v. *Cleveland Stone Co.*, 35 Fed. Rep. 896.

(*b*) *In re Green*, 8 U. S. Pat. Gaz. 729 ("German Sirup"); *In re Cornwall* (2), 12 *ib.* 312 ("Dublin" soap); and see *Ex parte Farnum & Co.*, 18 *ib.* 412, in which it was said that a geographical name would not be registered in the U. S. Patent Office unless it was clearly shown that it would be understood to be primarily fanciful, and that manufacturers residing at the place denoted by the name could be excluded from the use of it.

(*c*) See Patents Acts 1883-8, § 73.

(*d*) *I.e.*, numeral. See *Ex parte Stephens*, 3 Ch. D. 659.

(*e*) See *In re Mitchell* (1), 7 Ch. D. 36.

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

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

(*h*) *Ransome* v. *Bentall*, 3 L. J. Ch. 161.

In *Crawshay* v. *Thompson* (*a*), "W. C." in an oval was employed, and infringement being alleged through the use of "W. O." in a similar oval, a verdict was given by the jury for the defendants. The question whether initial letters could form a trade mark, alone or in conjunction with other symbols, was definitively raised before the Lord Chancellor of Ireland, in *Kinahan* v. *Bolton* (*b*). In that case the alleged trade mark consisted of the letters "L L" (standing for "Lord Lieutenant"), with a ducal coronet, which mark, it was alleged, had been adopted at a time when there was a ducal Lord Lieutenant of Ireland. The case of the defendants was that "L L" could no more compose a trade mark than "X X," but was a mere mark of quality. The Lord Chancellor, saying that there was no doubt as to this mark being a trade mark "in the strictest sense," went on to observe: "A most competent witness says that this whiskey, under the name of 'L L,' is a well-known article of commerce, that it has no other name than 'L L,' that under this name it has acquired a special reputation, and that for the long period of forty years this name has been applied to it. What is a trade mark more than that? It is proved that these two letters designate this whiskey. The letters of themselves mean nothing; no one *à priori* could know the meaning of such a trade mark: it is merely like a diamond, an anchor, or a crown, stamped on any article, the mark by which the vendor enables the public to recognise his wares."—"There can be no doubt, and indeed it is not disputed, that two letters may constitute a trade mark." Reference was then made to the cases of *Motley* v. *Downman* (*c*) and *Millington* v. *Fox* (*d*), and the injunction was granted. Since that time "S. and H." with a crown (*e*), "B. B. H." with a crown (*f*), or in any

(*a*) 4 M. & G. 357.
(*b*) 15 Ir. Ch. 75.
(*c*) 3 My. & Cr. 1.
(*d*) 3 My. & Cr. 338.
(*e*) *Hopkins* v. *Hitchcock*, 14 C. B. N. S. 65.
(*f*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Barrows* v. *Pelsall Coal & Iron Co.*, Dig. 530.

other combination (*a*), "C. B." with a cross (*b*), "M. and C." in a circle (*c*), and other letters (*d*), have been treated as undoubted trade marks.

Conclusion.

In the result, while letters used as a trade mark for the first time since the Act of 1875 must be combined with some distinctive feature, it seems clear that, if used as such before the Act, they will, even standing alone, be entitled to protection, though probably not as against persons having them for their initials and using them without fraud (*e*).

Single letters.

The Trade Marks Registration Act of 1875, § 10, only authorised the registration of letters by the use of the term "any special and distinctive combination of figures or letters;" and in *In re Mitchell* (1) (*f*), Hall, V.-C., felt himself compelled to hold that a single letter, however long and exclusively used by an applicant for registration, was not within the section, and was incapable of registration. Now, however, the wording of the present Act permits in express terms the registration of a "letter" as an old mark, so that the difficulty is removed. The letter will, of course, have to be proved to be special and distinctive. In America, the single letter "D" in a lozenge has been admitted to registration (*g*), notwithstanding the decision in *Ferguson* v. *Davol Mills* (*h*) with respect to the letter "K" enclosed in circular lines —a decision which appears to have been founded on

(*a*) *In re Barrows*, 5 Ch. D. 353.

(*b*) *Cartier* v. *Carlile*, 31 Beav. 292; *Cartier* v. *Westhead*, Dig. 199; *Cartier* v. *May*, Dig. 200.

(*c*) *Moet* v. *Clybouw*, Dig. 533; *Moet* v. *Pickering*, 8 Ch. D. 372.

(*d*) See *Ex parte Young*, Dig. 537 ("L. H. & S."); *Carver* v. *Bowker*, Dig. 581 ("R. H."); *Ransome* v. *Graham*, 51 L. J. Ch. 897 ("R. N."); *Bondier* v. *Depatie*, 3 Dorion, 233 ("G. B. D."). See also *In re Brook*, 26 W. R. 791; *Candee* v. *Deere*, 54 Ill. 439; *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Burton* v. *Stratton*, 12 Fed. Rep. 696; *Smith* v. *Imus*, 32 Alb. L. J. 455.

(*e*) The case is much the same as that of a maker's name. See *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518.

(*f*) 7 Ch. D. 36.

(*g*) *In re The Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248; and see *In re Imbs*, 10 U. S. Pat. Gaz. 463.

(*h*) 2 Brews. 314.

the mistaken interpretation of the expressions used in *Amoskeag Manufacturing Co.* v. *Spear* (*a*), previously referred to.

Numerical figures.

Numerals can only be registered as part of a new mark when combined with some essential particular (*b*); but provision is made for the registration of a single numeral or a combination of numerals, when it was used as an old mark and is special and distinctive, and in America a numeral may be registered as a trade mark (*c*). There does not, however, appear to be any case in which the English Courts have recognised a mere numeral or combination of numerals, standing alone, as sufficiently special and distinctive to constitute a trade mark (*d*); and in *Carver* v. *Bowker* (*e*), Little, V.-C. of Lancaster, held that that could not be; and in *Kinney* v. *Basch* (*f*) and *Burton* v. *Stratton* (*g*) the American Courts seem to have been of the same opinion. The use of numerals is, however, common in some trades, especially in the cotton trade, in which the usual combination marks generally include some arbitrary number or numbers; and there have been cases, in England (*h*), America (*i*) and India (*k*), in which the imitation of numbers has been restrained. In such cases, however, either the numerals have been parts

(*a*) 2 Sandf. S. C. 599.

(*b*) See Patents Act, 1883, § 64, as amended by the Act of 1888.

(*c*) *Ex parte Dawes & Fanning*, 1 U. S. Pat. Gaz. 27; and see *Dawes* v. *Davies*, Dig. 426.

(*d*) In *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518, the imitation of a series of numbers was held to be an important *indicium* of fraud, but the V.-C. did not treat the numbers as a trade mark; on the contrary, he distinguished them from one. See L. R. 1 Eq. 527.

(*e*) Dig. 581. The decision of the V.-C. was affirmed by the Court of Appeal in general terms.

(*f*) Dig. 542.

(*g*) 12 Fed. Rep. 696.

(*h*) *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90; *Carver* v. *Bowker*, Dig. 581; *Broadhurst* v. *Barlow*, W. N. 1872, p. 212; *Robinson* v. *Finlay*, 9 Ch. D. 487.

(*i*) *Gillott* v. *Kettle*, 3 Duer, 624; *Gillott* v. *Esterbrook*, 48 N. Y. 374; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402; *Kinney* v. *Basch*, Dig. 542; *Kinney* v. *Allen*, 1 Hughes, 106; *Lawrence Manufacturing Co.* v. *Lowell*, 129 Mass. 325; *India Rubber Comb Co.* v. *Rubber Comb and Jewelry Co.*, 45 N. Y. Super. Ct. 258; *Shaw Stocking Co.* v. *Mack*, 21 Bl. C. C. 1; *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338.

(*k*) *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417.

of combination marks (*a*), or they have been printed in a special and distinctive colour and configuration (*b*), or they have been selected in so arbitrary a manner that they conveyed no idea of number (*c*), or there has been an evident intention to commit a fraud (*d*); and it is apprehended that if a case were to occur in which the plaintiff's numeral was printed in an ordinary style, and the defendant could show any reason for desiring to use the number in the course of his business, which was not necessarily attributable to a wish to appropriate the plaintiff's custom, no relief would be granted against him.

Combinations of letters and figures.

A special and distinctive combination of letters and figures may also be registered as an old mark, and though the contention may possibly be raised that this does not include a combination of one letter and one figure, as "A 1," or of several letters with one figure (*e*), or of one letter with several figures, the intention of the words is so obviously comprehensive that it does not appear likely that the contention could succeed.

Trade marks under §§ 103 and 104 of Patents Act 1883.

This completes the list of trade marks specifically embraced within § 64 of the Patents Acts, 1883-8; but another possible class should be mentioned. By §§ 103 and 104 of the Act of 1883 subjects or citizens of foreign states or British possessions to which those sections have been made applicable by order in Council are entitled

(*a*) *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90; *Carver* v. *Barker*, Dig. 581; *Broadhurst* v. *Barlow*, W. N. 1872, p. 212; *Robinson* v. *Finlay*, 9 Ch. D. 487; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402; *Lawrence Manufacturing Co.* v. *Lowell*, 129 Mass. 325; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Humphreys' Specific Homœopathic Medicine Co.* v. *Wenz*, 14 Fed. Rep. 250.

(*b*) *Kinney* v. *Basch*, Dig. 542; *Kinney* v. *Allen*, 1 Hughes, 106.

(*c*) See *Kinney* v. *Allen*, 1 Hughes, 106; *Shaw Stocking Co.* v. *Mack*, 21 Bl. C. C. 1; *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338; and compare *Burton* v. *Stratton*, 12 Fed. Rep. 696, and *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981, in which registration was refused to numerals which had not been selected with sufficient arbitrariness.

(*d*) *Gillott* v. *Kettle*, 3 Duer, 624; *Gillott* v. *Esterbrook*, 48 N. Y. 374; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 412; *Kinney* v. *Basch*, Dig. 542.

(*e*) *E.g.*, "H. H. 6," in *Ransome* v. *Bentall*, 3 L. J. Ch. 161; "R. N. 1," in *Ransome* v. *Graham*, 51 *ib.* 897.

to certain privileges in the registration of trade marks; and it is provided that "any trade mark the registration of which has been duly applied for in the country of origin may be registered" under the Act. The wording of this provision appears to leave the comptroller at liberty, so long as the requirements of § 103 or 104 are complied with, to register any mark registered abroad (*a*), whether within § 64 or not; though this cannot be said to be clear, as § 64 says explicitly that "for the purposes of the Act a trade mark *must* consist of or contain at least one" of the specified essential particulars. It will be noticed that the comptroller is not in terms compelled, but only allowed, to register such marks. If the construction placed upon the section should be such as to allow of the registration of such descriptive words as "Syrup of Figs," which were claimed in *In re Californian Fig Syrup Co.* (*b*), a new class of marks may be formed, and the freedom of British subjects to use the English language in its ordinary signification may be materially restricted. The hardship on British subjects who cannot claim the like privileges is likely to be all the greater, that in many foreign countries registration is merely regarded as a record of claim, conferring no rights, so that anything tendered for registration is registered there.

Combination marks.

In some cases protection has been granted to a combination of marks, taken as a whole, notwithstanding that some of the component marks were *publici juris* (*c*); but it has been held in America (*d*) and Victoria (*e*) that a combination of marks, none of which was capable in itself of forming a valid trade mark, could not be claimed. On the other hand, it has been held in Canada

(*a*) See *In re Californian Fig Syrup Co.*, 40 Ch. D. 620.
(*b*) 40 Ch. D. 620.
(*c*) *Carver* v. *Bowker*, Dig. 581; *Robinson* v. *Finlay*, 9 Ch. D. 487, &c.
(*d*) *In re Tolle*, 2 U. S. Pat. Gaz. 415.
(*e*) *Wolfe* v. *Alsop*, 10 Vict. L. R. (Eq.) 41.

that words which separately are *publici juris* may in combination constitute a valid trade mark (*a*).

Official stamps.

An official stamp or brand can never become a private trade mark (*b*).

Colour.

It has been said in many cases that there can be no right of trade mark in the colour of wrappers, labels, &c.; but in the case of trade marks consisting of coloured threads in the lo er of a piece of stuff (*c*), or in the wick of a candle (*d*), or of the representation of a coin (*e*), the colour may form a material part of the mark, and such marks have been registered by deposit.

Price.

The price of the article to which the trade mark is attached is no part of the trade mark (*f*).

Shape of barrel, &c.

A particular shape of barrel, bottle, box, parcel, &c., containing goods is no trade mark for the goods contained in it (*g*); nor is the representation of such barrel, bottle, box, or parcel a trade mark for such goods (*h*), though the fraudulent imitation of it will be restrained (*i*). Nor is a mechanical convenience not used for purposes of identification, such as a strip of tobacco rolled round the mouthpiece of cigarettes (*k*), nor the general configuration and appearance of a machine (*l*), nor a sampler-pattern (*m*), nor the shape of a plug of tobacco (*n*), or of a stick of

(*a*) *Smith* v. *Fair*, 14 Ont. Rep. 729 ("Red Seal" cigars).

(*b*) *Chase* v. *Mayo*, 121 Mass. 343.

(*c*) *Harter* v. *Souvazoglu*, W. N. 1875, pp. 11, 101; *Carver* v. *Bowker*, Dig. 581; *Mitchell* v. *Henry*, 15 Ch. D. 181; *Robinson* v. *Finlay*, 9 Ch. D. 487.

(*d*) See the Public Stores Act, 1875.

(*e*) *In re Robinson*, 29 W. R. 31. See Patents Act, 1883, § 67.

(*f*) *In re Steedman*, L. J. N. of C. 1883, p. 83.

(*g*) *Moorman* v. *Hoge*, 2 Sawy. 78 (a barrel); *Harrington* v. *Libby*, 14 Bl. C. C. 128 (a collar box); *Sawyer* v. *Horn*, 4 Hughes, 239; *Ball* v. *Siegel*, 116 Ill. 137. See *In re Kane & Co.*, 9 U. S. Pat. Gaz. 105, and *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218.

(*h*) *Ex parte Halliday Brothers*, 16 U. S. Pat. Gaz. 500.

(*i*) *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392.

(*k*) *In re Gordon*, 12 U. S. Pat. Gaz. 517.

(*l*) *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337; *Wilcox & Gibbs Sewing Machine Co.* v. *Gibbon's Frame*, 21 Bl. C. C. 431; *Brill* v. *Singer Manufacturing Co.*, 41 Ohio St. 127.

(*m*) *In re Parker*, 13 U. S. Pat. Gaz. 323.

(*n*) *Liggett & Myers Tobacco Co.* v. *Hynes*, 20 Fed. Rep. 883.

chewing-gum (*a*), nor a manner of packing, in boxes, cakes of soap wrapped in differently coloured paper wrappers (*b*), nor the use of a tin tag or ticket, irrespective of its shape and contents (*c*), a trade mark; though a tin tag of a special shape, size and colour may be (*d*). But where the mark is "something different from the article itself which the mark designates" (*e*), such as a stick placed in a roll of carpet, showing an octagonal ring at each end (*f*), or a band attached to cigar-boxes (*g*), and is special and distinctive, and not in common use, then it may be recognised as a good trade mark, notwithstanding that it is not attached to the goods in the usual way.

Mark may be consumed with the article.

If a mark is in other respects a good trade mark, the fact that it is consumed with the article to which it is attached is no objection to its validity (*h*).

(*a*) *Adams* v. *Heisel*, 31 Fed. Rep. 279.
(*b*) *Davis* v. *Davis*, 27 *ib.* 490.
(*c*) *Lorillard* v. *Pride*, 28 *ib.* 434.
(*d*) *Lorillard* v. *Wight*, 15 *ib.* 383.
(*e*) Per Johnson, J., in *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337.
(*f*) *Lowell Manufacturing Co.* v. *Larned*, Dig. 428.
(*g*) *Ex parte Straiton & Storm*, 18 U. S. Pat. Gaz. 923.
(*h*) *In re Gordon*, 12 U. S. Pat. Gaz. 517; and see *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 441.

CHAPTER III.

ACQUISITION, TRANSFER, AND DISCONTINUANCE OF TRADE MARKS.

1. *Acquisition.*

Who may acquire.

As a general rule, any person capable of acquiring any other species of property is capable of acquiring a right to a trade mark, and this is equally the case with artificial persons, as corporations (*a*), as with physical persons, or individuals.

Aliens.

A question has, however, been raised as to whether an alien was capable of acquiring a right to a trade mark, but when raised was at once finally decided by Wood, V.-C., in accordance alike with justice and expediency. The plaintiffs in *Collins Co.* v. *Cowen* (*b*), were an American firm of edge-tool manufacturers, whose trade marks appear to have been systematically infringed by English rivals. In the case in question the defendants, who had copied the plaintiffs' stamp of "Collins Co., Hartford, cast steel, warranted," demurred. The Vice-Chancellor overruled the demurrer, and observed in the course of his judgment, "I apprehend that every subject of every country, not being an alien enemy—and even to an alien enemy the Court has extended relief in cases of fraud—has a right to apply to this Court to have a fraudulent injury to his property arrested. And here the plaintiffs have the right—a right recognised, I imagine, everywhere in the world, or at least in every civilised community—of

(*a*) See Patents Act, 1883, § 117, for definition of "person."

(*b*) 3 K. & J. 428.

saying, 'We, being the manufacturers of certain goods, claim that another man shall not manufacture goods and put upon them our trade mark, and then pass them off as manufactured by us.' It would be most grievous if any Court should hold that there was an incapacity of affording relief in a case where a fraud has been committed upon a subject of any country. I speak, of course, of a fraud so far connected with property as to be not a shadowy but a substantial injury. If you use the name of another for the purpose of securing to yourself, in the disposition of property, advantages which belong to him, the fraud is complete, and the remedy ought to be complete, as in the case of a libel, where the action is allowed to a foreigner. I cannot in my own mind entertain the slightest misgiving in this case, whether it be new or not" (*a*).

Where no user in England.

When no goods bearing the foreign trade mark have been sold in this country, the trade mark can have acquired here no reputation for its foreign owner, so that it would appear doubtful whether the protection extended to foreign trade mark owners should be afforded in cases where there has been no user in this country, and the mark does not expressly state a foreign origin. In such a case the first person to use the mark in the United Kingdom is the first person to gain a reputation for it here (*b*). But foreign

(*a*) See also *Collins Co.* v. *Brown*, 3 K. & J. 423; *Collins Co.* v. *Walker*, 7 W. R. 222; *Collins Co.* v. *Reeves*, 28 L. J. Ch. 56; *Howe* v. *McKernan*, 30 Beav. 547. So in Scotland the trade marks or names of American manufacturers have been protected: *Singer Manufacturing Co.* v. *Kimball & Morton*, Ct. Sess. Cas., 3rd Ser. XI. 267. The same rule obtains in America: *Taylor* v. *Carpenter*, 3 Story, 458; R. Cox, 14; Same *v.* Same, 2 Wood. & M. 1; R. Cox, 32; Same *v.* Same, 11 Paige, 292; R. Cox, 45; *Coats* v. *Holbrook*, 2 Sandf. Ch. 586; R. Cox, 20; *Lemoine* v. *Ganton*, 2 E. D. Smith, 343; R. Cox, 142; *Lacroix* v. *May*, 15 Fed. Rep. 236. And the infringement of a British trade mark has been criminally punished in Missouri: *State of Missouri* v. *Gibbs*, 56 Mo. 133. In India protection is afforded to British trade marks: *Orr-Ewing* v. *Chooneeloll Mullick*, Cor. 150; *Orr-Ewing* v. *Grant, Smith & Co.*, 2 Hyde, 185; and in Canada also the trade marks of aliens are protected: *Davis* v. *Kennedy*, 13 Grant, Up. Can. Ch. 523.

(*b*) See *In re Münch*, 50 L. T. N. S. 12; *In re Riviere & Co.*, 26 Ch. D. 48; *In re Leonard & Ellis*, *ib.* 288, per

or colonial marks can be registered in England under § 103 or 104 of the Patents Act, 1883, and registration is equivalent to public use (*a*).

Sovereigns.

It seems that there is nothing to prevent sovereign princes or states from being the proprietors of trade marks in respect of goods manufactured or produced on their account (*b*).

Officials.

A person in an official position, using an official stamp in his official capacity, cannot thereby acquire any private right therein (*c*).

Agents.

Nor can an agent acquire any interest in his principal's mark from the fact that he has used it (*d*); nor a printer in the trade mark of a mercantile firm from the fact that he has been employed to print it (*e*).

Artisans.

In America the question has been much discussed whether the members of an artisans' trade society were entitled to claim an exclusive right in a label supplied by the society to its members, and affixed by them to goods manufactured by them, for the purpose of showing that such goods had been manufactured by members of the society. The objection which was raised to the claim was, that the members of the society did not manufacture or deal in the goods on their own account, but were merely workmen in the employment of various firms, whose product the goods were, and not that of the workmen, and in some cases this objection has prevailed (*f*), but in the majority of the cases the decision has been in favour of the society, on the ground that its members

Fry, L. J.; *Berliner, &c., Tivoli* v. *Knight Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Newman* v. *Pinto*, 57 L. T. N. S. 31, per Kekewich, J.; *Smith* v. *Fair*, 14 Ont. Rep. 729.

(*a*) Patents Act, 1883, § 75.

(*b*) See *Ex parte King of Saxony*, Dig. 598; *Republic of Peru* v. *Reeves*, 40 N. Y. Super. Ct. 316.

(*c*) *Chase* v. *Mayo*, 121 Mass. 343.

(*d*) *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110.

(*e*) *Schumacher & Ettlinger* v. *Schwenke* (2), 36 U. S. Pat. Gaz. 457.

(*f*) *Ex parte Cigar Makers' Association*, 16 U. S. Pat. Gaz. 958; *Schneider* v. *Williams*, 44 N. J. Eq. 391.

were entitled to protection for the insignia which secured to them the benefit of their skilled labour (*a*).

Length of user formerly required.

There was for some time a doubt as to the circumstances under which one person could acquire a sufficient right in a trade mark to be entitled to restrain another from infringing it. The right to redress being treated as founded on the defendant's fraud, it was thought that a plaintiff who claimed an injunction against a defendant ought to show that he (the plaintiff) had acquired for the mark indicating his manufacture such a reputation (*b*) as would raise a presumption that the defendant in adopting a similar mark had done so with the intention of availing himself of that reputation to divert to himself the plaintiff's custom, or at all events that the plaintiff ought to show that he had used the mark long enough to render it probable that such a reputation had been acquired (*c*).

Latterly considered unnecessary.

But when it came to be recognised that there was a right of property in a trade mark, intentional fraud being unnecessary to justify restraint, it was at once seen that, as was stated by Romilly, M. R., "the interference of a Court of Equity could not depend on the length of time the manufacturers had used it" (*d*), but that, "from the time of their commencing the user of their trade mark they became entitled to the protection of the Court against any other persons using the same, so that purchasers might be induced to purchase the goods of other persons

(*a*) *Strasser* v. *Moonelis*, 108 N. Y. 611; *Allen* v. *Macarthy*, 37 Minn. 347; *People* v. *Fisher*, 57 N. Y. Sup. Ct. 552; *Bloete* v. *Simon*, 19 Abb. N. C. 88.

(*b*) In *Hine* v. *Lart*, 10 Jur. 106, Shadwell, V.-C. of England, thought that the imitation by a defendant of a plaintiff's trade mark afforded a presumption of that mark having acquired a reputation. And see *Dixon* v. *Jackson*, Ct. Sess. Cas., 3rd Ser. V. 326, per the Lord Justice Clerk: *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115, and *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027.

(*c*) See *Purser* v. *Brain*, 17 L. J. Ch. 141; *Edelsten* v. *Vick*, 11 Hare, 78; *Collins Co.* v. *Brown*, 3 K. & J. 423; and compare *Spottiswoode* v. *Clarke*, 2 Ph. 154.

(*d*) *Hall* v. *Barrows*, 32 L. J. Ch. 548.

as theirs" (*a*). "As soon as a trade mark has been so applied in the market as to indicate to purchasers that the goods to which it is attached are the manufacture of a particular firm, it becomes, to that extent, the exclusive property of the firm, and no one else has a right to copy it, or even to appropriate any part of it, if by such appropriation unwary purchasers may be induced to believe that they are getting goods which were made by the firm to whom the trade mark belongs" (*b*). There must, however, have been a real user (*c*).

Wrongful user gives no title.

Even, however, if user be established, extending over a considerable period, it does not follow that a title to the trade mark is made out; for if the user was fraudulent in its inception, and is still calculated to deceive, the user gives no right (*d*); and it has been held in America that if A has been using a trade mark which was really the property of B, and then B ceases to use it, A cannot acquire any title to the mark by continuing to use it after B's discontinuance, on account of the wrongful inception of his user (*e*).

Acquisition by common repute.

In *Siegert* v. *Findlater* (*f*), it was even held that the

(*a*) Per Hall, V.-C., in *Cope* v. *Evans*, L. R. 18 Eq. 138; and see *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183. This principle does not appear to be universally recognised in America. See *Seltzer* v. *Powell*, 8 Phila. 296. In *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120, it was held that prior registration and prior use of about six days, but only on a few articles by way of experiment, by one manufacturer, did not disentitle another to registration, he having systematically used the mark for some time before his rival had seriously adopted it. It is the adoption and use, not the invention, of the mark that gives a title to it: *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110; *Hoosier Drill Co.* v. *Ingels*, 14 *ib.* 785; *Leidersdorf* v. *Flint* (1), 8 Biss. 327; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *U. S.* v. *Steffens*, 100 *ib.* 82; and a trade mark may have been in part purchased and in part invented: *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60.

(*b*) Per the Privy Council in *Somerville* v. *Schembri*, 12 App. Cas. 453.

(*c*) *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820.

(*d*) *In re Heaton*, 27 Ch. D. 570.

(*e*) *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576; *Parlett* v. *Guggenheimer*, 67 Md. 542.

(*f*) 7 Ch. D. 801. And see *In re Barker & Son*, 53 L. T. N. S. 23; *Smith* v. *Woodruff*, 48 Barb. 438; *Rowley* v. *Houghton*, 2 Brews. 303; *Degraves* v. *Whiteman*, 5 Vict. L. R. Eq. 304.

plaintiffs were entitled to restrain the defendant from using the term "Angostura Bitters," although the defendant had used it on his labels before the plaintiffs had done so, on the ground that, before the plaintiffs had themselves used the term, it had become attached to their article in common parlance. But acquisition of a trade mark by common repute has not been universally recognised (*a*).

How property in a trade mark acquired.

Lord Westbury, C., said, in *McAndrew* v. *Bassett* (*b*), that the elements of the right to property in a trade mark might be represented as being the fact of the article being in the market as a vendible article with that stamp or trade mark at the time when the defendants imitated it; and he went on: "The essential qualities for constituting that property probably would be found to be no other than these: first, that the mark has been applied by the plaintiffs properly (that is to say, that they have not copied any other person's mark, and that the mark does not involve any false representation) (*c*); secondly, that the article so marked is actually a vendible article in the market; and, thirdly, that the defendants, knowing that to be so, have imitated the mark for the purpose of passing off in the market other articles of a similar description" (*d*).

The mark must be on a vendible article.

From this judgment it follows, and it was expressly recognised in *Maxwell* v. *Hogg* (*e*), that no property could be acquired in a trade mark, except through the process of sale, or offering for sale, in the market, of the article to which the trade mark was affixed (*f*). And in the last-

(*a*) See *Blackwell* v. *Armistead*, 5 Amer. L. T. 85; *Lorillard* v. *Pride*, 28 Fed. Rep. 434.

(*b*) 4 De G. J. & S. 380.

(*c*) Compare §§ 72, 73, 86 of the Patents Act, 1883. And see *In re Heaton*, 27 Ch. D. 570, and *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576; with which compare *Symonds* v. *Greene*, 28 Fed. Rep. 834.

(*d*) Compare remarks of Lord Kingsdown in the *Leather Cloth Companies' case*, 11 H. L. C. 523.

(*e*) L. R. 2 Ch. 307.

(*f*) And see per Willes, J., in *Lawson* v. *Bank of London*, 18 C. B. 84. Also *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512; *In re Simpson, Davies & Sons*, M. R., Jan. 12th, 1881; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Rowley* v. *Houghton*, 2 Brews. 303, R. Cox, 486; *Bowman* v. *Floyd*, 85 Mass. 76; *McLean*,

mentioned case it was held that no expenditure during the course of manufacture in advertisements or other announcements to the public of the article so in course of manufacture could give any right in the mark or name by which it was intended that the article should be known when completed and in the market (*a*). Moreover, user must be as of a trade mark, and not as of a mere descriptive term (*b*).

Acquisition by registration.

By the Trade Marks Registration Act, 1875, now repealed, a new manner of acquiring a right to a trade mark was introduced, and with respect to new marks substituted for the earlier method. By the Patents Acts, 1883-8 (*c*), which have now taken the place of the Act of 1875, no infringement of a registrable trade mark can be restrained or civilly punished, unless the mark has been registered. For five years after registration the fact of registration is *primâ facie* evidence of the right of the registered proprietor to the exclusive use of the trade mark (*d*), or, in other words, it qualifies him for taking proceedings against infringers (*e*); after five years have expired from the date of registration, the fact of registration becomes conclusive evidence of his right to the mark (*f*) in any

v. *Fleming*, 96 U. S. Rep. 245; *St. Louis Piano Manufacturing Co.* v. *Merkel*, 1 Mo. App. 305; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183; *Schneider* v. *Williams*, 44 N. J. (Eq.) 391; *Jaeger's, &c., Co.* v. *Le Boutillière*, 54 N. Y. Sup. Ct. 521; *McCall* v. *Theal*, 28 Grant Up. Can. Ch. 48; *Rogers Manufacturing Co.* v. *Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495; *Sheppard & Co.* v. *Stuart & Peterson*, 13 Phila. 117. As to the difficulty of acquiring a right of trade mark in a name applied to a patented article, see p. 59, *ante*.

(*a*) And see *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512; and *Schneider* v. *Williams*, 44 N. J. (Eq.) 391.

(*b*) *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Harrison, McGregor & Co.*, 42 Ch. D. 691.

(*c*) § 77; and see *Goodfellow* v. *Prince*, 35 Ch. D. 9.

(*d*) § 76; and see *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284.

(*e*) *Nuthall* v. *Vining*, C. A. Jan. 21st, 1880; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398. In the case of *Morse* v. *Martin*, Quebec Super. Ct. Feb. 28th, 1882, it was held that the corresponding Canadian statute gave no right of action for anything done before registration. But the Quebec Court of Queen's Bench did not decide the point: 3 Dorion 353.

(*f*) § 76. This is, however, subject to the provisions of the Act, *e.g.*, as to the connection with the goodwill: § 70.

action brought by him (*a*), though the mark is still liable to removal from the register in proceedings taken for that purpose, if it was registered wrongfully (*b*). Registration protects the trade mark in all sizes and in all colours, whether registered in colour (*c*) or not (*d*). In the case of trade marks in use before August 13th, 1875, application must be made for registration, and if that is refused, a certificate of refusal will preserve to the applicant whatever rights he would have had independently of the Act (*e*).

Registration before user.

In several cases (*f*) doubts were expressed whether a trade mark could be registered before it had been used, the doubt being founded on the old principle that a right in a trade mark could only be acquired by its being attached to vendible goods in the market, until which was the case user by others could lead to no deception; but these doubts were set at rest in *In re Hudson* (*g*), where the Court of Appeal came to a clear decision that registration before user was allowable.

Goods classified.

A trade mark must be registered as belonging to particular goods or classes of goods (*h*), as arranged in the Third Schedule to the Rules; the class to which the goods belong being determined, in case of doubt, by the comptroller (*i*). This requirement is no alteration of the rules of the pre-existing law, but is merely a statement of one of those rules as bearing upon registration under the Act. It had been already fully recognised that a particular trade mark could be protected as such

(*a*) *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*b*) *In re Palmer* (1), 21 Ch. D. 47; S. C. (3) 24 *ib.* 504; *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Edwards v. Dennis*, 30 Ch. D. 454; *Wood* v. *Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659. And so in Victoria: *Lewis* v. *Klapproth*, 11 Vict. L. R. 214; *Wolfe* v. *Alsop* (2), 12 Vict. L. R. (E.) 421; *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 752.

(*c*) See § 67.

(*d*) *Nuthall* v. *Vining*, C. A. Jan. 21st, 1880.

(*e*) § 77.

(*f*) *In re Anderson*, 54 L. J. Ch. 1084; *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Lyndon*, 32 Ch. D. 109.

(*g*) 32 Ch. D. 311.

(*h*) § 65. (*i*) Rule 6.

only in connection with particular goods or classes of goods. Thus Lord Westbury, C., says, "Property in a trade mark is the right to the exclusive use of some mark, name, or symbol in connection with a particular manufacture or vendible commodity; consequently the use of the same mark in connection with a different article is not an infringement of such a right of property" (*a*). And again, "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" (*b*). And V.-C. Wood similarly says, that "this Court has taken upon itself to protect a man in the use of a certain trade mark as applied to particular description of article. He has no property in that mark, *per se*, any more than in any other fanciful denomination he may assume for his own private use, otherwise than with reference to his trade. If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and caused his goods to circulate with this mark upon them," his right to the mark so applied will be protected (*c*).

Limit of rights acquired by user.

As a result of the rule that a trade mark can only be acquired by user in respect of the goods on which it has been used, it has been decided that the use of a mark

(*a*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137.

(*b*) *Hall* v. *Barrows*, 4 De G. J. & S. 150.

(*c*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; and see *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-43; *Merchants' Banking Co. of London* v. *Merchants' Joint Stock Bank, Limited*, 9 *ib.* 560; *Colladay* v. *Baird*, 4 Phila. 139; R. Cox, 257; *Rowley* v. *Houghton*, 2 Brews. 303; R. Cox, 486; *Amoskeag Manufacturing Co.* v. *Garner*, 55 Barb. 151; R. Cox, 541; *Colman* v. *Crump*, 70 N. Y. 573; *Société Anonyme, &c.*, v. *Baxter*, 14 Bl. C. C. 261.

before August 13th, 1875, on certain descriptions of goods gives no right to have it registered in respect of other descriptions of goods, except as a new mark; so that although the mark may have been long used in respect of some goods, it will be refused registration in respect of different goods or classes of goods (though of a somewhat similar character), if it conflicts with another mark already registered therein (*a*), or if for any reason it is not registrable as a new mark. If, however, it has been used for goods which, though not identical, were yet substantially the same as those for which it is claimed, registration may be allowed (*b*). And it has been held in America, with apparently good reason, that a mark which is descriptive, and therefore incapable of registration, when applied to one variety of goods, may be open to no such objection when applied to another variety of goods (*c*). Similarly, a mark may be in general use in connection with a variety of goods, and yet be perfectly good and distinctive in connection with particular goods on which there has been no such user. Thus it has been said in the Privy Council (*d*) that "the acquisition of an exclusive right to a mark or name in connection with a particular article of commerce cannot entitle the owner of that right to prohibit the use by others of such mark or name in connection with goods of a totally different character, and such use by others can as little interfere with his acquisition of the right."

New user of old mark may be infringement.

As a consequence of the rule that user only gives a right to the mark in respect of the goods for which it has been used, the user of a mark in connection with goods different from those in respect of which it has previously been

(*a*) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Edwards* v. *Dennis*, 30 Ch. D. 454; and see *In re Braby & Co.*, 21 Ch. D. 223; also *In re Lyndon*, 32 Ch. D. 109, per Pearson, J., and the American case of *Ex parte King* (2), 46 U. S. Pat. Gaz. 119.

(*b*) *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; and compare *Collins Co.* v. *Ames & Sons*, 20 Bl. C. C. 542.

(*c*) *In re English*, U. S. Pat. Comm. Decis. 1870, 142; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538.

(*d*) *Somerville* v. *Schembri*, 12 App. Cas. 453.

used, though of a somewhat similar character, may amount to an infringement of the rights of another person who has had an earlier user in respect of those different goods. Thus in *Moses* v. *Sargood* (*a*) it was held to be an infringement of the plaintiffs' rights for the defendants, who had previously only exported goods unmade up, and used their trade mark upon such goods, to begin to export and to use their trade mark upon ready-made clothing, having regard to the fact that the plaintiffs had been in the habit of exporting and using a somewhat similar trade mark upon made-up goods. And in *Upper Assam Tea Co.* v. *Herbert & Co.* (*b*) the proprietors of a mark which had been used and registered for coffee were restrained from applying it to tea, though in the same class, having regard to the fact that a similar mark had been used and registered for tea by another firm.

Wide registration, but limited user.

Again, though by § 75 of Patents Act, 1883, registration (*c*) of a trade mark is to be deemed to be equivalent to public use of the trade mark, it has been held by the Court of Appeal that if a trader has registered a mark for a variety of goods, and has only used it in connection with some of them, he is not entitled to restrain the use by another trader of a somewhat similar mark in connection with the goods for which his mark has not been used (*d*).

Mark only protected for goods for which registered.

Another question which has been raised, bearing on this point, is whether a mark which has been registered for some of the goods in a class can be protected for other goods in the class, as having been used in respect of them; and it would seem that, having regard to § 65, by which a trade mark must be registered for particular goods or classes of goods, a trade mark which is registered only for particular goods in a class is not registered for other goods, whether in the same or a different class, and consequently

(*a*) Dig. 636.
(*b*) C. A., July 3rd, 1889.
(*c*) Now "application for registration," § 17 of P. A. 1888.
(*d*) *Edwards* v. *Dennis*, 30 Ch. D. 454.

that by § 77 (*a*) it is deprived of any right to protection in respect of such other goods; and in *Hart* v. *Colley* (*b*), North, J., decided in favour of the view here suggested. In *Jay* v. *Ladler* (*c*) it was held that the mark could be protected in respect of such other goods; but full effect does not appear to have been given to the sections above mentioned.

Provisions in the Patents, &c., Acts and Rules.

By § 72 the registration of a mark identical with, or nearly similar to a mark already registered, is prohibited, not generally, but in connection with such goods or description of goods as those in respect of which the mark already on the register is registered. And, with a view to the protection of the public, this prohibition is extended over a period of one year after the removal of the mark once registered from the register for non-payment of a continuance fee, during which period of one year the removed mark in question is to be still deemed to be registered for this purpose only (*d*).

Steps necessary to obtain registration: The application.

A person desirous of having his trade mark registered must send an application to the comptroller in the prescribed form (*e*), together with the prescribed number (*f*) of representations (*g*) of the trade mark. When a representation cannot be given in the usual manner, a specimen or copy of the trade mark may be supplied instead (*h*). The application must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered (*i*). Words in other than

(*a*) See *Goodfellow* v. *Prince*, 35 Ch. D. 9.

(*b*) 44 Ch. D. 193.

(*c*) 40 Ch. D. 649.

(*d*) § 79 (5), as amended by § 19 of the Act of 1888, *q.v.*

(*e*) Form F in the Second Schedule to the Rules. See § 62 (2) and Rules 4, 5, 11, 12.

(*f*) Three, except when the application is in respect of goods in classes 23 to 35, *i.e.*, the textile classes. In such a case four representations must be sent. In either case one of the representations is to be placed on the application form. See Rule 13. When the application is for the registration of a series of marks under § 66, the case will be governed by Rule 14.

(*g*) For form of Additional Representation, see Form G. See also § 62 (3).

(*h*) See Rule 13.

(*i*) § 62 (3).

Roman character must have a translation supplied (*a*). Applications for registration in classes 23, 24, or 25, are to be sent to the Manchester Branch Office (*b*).

When mark is an old mark

When the mark is claimed as an old mark—*i.e.*, a mark used before the passing of the Trade Marks Registration Act, 1875 (August 13th, 1875)—the facts as to such prior user are to be stated (*c*), but no statutory declaration is now required, as was formerly the case. In such cases it is essential that the mark should be claimed and registered precisely in the form in which it has been used (*d*).

When by firm.

When the application is made by a firm or partnership it may be signed by some one or more members of the firm or partnership, as the case may be (*e*).

When by a body corporate.

When the application is made by a body corporate, it may be signed by the secretary or other principal officer of such body corporate (*e*).

Manner of making application.

The application and all other communications between the applicant and the comptroller may be made by or through a duly authorised agent (*f*), and may be sent by a prepaid letter through the post (*g*). If the applicant is abroad at the time of his application, and is not claiming under an international convention, he must give an address for service within the United Kingdom (*h*).

Advertisement, &c.

All that remains to be done by the applicant for registration, after sending in his application, is to await an acknowledgment of its receipt by the comptroller (*i*), and then to furnish the comptroller with the means of inserting in the official paper the necessary advertisement of the application (*k*).

Registration.

At the expiration of one month from the date of the

(*a*) Rule 15.
(*b*) Rule 8.
(*c*) Rule 11.
(*d*) See p. 49, *suprà*, and note (*l*) to § 64 of P. A. 1883.
(*e*) Rule 7.
(*f*) Rule 9.
(*g*) § 97 and Rule 16.
(*h*) § 8 of Act of 1888.
(*i*) Rule 10.
(*k*) § 68 and Rules 27-30.

advertisement, and subject to any proceedings which may have been taken, the comptroller is, if satisfied of the applicant's title, to register the trade mark (*a*) as from the date of the receipt of the application for registration (*b*), and upon registration is to send notice thereof to the registered proprietor with a reference to the advertisement (*c*).

In case of applicant's death.

If an applicant dies between application and registration the registration may be completed in the name of the successor to the goodwill of his business (*d*).

Sheffield and cotton marks.

Trade marks applied for in respect of goods within the Cutlers' Company's Acts (*e*) are governed by special rules (*f*); but marks on cotton goods, even B list marks, are for the future to be dealt with on the same footing as other trade marks. The only special requirements in the case of cotton marks are for the name by which the mark would be referred to in invoices to be stated (*g*), and for three additional representations to be sent instead of two (*h*), and for applications to be made at Manchester (*i*).

Series of marks.

Where it is desired to register a number of trade marks which, while resembling each other in the material particulars thereof (*k*), yet differ in respect of statements of the goods for which they are to be used, or of numbers, or price, or quality, or names of places, they may be registered as a series in one registration, each of the marks being treated as separately registered, except for purposes of assignment and transmission (*l*).

Common marks.

Additions which are common to the trade may, in accordance with the provisions of § 74, as amended by

(*a*) Rule 32.
(*b*) § 17 of the Act of 1888.
(*c*) Rule 35.
(*d*) Rule 33.
(*e*) See Appendix G, *infrà*.
(*f*) § 81 as amended by § 20 of the Act of 1888, and Rules 56-59.
(*g*) Instructions, par. 14.
(*h*) Rule 13.
(*i*) Rule 8.
(*k*) See § 64 as to essential particulars.
(*l*) § 66 and Rules 14, 30. This is new as an enactment, but the practice is not new. See note (*a*) to § 66, and note (*c*) to § 72, *infrà*.

§ 16 of the Act of 1888, be registered together with trade marks, but such common elements must be disclaimed by the applicant (*a*).

Alternative marks.

No provision is made in the Patents Act, 1883, for registering alternative marks, as has sometimes been done in America, *e.g.*, where a trade mark was registered as consisting either of the figure of a lion, or the word "lion," or both (*b*).

Colour.

Trade marks may now be registered in colour, and the effect of such registration is no longer to limit the protection conferred by registration to the one colour in which the registration has been effected (*c*).

Registration by deposit.

Provision is made by the Rules for registration by deposit in cases where such a course is rendered necessary by the nature of the trade mark (*d*).

Refusal to register.

Registration is by no means a necessary consequence of application. The comptroller may refuse to grant registration if he thinks fit (*e*), or if he thinks the use of the mark would be contrary to law or morality (*f*), and he must refuse registration where the same or a similar mark is already registered for the same goods (*g*), or where words inherently calculated to deceive are offered for registration (*h*). Where the refusal is made in the exercise of a discretion vested in the comptroller, he is not to exercise that discretion adversely to the applicant until he has had an opportunity of being heard personally, or by his agent (*i*), and if he does, in his discretion, refuse to register, there is an appeal to the Board of Trade (*k*),

(*a*) The practice of requiring common parts of marks or additions to marks to be disclaimed is not new. See per Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238; and per Kay, J., in *In re Hayward & Sons*, 54 L. J. Ch. 1003; and *In re Davies*, before Chitty, J., March 9th, 1885. Also notes to § 74, and note (*c*) to § 72, *infrà*.

(*b*) *In re Weaver*, 10 U. S. Pat. Gaz. 1.

(*c*) See § 67 and note thereto, *infrà*.

(*d*) Rules 13, 27. And see note to § 67.

(*e*) § 62 (4).

(*f*) § 86.

(*g*) § 72. (*h*) § 73.

(*i*) § 94 and Rules 17-19.

(*k*) § 62 (4). See Rules 20-26.

who may, if they think fit, refer the appeal to the Court *a*).

Opposition to application.

Even if the comptroller is willing to treat the application as unobjectionable, any person (*b*) may give notice of opposition at the Patent Office within one month or such further time, not exceeding three months, as the comptroller may allow, after the advertisement, and the applicant is then allowed one month for sending in a counter-statement, or the registrar may extend the time. If no such counter-statement is sent, the application is deemed to be withdrawn; if it is sent, the person giving notice of opposition will be furnished with a copy of it, and the comptroller will then hear the case (*c*); but his decision is to be subject to an appeal to the Board of Trade (*d*), who may, if it appears expedient, refer the appeal to the Court (*e*).

Limited registration.

In deciding whether registration is to be allowed or not, the Court will frequently grant the application in such a limited form as to obviate the risk of its clashing with the

(*a*) § 62 (5). "The Court" is the High Court of Justice (§ 117), the Chancery Division being no longer specified; but recourse will, no doubt, still be had to that Division. In the case of applications at the Manchester Office "the Court" is the Lancaster Palatine Chancery (§ 26 of the Act of 1888). When the registration is objected to on the ground that the mark tendered for registration is not qualified for registration, "the first duty cast upon the Court is to ascertain whether some one or more than one of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with the one or more than one essential particular or particulars which distinguish it." Per Lord Cairns, C., in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 484.

(*b*) It need not be the proprietor of a registered mark. In *In re Simpson, Davies & Sons*, M. R., Jan. 12th, 1881, the proprietors of a trade mark registered for coal in class 4 successfully opposed the registration of a similar mark for railway waggons in class 22, the opponent's coal being carried in and sold out of waggons.

(*c*) The practice in such case is prescribed by Rule 31.

(*d*) See Rules 20-26.

(*e*) § 69 as amended by § 13 of the Act of 1888, which for the first time gave the comptroller jurisdiction in such cases. As to the old practice, see *Ex parte Stephens*, 24 W. R. 819; *In re Salamon*, Dig. 569; *In re Johnston*, 43 L. T. N. S. 672; *In re Simpson, Davies & Sons*, 15 Ch. D. 525. As to costs, see *In re Brandreth*, 9 Ch. D. 618; *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278.

mark which it is considered to resemble (*a*). Thus registration has been granted in such a form as to be partial in respect of the mark itself which is registered (*b*), or of the goods for which it is registered (*c*), or of the manner of user in respect of colour (*d*), or otherwise (*e*), or of the locality within which it is to be used (*f*), or of the persons against whom it is to be protected (*g*).

Conflicting claims.

Again, where each of several persons claims the same trade mark the comptroller may refuse to register any of them until their rights have been determined according to law, and he may himself submit or require the claimants to submit their rights to the Court (*h*) in the form (unless the Court shall otherwise order) of a special case (*i*), agreed to by the parties, or, in case of difference, settled by the comptroller (*k*).

Issue may be directed.

In any proceeding for rectification of the register, the Court may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved (*l*).

Alteration of registered trade mark.

Subsequently to registration clerical errors may be corrected by the comptroller (*m*), who may also allow the application to be amended by omitting any of the goods for which the mark is claimed (*m*), and may, after registration, alter the address of the registered proprietor (*n*),

(*a*) See as to the growth of this form of registration, per Jessel, M.R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(*b*) See note (*c*) to § 72 and *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Hoyle & Sons, Limited* (2), Chitty, J., Nov. 30th, 1883; *In re Hayward & Sons*, 54 L. J. Ch. 1003; *In re Davies*, Chitty, J., March 9th, 1885.

(*c*) See note to § 65, *infrà*. The registration should always be so limited. See *Edwards* v. *Dennis*, 30 Ch. D. 454; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454.

(*d*) *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *In re Jeffrey & Co.*, Stirling, J., May 18th, 1888.

(*e*) See note (*c*) to § 72, *infrà*, and *In re Whiteley*, 43 L. T. N. S. 627; *In re Sykes*, *ib.* 626; *In re Farina* (3), Dig. 654.

(*f*) *In re Rahone*, Dig. 643; *In re Keep Bros.*, 26 Ch. D. 187; *In re Mitchell & Co.*, 28 Ch. D. 666; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888.

(*g*) *Ex parte Hemming & Son*, M. R., April 27th, 1881.

(*h*) § 71, and Rules 42, 43.

(*i*) Rule 44, and see note to § 71, *infrà*.

(*k*) Rule 45.

(*l*) § 90.

(*m*) § 91. (*n*) Rule 48.

and by leave of the Court the registered proprietor may alter his trade mark and procure an alteration of the register accordingly, but the alteration must not extend to any of the "essential particulars" of the trade mark (*a*).

No trust entered on register.

No notice of any trust, expressed, implied, or constructive, can be received by the comptroller, or entered in the register (*b*).

2. *Transfer.*

Assignment and transmission.

A trade mark is capable of being assigned during the life of its proprietor, and of being transmitted at his death; but it can be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered (*c*), and "an assignee has no exclusive right to a trade mark unless the assignment is of a business co-extensive with the trade mark as registered" (*d*). Trade marks registered as a series can only be assigned and transmitted as a whole (*e*).

Trade mark cannot be severed from goodwill.

Even apart from the Act, there is no doubt that the trade mark cannot be severed from and used independently of the goodwill. If that could be done, the *indicium* of genuineness might only serve to mislead. This view was clearly put by Lord Westbury, C., in the *Leather Cloth Companies' case* (*f*), when he suggested the case of a firm

(*a*) § 92; and see *In re Dewhurst*, M. R., June 11th, 1880. Notice of the application must be given to the comptroller: Rule 48.

(*b*) § 85. See *In re Mitchell & Co.*, 28 Ch. D. 666; *In re De Otaduy*, L. J. N. of C. 1885, p. 155.

(*c*) § 70. See *Massam* v. *Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Ex parte Lawrence & Co.*, 44 L. T. N. S. 98; *In re Wellcome*, 32 Ch. D. 213.

(*d*) Per Fry, L. J., in *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*e*) § 66.

(*f*) 4 De G. J. & S. 137; and see *Cotton* v. *Gillard*, 44 L. J. Ch. 90; *Taylor* v. *Bemis*, 4 Biss. 406; *Witthaus* v. *Braun*, 44 Md. 303; *Skinner* v. *Oakes*, 10 Mo. App. 45; *Morgan* v. *Rogers*, 19 Fed. Rep. 596; *McVeagh* v. *Valencia Cigar Factory*, 32 U. S. Pat. Gaz. 1124; *Oakes* v. *Tonsmierre*, 4 Woods 547; *Smith* v. *Fair*, 14 Ont. Rep. 729; *Smith* v. *Imus*, 32 Alb. L. J. 455; *In re Rowley & Pyne*, 9 Vict. L. R. (L.) 307. See *Goodman* v. *Meriden Britannia Co.*, 50 Conn. 139, as to the construction of a contract entered into on the sale of a trade mark.

of clothiers in Wiltshire, trading as A. B. & Co. for fifty years, and acquiring a great reputation for their broad cloth marked "A. B. & Co. Wilts"; then, he asked, supposing A. B. & Co. to discontinue their business, and to sell the right to use the mark to C. D. & Co., clothiers in Yorkshire, would the latter be protected in equity in their claim to the exclusive use of the mark? and he answered the question in the negative.

Trade mark passes with goodwill.

To such an extent is a trade mark an accessory of the goodwill, that in *Shipwright* v. *Clements* (*a*), Malins, V.-C., held that in the sale of the latter the trade mark would pass, whether specially mentioned or not (*b*).

Same principle adopted in America.

In a case before the New York Court of Appeals (*c*), the expression was adopted that "a property in trade mark might be obtained by transfer from him who had made the primary acquisition, though it was essential that the transferee should be possessed of the right either to manufacture or sell the merchandise to which the trade mark had been attached." In another American case (*d*), the statement that the "property or right to a trade mark might pass by an assignment or by operation of law," was followed by this limitation, "to any one who took at the same time the right to manufacture or sell the particular merchandise to which the trade mark had been attached." And in the case of *Kidd* v. *Johnson* (*e*), the Supreme Court of the United States laid down that "as distinct property, separate from the article created by the original producer or manufacturer, a trade mark may not be the subject of sale. But when it is affixed

(*a*) 19 W. R. 599.

(*b*) And see *Churton* v. *Douglas*, Johns. 174; *Fulton* v. *Sellers*, 4 Brews. 42; *Thompson* v. *Mackinnon*, 2 Steph. Dig. 726; *Merry* v. *Hoopes*, 111 N. Y. 415. But an assignment can give no exclusive right in a word used as a mere indication of quality: *Ib.*

(*c*) *Congress & Empire Spring Co.* v. *High Rock Congress Spring Co.*, 45 N. Y. 291; R. Cox, 599.

(*d*) *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews. 321; R. Cox, 559; and see *Walton* v. *Crowley*, 3 Bl. C. C. 440; R. Cox, 166; and *Derringer* v. *Plate*, 29 Cal. 292; R. Cox, 324.

(*e*) 100 U. S. Rep. 617.

to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred, either by contract or operation of law, to others, the right to the use of the trade mark may be lawfully transferred with it. Its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place, and are of the same character, as those to which the mark was attached by its original designer."

Personal trade mark.

It is possible that occasionally, though rarely, a trade mark may be so framed as not to be merely a simple indication of quality, or a guide to the place of manufacture, but to have the effect of ascribing the article to which it is attached to the personal skill or supervision of an individual. In such a case the question arises whether the trade mark which, when originally adopted, contained no assertion which was incorrect, is capable of transfer to another person so as to enable him to apply it to his own goods and to prevent a similar use of it by others, the personal skill and supervision of its former proprietor having ceased to be applied.

Not assignable.

The considerations which occur in cases where such a contention is set up are well stated by the Supreme Court of Massachusetts (*a*) in the following terms:—"There may, no doubt, be cases where the personal skill of an artist or artisan may so far enter into the value of a product that a trade mark bearing his name would, or at least might, imply that his personal work or supervision was employed in the manufacture; and in such cases it would be a fraud upon the public if the trade mark should be used by other persons, and for this reason such a trade mark would be held to be unassignable. . . . But, on the other hand, the usages of trade may be such that no such

(*a*) *Hoxie* v. *Chaney*, 143 Mass. 592.

inference would naturally be drawn from the use of a trade mark which contains a person's name, and that all that purchasers would reasonably understand is that goods bearing the trade mark are of a certain standard, kind, or quality, or are made in a certain manner, or after a certain formula, by persons who are carrying on the same business that formerly was carried on by the person whose name is in the trade mark."

Name of former proprietor.

It is, indeed, settled law in England, though there is some American authority (*a*) to the contrary, that the mere fact of the trade mark consisting of or containing the name of its former proprietor, who originally conducted the business with which the trade mark is connected, is not of itself sufficient to disentitle the transmittee or assignee of the business to continue to use the mark, since the mere name of the maker will be deemed to be indicative rather of a business, in whosesoever hands it may be, than of an individual proprietor of it (*b*).

When trade mark is personal.

It is, however, conceivable that a trade mark may be "so completely personal as of necessity to import that the goods sold under it have been manufactured by a particular individual" (*c*), as if it contains not only the name of the

(*a*) *Sherwood* v. *Andrews*, 3 Amer. L. Reg. N. S. 588; and see *Partridge* v. *Menck*, 2 Sandf. Ch. 622; *Carmichel* v. *Latimer*, 11 R. I. 395: *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; *Horton Manufacturing Co.* v. *Horton Manufacturing Co.*, 18 Fed. Rep. 816.

(*b*) *Bury* v. *Bedford*, 4 De G. J. & S. 352, *Churton* v. *Douglas*, Johns. 174; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Massam* v. *J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748; *Tussaud* v. *Tussaud*, 38 W. R. 503; and the American cases of *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Filkins* v. *Blackman*, 13 Bl. C. C. 440; *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178; *Booth* v. *Jarrett*, 52 How. Pr. 169; *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2) 51 How. Pr. 455; *Woods* v. *Sands*, Dig. 467; *Fulton* v. *Sellers*, 4 Brews. 42; *Young* v. *Jones Bros. & Co.*, 3 Hughes, 274. Compare *Clark* v. *German Mutual Fire Insurance Co.*, 7 Mo. App. 77; *Russia Cement Co.* v. *Le Page*, 147 Mass. 206; *Hoxie* v. *Chaney*, 143 Mass. 592; *Pepper* v. *Labrot*, 8 Fed. Rep. 29; *Société, etc., de la Bénédictine* v. *Micalovitch*, 36 Alb. L. J. 364; and the Canadian case of *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

(*c*) Per Turner, L. J., in *Bury* v. *Bedford*, 4 De G. J. & S. 352; so in *Carmichel* v. *Latimer*, 11 R. I. 395; *Oakes* v. *Tonsmierre*, 4 Woods 547; *Hoxie* v. *Chaney*, 143 Mass. 592.

proprietor, but also some reference to his personal qualifications or supervision (*a*), or an allusion to particular workmen in his employ (*b*), in which case the mark will already become deceptive even while the business remains in the same hands, if the proprietor should cease to give his personal attention, or to employ the same workmen. And in *Manhattan Medicine Co.* v. *Wood* (*c*), the Supreme Court of the United States said that "if one affix to goods of his own manufacture signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess in the estimation of purchasers. To put forth a statement, therefore, in the form of a circular or label attached to an article, that it is manufactured in a particular place by a person whose manufacture there had acquired a great reputation, when in fact it is manufactured by a different person at a different place, is a fraud upon the public which no Court of Equity will countenance."

No protection of deceptive marks.

In such a case, independently of statute, it is clear that no protection will be given to a mark become deceptive. Thus, Lord Westbury, C., was of opinion that the Court would not sell and transfer the right to use a mark of a personal character simply and without alteration (*d*).

The Patents, &c., Act, 1883.

The objection to the use of a trade mark become deceptive, which, independently of statute, applied rather to the

(*a*) *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453.

(*b*) And compare the reference by Lord Kingsdown to an artist's special skill, in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523.

(*c*) 108 U. S. Rep. 218, and see *In re Sweezy & Dart*, 62 How. Pr. 215; and Daly, C. J.'s observations in *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1.

(*d*) *Hall* v. *Barrows*, 4 De G. J. & S. 150. See, too, the Clothiers' case, suggested by him in the *Leather Cloth Co.'s case*, 4 De G. J. & S. 137; and the remarks of Lord Cranworth in that case in the House of Lords, 11 H. L. C. 523; and those of the L. JJ. in *Bury* v. *Bedford*, 4 De G. J. & S. 352. Compare *Sherwood* v. *Andrews*, 3 Am. L. Reg. N. S. 588, and *Partridge* v. *Menck*, 2 Sandf. Ch. 622.

use of the mark assigned than to the power of assigning it (*a*), should now, as it appears, more properly apply to the registration of the assignee or transmittee, by which the latter acquires, at least, a *primâ-facie* right to practise deceit. The Act, indeed, contains no provision expressly directed to meet a case of this kind, the 73rd section being only aimed at an attempted registration of a mark disentitled from the beginning to protection, by reason of being inherently calculated to deceive, and not to a registration of a subsequent proprietor of a mark which has lost its right to protection through a change of circumstances. The spirit of the Act is, however, to favour the general assignability of trade marks together with the goodwill to which they are attached, and it may be expected that such elements in a trade mark as would impede this assignability will very rarely, if ever, survive the original process of registration now necessary.

Trade marks generally transferable.

Subject only to the provision prohibiting the severance of a trade mark from the goodwill of the business with which it is connected, the trade mark is freely assignable. "The right to a trade mark may, in general, treating it as property, or an accessory of property, be sold and transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser" (*b*). If this were not so, the value of a very valuable and important part of

(*a*) Per Turner, L. J., in *Bury* v. *Bedford*, 4 De G. J. & S. 352.

(*b*) Per Lord Cranworth in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523; and see per V.-C. Wood in *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; also *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178; *Cook* v. *Starkweather*, 13 *ib.* 392; *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *In re Rohland*, 10 U. S. Pat. Gaz. 980; *Lockwood* v. *Bostwick*, 2 Daly, 521; *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306; and the clear and full statement by Daly, C. J., in *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1. It was said by Shipman, J., in the American case of *Filkins* v. *Blackman*, 13 Bl. C. C. 440, that "the right to the use of a trade mark cannot be so enjoyed by an assignee that he shall have the right to affix the mark to goods differing in character or species from the article to which it was originally attached."

the goodwill of the business carried on by a person (*a*) would be seriously diminished. And for a similar reason, and in the interest alike of the owner of a trade mark himself and of his assignee, the original owner will, subsequently to assignment, be restrained from the use of his former trade mark, equally with persons who have never had an interest in it (*b*). Nor after that event does he retain any power of conferring on another a right to use it (*c*). The same will be the case if the sale has been made, not by the owner himself, but by his trustee in bankruptcy (*d*). In the sale of a business a trade mark will pass to the purchaser without special mention (*e*).

Registration of subsequent proprietor.

When a person becomes entitled to a registered trade mark by assignment or transmission, or other operation of law, the way in which he has to obtain the registration of himself as the proprietor (*f*) is by sending a request to that effect to the comptroller (*g*), signed in the same way as is required in the case of an original application (*h*), stating the name, address, and description of the claimant, and the particulars of his title, showing that the trade mark has gone with the goodwill of the business (*i*), and accompanied by a statutory declaration verifying the several statements made (*k*). And further proof of title is to be furnished to the comptroller if he requires it (*l*).

Transmission on bankruptcy.

On the owner of a trade mark becoming bankrupt, his trade mark is transmitted with his business to his representative in bankruptcy, and will, together with

(*a*) Compare the observations of Wood, V.-C., as to the sale of a trade name, involving the same considerations, in *Churton* v. *Douglas*, Johns. 174; also *Shipwright* v. *Clements*, 19 W. R. 599.

(*b*) *Bury* v. *Bedford*, 4 De G. J. & S. 352; and see *Churton* v. *Douglas*, Johns. 174.

(*c*) *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Filkins* v. *Blachman*, 13 Bl. C. C. 440.

(*d*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1.

(*e*) *Shipwright* v. *Clements*, 19 W. R. 599.

(*f*) § 87.

(*g*) Rule 36.

(*h*) Rule 37.

(*i*) Rule 38, and see § 70.

(*k*) Rule 39. For form of application and declaration, see Form K in Second Schedule to Rules.

(*l*) Rule 40.

the business and goodwill, be dealt with by him (*a*). But, apart from the statutory provisions regulating registration, it seems that a trade mark which owes its value to its owner's personal skill will not pass; and in the American case of *In re Swezey and Dart* (*b*) an insolvent trader was directed to be examined for the purpose of ascertaining whether the value of the mark was owing to such skill or to the general working of the factory. And it has been held in America that an assignee in bankruptcy cannot sell a trade secret or a trade mark of which the main feature is the bankrupt's name, so as to restrict the bankrupt's right to use it (*c*); and also that where one of the partners in a solvent firm becomes bankrupt, his interest in the name or trade mark of the firm cannot be sold, on the ground that his right is only to an undivided part of the mark, and that this is of no value apart from its connection with the goodwill (*d*).

Formation of partnership.

Upon the formation of a partnership, one member of which is the proprietor of a trade mark, the trade mark will, in the absence of express provisions, or tacit acquiescence by the other partners in the previous owner's retention of his trade mark (*e*), pass into and become part of the partnership assets, for the trade mark is but an element of the trade (*f*). In that case it seems that the partner who has newly acquired an interest in the trade

(*a*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Cotton* v. *Gillard*, 44 L. J. Ch. 90; *Bury* v. *Bedford*, 4 De G. J. & S. 352; *Ex parte Young*, Dig. 537; *Rogers* v. *Taintor*, 97 Mass. 291; *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1; *Warren* v. *Warren Thread Co.*, 134 Mass. 247. And see *Longman* v. *Tripp*, 2 Bos. & P. N. R. 67; and *Ex parte Foss*, 2 De G. & J. 230.

(*b*) 62 How. Pr. 215.

(*c*) *Holmbold* v. *Holmbold Manufacturing Co.*, 53 How. Pr. 453; *Iowa Seed Co.* v. *Dorr*, 70 Iowa, 481.

(*d*) *Taylor* v. *Bemis*, 4 Biss. 406.

(*e*) *Kidd* v. *Johnson*, 100 U. S. Rep. 617, practically reversing *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337.

(*f*) *Bury* v. *Bedford*, 4 De G. J. & S. 352, per Turner, L. J. And see *Condy* v. *Mitchell*, 37 L. T. N. S. 268, *ib.* 766; *Filkins* v. *Blackman*, 13 Bl. C. C. 440; *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110; *Rogers* v. *Taintor*, 97 Mass. 291; *Sohier* v. *Johnson*, 111 Mass. 238; *Weston* v. *Ketcham* (2), 51 How. Pr. 455; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183.

mark will be entitled to registration as joint proprietor with his partner who is already on the register. And where, without the actual formation of a partnership, three persons agreed to carry on business in common, one manufacturing, another acting as exporting agent, and the third as consignee and merchant at Rangoon, it was held on appeal that neither had an exclusive right to the combination of marks used on the goods which had passed through this course, though some of the marks in the combination had been used separately by one of the three before the arrangement between them was made; the decision being based on the fact that the combination as a whole had come to denote goods which had passed through the hands of all three (*a*).

Dissolution of partnership.

Upon the dissolution of a partnership among whose property a trade mark is included, whether that dissolution be brought about by the mutual agreement of the partners or by the death of one of them, the trade mark, as forming part of the partnership assets, and also on account of its close connection with the goodwill of the business, must be treated in the same way as the business and goodwill are treated, unless there is an express agreement for its discontinuance. If the business and goodwill are sold, the trade mark will be included in the sale (*b*); if the share of the retiring or deceased partner is, by arrangement, taken over by the continuing or surviving partner or partners, the retiring or deceased partner's interest in the trade mark passes with his share in the business, and must be included in the valuation of that share (*c*); if the

(*a*) *Robinson* v. *Finlay*, 9 Ch. D. 487. Compare *In re Jones*, 53 L. T. N. S. 1.

(*b*) *Bradbury* v. *Dickens*, 27 Beav. 53; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Banks* v. *Gibson*, 34 Beav. 566; *Rogers* v. *Taintor*, 97 Mass. 291; *Armistead* v. *Blackwell*, 1 U.S. Pat. Gaz. 603.

(*c*) *Banks* v. *Gibson*, 34 Beav. 566; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Hazard* v. *Caswell*, 93 N. Y. 259; *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306; *Hoxie* v. *Chaney*, 143 Mass. 592. But it seems that if a retiring partner sets up no claim to an interest in the trade mark, and the continuing partner continues to use it without objec-

partners merely agree to divide the partnership assets, so that each in effect carries on the same business, though they carry it on severally instead of jointly, then each is at liberty to use the mark as he did before (*a*). Thus, where H. B. Condy had brought into a partnership formed between himself and one Mitchell certain trade marks, which consisted in part of the former's name, it was held that after the dissolution, on which the goodwill became divisible in equal shares between the partners, Mitchell was equally entitled with Condy to continue to use the trade mark (*b*). And where certain partners sold to their co-partner their interest in the business premises and in certain personal property connected with the business, but not their interest in the goodwill or trade mark, it was held that they retained their right to use the trade mark concurrently with their former co-partner (*c*).

Transmission on death.

Where a trade mark has been transmitted by the death of the registered proprietor, his legal personal representative will be recognised as having the title to the mark. So long since as the reign of King George II., Lord Hardwicke, C., decided (*d*) that shares in the goodwill of a newspaper, entitled *The St. James's Evening Post*, were to be considered as part of the personal property of the proprietor; and that, on the death of the proprietor, his

tion, the former will be held to have given up his interest in favour of the latter: *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337. See *Kidd* v. *Johnson*, 100 U. S. Rep. 617; *Holt* v. *Menendez*, 128 U. S. Rep. 182; and *Simpson* v. *Wright* (1), 15 U. S. Pat. Gaz. 248. On the other hand, the continued use of the mark by the retiring partner, even on a spurious article, is evidence of his intention to preserve his interest in the mark: *Wright* v. *Simpson*, 15 *ib.* 968.

(*a*) *Banks* v. *Gibson*, 34 Beav. 566. And see *Bond* v. *Milbourn*, 20 W. R. 197; *Weston* v. *Ketcham*, (1), 39 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455; *Young* v. *Jones Bros. & Co.*, 3 Hughes, 274; *Hazard* v. *Caswell*, 93 N. Y. 259; *Robinson* v. *Finlay*, 9 Ch. D. 487. In *In re Jones*, 53 L. T. N. S. 1, it was held that neither of the parties to a joint adventure was entitled, after this had come to an end, to use or register the joint trade marks as against the others.

(*b*) *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766.

(*c*) *Huver* v. *Dannenhoffer*, 82 N. Y. 499; *Hazard* v. *Caswell*, 93 N. Y. 259.

(*d*) *Giblett* v. *Read*, 9 Mod. 459.

trade mark passes to his personal representative with the remainder of his personal property has never been questioned (*a*). Where letters of administration to a person who had adopted a trade mark for an article of his invention had not been taken out, it was held that his son could not, by merely continuing to make the article and use the trade mark after his father's death, acquire a right in the trade mark so as to be entitled to prevent another person from using it; still less could a purchaser of the son's business do so (*b*). But a rather different view of the results of such a proceeding has been taken in America (*c*).

Bequest of trade mark.

The proprietor of a trade mark may bequeath it according to pleasure (*d*), but this is subject to the provisions prohibiting its transmission otherwise than in connection with the goodwill of his business (*e*), and a registered series of marks can only be transmitted as a whole (*f*).

Several proprietors.

By means of bequest, dissolution of partnership, &c., it is possible for more than one person to become severally entitled to the same trade mark at the same time (*g*), and concurrent rights may similarly arise by reason of concurrent substantial user by more firms than one (*h*). In such cases it was provided by the old rules, now repealed, that the several claimants might, by their common consent, be registered separately as separate proprietors of such trade mark; and although no such provision is contained

(*a*) Thus, in *Croft* v. *Day*, 7 Beav. 84, 28 Leg. Obs. 378, the successful plaintiffs were the executors of the former proprietor of the business and trade mark. See *In re Farina*, (4), 44 L. T. N. S. 99.

(*b*) *Hovenden* v. *Lloyd*, 18 W. R. 1132. And see *Singleton* v. *Bolton*, 3 Doug. 293.

(*c*) *Pratt's Appeal*, 117 Penn. St. 401.

(*d*) *Dent* v. *Turpin*, 2 J. & H. 139; *M'Lean* v. *Fleming*, 96 U. S. Rep. 245.

(*e*) § 70. And see Rules 38, 39, and Form K.

(*f*) § 66.

(*g*) *Hine* v. *Lart*, 10 Jur. 106; *Dent* v. *Turpin*, 2 J. & H. 139; *Banks* v. *Gibson*, 34 Beav. 566; and see *Southorn* v. *Reynolds*, 12 L. T. N. S. 75; and *Pratt's Appeal*, 117 Penn. St. 401.

(*h*) *In re Powell*, Dig. 589; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Benbow* v. *Low* (4), 44 L. T. N. S. 875; *Day* v. *Neale*, V.-C. B., May 24th, 1881; *In re Hodson & Co.*, 26 Sol. J. 43; and other cases on the Three Mark Rule. See note (*e*) to § 72, *infrà*.

in the new rules, it would appear that in such a case the comptroller would have a discretion to register each of the claimants (*a*). But where one of the claimants has got on to the register, the comptroller cannot register the other without the leave of the Court (*b*); neither can he do so where either application is opposed (*c*).

Position of subsequent proprietors.

By the 4th section of the Act of 1875, it was provided that every proprietor registered in respect of a trade mark subsequently to the first registered proprietor was, as respected his title to that trade mark, to stand in the same position as if his title were a continuation of the title of the first registered proprietor (*d*). This section is not re-enacted, but there appears to be no doubt that in ordinary cases the result will be the same as if it had been. It may be noticed that by § 76 the privileges conferred by § 3 of the Act of 1875 upon the *first* registered proprietor are now given to the registered proprietor.

3. *Discontinuance.*

When trade mark protected.

In order for a trade mark to be entitled to protection, it is now necessary either that the trade mark shall be registered, or, if an old mark incapable of registration is in question, that registration shall have been refused (*e*). The protection of a mark once registered terminates, therefore, with the cessation of registration.

Duration of registration.

The original registration of a trade mark is for a period of fourteen years; and unless previously to the expiration of that period the fee for continuance is paid, the comptroller may, after the end of three months from such expiration, remove the mark from the register, and in the same way from time to time at the expiration of every fresh period of fourteen years (*f*). No difficulty need in ordinary cases be apprehended from the prolongation of registration, for the exclusive use o a trade mark is no

(*a*) See § 71.
(*b*) § 72.
(*c*) § 69.
(*d*) Compare *Hovenden* v. *Lloyd*, 18 W. R. 1132.
(*e*) § 77.
(*f*) § 79 (1), (2).

injury or deprivation to the public, but a protection against fraud.

If subsequently to the expiration of the fourteen years, but before the expiration of the additional three months, the proprietor pays the increased fee, the comptroller may accept the fee as if paid before the expiration of the fourteen years, and allow the mark to remain on the register (*a*).

Restoration to register.

Even after the removal from the register for non-payment of the fee, the mark may be restored to the register by the comptroller, if he is satisfied that it is just so to do, on payment of an additional fee.

Must be a vendible article with trade mark attached.

Independently of registration no trade mark can exist as such unless there is actually existent in the market a vendible article to which the mark is in some way affixed or attached (*b*), though it is not necessary for the mark to be externally visible—*e.g.*, where it is placed on the bottom of a wine cork, which is not seen until the bottle is bought and opened (*c*).

Registration now equivalent to public use.

The necessity of proving the existence of such an article so marked, in the case of registered marks, now no longer exists, since, subject to the connection with the goodwill of the business, registration is to be deemed to be equivalent to public use (*d*); although, if a mark somewhat similar

(*a*) § 79 (3).

(*b*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Edwards* v. *Dennis*, 30 Ch. D. 454; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Candee* v. *Deere*, 54 Ill. 439; *Blackwell* v. *Dibrell*, 14 U. S. Pat. Gaz. 633; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027. And see *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434. In *Cotton* v. *Gillard*, 44 L. J. Ch. 90, the plaintiffs had bought from the trustee in bankruptcy the interest of the bankrupt in a certain sauce and in his trade mark, but the sauce being compounded according to a secret which the trustee could not communicate, Sir G. Jessel, M. R., held that the plaintiff could not use or protect the trade mark. See *Witthaus* v. *Braun*, 44 Md. 303; *Taylor* v. *Bemis*, 4 Biss. 406; *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455; *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; *Morgan* v. *Rogers*, 19 Fed. Rep. 596.

(*c*) *Moët* v. *Pichering*, 8 Ch. D. 372; *Moët* v. *Clybourn*, Dig. 533.

(*d*) § 75. This is so also in the United States: *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248. See *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120.

to, but not identical with, the registered mark has been used on goods on which the registered mark has never been used, though they are covered by the registration, the Court may decline to recognise the probability of deception (*a*). But in the case of old marks, it seems that a certificate of refusal will not entitle the unsuccessful applicant to his remedy, if discontinuance can be established. The 34th Rule under the Act of 1875 contained provisions intended to prevent the continuance of restrictions which no longer served any useful purpose, and this was put into practice in the case of *In re Ralph* (*b*). It has not been re-enacted; but since, by § 70, a trade mark is determinable with the goodwill, it may be held, though it is not clear, that the Court has jurisdiction under § 90 to remove from the register, on the application of any person aggrieved, a trade mark which has lost its right to existence by the discontinuance of its proprietor's business. Whether this is so or not, it appears very improbable that in such a case an injunction would be granted to protect it.

Abandonment by disuse.

"That the right to use a trade mark may be lost by abandonment or disuse is too clear to need argument or the support of authority" (*c*), and the neglect on the part of the owner which is fatal to his exclusive right may either take the shape of cessation of user on his own part, or of the growth of a concurrent right in others. Each of these depends upon intention. "To constitute abandonment" (*i.e.* by cessation of user) "an intention to abandon must be shown. Mere non-user of a trade mark can no more be said to constitute abandonment than the mere non-user of a right to foul a stream belonging to a mill as an easement can be said to constitute an abandonment of the easement" (*d*). But when the word claimed as a trade

(*a*) *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*b*) 25 Ch. D. 194.

(*c*) Per Hughes, J., in *Blacknell* v. *Dibrell*, 14 U. S. Pat. Gaz. 633. See *Lavergne* v. *Hooper*, Ind. L. R. 8 Mad. 149.

(*d*) Per Chitty, J., in *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398. It would be evidence of intention to

mark had not been used during a period of eleven years, and the sale of the article on which it had been used had been discontinued, and the labels on which it had appeared had been destroyed, it was held that there had been abandonment (*a*).

Abandonment of permitting infringements.

"The question of abandonment" (*i.e.* by non-interference with infringers) "is one of intention, and the burden of establishing it lies upon the party who affirms it," said an American judge (*b*); and in the same way it was said in the High Court of Bengal (*c*) that the right of property in a trade mark acquired by user "would continue until it had been proved by evidence that the proprietor had abandoned it." In particular, where the trade mark owner is ignorant of infringements taking place, it will not be held that he has abandoned his rights because of his failure to enforce them, that failure being due to his ignorance of what was going on (*d*); but it may be assumed that there must be reasonable diligence shown in the defence of his rights.

Distinctive words become descriptive.

With respect to trade marks consisting of words which originally were distinctive, it has occasionally happened that they have ceased to denote the manufacture of any particular person, and have become simply descriptive of a certain article or a certain principle of manufacture. When that has become the case, such words have ceased to be capable of protection as trade marks, having become *publici juris*, open to the use of all (*e*). But a composite mark is

abandon if a trade mark owner were to break up his moulds and erase the mark from his books and lists: *Ib.*

(*a*) *In re Grossmith*, 60 L. T. N. S. 612.

(*b*) Morris, Comm., in *Julian* v. *Hoosier Drill Co.*, 75 Ind. 408, in which a delay of three years was held not to amount to abandonment.

(*c*) In *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185, per Levinge, J.

(*d*) *Weldon* v. *Dicks*, 10 Ch. D. 247; *In re Farina* (2), 27 W. R. 456; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398; *Williams* v. *Adams*, 8 Biss. 452; *Sawyer* v. *Kellogg*, 7. Fed. Rep. 721; 9 *ib.* 601.

(*c*) Per Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. 611. And see *Wheeler & Wilson Manufacturing Co.* v. *Shakespeare*, 39 L. J. Ch. 36; *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298; *Same* v. *Anderson*, W. N. 1883, p. 185; *Lazenby* v. *White*, 41 L. J. Ch. 354; *In re Hyde & Co.*, 7 Ch. D. 724; *Brownie* v. *Freeman*, W. N.

not abandoned by isolated words or symbols contained in it being used by others (*a*); and it has been held in America that where a word has been properly appropriated as a trade mark, and has not been formally abandoned, use in a descriptive sense by persons other than the proprietor does not make it open to the public (*b*). Where a name, which it has been attempted to appropriate as a trade mark, has been in fact descriptive throughout, the case can hardly be said to have arisen of a discontinuance of a trade mark, inasmuch as it was invalid originally (*c*).

The Three Mark Rule.

In this connection the "three-mark rule," as it is called, becomes of importance. This rule originated in the discovery—soon after the Act of 1875 came into operation—that the same or substantially the same trade mark was in many instances in use by more firms than one, generally carrying on business in different parts of the country; and in order to avoid injustice being done in such cases the rule was laid down by the Commissioners of Patents, and acted on in various decisions of the Courts, that where two or three firms could prove that they had used the same or substantially the same mark on the same or substantially the same goods, to a substantial extent, before the passing of the Act of 1875, each should be allowed to register; but that where the mark had been used by more than three firms it was common to the trade (*d*); and on this principle it has been held that various

1873, p. 178; *Lea* v. *Millar*, Dig. 513; *Lea* v. *Deakin*, 11 Biss. 23; *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. (E.) 98; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776; *Smith* v. *Imus*, 32 Alb. L. J. 455; *Wolfe* v. *Goulard*, 18 How. Pr. 64; R. Cox, 226; *Burke* v. *Cassin*, 45 Cal. 467; 13 Amer. Rep. 204.

(*a*) *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Filley* v. *Child*, 16 Bl. C. C. 376.

(*b*) *Celluloid Manufacturing Co.* v. *Cellonite Manufacturing Co.*, 32 Fed. Rep. 94; *Selchow* v. *Baker*, 93 N. Y. 59; *Société, &c., de la Bénédictine* v. *Micalovitch*, 36 Alb. L. J. 364.

(*c*) *Young* v. *Macrae*, 9 Jur. N. S. 322; *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *In re Horsburgh*, 53 L. J. Ch. 237; *Rowland* v. *Breidenbach*, Dig. 386; *In re Leonard & Ellis*, 26 Ch. D. 288; *Bulloch, Lade & Co.* v. *Gray*, 19 Journ. of Jurisp. 218; and see p. 62, note (*c*), *supra*.

(*d*) See note (*e*) to § 72, *infra*.

marks were common in different trades (*a*). This rule is now incorporated in § 74, so far as is necessary for the purpose of determining what parts of a composite mark must be disclaimed as common.

Trade mark not abandoned by habitual user in combination with name.

In *Braham* v. *Bustard* (*b*) and *Ford* v. *Foster* (*c*) it was held that the habitual use of the manufacturer's name (which was alone a sufficient trade mark), before the special and distinctive appellation of "Excelsior" in the one case and "Eureka" in the other, did not amount to an abandonment of the manufacturer's right in those appellations when used without the name, but that the manufacturer remained entitled to his essential mark. In *Lea* v. *Millar* (*d*) it was held that, in addition to the evidence as to the common use of the alleged trade mark by persons other than the plaintiff, the fact that the plaintiff had recently adopted a new label upon his goods, on the ground that his existing label did not afford sufficient protection, was a public abandonment of the latter. And in *Manhattan Medicine Co.* v. *Wood* (*e*), it was held that a trade mark had been lost by abandonment, a new form of bottle and label having been adopted in place of the old ones. An exclusive right to a mark may be lost by its owner using it habitually and exclusively upon goods which pass through other persons' hands so that they acquire a right in it (*f*); and it would appear that, notwithstanding certain American decisions (*g*) to the effect that the habitual addition to a label of the name of the merchant to whom the goods are supplied does not deprive the owners of the label of their right to it, yet such a practice would cause the label to lose its distinctive character as indicating its proprietor's goods (*h*).

(*a*) See notes to § 74, *infrà*.
(*b*) 1 H. & M. 447.
(*c*) L. R. 7 Ch. 611.
(*d*) Dig. 513.
(*e*) 108 U. S. Rep. 218.
(*f*) *Robinson* v. *Finlay*, 9 Ch. D. 487.
(*g*) *Pike Manufacturing Co.* v. *Cleveland Stone Co.*, 35 Fed. Rep. 896; *Sheppard & Co.* v. *Stuart & Peterson*, 13 Phila. 117.
(*h*) *Wood* v. *Lambert*, 32 Ch. D. 247.

Abandonment by a retiring partner.

It has been held in the United States that a partner who, on retiring from the partnership, sets up no claim to an interest in the trade mark, and sees, without objection, the remaining partner continuing to use it, must be taken to have abandoned all interest in it (*a*). But it has also been held in America that the continued use of the mark by the retiring partner, even on a spurious article, is evidence that he does not intend to abandon his interest (*b*).

Abandonment by dismissal of suit.

In *Browne* v. *Freeman* (*c*) it was held that the plaintiff, having previously commenced a suit against an infringer of his trade mark, and then having got his bill dismissed with costs, in consequence of being advised that his right was doubtful, had lost all rights in the trade mark. Under the registration system such a loss of trade mark can seldom occur except in the case of unregistered though certified marks, since the rights of a proprietor of a registered mark are such that it is impossible to suppose that in many cases such a proprietor would resign his claims without a struggle. With respect to marks unregistered, or even uncertified, there does not appear to be anything in the Act to prevent proof of the imitation of such marks being given in support of an action for unfair competition in trade carried on by means of actual intentional fraud, and not depending solely on the similarity of the marks.

Abandonment of registered marks not to be anticipated.

On the whole, it may be expected that, with respect to registered marks, there will be in the future but little discontinuance or abandonment, except where registration has been discontinued, in consequence of non-compliance on the part of the registered proprietor with the requirements of the Act with respect to prolonged registration.

(*a*) *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337; but see *Kidd* v. *Johnson*, 100 U. S. Rep. 617. See also *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110; *Simpson* v. *Wright* (1), 15 *ib.* 248; *Holt* v. *Menendez*, 128 U. S. Rep. 182.

(*b*) *Wright* v. *Simpson*, 15 U. S. Pat. Gaz. 968.

(*c*) 12 W. R. 305; and see W. N. 1873, p. 178. See *Massam* v. *Thorley's Cattle Food Co.*, 14 Ch. D. 748.

Infringement of disused mark.

In *Lemoine* v. *Ganton* (*a*), a plaintiff was allowed to recover nominal damages for the infringement by the defendant of a trade mark which the plaintiff had formerly used, but had ceased to use for a year. And it has also been held by the United States Commissioner of Patents that a person who, after having acquired certain rights in a trade mark, has discontinued his business for several years, recovers, on again commencing business, superior rights in the trade mark to those possessed by another person who has used the mark during the period of discontinuance (*b*).

Effect of removed mark.

By § 79 (5), as amended by the Act of 1888, a registered trade mark removed from the register is, for the purpose of any application for registration during one year next after the date of such removal, to be deemed to be a trade mark already registered.

Cancellation.

By § 91 power is given to the comptroller upon a proper application to cancel the whole or a part of the entry of a trade mark on the register. In this case a statutory declaration by the registered proprietor is necessary (*c*).

(*a*) 2 E. D. Smith, 343; R. Cox, 142.

(*b*) *Armistead* v. *Blacknell*, 1 U. S. Pat. Gaz. 603.

(*c*) See notes to § 91, *infrà*, and Forms O. and P

CHAPTER IV.

INFRINGEMENT.

Requisites for infringement.

WHEN an action has been commenced, having for its object the restraint of an unfair competition in trade, carried on by means of an employment by the defendant of a trade mark identical, or nearly identical, with the plaintiff's, there must be established, in order for the action to be successful, the existence of the trade mark, the plaintiff's exclusive right therein (*a*), the fact of an imitation, and the absence of licence or acquiescence on the part of the plaintiff (*b*).

Fact of infringement.

Assuming, then, the validity of the trade mark and the rights of the plaintiff therein to be established, the next and most important point for the plaintiff to prove is the fact of infringement. The plaintiff has no right to say that the defendant shall not sell exactly the same article, better or worse, or an article looking exactly like his own unpatented article; but he has a right to say that the defendant shall not sell such article in such a way as to steal (so to call it) the plaintiff's trade mark, and make purchasers believe that it is the manufacture to which that trade mark was originally applied (*c*). In the language of the Common Law, the defendant has no right to sell his goods "as and for" those of the plaintiff (*d*); and "where

(*a*) As to this, see *Witthaus* v. *Braun*, 44 Md. 303; *Popham* v. *Wilcox*, 38 N. Y. Super. Ct. 274; *Weston* v. *Ketcham* (1) and (2), 39 *ib.* 54; 51 How. Pr. 455; and *Compagnie Laferme* v. *Hendrickx*, Dig. 512.

(*b*) See *Kinahan* v. *Bolton*, 15 Ir. Ch. 75; and *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137.

(*c*) See per Lord Cranworth, C., in *Farina* v. *Silverlock*, 6 De G. M. & G. 214; and per Lord Langdale, M.R., in *Franks* v. *Weaver*, 10 Beav. 297.

(*d*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; *Morison* v. *Salmon*, 2 Man. & G. 385; *Cranshay* v. *Thompson*, 4 *ib.* 357.

it is shown that a dealer has the imitated article in his store, and offers it for sale as genuine, even though but a single sale is proved (*a*), that is sufficient to sustain an injunction against a continuance of the wrong, and an action for such injunction will not be defeated solely on the ground that on the day it is brought the dealer happens not to have any of the article on hand" (*b*).

Fraudulent intention.

The question of how far a fraudulent intention in the mind of the defendant was necessary to entitle the plaintiff to obtain redress from him long remained a subject of discussion in connection with trade marks. The doctrine of the Common Law was that, inasmuch as the only manner in which the Common Law could be set in motion to repair the wrongful proceedings of an infringer was by the institution of an action on the case (*c*), an allegation of intentional fraud (*d*), supported by evidence, was necessary to enable the plaintiff to bring his action to a successful conclusion (*e*).

First purchaser not deceived.

While, however, it was necessary at Common Law for a fraudulent intention to be proved, it was not required that the defendant should have represented to his immediate purchaser that the goods marked were of the plaintiff's manufacture; it was sufficient to bring the case within the reach of the law if he had sold the goods for the purpose of their being resold as and for goods of the plaintiff's manufacture, which object the mark attached to them by the defendant would be calculated to facilitate (*f*).

Early doctrine in Chancery.

When plaintiffs in trade-mark cases began to seek

(*a*) See *Bondier* v. *Depatie*, 3 Dorion 233.

(*b*) Per the New York Court of Appeals in *Low* v. *Hart*, 90 N. Y. 457.

(*c*) See *Cranshay* v. *Thompson*, 4 Man. & G. 357.

(*d*) *I.e.*, that the defendant had acted knowingly—*scienter*.

(*e*) *Singleton* v. *Bolton*, 3 Doug. 293; *Morison* v. *Salmon*, 2 Man. & G. 385; *Cranshay* v. *Thompson*, 4 *ib.* 357; *Rodgers* v. *Nowill*, 5 C. B. 109; and *Myers* v. *Baker*, 3 H. & N. 802. See, too, per Parke, B., in *Taylor* v. *Ashton*, 11 M. & W. 415.

(*f*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; and see *Chappell* v. *Davidson*, 2 K. & J. 123; *Rose* v. *Loftus*, 47 L. J. Ch. 576; *Orr-Ewing & Co.* v. *Johnston & Co.*, 7 App. Cas. 219; *Balfour & Co.* v. *Kilburn & Co.*, 1 Hyde, 270.

redress in the Court of Chancery, desirous of obtaining the more convenient remedy by way of injunction and account, which was superior to the damages to be gained at Common Law alike in the compensation for the past and in the security for the future, the Chancery judges held that the Courts in which they presided could act only in aid of and as ancillary to the legal right (*a*). And acting upon this same principle, they held that the rules by which they had to judge of infringement must be identical with those of the Common Law, the plaintiff's right to his remedy being considered to be based, not on any right of property in him, but on the fraudulent proceedings of the defendant (*b*). The cases which were frequently sent by Chancery judges to be tried at Common Law by a jury were, of course, tried in accordance with Common Law principles (*c*).

Same injury caused, whether actual fraud or not.

It is, however, apparent that the seriousness of the injury inflicted on the manufacturer who has acquired a reputation for excellence in a particular class of goods, denoted by a special trade mark, by the offering for sale in the market of other goods, side by side with his, bearing the same mark, is not affected by the question whether such rival goods are made and marked by a person who is aware of the reputation of the original goods and desirous of attracting to himself some of the profits of that reputation, or by one who is actuated by no such motives, and is even ignorant of the prior use of the mark. As Lord Cairns, C., said, in a well-known case (*d*):—"A man may take the trade mark of another ignorantly, not knowing it

(*a*) See per Lord Cottenham, C., in *Motley* v. *Downman*, 3 My. & Cr. 1.

(*b*) *Blanchard* v. *Hill*, 2 Atk. 484; *Canham* v. *Jones*, 2 V. & B. 218; *Perry* v. *Truefitt*, 6 Beav. 66; *Croft* v. *Day*, 7 Beav. 84. And see the observations of V.-C. Wood in *Edelsten* v. *Vick*, 11 Hare, 78; *Collins Co.* v. *Cowen*, 3 K. & J. 428; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; *Hall* v. *Barrows*, 32 L. J. Ch. 548; and *McAndrew* v. *Bassett*, 33 L. J. Ch. 561.

(*c*) *E.g.*, *Rodgers* v. *Nowill*, 5 C. B. 109.

(*d*) *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 391.

was the trade mark of the other; or he may take it in the belief, mistaken but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it knowing it is the trade mark of his neighbour, and intending and desiring to injure his neighbour by so doing. But in all these cases it is the same act that is done, and in all these cases the injury to the plaintiff is just the same." "If a man has acquired legitimately a right to the property in an exclusive use of a name, it is of small account to him, should it be invaded, whether the invasion comes from a purpose to deceive, or from ignorance, or inadvertence, or an honest misconception of the relative rights of the parties; and the law ought not to permit, and will not permit, the continuance of the invasion, whatever may have been its origin" (*a*). The first maker is defrauded, even though his rival's conduct be not intentionally fraudulent.

Later doctrine in Chancery.

In 1838, Lord Cottenham, C., awarded a perpetual injunction in a case in which he rejected any imputation of intentional fraud (*b*), and this is not now necessary to obtain redress in equity. The principles in accordance with which relief will be given in equity were summed up as follows by Lord Westbury, C.:—"At Law the proper remedy is by action on the case for deceit, and proof of fraud on the part of the defendant is of the essence of the action; but this Court will act on the principle of protecting property alone, and it is not necessary for the injunction to prove fraud in the defendant, or that the credit of the plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief. Neither will the plaintiff be deprived of remedy in Equity,

(*a*) Per Lord O'Hagan, *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 396; and see per Cotton, L. J., in *Singer Manufacturing Co.* v. *Loog* (3), 18 Ch. D. 412; and *Blackwell* v. *Wright*, 73 N. Car. 310.

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

even if it be shown by the defendant that all the persons who bought from him goods bearing the plaintiff's trade mark were well aware that they were not of the plaintiff's manufacture. If the goods were so supplied by the defendant for the purpose of being sold again in the market the injury to the plaintiff is sufficient. Again, it is not necessary for relief in Equity that proof should be given of persons having been actually deceived, and having bought goods with the defendant's mark, under the belief that they were of the manufacture of the plaintiff, provided that the Court be satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other" (*a*). It is not necessary for the plaintiff to show that the defendant knew whose trade mark his resembled (*b*), nor, in fact, to show that the defendant knew that his trade mark resembled any existing mark (*c*). "The action of the Court must depend upon the right of the plaintiff, and the injury done to that right. What the motive of the defendant may be, the Court has very imperfect means of knowing. If he was ignorant of the plaintiff's rights in the first instance, he is, as soon as he becomes acquainted with them and perseveres in infringing upon them, as culpable as if he had originally known them" (*d*). In short, "the absence of fraudulent intention is no defence against an application to the Court for an injunction by the person whose property has been injured" (*e*); and

(*a*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185. That the rule of the Court of Chancery was as here stated, was recognised by the Court of Queen's Bench in *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537.

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

(*c*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Burgess* v. *Hills*, 26 Beav. 244; *Harrison* v. *Taylor*, 11 Jur. N. S. 408; *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185; and see per Cotton, L. J., in *Singer Manufacturing Co.* v. *Loog* (3), 18 Ch. D. 412.

(*d*) Per Lord Cairns, C., in *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376-91.

(*e*) Per Stuart, V.-C., in *Clement* v. *Maddick*, 1 Giff. 98; *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434; *Rose* v. *Loftus*, 47 L. J. Ch. 576; *Upmann* v. *Forester*, 24 Ch. D. 231; *Cowen* v. *Hulton*,

even if a person who has in his possession a quantity of goods bearing a spurious trade mark, is not intending to sell them or part with them, but to use them for his own consumption, relief will be granted against him (*a*).

Indulgence to innocent offender.

It was, however, suggested by Lord Romilly, M. R., that the Court would not require a person to completely change a trade mark which he had taken *bonâ fide*, and without any intention of deception, but which did in point of fact resemble the trade mark of another person, since the complete change of trade mark might be of so serious consequence to the unintentional offender (*b*); and it has been held in America that a plaintiff may lose by delay his right to an injunction against an innocent vendor of goods spuriously marked, whatever might be the case with regard to the guilty manufacturer (*c*).

Fraudulent intention, as affecting account, or damages.

It is also important to prove the fact of fraudulent intention, having regard to the account to be obtained, which may not be given in respect of sales by the defendant during such time as he continued in ignorance that he was infringing the plaintiff's rights (*d*), or with a view to the question of damages (*e*).

Fraudulent intention in case of delay.

Again, in *Rodgers* v. *Rodgers* (*f*), Mellish, L. J.,

46 L. T. N. S. 897. The same principle holds good in Ireland: *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371; in the United States: *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Stonebraker* v. *Stonebraker*, 33 Md. 252; *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298; *Colman* v. *Crump*, 70 N. Y. 573; *Blackwell* v. *Wright*, 73 N. Car. 310; *McCann* v. *Anthony*, 21 Mo. App. 83; *Williams* v. *Brooks*, 50 Conn. 278; *Pratt's Appeal*, 117 Penn. St. 401; in India: *Balfour & Co.* v. *Kilburn & Co.*, 1 Hyde, 270; *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185; *Graham & Co.* v. *Kerr, Dods & Co.*, 3 Beng. L. R. App. 4; and in Australia: *Hennessy* v. *White*, 6 W. W. & A'B. Eq. 216; *Hennessy* v. *Hogan*, 6 W. W. & A'B. Eq. 225.

(*a*) *Upmann* v. *Forester*, 24 Ch. D. 231. But see *Upmann* v. *Currey*, 29 Sol. J. 735.

(*b*) *Bass* v. *Dawber*, 19 L. T. N. S. 626.

(*c*) *Rodgers* v. *Philp*, 1 U. S. Pat. Gaz. 29.

(*d*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Moet* v. *Couston*, 33 Beav. 578. See *Rose* v. *Loftus*, 47 L. J. Ch. 576.

(*e*) See *Faber* v. *D'Utassey*, 11 Abb. Pr. N. S. 399; *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178.

(*f*) 31 L. T. N. S. 285. And see *McLean* v. *Fleming*, 96 U. S. Rep. 245, where an injunction which had been granted was confirmed by the U. S. Supreme Court, notwithstanding a delay of many years.

expressed an opinion that, in a case in which the application for an injunction would, in the absence of proof of actual fraud, have to be rejected on the ground of long user by the defendants without assertion by the plaintiffs of their right, yet if it were clearly made out that the use of the trade mark by the defendants was fraudulent, and that it had the practical effect of deceiving the public, then in such a case the intentional fraud would operate to prevent the application for the injunction from being defeated on the ground of lapse of time.

In other respects.

Further, in *Radde* v. *Norman* (*a*), it was held by Wickens, V.-C., to be quite obvious that much less absolute proof of the plaintiff's title would be required where there was reason to doubt the defendant's good faith; and in *Cope* v. *Evans* (*b*), Hall, V.-C., said that where fraudulent intention was proved, the Court would restrain the defendants without further inquiry.

Circumstances pointing to fraudulent intention.

In default of direct proof of fraudulent intention, there are various circumstances which may serve to point to the conclusion that such intention has existed: thus, the continuing to use a mark after objections raised (*c*); the exact imitation of peculiar characteristics (*d*); the addition

(*a*) L. R. 14 Eq. 348.

(*b*) L. R. 18 Eq. 138. And see *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Wilson* v. *Maxfield*, L. J. N. of C. 1875, p. 51; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Moxie Nerve Food Co.* v. ——, 43 U. S. Pat. Gaz. 888; *Miller Tobacco Manufactory* v. *Commerce*, 45 N. J. Law 123.

(*c*) See per Lord Cairns in *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376; and per Cotton, L. J., and Lord Blackburn in *Singer Manufacturing Co.* v. *Loog* (3), 18 Ch. D. 395; 8 App. Cas. 15. Also *Williams* v. *Osborne*, 13 L. T. N. S. 498; *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434; *Walker* v. *Alley*, 13 Grant Up. Can. Ch. 366; *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371; *Holt* v. *Menendez*, 128 U. S. Rep. 182.

(*d*) *Hine* v. *Lart*, 10 Jur. 106; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *Davis* v. *Reid*, 17 Grant Up. Can. Ch. 69; *Rodgers* v. *Philp*, 1 U. S. Pat. Gaz. 29; *Landreth & Sons* v. *Landreth*, 22 Fed. Rep. 41; *Glen Cove Manufacturing Co.* v. *Ludeman*, 23 Bl. C. C. 46; *Southern White Lead Co.* v. *Carey*, 25 Fed. Rep. 125; *Anheuser Busch Brewing Association* v. *Clarke*, 26 Fed. Rep. 410; *Pierce* v. *Guittard*, 68 Cal. 68.

to an existing mark of a feature taken from the plaintiff's mark (*a*); the imitating changes introduced by the plaintiff (*b*); the removal, one by one, of points of difference, which originally served to distinguish the defendant's mark from the plaintiff's (*c*); the marking goods in obedience to an order to imitate the plaintiff's mark (*d*); the giving orders for that to be done (*e*); the adoption of an essential part of the plaintiff's mark, with a trifling and colourable alteration (*f*); the placing of a word resembling the plaintiff's word on the same spot on an article of the same shape (*g*); the statement that the sources from which both plaintiff and defendant derive their raw material, and after which the plaintiff's works are named, are the defendant's sole property (*h*); the use on the goods of the name of a town where the defendant does not carry on business but the plaintiff does (*i*); the copying directions for use (*k*); the giving thanks to the plaintiff's customers for past favours (*l*); the adoption of similar type to the plain-

(*a*) *Dixon* v. *Jackson*, Ct. of Sess. Cas., 3rd Ser., V. 326 (a star added); *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417.

(*b*) *Braham* v. *Beachim* (1), 7 Ch. D. 848; *Siegert* v. *Findlater*, *ib.* 801.

(*c*) *Farina* v. *Cathery*, L. J. N. of C., 1867, p. 134; *Brown* v. *Mercer*, 37 N. Y. Super. Ct. 265; *Bell, Black & Co.* v. *Bell & Co.*, Dig. 514; *Reynolds & Son* v. *Walker*, 87 L. T. (Journal) 93; *Celluloid Manufacturing Co.* v. *Cellonite Manufacturing Co.*, 32 Fed. Rep. 94; *Pratt's Appeal*, 117 Penn. St. 401.

(*d*) *Woollam* v. *Ratcliff*, 1 H. & M. 259.

(*e*) *Godillot* v. *Hazard*, 81 N. Y. 263; *Twentsche Stoom Bleekery Geer* v. *Ellinger & Co.*, 26 W. R. 70.

(*f*) *Radde* v. *Norman*, L. R. 14 Eq. 348 ("Leopoldsalt" for "Leopoldshall"); *Derby Photographic Dry Plate Co. v. Pollard, Graham & Co.*, 2 Times L. R. 276 ("Derwent" for "Derby"); *Thompson* v. *Montgomery*, 41 Ch. D. 35 (a T for a cross); *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Davis* v. *Reid*, 17 Grant Up. Can. Ch. 69; *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434; *Balfour & Co.* v. *Kilburn & Co.*, 1 Hyde, 270.

(*g*) *Slazenger & Sons* v. *Feltham & Co.*, 6 P. R. 531.

(*h*) *Wheeler* v. *Johnston*, 3 L. R. Ir. 284.

(*i*) *Anheuser Busch Brewing Association* v. *Piza*, 23 Bl. C. C. 245; *Southern White Lead Co.* v. *Carey*, 25 Fed. Rep. 125.

(*k*) *Franks* v. *Weaver*, 10 Beav. 297; *Sedon* v. *Senate*, Dig. 18; *Youatt* v. *Winyard*, 1 Jac. & W. 394; *Blofeld* v. *Payne*, 4 B. & Ad. 410; *Day* v. *Walls*, 12 Phila. 274; and many other cases.

(*l*) *Mogford* v. *Courtenay*, 45 L. T. N. S. 303; *Walker* v. *Alley*, 13 Grant Up. Can. Ch. 366.

tiff's (*a*); the use of large type for a catchword (*b*); or of small type for a word showing the article not to be the original (*c*); the imitation of numbers used by the plaintiff (*d*); the imitation of the barrels (*e*), or bottles (*f*), containing the plaintiff's article; the buying up and using the plaintiff's old bottles (*g*); the use by the defendant of a name not his own (*h*), possibly under the authority of some person who bore the same name as the plaintiff (*i*); the formation of a partnership with another person, whose name or initial was such as to enable the defendant to imitate the plaintiff's mark with some specious pretence of legality (*k*); the addition of "and Co." after the name (*l*); the alteration of a name acquired by purchase with the

(*a*) *India Rubber Comb Co.* v. *Rubber Comb and Jewelry Co.*, 45 N. Y. Super. Ct. 258; *Potter* v. *McPherson*, 28 N. Y. Sup. Ct. 559.

(*b*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; *Motzler* v. *Wood*, 8 Ch. D. 606; *Dence* v. *Mason* (1), Dig. 534; *Foot* v. *Lea*, 13 Ir. Eq. 484.

(*c*) *Day* v. *Binning*, C. P. Coop. 489; *Glenny* v. *Smith*, 2 Dr. & Sm. 476; *Hookham* v. *Pottage*, L. R. 8 Ch. 91; *Robinsau* v. *Charbonnel*, W. N., 1876, p. 160; *Dence* v. *Mason* (1), Dig. 534; 41 L. T. N. S. 573; *Colton* v. *Thomas*, 7 Phila. 257; *Chubb* v. *Priest*, 1 L. T. 142; *Hennessy* v. *White*, 6 W. W. & A'B. Eq. 216; *Morgan* v. *Schuyler*, 79 N. Y. 490.

(*d*) *Humphreys' Specific Homœopathic Medicine Co.* v. *Wenz*, 14 Fed. Rep. 250.

(*e*) *Moorman* v. *Hoge*, 2 Sawy. 78; *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392.

(*f*) *Henry* v. *Price*, 1 Leg. Obs. 364; *Siegert* v. *Findlater*, 7 Ch. D. 801; *Wolfe* v. *Goulard*, 18 How. Pr. 64; *Laird* v. *Wilder*, 9 Bush 131; *Congress Co.* v. *High Rock Co.*, 45 N. Y. 291; *Wilder* v. *Wilder*, Dig. 372; *Wolfe* v. *Hart*, 4 Vict. L. R. Eq. 125; *Fullwood* v. *Fullwood* (1), W. N. 1873, p. 93, 185; *Hostetter* v. *Adams*, 20 Bl. C. C. 326; *Carbolic Soap Co.* v. *Thompson*, 25 Fed. Rep. 625; *Moxie Nerve Co.* v. *Baumbach*, 32 Fed. Rep. 205.

(*g*) *Rose* v. *Henley*, Dig. 551; *Allen* v. *Richards*, 26 Sol. J. 658; *Hostetter* v. *Anderson*, 1 V. R. Eq. 7.

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

(*i*) *Meriden Britannia Co.* v. *Parker*, 39 Conn. 450; 12 Amer. Rep. 401; *Perks* v. *Hall & Co.*, W. N. 1881, p. 111; *Melachrino* v. *Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Rogers Manufacturing Co.* v. *Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495.

(*k*) *Croft* v. *Day*, 7 Beav. 84 (Day & Martin); *Moët* v. *Clybourn*, Dig. 533 (M. & C.). And see *Schweitzer* v. *Atkins*, 37 L. J. Ch. 847; *Hallett* v. *Cumston*, 110 Mass. 29; *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(*l*) *Churton* v. *Douglas*, Johns. 174; *Fullwood* v. *Fullwood* (1) W. N. 1873, pp. 93, 185; *Holt* v. *Smith*, 4 Times L. R. 329; *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888; *Devlin* v. *Devlin*, 69 N. Y. 212; *Brooklyn White Lead Co.* v. *Masury*, 25 Barb. 416.

goodwill of a business, so as to assimilate it to the name of another firm carrying on a similar business (*a*); the removal into the plaintiff's neighbourhood (*b*); the adoption of a name for a manufactory similar to that used by another, and placing it on goods, but keeping it out of the Directory (*c*); the making an improper use of the defendant's relationship to the plaintiff (*d*); the claiming untruly to be the sole proprietor (*e*); the making an unfair reference to a former partnership (*e*); the making an intentional misstatement as to the date of the commencement of a business (*f*), or as to prizes gained at an exhibition (*g*); the false pretence of an appointment as purveyor to a royal personage (*g*); have all been held to afford ground for reasonable suspicion of the presence of an *animus fraudandi*.

Circumstances pointing to absence of fraud.

On the other hand, if the defendant uses, on the goods which he is alleged to be endeavouring to pass off as the plaintiff's, a distinct and obvious trade mark of his own, or if he states plainly and in fair-sized and clear type that such goods are in fact manufactured by himself, there is a strong indication that the defendant has no intention of attempting deception (*h*). So, again, if the defendant has

(*a*) *Holt* v. *Smith*, 4 Times L. R. 329.

(*b*) *Lee* v. *Haley*, L. R. 5 Ch. 155; *Fullwood* v. *Fullwood* (1), *ubi sup.*

(*c*) *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285.

(*d*) *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627.

(*e*) *Wolfe* v. *Alsop*, 10 Vict. L. R. (E.) 41.

(*f*) *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176; *Blacknell* v. *Armistead*, 5 Amer. L. T. 85.

(*g*) *Cave* v. *Myers*, Dig. 304.

(*h*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-44; so, too, in *Cheavin* v. *Walker*, 5 Ch. D. 850, where the goods were stated to be manufactured by the defendants. And see *Beard* v. *Turner*, 13 L. T. N. S. 746; *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *Singer Manufacturing Co.* v. *Loog* (3), 18 Ch. D. 395; *Magee Furnace Co.* v. *Le Barron*, 127 Mass. 115; *Wolfe* v. *Goulard*, 18 How. Pr. 64; *McCartney* v. *Garnhart*, 45 Mo. 593; *Gilman* v. *Hunnewell*, 122 Mass. 139; *Ayer* v. *Rushton*, 7 Daly, 9. But compare *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376; *Perry* v. *Truefitt*, 6 Beav. 66; *Braham* v. *Bustard*, 1 H. & M. 447; *Ford* v. *Foster*, L. R. 7 Ch. 611; *Siegert* v. *Findlater*, 7 Ch. D. 801; *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57; *Henderson* v. *Jores*, Dig. 198; *Singer Manufacturing Co.* v. *Kimball & Morton*, Ct. Sess. Cas., 3rd Ser. XI. 267;

ventured to display at a public exhibition goods bearing the mark to which exception is afterwards taken (*a*); or if he has truly stated the connection between himself and the original adopter of the trade mark (*b*); or if, when using bottles moulded with the plaintiff's name, which have come into his possession without fraud, he places his own labels on the bottles in place of the plaintiff's (*c*).

Fraud unnecessary where mark registered.

A registered trade mark is property, and evidence of fraudulent intention is unnecessary in a case of alleged infringement of such a mark, as appears from the Patents Act, 1883, § 76 (*d*), in accordance with which the registration of a person as proprietor of a trade mark is *primâ facie* evidence of his right to the *exclusive use* of such trade mark, and, after the expiration of five years from the date of such registration, conclusive evidence of his right to the exclusive use of such trade mark, subject to the provisions of the Act.

Where mark registered, infringement must be of mark as registered.

But when infringement of a registered trade mark is in question, the point is, not whether there has been infringement of the mark which the plaintiff has used in his business, but whether there has been infringement of the mark which he has actually registered. Thus, Jessel, M. R., said, in *Ellis & Sons* v. *Ruthin Soda Water Co.* (*e*), "As I understand the Trade Marks Act, if you come for trade

Lea v. *Wolff*, 46 How. Pr. 157; *Field* v. *Lewis*, Dig. 280; *Rose* v. *Loftus*, 47 L. J. Ch. 576; *Eno* v. *Stephens*, Dig. 609; *Kinahan* v. *Bolton*, 15 Ir. Ch. 75; *Williams* v. *Johnson*, 2 Bos. 1; *Phalon* v. *Wright*, 5 Phila. 464; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402; *Whitney* v. *Hickling*, 5 Grant Up. Can. Ch. 605; *Hier* v. *Abrahams*, 82 N. Y. 519; *Thornton* v. *Crowley*, 47 N. Y. Super. Ct. 527; *Hegeman & Co.* v. *O'Byrne*, 9 Daly, 264; *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *Carroll* v. *Ertheiler*, 1 Fed. Rep. 688; *Fleischmann* v. *Schuckmann*, 62 How. Pr. 92; *Lewis* v. *Klapproth*, 11 Vict. L. R. 214.

(*a*) *Beard* v. *Turner*, 13 L. T. N. S. 746.

(*b*) *Emerson* v. *Badger*, 101 Mass. 82; *Gilman* v. *Hunnewell*, 122 *ib.* 139.

(*c*) *Rose* v. *Loftus*, 47 L. J. Ch. 576; *Barrett* v. *Gomm*, 74 L. T. (Journal) 388; *Barrett* v. *White*, North, J., May 12th, 1883.

(*d*) This re-enacts § 3 of the Trade Marks Registration Act, 1875.

(*e*) M. R., Nov. 21st, 1879. And see *Nuthall* v. *Vining*, C. A., Jan. 21st, 1880; *Lamplough* v. *Beedzler*, C. A., Nov. 12th, 1880; *Russell & Sons, Ld.* v. *Smith*, M. R., June 18th, 1880; *In re Lyndon*, 32 Ch. D. 109.

mark and not for actual fraud, you can only sue in respect of what you had registered as a trade mark." And in considering whether there has been infringement of the registered mark, it is necessary to see whether the essential particular in that registered mark has been imitated. Thus it was held by Jessel, M. R., in *In re Horsburgh* (*a*), that there was no conflict between two marks which combined substantially the same descriptive word with different devices, since the essential particulars, the devices, being different, it was immaterial that the marks resembled each other in a non-essential feature.

Burden of proof.

When a defendant has taken the material and essential part of the plaintiff's trade mark, the burden is upon the defendant to disprove the probability of deception, not upon the plaintiff to prove it (*b*).

Infringement of names as old marks.

With respect to trade marks used before the passing of the Trade Marks Registration Act, 1875, and consisting of a name printed or stamped in ordinary characters, which might be the case independently of the Act, it has been held that it is not necessary, in order to obtain an injunction, to prove the *scienter* where the infringer does not bear the name he has assumed (*c*), but that, on the other hand, where he does bear that name, such evidence must be produced (*d*); and, in the same way, where two firms have become entitled to use the same trade mark or firm name, it is only in a case of fraud that an injunction will be granted; and an allegation that the defendants use the mark on inferior goods is not sufficient, since, if they have the right to use it, they can use it as they please (*e*).

Infringement of names as new marks.

With respect to names first used as trade marks after

(*a*) 53 L. J. Ch. 237. And see *Lucke* v. *Webster*, M. R., April 4th, 1879.

(*b*) *Ford* v. *Foster*, L. R. 7 Ch. 611; *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376; *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434.

(*c*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *McLean* v. *Fleming*, 96 U. S. Rep. 245.

(*d*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Turton & Sons, Ld.* v. *Turton*, 42 Ch. D. 128; *McLean* v. *Fleming*, 96 U. S. Rep. 245.

(*e*) *Rogers* v. *Taintor*, 97 Mass. 291; *Emerson* v. *Badger*, 101 *ib.* 82.

the passing of the Act of 1875, the requirement that they shall be "printed, impressed, or woven, in some particular and distinctive manner" (*a*), renders the mere use of the same name no infringement, unless the particular and distinctive manner is also copied, in which case evidence of actual intentional fraud will be unnecessary, whatever may be the name of the infringer.

Colour. In the same way, where a trade mark consisting of the coloured threads which form the heading to a piece of stuff (*b*), or of the representation of a coin (*c*), or of any other mark in which colour is essential, and which would lose its distinctiveness by being registered in the ordinary way, has been registered by deposit, it will not be infringed unless the colour and arrangement have been imitated. But, where the trade mark does not substantially consist in colour, and has been registered in the ordinary way, then, though the mark has been registered in colour, the exclusive right to use the mark in any colour is now given to the registered proprietor (*d*).

Mode of comparing uncoloured marks. When it is alleged that a trade mark registered without colour has been infringed, it has been said that the proper manner of comparing the two trade marks is to compare their designs in the same size and free from colour, and that similarities in respect of colour in actual use should only be regarded in order either to prove fraud or to turn the scale when the question of infringement, leaving colour out of sight, is very difficult to decide (*e*). Where the plaintiffs had used a label for coffee, coloured red,

(*a*) Patents Act, 1883, § 64, amended by Act of 1888. And see *In re Gianaclis*, 58 L. J. Ch. 782.

(*b*) *Mitchell* v. *Henry*, 15 Ch. D. 181.

(*c*) *In re Robinson*, 29 W. R. 31. And see *In re Horsburgh*, 53 L. J. Ch. 237. In America it has been held that where the identical form, size, colour, and style of a numeral registered as a trade mark had been copied, an infringement had been committed, although it would have been no infringement to have used the numeral without copying those peculiarities: *Kinney* v. *Allen*, 1 Hughes, 106.

(*d*) Patents Act, 1883, § 67.

(*e*) Per Ct. of App. in *Nuthall* v. *Vining*, C. A., Jan. 21st, 1890.

white and blue, and containing the words "red, white and blue label," and had registered it without colour, the use by others of labels similarly coloured and containing the words was restrained (*a*). Another mode of comparing two trade marks is to compare the designs in the same colour (*b*), but this is more appropriate to cases of opposed registration.

What is infringement.

The real question which the Court has to try in a case of alleged infringement of trade mark, is whether what the defendant has done is calculated to deceive, whether there is so much imitation that goods bearing the one mark may be readily mistaken for goods bearing the other, and whether a careful inspection is necessary to distinguish the mark and appearance of the former goods from those of the latter (*c*).

Croft v. *Day*.

In *Croft* v. *Day* (*d*), it was remarked by Lord Langdale, M. R., that two things were necessary for the accomplishment of a fraud such as was there 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 the general resemblance was 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 was improperly sought to be sold. For the accomplishment of such a fraud it was necessary in the first instance to mislead the public, and in the next place to secure a benefit to the party practising the de-

(*a*) *Hanson* v. *British Tea and Trading Association* (*Ld.*), Bacon, V.-C., April 9th, 1884; C. A. June 19th, 1884. The same trade mark was afterwards refused registration under P. A. 1883; *In re Hanson*, 37 Ch. D. 112.

(*b*) *In re Worthington*, 14 Ch. D. 8.

(*c*) See per Bynum, J., in *Blackwell* v. *Wright*, 73 N. Car. 310.

(*d*) 7 Beav. 84.

ception by preserving his own individuality" (*a*). In that case, however, a deliberate attempt was made to represent the defendant's establishment as the plaintiff's, and the injury done to the plaintiff by the sale of goods bearing the spurious marks instead of his genuine goods is ordinarily sufficient to entitle him to his remedy, independently of any habit induced in the customer to resort to the defendant instead of to the plaintiff.

Tests of infringement.

By what test, then, has it to be determined whether there is such a degree of similarity as to require the interference of the Court?

Actual deception.

In the first place, where one person has adopted the trade mark of another, or a mark nearly resembling it, and there is evidence of actual deception—that is to say, "that any one has in fact been thereby induced to buy the defendant's goods as being the goods of the plaintiff—the question of resemblance has been decided by the test of facts, and the Court will restrain the defendant without further inquiry (*b*), unless it is clearly of opinion that the resemblance is so slight that no rational person ought to have been deceived (*c*). It is not, indeed, necessary that there shall have been actual deception (*d*), or damage sustained (*e*); but since, unless that can be proved, the case which the Court has to try is a hypothetical case, in which honest evidence as to the likelihood of deception can in all probability be procured on both sides (*f*), it is always

(*a*) And see *Edelsten* v. *Vick*, 11 Hare, 78; *Rowley* v. *Houghton*, 2 Brews. 303; R. Cox, 486; *Enoch Morgan's Sons' Co.* v. *Schwachhofer*, 55 How. Pr. 37.

(*b*) *Cope* v. *Evans*, L. R. 18 Eq. 138; and see *Woollam* v. *Ratcliff*, 1 H. & M. 259; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392; *Kinney* v. *Basch*, Dig. 542.

(*c*) *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512.

(*d*) *Abbott* v. *Bakers & Confectioners' Tea Association*, W. N. 1871, p. 207; *Field* v. *Lewis*, Dig. 280; and see *Filley* v. *Fassett*, 44 Mo. 173; R. Cox, 530; *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews. 321; R. Cox, 559; and *India Rubber Comb Co.* v. *Rubber Comb & Jewelry Co.*, 45 N. Y. Super. Ct. 258.

(*e*) *Braham* v. *Beachim* (1), 7 Ch. D. 848.

(*f*) As a rule, not much weight is given to expert evidence on questions of similarity. See *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392; *Popham* v. *Wilcox*,

safer for a plaintiff to obtain proof of actual deception if possible, and a certain degree of delay to enable him to obtain such proof will be excused (*a*).

Probable deception.

In most cases, however, there is not produced any evidence of actual deception, and the plaintiff then has to satisfy the Court or jury that the defendant has used a mark either identical with, or only colourably differing from, his own (*b*). It is not sufficient for the plaintiff to produce evidence tending to show that in the opinion of the witnesses deception may occur: he has to convince the Court or jury that there is such reasonable probability of deception as to justify interference with the defendant (*c*);

66 N. Y. 69; but there may be circumstances in which much weight will be given to it: *Mitchell* v. *Henry*, 15 Ch. D. 181; *In re Worthington*, 14 Ch. D. 8; *In re Christiansen*, 3 P. R. 54; *Williams* v. *Brooks*, 50 Conn. 278. In *Wallace & Co.* v. *King & Co.*, Bomb. High Ct., April 30th, 1879, it was held in the High Court of Bombay that evidence given by European witnesses in Bombay and Manchester as to the probability of deception, was not admissible under the Indian Evidence Act, the witnesses not being experts, and the question not being one of science or art.

(*a*) *Lee* v. *Haley*, L. R. 5 Ch. 155; *Cave* v. *Myers*, Dig. 304.

(*b*) See *Cartier* v. *Carlile*, 31 Beav. 292; and *Cope* v. *Evans*, L. R. 18 Eq. 138.

(*c*) *Blackwell* v. *Crabb*, 36 L. J. Ch. 504; *Bass* v. *Dawber*, 19 L. T. N. S. 626; *Cope* v. *Evans*, L. R. 18 Eq. 138; *Snowden* v. *Noah*, Hopk. 347; R. Cox, 1; *Colladay* v. *Baird*, 4 Phila. 139; R. Cox, 257; *Colton* v. *Thomas*, 2 Brews. 308; R. Cox, 507; *Falkinburg* v. *Lucy*, 35 Cal. 52; R. Cox, 448; *Bell* v. *Locke*, 8 Paige, 75; R. Cox, 11; *Ledger* v. *Ray*, Dig. 550; *Stephens* v. *De Conto*, 30 N. Y. Sup. Ct. 343; R. Cox, 442; *Wylam* v. *Clarke*, W. N. 1876, p. 68; *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Wilson* v. *Maxfield*, L. J. N. of C. 1875, p. 51; *Ellis* v. *Zeilen & Co.*, 42 Ga. 91; *Blackwell* v. *Wright*, 73 N. Car. 310; *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392; *Degraves* v. *Whiteman*, 5 Vict. L. R. Eq. 304; *Lamplough* v. *Beedzler*, C. A., Nov. 12th, 1880; *Enoch Morgan's Sons' Co.* v. *Troxell*, 89 N. Y. 292; *American Grocer Publishing Association* v. *Grocer Publishing Co.*, 51 How. Pr. 402; *Massam* v. *Thorley's Cattle Food Co.*, 14 Ch. D. 748; *In re Imbs*, 10 U. S. Pat. Gaz. 463; *Daves* v. *Davies*, Dig. 426; *Prince Metallic Paint Co.* v. *Carbon Metallic Paint Co.*, Dig. 573; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Chinn* v. *Thomas*, 5 Vict. L. R. Eq. 188; *Goodwin* v. *Venning*, 24 Sol. J. 690; *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; *Hurricane Patent Lantern Co.* v. *Miller & Co.*, 56 How. Pr. 234; *Talbot* v. *Webley*, 3 P. R. 276; *Beddow & Sons* v. *Boyd*, 4 P. R. 310; *Vogeler Co.* v. *Middleton*, 84 L. T. (Journal) 45 (where the plaintiffs sold "St. Jacob's Oil," and the defendants sold "St. Joseph's Oil"); *Waterman* v. *Ayres*, 39 Ch. D. 29; *Great Tower St. Tea Co.* v. *Smith*, 6 P. R. 165; *Gail* v. *Wackerbarth*, 23 Fed. Rep. 286; *Liggett & Myers Tobacco Co.* v. *Finzer*, 128 U. S. Rep. 182; *New Haven Patent Rolling Spring Bed Co.* v. *Farren*, 51 Conn. 324; *Rogers* v. *Rogers*, 53 Conn. 121;

and if he "cannot allege and prove that the public are deceived, or that there is a reasonable probability of deception, he has no right to interfere with the use of the mark by others" (*a*). But where this burden is discharged, the defendant's conduct "cannot be justified by showing that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways" (*b*).

When is deception probable.

It is obvious that in these cases questions of considerable nicety may arise; and, in the language of Lord Cranworth, C., in *Seixo* v. *Provezende* (*c*), "it is hardly necessary to say that, in order to entitle a party to relief, it is by no means necessary that there should be absolute identity (*d*). What degree of resemblance is necessary, is, from the nature of things, a matter incapable of definition *à priori* (*e*). All that Courts of Justice can do is to say that no trader can adopt a trade mark so resembling that of a rival as that *ordinary purchasers, purchasing with ordinary caution*, are likely to be misled (*f*).

Morse v. *Martin*, Can. Sup. Ct. Cas. Dig. 509; *Marshall* v. *Hawkins*, 4 N. Z. L. R. Sup. Ct. 59; *Desmond's Appeal*, 103 Penn. St. 126; *Singer Manufacturing Co.* v. *Riley*, 11 Fed. Rep. 706; *Adams* v. *Heisel*, 31 Fed. Rep. 279; *Evans* v. *Von Lavr*, 32 Fed. Rep. 153.

(*a*) Per Lord Watson in *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 39.

(*b*) Per Lord Selborne, C., in *Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 18. So in *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(*c*) L. R. 1 Ch. 192.

(*d*) As to this, see per Lord Chelmsford in *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; and per Malins, V.-C., in *Anglo-Swiss Condensed Milk Co.* v. *Swiss Condensed Milk Co.*, W. N. 1871, p. 163. Also *McCann* v. *Anthony*, 21 Mo. App. 83. And see *post*, p. 150-1.

(*e*) What will constitute infringement is not to be defined. See per Stawell, C. J., in the Sup. Ct. of Victoria in *Hennessy* v. *White*, 6 W. W. & A'B. Eq. 216.

(*f*) As to this criterion, see *Archbold* v. *Sweet*, 1 Mo. & Rob. 162; *Shrimpton* v. *Laight*, 18 Beav. 164; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523 (per Lord Cranworth); *Barnard* v. *Pillow*, W. N. 1868, p. 94; *Anglo-Swiss Condensed Milk Co.* v. *Swiss Condensed Milk Co.*, W. N. 1871, p. 163; *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Abbott* v. *Bakers & Confectioners' Tea Association, Ld.*, W. N. 1872, p. 31; L. J. N. of C. 1871, p. 199; *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376, 392, 394; *London & County Banking Co.* v. *Hampshire & North Wilts Bank*, Dig. 618; *Moses* v. *Sargood*, Dig. 636; *In re Worthington*, 14 Ch. D. 8; *Liebig's Extract of Meat Co.* v. *Anderson*,

"It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side (*a*). The rule so restricted would be of no practical use. If a purchaser looking at the article offered to him would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the Court considers the use of such a mark to be fraudulent. But I go farther. I do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular

W. N. 1883, p. 185; *In re Christiansen*, 3 P. R. 54; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454; *Lever* v. *Goodwin*, 36 Ch. D. 1; *Steinway & Sons* v. *Henshaw*, 5 P. R. 77; *Hennessy* v. *White*, 6 W. W. & A'B. Eq. 216; *Hennessy* v. *Hogan*, *ib.* 225; *Partridge* v. *Menck*, 1 How. App. Cas. 558; R. Cox, 72; *Walton* v. *Crowley*, 3 Bl. C. C. 440; R. Cox, 166; *Clark* v. *Clark*, 25 Barb. 76; R. Cox, 206; *Brooklyn White Lead Co.* v. *Masury*, 25 Barb. 416; R. Cox, 210; *Swift* v. *Dey*, 27 N. Y. Sup. Ct. 611; R. Cox, 319; *Rowley* v. *Houghton*, 2 Brews. 303; R. Cox, 486; *Colton* v. *Thomas*, 2 Brews. 308; R. Cox, 507; *Lockwood* v. *Bostwick*, 2 Daly, 521; R. Cox, 555; *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews. 321; R. Cox, 559; *Blackwell* v. *Wright*, 73 N. Car. 310; *Gilman* v. *Hunnewell*, 122 Mass. 139; *Popham* v. *Wilcox*, 66 N. Y. 69; *Tallcott* v. *Moore*, 13 N. Y. Sup. Ct. 106; *Brown* v. *Mercer*, 37 N. Y. Super. Ct. 265; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Dawes* v. *Davies*, Dig. 426; *Colman* v. *Crump*, 70 N. Y. 573; *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; *Wolfe* v. *Hart*, 4 Vict. L. R. Eq. 125; *Ex parte Caire*, 15 U. S. Pat. Gaz. 248; *Robertson* v. *Berry*, 50 Md. 591; *Glen Cove Manufacturing Co.* v. *Ludeman*, 23 Bl. C. C. 46; *McCann* v. *Anthony*, 21 Mo. App. 83; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Liggett & Myers Tobacco Co.* v. *Hynes*, 20 Fed. Rep. 883; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Ex parte Kennedy*, 9 Vict. L. R. (L.) 335; *Brill* v. *Singer Manufacturing Co.*, 41 Ohio St. 127; *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601. In *Singer Manufacturing Co.* v. *Loog* (3) (8 App. Cas. 18), Lord Selborne, C., says, "The imitation of a man's trade mark, in a manner liable to mislead the unwary, cannot be justified by showing either that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled."

(*a*) See *Moses* v. *Sargood*, Dig. 636; *Read* v. *Richardson*, 45 L. T. N. S. 54; *Aseough* v. *Johnson & Co.*, 3 Times L. R. 735; *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115; *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Liggett & Myers Tobacco Co.* v. *Hynes*, 20 Fed. Rep. 883.

name, I think that the adoption by a rival trader of *any mark which will cause his goods to bear the same name in the market* (*a*), may be as much a violation of the rights of that rival as the actual copy of his device."

Deception of ultimate purchaser.

The natural consequence of marking goods so as to cause them to bear the same name in the market as those of a well-known firm is to deceive the ultimate purchaser, and such deception will be restrained, even though the original purchaser is not deceived (*b*). "No

(*a*) Thus, where the plaintiff's yarn had become known as "The Hathi," or "two elephant" yarn, from the representation of two elephants on the trade mark, the defendants were restrained from using two different elephants (*Orr-Ewing & Co.* v. *Johnston & Co.*, 7 App. Cas. 219); where the plaintiff's beer was known as "Dog's Head Beer," the defendants were restrained from using on their beer the head of a different kind of dog from that used by the plaintiffs (*Read* v. *Richardson*, 45 L. T. N. S. 54); where the plaintiff's clothing was known as "Crown Clothing," from the use of a royal crown, the defendants were restrained from using an imperial crown between two standards (*Moses* v. *Sargood*, Dig. 636). So, if in *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185, the defendant had called his wire "Anchor Wire," without using the figure of an anchor, the plaintiff's wire having acquired the name of "Anchor Wire" because of the trade mark being an anchor. See *Cartier* v. *Carlile*, 31 Beav. 292; *Cartier* v. *Westhead*, Dig. 199; *Cartier* v. *May*, Dig. 200 ("Cross Cotton"); *In re Jelley, Son & Jones*, 51 L. J. Ch. 639 ("Dog-brand Files"); *In re Whiteley*, 43 L. T. N. S. 627 ("Globe Steel"); *In re Rabone*, Dig. 643 ("Lion" edge tools); *In re Worthington*, 14 Ch. D. 8 ("Triangle Beer"); *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454 ("Milk-maid" or "Dairymaid Brand"); *In re Baschiera & Co.*, 33 Sol. J. 469 ("Lion" matches); *Taylor* v. *Virasami*, Ind. L. R. 6 Mad. 108 ("Talwar" shirtings); *Smith* v. *Fair*, 14 Ont. Rep. 729 ("Red Seal" cigars). In the U. S. Patent Office there was held to be a fatal conflict between two trade marks for hams, of which the one consisted of the word "Bouquet," the other of a bouquet of flowers: *Schrauder* v. *Beresford & Co.*, U. S. Patent Office, June 27th, 1872; and in *In re American Lubricating Oil Co.*, 9 U. S. Pat. Gaz. 687, registration was refused to the word "Star" for oil, the device of a star having already been registered for that article. But in *Curtis, Harvey & Co.* v. *Kraft, Meyer & Co.*, Chitty, J., June 16th, 1882, it was thought that the German words "Diamant Pulver" were not likely to be mistaken for the English words "Diamond Powder." See *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Morrison* v. *Case*, 9 Bl. C. C. 548; *In re Weaver*, 10 U. S. Pat. Gaz. 1; *In re Pratt* v. *Farmer*, *ib.* 866; *In re Park*, 12 *ib.* 2; *Barsalon* v. *Darling*, 9 Can. Sup. Ct. 677.

(*b*) See *Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 15; *Orr-Ewing & Co.* v. *Johnston & Co.*, 7 App. Cas. 219; *In re Christiansen*, 3 P. R. 54; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Manookji Petit Manufacturing Co., Ld.* v. *Mahalaxmi Spinning & Weaving Co., Ld.*, Ind. L. R. 10 Bomb. 617.

man is entitled to represent his goods as being the goods of another man, and no man is permitted to use any mark, sign or symbol, device, or other means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer" (*a*). "If a man does that, the natural consequence of which (although it does not deceive the person with whom he deals, and is therefore no misrepresentation to him) is to enable that other person to deceive and pass off his goods as somebody else's, for that he is answerable. But this is confined to those things which in their necessary or natural uses accompany the things sold. For instance, the corks of champagne bottles marked "Moet and Chandon" must be in the bottles sold, and must accompany the bottles. They must necessarily accompany the thing to the retail buyer, and so must labels to be put on the bottles. The very reason for their existence is that they must be put on the bottles, and if they are deceptive and fraudulent, then the person who prepares them is answerable for it. Such things must not be used if their natural and legitimate consequence is, not to deceive the person to whom they are sold, but to enable the purchaser to pass off the goods as being the goods of other persons" (*b*).

Deception by get-up of goods.

And the same principle of preventing that which would deceive the ultimate purchaser is observed where the probability of deception arises, not from the imitation of a trade mark proper, but from copying the peculiar get-up of the plaintiff's goods or from some similar act. In *Lever* v. *Goodwin* (*c*) the plaintiffs' soap was got up in a special manner, which had been copied somewhat nearly by the

(*a*) Per James, L. J., in *Singer Manufacturing Co.* v. *Loog* (3), 18 Ch. D. 412.

(*b*) Per Cotton, L. J., in S. C., 18 Ch. D. 422.

(*c*) 4 P. R. 492 (Chitty J.), 36 Ch. D. 1 (C. A.).

defendants; and Chitty, J., said, "The law applicable to the case is plain: it is founded on fraud. The simplest case is where the seller misrepresents to the buyer that the goods which are being offered for sale are the goods, not of the person who made them, but of some other manufacturer. That is a case merely between the buyer and the seller. Then comes the case where the manufacturer, by devices which are to accompany the goods on their sale in the market, gets them up in such a form as to be calculated to deceive the ultimate buyer into the belief that the goods which he, the manufacturer, is putting on the market are the goods of some other maker. Here, generally speaking, a double fraud is committed: first, there is the fraud which is perpetrated on the ultimate buyer; and, secondly, there is a fraud perpetrated on the other manufacturer, who loses part of his trade. In this class of cases the trade is seldom deceived; the retail dealers know from whom they are buying, and if there is a fraudulent device, they are rarely taken in by it. But in such a case the manufacturer puts an instrument of fraud into their hands. Now, it has been said more than once in this case, that the manufacturer ought not to be held liable for the fraud of the ultimate seller—that is, the shopkeeper or the shopkeeper's assistant; but that is not the true view of the case. The question is whether the defendants have or have not knowingly put into the hands of the retail dealers the means of deceiving the ultimate purchasers." So, in another case (*a*), Kekewich, J., said "The plaintiffs are entitled to have their trade mark protected; and, further than that, they are entitled to have their business protected to this extent, that if any person has used the words which they employ, so as to pass off, or so as to tend to pass off, the goods of that other person as the goods of the plaintiffs, then the

(*a*) *Sanitas Co., Ld.* v. *Condy*, 4 R. P. R. 530. And see, per Kay, J., in *In re Sanitas Co., Ld.*, 58 L. T. N. S. 166.

plaintiffs are entitled, apart from their trade mark, to insist that that should be restrained."

Infringement of essential part, or of combination.

The infringement of a trade mark may consist in the adoption of the essential part of the plaintiff's trade mark by the defendant, as the word "Eureka" (*a*), or "Glenfield" (*b*), or "Apollinaris" (*c*). And where there is no imitation of the essential part, a resemblance in particulars common to the trade does not constitute an infringement (*d*). But, on the other hand, the infringement may consist in the imitation of the general appearance of the plaintiff's mark, and where both trade marks are of a composite character, it is possible that, though no one particular mark has been exactly imitated, or the principal mark which has been reproduced cannot, for some reason or other, be protected as a trade mark, the combination may be very similar and likely to

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

(*b*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508.

(*c*) *Apollinaris Co.* v. *Norrish*, 33 L. T. N. S. 242; and see *Filley* v. *Fassett*, 44 Mo. 173; R. Cox, 530 ("Charter Oak" stoves); *Siegert* v. *Ehlers*, Dig. 432, and *Siegert* v. *Findlater*, 7 Ch. D. 801 ("Angostura Bitters"); *Eno* v. *Stephens*, Dig. 609 ("Fruit Salt"); *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70 ("Tivoli" beer); *Slazenger* v. *Malings*, W. N. 1885, p. 124 ("The Lawford" racquet); *Compania General de Tabacos* v. *Rehder*, 5 P. R. 61 ("Cavite" cigars); *Lawrie* v. *Baker*, 2 P. R. 213 ("Patent cups"); *Dunbar* v. *Glenn*, 42 Wisc. 118 ("Bethesda" water); *Blackwell* v. *Armistead*, 5 Am. L. T. 85 ("Durham" tobacco); *In re Coggin, Kidder & Co.*, 11 U. S. Pat. Gaz. 1109 ("Haxall"); *Rillet* v. *Carlier*, 61 Barb. S. C. 435 ("Grenade Syrup"); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 ("Pain-Killer"); *Crawford* v. *Shuttock*, *ib.* 149 ("Imperial" soap); *Carroll* v. *Ertheiler*, 1 Fed. Rep. 688 ("Lone Jack" tobacco); *Fleischmann* v. *Schuckmann*, 62 How. Pr. 92 ("Vienna Bread"); *Lauferty* v. *Wheeler*, 63 *ib.* 488; 11 Daly, 194 ("Alderney" oleo-margarine). See also, per Cotton, L. J., in *In re Leonard & Ellis*, 26 Ch. D. 288; *Vulcan Match Co.* v. *Jebsen & Co.*, 1 Kyshe 650; *Humphreys' Specific Homœopathic Medicine Co.* v. *Wenz*, 14 Fed. Rep. 250.

(*d*) *Lucke* v. *Webster*, M. R., April 4th, 1879; *In re Horsburgh*, 53 L. J. Ch. 237; *Wallace & Co.* v. *King & Co.*, Bomb. High Ct., April 30th, 1879; *Tucker Manufacturing Co.* v. *Boyington*, 9 U. S. Pat. Gaz. 455; *Thornton* v. *Crowley*, 47 N. Y. Super. Ct. 527; *Coats* v. *Merrick Thread Co.*, 45 U. S. Pat. Gaz. 347; *Stacholberg* v. *Ponce*, 128 U. S. Rep. 686; *Marshall* v. *Hawkins*, 4 N. Z. L. R. Sup. Ct. 59; *Ball* v. *Siegel*, 116 Ill. 137; *Portuondo* v. *Monne*, 28 Fed. Rep. 16.

deceive, and will therefore be restrained by injunction (*a*).

"For the purpose of establishing a case of infringement it is not necessary to show that there has been the use of a mark in all respects corresponding with that which another person has acquired an exclusive right to use, if the resemblance is such as, not only to show an intention to deceive, but also such as to be likely to make unwary purchasers suppose that they are purchasing the article sold by the party to whom the right to use the trade mark belongs" (*b*). It is seldom that the mark employed by

Infringer's mark need not be identical with mark infringed. Colourable differences.

(*a*) *Abbott* v. *Bakers' & Confectioners' Tea Association*, W. N. 1871, p. 207; *ib.* 1872, p. 31; *Hargreaves* v. *Smith*, Dig. 338; *Lazenby* v. *Lazenby*, Dig. 160; *In re Barker & Son*, 53 L. T. N. S. 23; *Compania General de Tabacos* v. *Rehder*, 5 P. R. 61; *Great Tower St. Tea Co.* v. *Langford & Co.*, 5 P. R. 66; *Ascough* v. *Johnson & Co.*, 3 Times L. R. 735; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Brown* v. *Mercer*, 37 N. Y. Super. Ct. 265; *Godillot* v. *Hazard*, 81 N. Y. 263; *Lea* v. *Wolff* (S. T.), 13 Abb. Pr. N. S. 389; *Whitney* v. *Hickling*, 5 Grant Up. Can. Ch. 605; *Davis* v. *Reid*, 17 *ib.* 69; *Day* v. *Walls*, 12 Phila. 274; *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Hostetter* v. *Adams*, 20 Bl. C. C. 326; *Conrad* v. *Joseph Uhrig Brewing Co.*, 8 Mo. App. 277; *Electro-Silicon Co.* v. *Levy*, 59 How. Pr. 469; *Royal Baking Powder Co.* v. *Davis*, 26 Fed. Rep. 293; *McCann* v. *Anthony*, 21 Mo. App. 83; *Green* v. *Woodhouse*, 38 U. S. Pat. Gaz. 1491; *Williams* v. *Brooks*, 50 Conn. 278; *Hop Bitters Manufacturing Co.* v. *Wharton*, 10 Vict. L. R. (L.) 377; *Pierce* v. *Guittard*, 68 Cal. 68; *Lealanohe Battery Co.* v. *Western Electric Co.*, 21 Fed. Rep. 538; *Carbolic Soap Co.* v. *Thompson*, 25 Fed. Rep. 625; *Foster* v. *Blood Balm Co.*, 77 Ga. 216; but see *Blackwell* v. *Crabb*, 36 L. J. Ch. 504; and *Blackwell* v. *Wright*, 73 N. Car. 310.

(*b*) Per Lord Chelmsford, in *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508. And see *Moses* v. *Sargood*, Dig. 636; *In re Farina* (2), 27 W. R. 456; *Hennessy* v. *White*, 6 W. W. & A'B. Eq. 216; *Hennessy* v. *Hogan*, *ib.* 225; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes 115; *Barrows* v. *Knight*, 6 R. I. 434; *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392; *Brown* v. *Mercer*, 37 N. Y. Super. Ct. 265; *Shaver* v. *Shaver*, 54 Iowa, 208; *Godillot* v. *Hazard*, 81 N. Y. 263; *Rodgers* v. *Philp*, 1 U. S. Pat. Gaz. 29; *Colman* v. *Crump*, 70 N. Y. 573; *Amoskeag Manufacturing Co.* v. *Garner*, (2), 54 How. Pr. 298; *Wolfe* v. *Hart*, 4 Vict. L. R. Eq. 125; *Actien Gesellschaft Apollinaris Brunnen* v. *Somborn*, 14 Bl. C. C. 380; *Hegeman & Co.* v. *O'Byrne*, 3 Daly, 264; *Leidersdorf* v. *Flint* (2), 50 Wisc. 401; *Atlantic Milling Co.* v. *Robinson*, 20 Fed. Rep. 217; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Liggett & Myers Tobacco Co.* v. *Hynes*, 20 Fed. Rep. 883; *Heyde* v. *Wittkowski*, 5 N. S. W. Rep. (E.) 74; *Bryant & May* v. *Heyde*, 7 N. S. W. Rep. (E.) 72; *Pierce* v. *Guittard*, 68 Cal. 68; *Ball* v. *Siegel*, 116 Ill. 137; *Lorillard* v. *Wight*, 15 Fed. Rep. 383; *Dreydoppel* v. *Young*, 14 Phila. 226.

the infringer does correspond in all respects with that of the person whose rights he is attacking; the usual practice is to introduce some colourable variation, which may supply the infringer with a plausible excuse for his fraud. "In every case," however, "the Court must ascertain whether the differences are made *bonâ fide* in order to distinguish the one article from the other; whether the resemblances and the differences are such as naturally arise from the necessity of the case, or whether, on the other hand, the differences are simply colourable, and the resemblances are such as are obviously intended to deceive the purchaser of the one article into the belief of its being the manufacture of another person. Resemblance is a circumstance which is of primary importance for the Court to consider, because if the Court finds, as it almost invariably does find in such cases as this, that there is no reason for the resemblance, excepting for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading" (*a*).

Examples.

Thus, it was held that "Cacaotine" was a colourable imitation of "Cocoatina" (*b*), "Steel pens" of "Stephens" (*c*), "Tung's" of "Tonge's" (*d*), "Leopoldsalt" of "Leopoldshall (*e*), "Lactopepsine" of "Lactopeptine" (*f*), "Cocoine" of "Cocoaine" (*g*), "Bovina" of "Bovilene" (*h*).

(*a*) Per Wood, V.-C., *Taylor* v. *Taylor*, 23 L. J. Ch. 255; and in the case of a prosecution for obtaining money by false pretences, see per Erle, J., in *R.* v. *Dundas*, 6 Cox, 380.

(*b*) *Schweitzer* v. *Atkins*, 37 L. J. Ch. 847.

(*c*) *Stephens* v. *Peel*, 16 L. T. N. S. 145.

(*d*) *Tonge* v. *Ward*, 21 L. T. N. S. 480.

(*e*) *Radde* v. *Norman*, L. R. 14 Eq. 348.

(*f*) *Carnrick* v. *Morson*, L. J. N. of C., 1877, p. 71.

(*g*) *Burnett* v. *Phalon*, 9 Bos. 192; R. Cox, 376.

(*h*) *Lockwood* v. *Bostwick*, 2 Daly, 521; R. Cox, 555. Other instances are:—"Schrewsbury-Marchal Patent Thread" put for "Shrewsbury, Marshall & Co. Patent Thread," *Marshall* v. *Ross*, L. R. 8 Eq. 651; "Burgiss" for "Burgess," *Burgess* v. *Hills*, 26 Beav. 244; "Genuine" for "Guinness," *Guinness* v. *Heap*, Dig. 617; "Derwent" for "Derby," *Derby Photographie Dry Plate Co.* v. *Pollard, Graham & Co.*, 2 Times L. R. 276; "Condisanitas" for "Sanitas," *Sanitas Co., Ld.* v.

Again, a beehive was held to be a colourable imitation of a bell of a similar shape, similarly printed on a label (*a*).

Condy, 4 P. R. 195, 530; "Apollinis" for "Apollinaris," *Apollinaris Co., Ld.* v. *Herrfeldt*, 4 P. R. 478; "Steinberg" for "Steinway," *Steinway & Sons* v. *Henshaw*, 5 P. R. 77; "Demotic" for "Demon," *Slazenger & Sons* v. *Feltham & Co.*, 6 P. R. 531; "Holsteter & Smyte" for "Hostetter & Smith," *Hostetter* v. *Vowinkle*, 1 Dill. 329; "Rogers & Son" for "J. Rodgers & Sons," *Rodgers* v. *Philp*, 1 U. S. Pat. Gaz. 29; "Andrew Coe's Superphosphate of Lime" for "Coe's Superphosphate of Lime" *Coe* v. *Bradley*, 9 *ib.* 541; "Star" for "Stark," *Gardner* v. *Bailey*, Dig. 365; "Wamyesta" for "Wamsutta," *Wamsutta Mills* v. *Allen*, 12 Phila. 535; "Electric-Silicon" for "Electro-Silicon," *Electro-Silicon Co.* v. *Trask*, 59 How. Pr. 189; "Pride of Syracuse" for "Pride" *Hier* v. *Abrahams*, 82 N. Y. 519; "South-western, St. Louis" for "Southern Company, St. Louis," *Southern White Lead Co.* v. *Carey*, 25 Fed. Rep. 125; "Cellonite" for "Celluloid," *Celluloid Manufacturing Co.* v. *Cellonite Manufacturing Co.*, 32 Fed. Rep. 94; "Willoughby Ridge" for "Willoughby Lake," *Pike Manufacturing Co.* v. *Cleveland Stone Co.*, 35 Fed. Rep. 896; "Diamond Gem" for "Black Diamond," *ib.*; "Seamless," with a flourish, for "Shawknit," with a flourish, *Shaw Stocking Co.* v. *Mack*, 21 Bl. C. C. 1; "Dr. Morse's Improved Yellow Dock and Sarsaparilla Compound" for "Morse's Compound Syrup of Yellow Dock Root," *Alexander* v. *Morse*, 14 R. I. 153; "Chatterbook" for "Chatterbox," *Estes* v. *Leslie* (2), 29 Fed. Rep. 91; "Sawin's Soluble Blue and Pepper Box" for "Sawyer's Crystal Blue and Safety Box," *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; "Maizharina" with a device for "Maizena" with a device, *Glen Cove Manufacturing Co.* v. *Ludeman*, 23 Bl. C. C. 46.

(*a*) *Bell, Black & Co.* v. *Bell & Co.*, Dig. 514. Other instances are:—A crown with "B. B. S." in italics put for a crown with "B. B. H." in Roman characters, *Barrows* v. *Pelzall Coal & Iron Co.*, Dig. 530; a volcano with a man coming out of it and the words "Volcanic Paraffin Matches," for a volcano with the words "The Vulcan Paraffin Matches," *Vulcan Match Manufacturing Co.* v. *Knos & Co.*, Pearson, J., June 22nd, 1883; a device of a diamond with a K in the centre for a device of a plain diamond, *Curtis & Harvey* v. *Pape*, 5 P. R. 146; "Rottgen" with two crosses for "Rodgers" with a star and a cross, *Rodgers & Sons, Ld.* v. *Rottgen*, 5 Times L. R. 678; a pelican, with an inscription in gold on a green ground, for a crane with an inscription in gold on a green ground, *Balfour & Co.* v. *Kilburn & Co.*, 1 Hyde, 270; an orb rising over a piece of water, with the words "Rising Moon Stove Polish," for an orb with rays rising over a piece of water, with the words "Rising Sun Stove Polish": *Morse* v. *Worrell*, 10 Phila. 168; a sprig of grape vine for a sprig of hop vine, *Hop Bitters Manufacturing Co.* v. *Wharton*, 10 Vict. L. R. (L.) 371; a unicorn's head for a horse's head similarly arranged, *Barsalon* v. *Darling*, 9 Can. Sup. Ct. 677. But in *McCartney* v. *Garnhart*, 45 Mo. 593, it was held that two picks with a pair of scales, and the words "J. H. Garnhart's Old Bourbon," were not too similar to two anchors and the initials "S. McC." Where the infringement consisted in a general resemblance between labels on "Old Bachelor" tobacco and "Old Coon" tobacco, it was held that the wrong was not remedied by printing across the former the words "Not Old Coon," *McCann* v. *Anthony*, 21 Mo. App. 83.

Seixo v. *Provezende.*

In *Seixo* v. *Provezende* (*a*) the plaintiff, a Portuguese nobleman and wine grower, sold his wine in casks branded on the head with a crown and eagle, and the letters "B. S.," and also at the bung-hole with a crown, the word "Seixo," and the year of vintage. This wine had acquired a reputation as "Crown Seixo Wine," when the defendant began to sell wine which he called "Seixo de Cima," and placed in casks branded in a somewhat similar manner to the plaintiff's. The injunction was granted and affirmed, although the defendants contended that parts of their own vineyards were called "Seixo," and that the name was an ordinary Portuguese adjective, signifying "stony."

Wotherspoon v. *Currie.*

In *Wotherspoon* v. *Currie* (*b*) the plaintiffs manufactured starch, which, under the name of "Glenfield Starch" —a name derived from a small place near Paisley, where it was made—acquired a great reputation. They subsequently removed their works to Paisley, and there continued to make "Glenfield Starch." The defendants, also starch manufacturers at Paisley, bought a small plot of land at Glenfield, and began selling "Glenfield Starch." It was held by V.-C. Malins and the House of Lords that the use of the word "Glenfield" in connection with starch had the effect of inducing people to buy the defendants' manufacture, under the impression that it was the plaintiffs', and that there was a colourable imitation of the mark to which the plaintiffs were entitled (*c*).

Similarity of packing or get-up.

Where the goods of one manufacturer are so packed or arranged as externally to resemble those of others engaged

(*a*) L. R. 1 Ch. 192.
(*b*) L. R. 5 H. L. 508.
(*c*) See also *Thompson* v. *Montgomery*, 41 Ch. D. 35, and the American cases, *Coffeen* v. *Brunton*, 4 McLean, 516, R. Cox, 82; *Amoskeag Manufacturing Co.* v. *Spear*, 2 Sand. S. C. 599, R. Cox, 87; *Davis* v. *Kendall*, 2 R. I. 566, R. Cox, 112; *Williams* v. *Johnson*, 2 Bos. 1; R. Cox, 214; *Bradley* v. *Norton*, 33 Conn. 157, R. Cox, 331; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402, R. Cox, 490; *Gillis* v. *Hall*, R. Cox, 596; *Meriden Britannia Co.* v. *Parker*, 39 Conn. 450, 12 Amer. Rep. 401; *Burke* v. *Cassin*, 45 Cal. 467, 13 Amer. Rep. 204.

in the same trade, as where starch was put up commonly in the trade in packets of a certain colour and appearance, the similarity common to all does not of itself expose the manufacturer to an action, but it makes it incumbent upon him to take care that his distinguishing mark is really distinguishing (*a*). And where a plaintiff has been in the habit of packing or getting up his goods in a peculiar and distinctive manner, he will be entitled to restrain another from imitating his packages (*b*), even though his actual trade mark is bad (*c*); and the imitation of bottles (*d*) or barrels (*e*) of a peculiar design, such as is used only by the plaintiff, will afford a strong presumption that fraud is intended. As Cotton, L. J., said, in *Lever* v. *Goodwin* (*f*), "there may be no monopoly at all in the individual things, but if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old Common Law doctrine, in respect of which Equity will give to the aggrieved party an injunction, in order to restrain the defendants from

(*a*) See per Lord Hatherley, C., *Wotherspoon* v. *Currie*, 5 H. L. 508; also *Enoch Morgan's Sons' Co.* v. *Troxell*, 89 N. Y. 292; *Gail* v. *Wackerbarth*, 28 Fed. Rep. 286.

(*b*) *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *Enoch Morgan's Sons' Co.* v. *Schwachhofer*, 55 How. Pr. 37; *Great Tower St. Tea Co.* v. *Langford & Co.*, 5 P. R. 66; *Aseough* v. *Johnson & Co.*, 3 Times L. R. 735; *Landreth & Sons* v. *Landreth*, 22 Fed. Rep. 41; *Southern White Lead Co.* v. *Carey*, 25 Fed. Rep. 125; *Anheuser Busch Brewing Association* v. *Clarke*, 26 Fed. Rep. 410; *Pierce* v. *Guittard*, 68 Cal. 68; *Moxie Nerve Food Co.* v. *Baumbach*, 32 Fed. Rep. 205; *Miller Tobacco Manufactory* v. *Commerce*, 45 N. J. Law 123; *Trask Fish Co.* v. *Wooster*, 28 Mo. App. 408.

(*c*) *Lever* v. *Goodwin*, 36 Ch. D. 1; *Sawyer* v. *Horn*, 4 Hughes, 239; *McCall* v. *Theal*, 28 Grant Up. Can. Ch. 48; *Carbolic Soap Co.* v. *Thompson*, 25 Fed. Rep. 625; *Smith* v. *Fair*, 14 Ont. Rep. 729.

(*d*) *Henry* v. *Price*, 1 Leg. Obs. 364; *Sieger* v. *Findlater*, 7 Ch. D. 801; *Fullwood* v. *Fullwood* (1), W. N. 1873, 185; *Wolfe* v. *Goulard*, 18 How. Pr. 64; *Laird* v. *Wilder*, 9 Bush 131; *Congress Co.* v. *High Rock Co.*, 45 N. Y. 291; *Wilder* v. *Wilder*, Dig. 372; *Hostetter* v. *Adams*, 20 Bl. C. C. 326; *Carbolic Soap Co.* v. *Thompson*, 25 Fed. Rep. 625; *Moxie Nerve Food Co.* v. *Baumbach*, 32 Fed. Rep. 205; *Moxie Nerve Food Co.* v. *Beach*, 33 Fed. Rep. 248.

(*e*) *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392. See *Moorman* v. *Hoge*, 2 Sawy. 78.

(*f*) 36 Ch. D. 1.

passing off their goods as those of the plaintiffs." It has been held in America (*a*) that a label, on which is a representation of a box filled with cakes of soap, wrapped in variously coloured paper wrappers and arranged in a particular way, is not infringed by offering for sale boxes containing cakes of soap so wrapped and arranged.

Not conclusive.

However, where a defendant had, in obedience to express directions, put up his silk in imitation of the plaintiff's bundles, his execution of the order was held not to be conclusive against him (*b*). So, too, where a defendant packed inferior brandy in the plaintiff's cases at the express request of an agent of the plaintiff, who was seeking to entrap him, Malins, V.-C., refused the injunction with costs (*c*).

Sale over counter.

Where a manufacturer, *e.g.* of beer or whiskey, sets up a case against a retail dealer of having sold the product of another manufacturer over the counter in response to a request for the plaintiff's goods, and the defendant shows that he took reasonable precautions to avoid mistakes, it has been held in Scotland that it is not sufficient to prove that one or two mistakes have occurred, but that a course of fraudulent dealing must be made out (*d*).

User in circulars.

It has also been held in Scotland that a word registered as a trade mark is not infringed by its being used in circulars and advertisements in a properly descriptive sense (*e*).

Infringement must be by

The use by one manufacturer of a trade mark resem-

(*a*) *Davis* v. *Davis*, 27 Fed. Rep. 490.

(*b*) *Woollam* v. *Ratcliff*, 1 H. & M. 259. And see *Frese* v. *Bachof* (1), 13 Bl. C. C. 234; *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601.

(*c*) *Hennessy* v. *Kennett*, Dig. 556. But in the Indian case of *Orr-Ewing* v. *Chooneelall Mullick*, Cor. 150, the defendant was restrained, though there was no evidence of his having sold the spurious goods (which he had bought ready marked) to any one but the plaintiff's agent.

(*d*) *Bass, Ratcliff & Gretton, Ld.* v. *Laidlaw*, Ct. Sess. Cas., 4th Ser. XIII. 898; *Thomson & Co.* v. *Robertson*, Ct. Sess. Cas., 4th Ser. XV. 880.

(*e*) *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser. XIII. 1.

bling or even identical with that used by another, is not an infringement of that other's rights, unless the class of goods on which the two marks are used is the same (*a*) or, at least, of so similar a description that they may fairly be supposed to be of the same manufacture as the goods to which the mark is properly applied (*b*).

use on same class of goods.

And where a trader has registered a trade mark for an extensive class of goods, but has only used it for a small part of the goods in the class, another person does not infringe his rights by using a somewhat similar mark on goods also in the class, but substantially different from the goods on which the registered proprietor has used it. This was so laid down by the Court of Appeal in *Edwards* v. *Dennis* (*c*), in which Cotton, L. J., said "no doubt the intention of the Trade Marks Act of 1875 is to give a right to what is on the register so as to enable a person who has been registered for five years as the proprietor of a trade mark to maintain an action against any other person taking or infringing that trade mark; but when the alleged infringement consists in using, not the exact thing upon the register, but something similar to it, the Court must, in considering whether there has been an infringement or not, proceed upon the old principle, which prevailed both at law and in equity before the Act, that a man is not to pass off his goods as the goods of another. At common law the man thus injured might obtain damages, and in equity the more effectual protection of an injunction."

No infringement where registration wider than user.

(*a*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *Moses* v. *Sargood*, Dig. 636; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Whiteley*, 43 L. T. N. S. 627; *In re Rabone*, Dig. 643; *In re Ashton*, V.-C. H. Feb. 26th, 1881; *Colman* v. *Crump*, 70 N. Y. 573; *Société Anonyme* v. *Baxter*, 14 Bl. C. C. 261. In *Hecht* v. *Porter*, 9 Pac. C. L. J. 569, it was held that leather boots and indiarubber boots were so far distinct that a trade mark for the former was not infringed by user in respect of the latter.

(*b*) *Wansutta Mills* v. *Allen*, 12 Phila. 535; *Carroll* v. *Ertheiler*, 1 Fed. Rep. 688; *Collins Co.* v. *Ames & Sons*, 20 Bl. C. C. 542.

(*c*) 30 Ch. D. 454. And compare *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454.

Rights of agent of foreign firm.

In the case of *Apollinaris Co., Ld.* v. *Scherer* (*a*) the plaintiffs, an English company had obtained from one Saxlehner, the proprietor of a spring in Hungary, called the "Hunyadi Janos" spring, the exclusive right to export the water to the United States, and to use the name there. Saxlehner sold the water in Europe under a label which stated that it was not meant for export to America, and the plaintiffs sold the water in the United States under a label which stated that they were the sole exporters. The defendant bought genuine water in Europe under labels bearing Saxlehner's caution, and sold it in the United States as "Hunyadi Janos" water; and it was held that the Apollinaris Co. was entitled to no relief against him, the Court being of opinion that genuine water, rightfully bought, might be sold under its proper name anywhere, and that the arrangement between the Apollinaris Co. and Saxlehner was not binding on persons who were no parties to it.

Rights of lessee of spring.

On the other hand, it has been held (*b*) that the concessionnaire of a spring for a term is not entitled, at all events during the term, to open another spring in the same neighbourhood, and sell the water derived therefrom under the same name as the water derived from the first spring, and in competition with that water.

Sale of materials under name.

Where the plaintiffs' article was known as "Hostetter's Stomach Bitters," and the defendants sold materials which they alleged could be used in the production of that article, no relief was granted, there being no allegation that the defendants had done more than this, or that they were engaged with others in a scheme of fraud (*c*).

Infringement of disused mark.

It has been held in America that the use by a manufacturer of a mark previously used by another manufacturer, but discontinued by him for a year, is an infringement of the rights of the latter (*d*); but it is no infringement to use

(*a*) 23 Bl. C. C. 459.

(*b*) *Hill* v. *Lockwood*, 32 Fed. Rep. 389.

(*c*) *Hostetter* v. *Fries*, 21 Bl. C. C. 339.

(*d*) *Lemoine* v. *Ganton*, 2 E. D. Smith, 343, R. Cox, 142. But see *Symonds* v. *Greene*, 28 Fed. Rep. 834.

in an honest way a mark which has failed to obtain protection in the hands of another trader by reason of that trader's misstatements; and an infringer of the mark as subsequently used by the honest trader cannot escape by setting up the prior user of the dishonest trader (*a*).

Infringement by use of a registered mark.

Registration of a trade mark which resembles a prior trade mark, which is registered so nearly as to be calculated to deceive, does not, at all events for five years from the date of registration, prevent the owner of the prior mark from obtaining an injunction to restrain its use (*b*); and since registration is, for the first five years, only a qualification for bringing an action (*c*), it would seem that if the second of two registered marks had been used first, the owner of that mark would, by virtue of his prior user, be entitled to restrain the owner of the mark which was used later, but registered first, from using that mark. Where the plaintiff's mark had been registered for an extensive class of goods, and the defendant's mark had been registered for a class which overlapped the plaintiff's, but had been used only for goods distinct from theirs, on the defendant beginning to use his mark on goods included in his registration, but similar to those for which the plaintiff's mark had been registered and used, his registration was rectified by limiting it to the distinct goods, and an injunction was granted as to the goods on which he was newly using it (*d*). Again, where the proprietors of a mark registered for coffee in 1876 began, in 1889, to apply it to tea, they were restrained from so doing on motion by the proprietor of a similar mark registered for tea in 1878 (*e*).

(*a*) *Parlett* v. *Guggenheimer*, 67 Md. 542, with which compare *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576.

(*b*) *Read* v. *Richardson*, 45 L. T. N. S. 54; *Goodwin* v. *Venning*, 24 Sol. J. 690. And in New South Wales the use of a registered mark has been restrained: *Harris* v. *Ogg*, 5 N. S. W. Rep. (E.) 114; *Bryant & May* v. *Heyde*, 7 N. S. W. Rep. (E.) 72.

(*c*) *Nuthall* v. *Vining*, C. A. Jan. 21st, 1880; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398; *Hart* v. *Colley*, 44 Ch. D. 193.

(*d*) *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454.

(*e*) *Upper Assam Tea Co.* v. *Herbert & Co.*, C. A., July 3rd, 1889.

Infringement by improper use of genuine mark.

It is an infringement to use a genuine trade mark of a manufacturer upon goods not of his production (*a*); and it is no less an infringement to use it upon goods of a quality to which he did not intend it to be applied, even though the goods upon which the infringer uses it are of the make of the owner of the mark (*b*). But where goods have been purchased in bulk, the purchaser is entitled to resell them retail under the name given to them by the manufacturer (*c*).

Moulded bottles.

In some cases a rather difficult question has arisen with respect to the use of bottles moulded with the plaintiff's name or trade mark. Where such bottles have been systematically bought up and refilled with spurious waters, &c., so as to pass them off as being of the plaintiff's manufacture, an injunction will be granted to restrain the continuance of the fraud (*d*); but where the bottles have been bought by the defendant in the ordinary course of his business they have become his property, though they bear the plaintiff's trade mark (*e*), and it does not appear that he will be restrained from using what he has bought, merely because the bottles are moulded, so long as he uses them in a fair manner, and places on them his own adhesive labels (*f*). There does not, indeed, seem to be a clear decision on the point, as the question has not been raised free from complications. Thus, in *Barrett* v. *Gomm* (*g*), the Court of Appeal held that no injunction could be

(*a*) *Barnett* v. *Leuchars*, 13 L. T. N. S. 495 (boxes for "Pharaoh's Serpents"); *Richards* v. *Williamson*, 30 L. T. N. S. 746 (gun stamps); *Hennessy* v. *Rohmann*, 36 L. T. N. S. 51; *Hennessy* v. *Cooper*, Dig. 549 (cases for brandy).

(*b*) *Hennessy* v. *Kennett*, Dig. 556; *Hennessy* v. *White*, 6 W. W. & A'B. Eq. 216; *Hennessy* v. *Hogan*, *ib.* 225 (cases intended for brandy of superior quality used for brandy of inferior quality); *Gillott* v. *Kettle*, 3 Duer, 624, R. Cox, 148 (labels indicating superior pens placed on boxes of inferior ones).

(*c*) *Condy & Mitchell* v. *Taylor & Co.*, 56 L. T. N. S. 891.

(*d*) *Rose* v. *Henley*, Dig. 551; *Allen* v. *Richards*, 26 Sol. J. 658; *Hostetter* v. *Anderson*, 1 V. R. Eq. 7; *Sawyer Crystal Blue Co.* v. *Hubbard*, 32 Fed. Rep. 388; *Evans* v. *Von Laer*, 32 Fed. Rep. 153.

(*e*) *Idris & Co.* v. *Ward*, C. A. Feb. 4th, 1889.

(*f*) *Welch* v. *Knott*, 4 K. & J. 747; *Rose* v. *Loftus*, 47 L. J. Ch. 576. See, however, *Wood* v. *Burgess*, 24 Q. B. D. 162, a case under the Merchandise Marks Act, 1887.

(*g*) 74 L. T. (Journal) 388.

granted against soda-water manufacturers whose labels were found to be placed on two bottles of soda-water moulded with the plaintiff's name and trade mark, but in this case there was no evidence to show that the soda-water in the bottles was of the defendant's manufacture, or that the defendants had filled or sold them. The Master of the Rolls (Sir G. Jessel), however, stated that if some of the plaintiff's engraved bottles had come fairly into the defendants' possession, they would have been entitled to refill and sell them, at all events if they had placed on them their own adhesive labels, so as to cover the plaintiff's name and trade mark. And this opinion appears to have been adopted by North, J., in *Barrett* v. *White* (*a*).

Infringement by engraver.

It is an infringement for an engraver to prepare and supply to one person printing-blocks engraved with the trade mark, or an important part of the trade mark of another, inasmuch as the piracy would be impossible without the blocks; and Shadwell, V.-C. of E., went so far as to say that if a thing contained twenty-five parts, and one only was taken, such an imitation would be sufficient to contribute to a deception, and the law would hold those responsible who had contributed to the fraud (*b*). The principle is the same where the engraver, though retaining the blocks in his own possession, yet facilitates fraud by the dissemination of labels bearing pirated trade marks (*c*). Lord Cranworth, C., thought, however, that a man who had A's goods, but none of his labels, might rightfully employ a printer or engraver to supply him with imitated labels, and that A could have no ground of complaint against the sale of his goods with something on them to represent his trade mark, though not his genuine mark (*d*).

(*a*) North, J., May 12th, 1883.

(*b*) *Guinness* v. *Ullmer*, 10 L. T. (Old Series) 127.

(*c*) *Farina* v. *Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650; *De Kuyper* v. *Wittman*, 23 Fed. Rep. 871; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183; *Holt* v. *Menendez*, 128 U. S. Rep. 182.

(*d*) *Farina* v. *Silverlock*, 6 De G. M. & G. 214.

Untrue allegation of registration.

It does not appear that the position of a defendant in an action for infringement is altered for the worse by the fact of his having alleged his trade mark to be registered, before it in fact was so (*a*); but by so doing he will expose himself to penalties under § 105 of the Patents Act, 1883 (*b*).

Use by a trade-mark owner of his mark upon another's goods.

It seems that a manufacturer is entitled to place his trade mark on articles not of his own make, unless there is some trade custom or contract that he shall not do so, and to remove the maker's mark for the purpose of substituting his own, and that such a course would not be actionable (*c*). Nor is there any reason why it should be so. The maker's mark has already performed its function when the goods are sold, and when it is removed from the goods the maker ceases to be responsible for the guarantee implied by its presence on them. The purchaser, by substituting his own mark, undertakes the responsibility for the quality of the goods, which are, in effect, selected and guaranteed by him (*d*).

(*a*) *Ellis & Sons* v. *Ruthin Soda Water Co.*, M. R., Nov. 21st, 1879.

(*b*) See also § 3 (1) (*c*) of the Merchandise Marks Act, 1887.

(*c*) See *Johnson* v. *Raylton*, 7 Q. B. D. 438. Compare *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90.

(*d*) See *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Wood* v. *Lambert*, 32 Ch. D. 247; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183.

CHAPTER V.

THE CRIMINAL PROSECUTION.

Remedies for fraudulent imitations.

"In cases like the present" (*i.e.*, in cases of imitation of a wrapper imprinted with a trade mark), "the remedy," said Willes, J., "is well known. The prosecutor may, if he pleases, file a bill in equity to restrain the defendant from using the wrappers, or he may bring an action at law for damages, or he may indict him for obtaining money under false pretences" (*a*).

Infringement of trade mark not forgery at Common Law.

At Common Law the imitation of a trade mark or of a trade wrapper is not a forgery. "A forgery must be of some document or writing" (*b*); "it is the forging of a false document to represent a genuine document" (*c*). In a case in which the prisoner had imitated the label used on Borwick's baking powder, and was indicted for forgery (*d*), the Court of Crown Cases Reserved, consisting of Pollock, C. B., Willes and Byles, JJ., and Bramwell and Channell, BB., decided that the conviction for forgery was not sustainable, though an indictment for false pretences would have been good. The grounds of the decision are thus stated by Bramwell, B.: "I think that this was not a forgery. Forgery supposes the possibility of a genuine document, and that the false document is not so good as the genuine document, and that the one is not so efficacious for all purposes as the other. In the

(*a*) *R.* v. *John Smith*, D. & B. 566; 8 Cox, 32. This was in 1858, before the Merchandise Marks Act of 1862.

(*b*) Per Cockburn, C. J., *R.* v. *Closs*, D. & B. 460; 7 Cox, 494.

(*c*) Per Willes, J., *R.* v. *John Smith*, *ubi suprà*.

(*d*) *R.* v. *John Smith*, *ubi suprà*.

present case, one of these documents is as good as the other: the one asserts what the other does; the one is as true as the other; but one gets improperly used. But the question is whether the document itself is a false document. It is said that the wrapper is so like one used by somebody else, that it may mislead; but that is not material to the question we have to decide. The prisoner may have committed a gross fraud in using the wrappers for that which was not the genuine powder, and may possibly be indicted for obtaining money by false pretences, but I think he cannot be convicted of forgery" (*a*).

Not even if the mark consists of a signature.

It might be thought that where the trade mark consisted of a signature, an imitation of this would amount to forgery; but this has been decided not to be so, in the case of *R.* v. *Closs* (*b*), in which the prisoner imitated the signature of the artist, J. Linnell, in the corner of a spurious picture. Cockburn, C. J., in delivering the judgment of the Court of Crown Cases Reserved, said that the stamp was merely in the nature of a mark put upon the painting with a view to identifying it, and was no more than if the painter put any other arbitrary mark as a recognition of the painting being his; and in the course of the argument he expressed a similar opinion with respect to the imitation of a signature stamped on a gun.

The Merchandise Marks Act, 1862.

Under the Merchandise Marks Act, 1862 (*c*), the forgery of trade marks was made a misdemeanour, and the Criminal Law made to cover such offences as those committed in *R.* v. *John Smith* (*d*) and *R.* v. *Closs* (*e*).

(*a*) Taking the same view, Pollock, C. B., said that the real offence was the enclosing the false powder in the false wrappers; that the issuing of the wrappers without the stuff within them would be no offence; but that the real offence was the issuing them with the fraudulent matter in them.

(*b*) D. & B. 460; 7 Cox, 494. 25 & 26 Vict. c. 68, § 7, now provides for spurious pictures with a forged signature.

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

(*d*) D. & B. 566; 8 Cox, 32.

(*e*) D. & B. 460; 7 Cox, 494. See *R.* v. *Lloyd* (Recorder of Birmingham, Oct. 13th, 1881), in which the infringement of a gunmaker's trade mark was punished under the

And this is so now under the new Merchandise Marks Act, 1887 (*a*).

By that Act (*b*) the following offences are made punishable:— What offences are punishable under the Merchandise Marks Act, 1887.

1. Forging a trade mark registered in the United Kingdom or protected in any British possession or foreign state to which § 103 or 104 of the Patents Act, 1883, has been made applicable (*c*).
2. Falsely applying to goods any trade mark as above, or any mark so nearly resembling such a trade mark as to be calculated to deceive (*d*).
3. Making any die, block, machine, or other instrument for the purpose of forging or of being used for forging a trade mark as above (*e*).
4. Applying to goods any false trade description—*i.e.*, any description, statement, or other indication, direct or indirect—
   - (*a*) As to the number, quantity, measure, gauge or weight of any goods; or
   - (*b*) As to the place or country in which any goods were made or produced; or
   - (*c*) As to the mode of manufacturing or producing any goods; or
   - (*d*) As to the material of which any goods are composed; or

Merchandise Marks Act, 1862, with six months' imprisonment. In *R.* v. *Willis*, C.C.C., September 21st, 1885, Hawkins, J., inflicted six years' penal servitude on a person who had offered for sale watches of base metal thinly coated with gold and bearing a forged Goldsmiths' Hall mark. In *R.* v. *Boyes*, C. C. C., April 6th, 1886, the Recorder of London inflicted four months' imprisonment without hard labour for imitation of the prosecutor's perfumes, bottles and labels. In *R.* v. *Pemberton*, 20 Iron, 110, the defendant had forged the "Low Moor" trade mark on iron tubes not of the Low Moor Co.'s material or manufacture, and Day, J., inflicted three months' imprisonment without hard labour. See *Cooper* v. *Hamilton*, 6 N. Z. L. R. 598, as to the practice in New Zealand.

(*a*) 50 & 51 Vict. c. 28.

(*b*) As to this Act generally, see *Gridley* v. *Swinborne*, 5 Times L. R. 71; *Wood* v. *Burgess*, 24 Q. B. D. 162; and *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90; and the notes to the Act in Appendix E.

(*c*) §§ 2 (1) (*a*), 3 (1) and 4.

(*d*) §§ 2 (1) (*b*), 3 (1), 5 and 6.

(*e*) §§ 2 (1) (*c*), 4 and 6.

(*e*) As to any goods being the subject of an existing patent, privilege, or copyright;

(*f*) As to the person or firm who manufactured any goods,

which is false in a material respect as regards the goods to which it is applied (*a*).

5. Disposing of or having in possession any die, block, machine, or other instrument for the purpose of forging a trade mark as above (*b*).
6. Causing any of the above things to be done (*c*).
7. Selling, or exposing for or having in possession for sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark as above or false trade description is applied, or to which any trade mark as above or mark so nearly resembling such a trade mark as to be calculated to deceive, is falsely applied (*d*).
8. Procuring, counselling, aiding, abetting, or being accessory to, from within the United Kingdom, the commission without the United Kingdom of any such act as above (*e*).
9. Falsely representing that any goods are made by a person holding a Royal warrant, or for the service of Her Majesty, or of any of the Royal Family, or any Government department (*f*).

Additions to and alterations of trade marks.

By § 4 (*b*) it is made forgery of a trade mark to falsify a genuine trade mark, whether by alteration, addition, effacement, or otherwise.

Forgery at Common Law.

At Common Law "it is forgery to alter a material part of a true instrument" (*g*). Thus, where in a bill of exchange "0" was added to "8" and

(*a*) §§ 2 (1) (*d*), 3, 5, and 6. Compare § 18. As to 4 (*a*) see *R.* v. *Sherwood*, 7 Cox, 270; *R.* v. *Ragg*, 8 Cox, 265; *R.* v. *Lee*, 9 Cox, 460. As to 4 (*b*) see § 7, with respect to watches. As to 4 (*e*) see § 105 of the Patents Act, 1883, and *R.* v. *Wallis*, 3 P. R. 1, *R.* v. *Crampton*, 3 P. R. 367, and *R.* v. *Morris*, Great Marlborough Street Police Court, December 16th, 1886.

(*b*) §§ 2 (1) (*c*), 3 (1) and 4.

(*c*) §§ 2 (1) (*f*) and 6.

(*d*) § 2 (2). (*e*) § 11.

(*f*) § 20. And see § 106 of the Patents Act, 1883, as to wrongful assumption of the Royal Arms.

(*g*) 2 East, P. C., 978.

"y" to "eight," so as to make it appear to be for £80 (*a*). And "the making of any false instrument which is the subject of forgery, with a fraudulent intent, although in the name of a non-existing person, is as much a forgery as if it had been made in the name of one who was known to exist, and to whom it was due" (*b*). "An exact resemblance, or facsimile, is not required to constitute the crime of forgery, for if there be a sufficient resemblance to show that a false making was intended, and that the false stamp is so made as to have an aptitude to deceive, that is sufficient" (*c*).

Defences.

The defences to a charge of one of the above offences are set out, as to Nos. 1 to 6, in § 2 (1); as to No. 7, in § 2 (2). A special defence is also provided by § 6 for persons who are charged with having committed offences 2, 3, 4 or 6, when they were in fact employed in the ordinary course of their business.

Penalties.

The penalties for offences Nos. 1 to 8 are set out in § 2 (3); as to No. 9, in § 20.

Expressions generally understood may be employed.

It is not an offence for persons to use any trade description lawfully and generally applied, at the passing of the Act, to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods (*d*), when the description is so applied. Thus, patent leather, patent thread (*e*), patent pins (*f*), patent isinglass (*g*). But there is a special requirement, when the name of a place or country is stated in a misleading way, that the place of origin shall be stated (*h*).

Civil remedy not affected by conviction.

A conviction under this Act does not relieve the defendant from any civil proceedings (*i*).

(*a*) *R.* v. *Elsworth*, 2 East P. C. 986.

(*b*) *Ib.* 957; and see *R.* v. *Lewis*, Foster Cr. Cas. 116; *R.* v. *Avery*, 8 C. & P. 596; *R.* v. *White*, 72 C. C. C. Sessions Papers, 222.

(*c*) Per Grose, J., in *R.* v. *Collicott*, 2 Leach, 1048, a Stamp case.

(*d*) § 18.

(*e*) *Marshall* v. *Ross*, L.R. 8 Eq. 651.

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

(*g*) *Gridley* v. *Swinborne*, 5 Times L. R. 71.

(*h*) § 18. (*i*) § 19.

Where deception succeeds, indictment for false pretences will lie.

While, apart from the Merchandise Marks Act, the fraudulent imitation of a trade mark is not forgery, such an imitation, when it has been intended to be and has been the means of inducing persons to part with their money, in the belief that they were buying one thing, when in fact they were buying another, is sufficient to support a conviction on an indictment for obtaining money by false pretences. This affords sufficient protection to the innocent purchaser of goods falsely marked; the Act gives protection to the manufacturer who has suffered in his custom and in his reputation by piracies.

Convictions.

"There is no difference in principle between a misrepresentation of a mark, and one that an acceptance was the acceptance of John Jones or any other person" (*a*); and it is established that the fraudulent imitation of a trade mark will be punished in the same way, where the necessary circumstances exist. Thus, in *R.* v. *Dundas* (*b*), the prisoner, who asserted his own name to be Everett, sold blacking in bottles labelled "Everett's Premier," in a similar manner, with only trifling variations, to the bottles of a well-known manufacturer of that name. Erle, J., told the jury that "with respect to the difference between the labels, the jury should consider whether it was a small and colourable difference only, and intended to deceive. It was of little consequence whether the man's name was Everett, as he had stated, or not; for even if it were, and he went about the country and offered blacking for sale as 'Everett's Premier,' representing it to be the well-known article of that name, knowing that it was not so, and intending to cheat the prosecutor by passing upon him a spurious article as the true one, his conduct was equally fraudulent" (*c*). The prisoner was convicted.

(*a*) Per Kelly, C. B., in *R.* v. *Suter & Coulson*, 10 Cox, 577.

(*b*) 6 Cox, 380.

(*c*) It was also held that an offer to sell on sale or return was immaterial, the actual bargain being for cash.

In *R.* v. *Smith* (*a*), the conviction for forgery being quashed, the prisoner afterwards pleaded guilty to an indictment for false pretences (*b*). In *R.* v. *Suter & Coulson* (*c*), it was held by the Court of Crown Cases Reserved that a representation that a mark of "18" on a watch was a genuine hall-mark of the Goldsmiths' Company was clearly a false pretence within the statute (*d*).

R. v. *Bryan.* Question as to misrepresentation of quality.

The case of *R.* v. *Bryan* (*e*) gave rise to some differences of opinion in respect to the Law of False Pretences. The prisoner in that case was found by the jury to have obtained money from pawnbrokers on spoons which he had fraudulently represented to have as much silver on them as Elkington's "A" spoons. They also found that he had represented the foundations to be of the best material, knowing that to be untrue, and that in consequence of this he obtained the moneys mentioned in the indictment. The Recorder of London reserved the case for the consideration of the Court of Crown Cases Reserved. Twelve judges heard the case, and of these ten held that the conviction must be quashed, Willes, J., and Bramwell, B., dissenting. The language employed by some of the judges on that occasion, and in particular by Lord Campbell, C. J. (*f*), led to an impression that in the opinion of the judges it was impossible to convict under the Statute of False Pretences, when the misrepresentation had reference only to quality and not to substance: that is to say, that where, for instance, an

(*a*) D. & B. 566; 8 Cox, 32.

(*b*) 8 Cox, 37; and 48 C. C. C. Sessions Papers, 8.

(*c*) 10 Cox, 577.

(*d*) And in *R.* v. *Gray & Gosling*, Dig. 183, the imitation of Messrs. Allsopp's labels was punished; and in *R.* v. *S. Jones*, Dig. 182, the imitation of Mr. Borwick's wrappers. See, too, *R.* v. *Closs*, D. & B. 460; 7 Cox, 494.

(*e*) D. & B. 265; 7 Cox, 312.

(*f*) He said, for instance, that the conviction proceeded upon "a mere misrepresentation, during the bargaining for the purchase of a commodity, of the quality of that commodity." "If the seller were criminally liable for unduly exaggerating the value of the article, the buyer would be for unduly depreciating." He "found no case in which a mere misrepresentation at the time of sale of the quality of the goods had been held to be an indictable offence."

infinitesimal quantity of gold was found in a ring represented to be of eighteen-carat gold, the presence of that infinitesimal quantity of gold prevented the false representations from supporting a criminal charge (*a*). Where the jewellery contained no metal of the kind specified, the prisoner was convicted (*b*). Anticipating such a result, Bramwell, B., said (*c*) that the result of the decision would be that the prisoner would be indictable if Elkington's spoons had half an ounce and his none, but not if Elkington's had one ounce and his a quarter of an ounce.

The interpretation thus put upon the decision in *R.* v. *Bryan* was unfortunate, tending, as it did, to encourage an idea of fraud being possible with impunity; and some of the judges who had decided *R.* v. *Bryan* (*c*) took opportunities of explaining what the real principle of the judgment was (*d*). It was also difficult to reconcile such a conclusion with such cases as those in which the prisoner sold a cheese by means of the representation that a taster taken from a cheese of superior quality was in fact taken from the one in question (*e*). There was, indeed, in those cases, a certain misrepresentation as to substance, but the real grievance was that a cheese was sold as being of one quality, when it was in fact of another (*f*).

R. v. *Ardley.* The whole question is now fully explained and set at rest by the judgment in *R.* v. *Ardley* (*g*). There the

(*a*) *R.* v. *Suter & Coulson*, 10 Cox, 577; and see *R.* v. *Lee*, 8 Cox, 233; *R.* v. *Levine & Wood*, 10 Cox, 374. Previously to *R.* v. *Bryan*, D. & B. 265, 7 Cox, 312, in *R.* v. *Hall*, 45 C. C. C. Sessions Papers, 451, the prisoner was convicted, though there was a minute quantity of gold.

(*b*) *R.* v. *Roebuck*, 7 Cox, 126; D. & B. 24; and see *R.* v. *Ball*, C. & M. 249; *R.* v. *Stevens*, 1 Cox, 83; and *R.* v. *Priestley*, 63 C. C. C. Sessions Papers, 541.

(*c*) *R.* v. *Bryan*, D. & B. 265; 7 Cox, 312.

(*d*) See, for instance, per Erle, C. J., in *R.* v. *Goss*, Bell, 208; 8 Cox, 262; and per Willes, J., in *R.* v. *Suter & Coulson*, 10 Cox, 577.

(*e*) *R.* v. *Abbott*, 1 Den. 273; *R.* v. *Dark*, 1 Den. 276; *R.* v. *Garlick*, 1 Den. 276; *R.* v. *Goss*, Bell, 208; 8 Cox, 262.

(*f*) And on this ground Lord Campbell, C. J., in *R.* v. *Roebuck*, 7 Cox, 126, D. & B. 24, dissented from *R.* v. *Abbott*.

(*g*) L. R. 1 C. C. R. 301, 12 Cox, 23. Compare *R.* v. *Foster*, 13 Cox, 393.

prisoner obtained money for a watch chain which he represented to be of fifteen-carat gold, stamped on every link, but which representation was untrue. In giving judgment, Bovill, C. J., said: "The case which has been most pressed upon us is *R.* v. *Bryan* (*a*). The representation in that case was that certain plated spoons were 'equal to Elkington's A.' *Primâ facie* that representation would seem to be a mere matter of opinion, and the Court held that it was not sufficient to support the conviction. But many of the judges expressed the opinion that there might well be cases in which misrepresentations, though as to quality, would be within the statute. Cockburn, C. J., says, 'If the prisoner had represented these articles as being of Elkington's manufacture, when in point of fact they were not, and he knew it, that would be an entirely different thing.' Pollock, C. B., says, 'I think if a tradesman or a merchant were to concoct an article of merchandise expressly for the purpose of deceit, and were to sell it as and for something very different even in quality from what it was, the statute would apply.' It is plain that these learned judges considered that a specific representation of quality, if known to be false, would be within the statute. Coleridge, J., expressly concurs in the observations of Pollock, C. B. Erle, J., at the close of his judgment, says: 'No doubt it is difficult to draw the line between the substance of the contract and the praise of an article in respect of a matter of opinion; still it must be done, and the present case appears to me not to support a conviction, upon the ground that there is no affirmation of a definite triable fact in saying the goods were equal to Elkington's "A," but the affirmation is of what is mere matter of opinion, and falls within the category of untrue praise in the course of a contract of sale, where the vendor has in substance the article contracted for, namely, plated spoons.' Crompton, J., also considered that the statute

(*a*) D. & B. 265; 7 Cox, 312.

applies 'where the thing sold is of an entirely different description from what it is represented to be.' Willes, J., who dissented from the judgment of the Court, goes the whole length of saying that a representation as to quality, if known to be false, is enough to support a conviction. And Bramwell, B., leans to the same opinion.

"Applying these observations to the present case, the statement here made is not in form an expression of opinion or mere praise. It is a distinct statement, accompanied by other circumstances, that the chain was fifteen-carat gold. That statement was untrue, was known to be untrue, and was made with intent to defraud. How does that differ from the case of a man who makes a chain of one material and fraudulently represents it to be of another? Therefore, whether we look at the whole of the evidence, or only at that which goes to the quality of the chain, the conviction is good. The case differs from *R.* v. *Bryan* (*a*), because here there was a statement as to a specific fact within the actual knowledge of the prisoner, namely, the proportion of pure gold in the chain."

Intentional misstatement as to fact punishable.

From this case it follows that where a person has made a false statement in regard to a specific question of fact, knowing that statement to be false, with intent to defraud, and he does defraud by means of that statement, then, even though the statement have reference to the quality of the article, he will be liable to be convicted (*b*).

Wrongful user of trade marks.

Placing a forged trade mark on goods not the make of the manufacturer whom the trade mark denotes will amount to such a statement; and it seems that the shifting a genuine label from goods of superior quality to goods of inferior quality, though of the same maker, will also come within the principle of *R.* v. *Ardley* (*c*).

(*a*) D. & B. 265; 7 Cox, 312.

(*b*) On this principle, in New South Wales, a prosecution was directed against a person who had sold German cigars as Havannahs. *Heyde* v. *Witthowski*, 5 N. S. W. Rep. (E.) 74.

(*c*) L. R. 1 C. C. R. 301; 12 Cox, 23.

In the sale of goods by weight, if money is obtained by representing the weight sold to be greater than it really is, an indictment for false pretences will be good, and it will make no difference that the goods were sold as a whole—for instance, by the load—if the price was calculated on the assumption that the load was of the weight represented by the prisoner (*a*). False pretences as to weight.

By § 105 of the Patents Act, 1883, penalties are now imposed on persons untruly representing that a trade mark is registered (*b*). False pretences as to registration of trade marks.

Words are not necessary to constitute the false representation. Thus, where hewers at a colliery placed in their tubs of coal tokens to represent a greater weight of coal than they had in fact worked, it was held that they were properly convicted (*c*). False pretences without words.

(*a*) *R.* v. *Sherwood*, 7 Cox, 270; *R.* v. *Ridgway*, 3 F. & F. 838; *R.* v. *Ragg*, 8 Cox, 265; *R.* v. *Lee*, 9 Cox, 460.

(*b*) See § 3 (1) of the Merchandise Marks Act, also *R.* v. *Morris*, Great Marlborough Street Police Court, December 16th, 1886.

(*c*) *R.* v. *Hunter*, 10 Cox, 642; *R.* v. *Carter*, *ib.*

CHAPTER VI.

THE CIVIL REMEDY. I.

Common Law. THE proper remedy at Common Law for a fraud committed by means of the infringement of a trade mark belonging to a rival trader is by an action on the case for deceit. The manner in which that form of action was made applicable to cases of trade mark and developed to meet the necessities of such cases, which in some respects differ from other cases of fraudulent misrepresentation, may be well stated in the language employed by Mellish, L. J., who says (*a*): "In my opinion, all actions of this nature must be founded upon false representations. Originally, I apprehend, the right to bring an action in respect of the improper use of a trade mark arose out of the Common Law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect, that an action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trade mark, the Common Law Courts noticed that the false representation which is made by putting another man's trade mark, or the trade name of another manufacturer, on the goods which the wrongdoer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trade mark is imitated; and, therefore, the Common Law Courts held that such a manufacturer had a

(*a*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-53.

right of action for the improper use of his trade mark. Then the Common Law Courts extended that doctrine one step farther; first, if I recollect rightly, in the case of *Sykes* v. *Sykes* (*a*). There it was held that, although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods, and therefore was not deceived into believing that he had bought goods manufactured by another person; yet if the trade mark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade mark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trade mark a right of action. That was the Common Law right."

Action may be brought by manufacturer defrauded.

An action on the case for deceit at Common Law may then be brought, not only by the person who has been induced to purchase goods manufactured by one maker in the faith that they have been manufactured by another, but also by the maker of whose manufacture the goods in question have falsely been represented to be. It seems at least probable that this principle was recognised as early as the reign of Queen Elizabeth. In *Southern* v. *How* (*b*) a case was quoted by Doderidge, J., in which, in that reign, a clothier of Gloucester, who manufactured better cloth than any other person in the trade, had invented and applied to his cloth a special mark to denote his manufacture. Another clothier then pirated this mark and applied it to his own inferior cloth; and it was held in the Court of Common Pleas that an action on the case for deceit would lie against the fraudulent clothier.

(*a*) 3 B. & Cr. 541. And see per Lord Blackburn, in *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15.

(*b*) Cro. Jac. 471; Poph. 144; 2 Rolle, 28.

Whether the action was brought by the buyer of the cloth or by the rival clothier cannot be determined, since the reporters differ on this point; but this much is clear, that Chief Justice Popham (*a*) reported the case as establishing the right of the defrauded clothier to compensation for the injury done him.

Right to redress.

Whatever the circumstances in that particular case may have been, the principle that a person who has suffered by reason of his trade mark being intentionally imitated by another has a right at Common Law to redress from the infringer has been repeatedly acted on, and is thus clearly stated by Coltman, J., in *Rodgers* v. *Nowill* (*b*), where, after expressing his agreement with the law laid down by Williams, J., that no man had a right to sell goods of his own manufacture upon a false and deceitful representation that they were of the manufacture of another, he says: "To this I would add that an action is clearly maintainable by the party whose name is so fraudulently used, if any damage results to him from the false representation."

At Common Law, fraudulent intention must be proved.

According to the strict principles of the Common Law, for an action in respect of a trade mark to be successful, it must be proved that the defendant acted with fraudulent intention. "Proof of fraud on the part of the defendant," says Lord Westbury, C., "is of the essence of the action" (*c*). The general law on the subject of false representations is

(*a*) The great weight to be given to any statement by Popham, C. J., appears from the terms applied to him in 6 Co. Rep. 75, where he is described as "the venerable and honourable Chief Justice of England, and Councillor of State to Queen Elizabeth and to our Lord the King that now is. . . . Who was a most reverent judge, of a ready apprehension, profound judgment, most excellent understanding in the true reason of the law, and of universal and admirable experience and knowledge of all business which concerned the commonwealth; accompanied with a rare memory, with perpetual industry and labour for the maintenance of the tranquillity and public good of the realm, and in all things behaving with great constancy, integrity and patience." Eyre, C. J. (1 B. & P. 610), speaks of him as "a very able judge," and Lord Fitzgerald (14 App. Cas. 357) says "he had the reputation of being a consummate lawyer."

(*b*) 5 C. B. 109.

(*c*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185.

summed up by Parke, B., in *Taylor* v. *Ashton* (*a*), as being that, independently of any contract between the parties, no one can be made responsible for a representation of such a kind as there was in that case (*i.e.*, a false representation of the flourishing state of a bank, which had induced the plaintiff to take shares), unless it be fraudulently made. The law so enunciated was applied in a succession of trade-mark cases at Common Law (*b*), the effect of which was stated by Lord Westbury as above.

Defendant must have expected deception.

It has been held that intentional fraud cannot be inferred from the fact alone that the plaintiff has informed the defendant that in his opinion the defendant was using a trade mark calculated to deceive, nor even from the fact being that the trade mark so used is really calculated to deceive: there must be evidence that the defendant believed such deception to be probable (*c*); in other words, that the defendant has sold his goods "as and for" the plaintiff's goods (*d*). "But," said Lord Blackburn, in *Singer Manufacturing Co.* v. *Loog* (3) (*e*), "it is to my mind obvious that, though the defendants might have committed no

(*a*) 11 M. & W. 415.

(*b*) See, among other cases, *Singleton* v. *Bolton*, 3 Doug. 293; *Crawshay* v. *Thompson*, 4 Man. & G. 357; *Rodgers* v. *Nowill*, 5 C. B. 109; *Myers* v. *Baker*, 3 H. & N. 802. In *Crawshay* v. *Thompson*, Coltman, J., expressed himself thus: "It appears to me that an intention to deceive is a necessary ingredient in this case. The intention is for the jury; and fraud must be made out by proof of an intention existing in the mind of the party that the iron should pass as the iron of the plaintiff." And in *Hargreaves* v. *Smith*, Dig. 338, Lush, J., told the jury that an intention to divert customers from the plaintiffs to the defendant must be proved. See per Lord Blackburn in *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15, in the House of Lords, and *Lawrie* v. *Baker*, 2 P. R. 213.

(*c*) *Crawshay* v. *Thompson*, 4 Man. & G. 357.

(*d*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; *Morison* v. *Salmon*, 2 Scott, N. R. 449, 2 Man. & G. 385; *Crawshay* v. *Thompson*, *ubi suprà*. In equity, it is not necessary to prove fraudulent intention otherwise than by proving that the defendant has used a mark which is, in fact, calculated to deceive; and this was recognised by the Court of Queen's Bench in *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537. Since by the Judicature Act of 1873, § 25, the rules of Equity are to prevail where they conflict with those of the Common Law, it appears that at least nominal damages should now be recoverable in the Queen's Bench Division on proof of such facts as would be satisfactory to a Court of Equity.

(*e*) 8 App. Cas. 15

actionable wrong whilst using the plaintiff's trade mark innocently, yet, if they persevered with the use of it after they had knowledge of the facts, they would do wrong, and there would be evidence to support a claim at law for damages for knowingly selling the defendants' goods as and for the plaintiff's." And in a recent Canadian case at law (*a*), it was held that the plaintiff was entitled to damages, though the defendant denied any fraudulent intention, since the mark had been registered for a year as the plaintiff's, and the defendant must be taken to have known it.

Deception of first purchaser not necessary.

It is not necessary, in order for the plaintiffs to recover, for them to show that the defendants made fraudulent representations directly to the persons to whom they sold the goods; "although they did not themselves sell them as goods of the plaintiffs' manufacture, yet if they sold them to retail dealers for the express purpose of being resold as goods of the plaintiffs' manufacture" (*b*), thus "scattering over the world the means of enabling parties to commit frauds upon the plaintiffs" (*c*), proof of that would be sufficient for the plaintiffs' case (*d*).

Questions for jury.

The question of fraudulent intention is for the jury, with whom it rests to say whether or not such intention is proved by the evidence before them (*e*). And it was held under the old practice that the plaintiff's pleadings must allege with sufficient distinctness a false representation on the part of the defendant (*f*), when it was left to the jury to say whether the defendant had adopted the particular mode of deceit charged (*g*).

(*a*) *Bondier* v. *Depatie*, 3 Dorion 233.

(*b*) *Sykes* v. *Sykes*, 3 B. & Cr. 541.

(*c*) Per Wood, V.-C., in *Farina* v. *Silverlock*, 1 K. & J. 509.

(*d*) Compare the language of the Court of King's Bench in *Polhill* v. *Walter*, 3 B. & Ad. 114; and see *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-42-51-53, and *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15.

(*e*) *Crawshay* v. *Thompson*, 4 Man. & G. 357; *Rodgers* v. *Nowill*, 5 C. B. 109.

(*f*) *Morison* v. *Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385.

(*g*) *Rodgers* v. *Nowill*, 5 C. B. 109. In *Hargreaves* v. *Smith*, Dig.

Plaintiff must be injured.

In order to entitle the plaintiff to recover, it must be shown that the defendant's conduct has injuriously affected the plaintiff, and the plaintiff's pleadings must be so framed as to disclose a sufficient cause of action; so that where a banking business was established in London under the same name as a previously existing bank, it was held that the proprietor of the earlier bank could not recover, since he had not averred that he was a banker or had ever carried on a banking business (*a*). This case was decided on the same principle on which it was held, in the Court of Chancery, that there was no infringement of trade mark unless there was actually in the market a vendible article to which the mark was in some way attached, and that no right to an injunction existed before the article had in fact been produced, even though it had been repeatedly advertised, and considerable outlay so incurred (*b*).

Costs incurred by defendant's fraud recovered from him.

Where A ordered from B a quantity of fire-bricks, marked with the name of C, who used it as his own trade mark, and the order was being executed by B in ignorance of C's rights, C filed a bill in Chancery to restrain B, who compromised the matter on paying a sum amounting in all, including costs, to over £200. On B bringing an action against A to recover the sum which he had so been compelled to pay, it was held by the Court of Queen's Bench that he was entitled to recover that sum, C being entitled to an injunction in Equity on mere proof of the imitation, though at Common Law he would have had to prove fraud on the part of B (*c*).

Innocent vendor of goods falsely marked.

It has been held in America that an innocent vendor of goods falsely marked, the genuineness of which he has not

338, Lush, J., left it to the jury to say (1) whether the plaintiffs' mark was a good one; (2) whether it had been imitated; (3) whether, if there was imitation, it was with intent to deceive. And see *Gillespie & Co.* v. *Marshall*, Dig. 648.

(*a*) *Lawson* v. *Bank of London*, 18 C. B. 84. And see per Lord Blackburn in *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15.

(*b*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307.

(*c*) *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537.

warranted, is entitled to maintain an action to recover the price of the goods from a person to whom he has sold them (*a*).

Damages.

Although it cannot be assumed by the Court, in default of evidence, that the same quantity of goods which a defendant has sold under a trade mark imitated from that of the plaintiff would have been sold by the plaintiff but for the defendant's unfair competition (*b*), yet, where the whole profit made by an infringer upon the sale of the goods wrongfully marked was awarded by the jury as damages, the American Court held that this was not excessive, and said that the fact that it was impossible to apportion the profit rendered it just that the infringer should lose the whole (*c*). And in *Taylor* v. *Carpenter* (*d*), when the defendant, against whom a verdict had been found with substantial damages, moved for a new trial, urging, among other arguments, that the jury should have been told that if the defendant's goods were not inferior to the plaintiffs', the latter could not recover, or at all events could recover only nominal damages, it was held that the plaintiffs were not only not debarred from recovering at all, but that they could recover substantial damages, "since the actual damage suffered by loss of sales by the plaintiffs, which was the ground of recovery, was just as great as if the thread had been inferior, though the credit of their mark and thread might not suffer as much thereby, if it did at all."

Nominal damages where right infringed.

That a plaintiff is entitled to recover some damages where his trade mark has been infringed, appears clearly from *Blofeld* v. *Payne* (*e*), in which Lord Denman, C. J., told the jury that even if the defendants' hones were not

(*a*) *Rudderow* v. *Huntington*, 3 Sand. S. C. 252, R. Cox, 106.

(*b*) *Leather Cloth Co.* v. *Hirschfeld*, L. R. 1 Eq. 299. As to damages see cap. 7 *infrà*.

(*c*) *Graham* v. *Plate*, 40 Cal. 593, 6 Amer. Rep. 639. And see *Hostetter* v. *Vowinkle*, 1 Dill. 329.

(*d*) 2 Wood. & M. 1; 9 L. T. (Old Series) 514, R. Cox, 32-42.

(*e*) 4 B. & Ad. 410.

inferior, the plaintiff was still entitled to some damages, inasmuch as his right had been evaded by the fraudulent act of the defendants. The jury found a verdict for the plaintiff, with a farthing damages, and also found that the defendants' hones were not inferior to the plaintiff's. The verdict was upheld by the Court of King's Bench, Littledale, J., saying that "the act of the defendants was a fraud against the plaintiff, and that even if it occasioned him no specific damage, it was still, to a certain extent, an injury to his right." It is evident that in this case, although the plaintiff did not suffer in reputation by the sale of inferior hones as his, yet he suffered in another way, his custom being diminished to an undetermined extent by goods being sold as his, so as to compete with those really of his make (*a*).

Equity—*Blanchard* v. *Hill*.

The first recorded case of trade mark brought before the judicial notice of the Court of Chancery was that of *Blanchard* v. *Hill* (*b*), in 1742, which, however, resulted in a statement by Lord Hardwicke, C., that he did not know "any instance of granting an injunction in Chancery to restrain one trader from using the same mark with another," and that he thought "it would be of mischievous consequence to do it."

Growth of jurisdiction of Chancery.

In *Day* v. *Day* (1816) (*c*), *Henry* v. *Price* (1831) (*d*), and *Gout* v. *Aleploglu* (1833) (*e*), however, injunctions were granted to restrain the infringement of the plaintiffs' trade marks, and from this time the steadily increasing number of such cases coming before the Court of Chancery shows the growing favour with which that Court was regarded by suitors, the chief incentive no doubt being

(*a*) See per Erskine, J., in *Morison* v. *Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385; and per Wilde, C. J., in *Rodgers* v. *Nowill*, 5 C. B. 109; also *Coffeen* v. *Brunton*, 4 McLean, 516, R. Cox, 82; *Lemoine* v. *Ganton*, 2 E. D. Smith, 343, R. Cox, 142; *Chappell* v. *Davidson*, 2 K. & J. 123; *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-42-51-54; *Lawrie* v. *Baker*, 2 P. R. 213; and *Boudier* v. *Depatie*; 3 Dorion 233.

(*b*) 2 Atk. 484.

(*c*) Dig. 21.

(*d*) 1 Leg. Obs. 364.

(*e*) 5 *ib.* 495, and 6 Beav. 69; and see *Day* v. *Binning*, C. P. Cooper, 489, 1 Leg. Obs. 205.

the more beneficial character of the remedy awarded, by injunction and account, as compared with the Common Law remedy of damages. By degrees the Court of Chancery absorbed the jurisdiction in trade-mark cases, until such cases were rarely if ever tried in the Common Law Courts, except when they were remitted by a Chancery judge for trial of the Common Law right. That practice was discontinued in consequence of Sir John Rolt's Act (*a*), and the effect was, notwithstanding the extended power given to the Common Law Courts by the Merchandise Marks Act of the same year (*b*), to confine the consideration of this class of cases more strictly, if possible, than before to the Court of Chancery.

Registration Acts administered by Chancery Division.

This fact was recognised by the Chancery Division being appointed to administer the Trade Marks Registration Acts (*c*), and although the High Court of Justice generally is now substituted for the Chancery Division (*d*), trade-mark cases are still usually brought before that Division.

Board of Trade.

The comptroller appointed under the Patents Act is, however, subject to the superintendence of the Board of Trade, who will, it may be assumed, refer all cases of difficulty, whether arising from questionable applications or from oppositions persisted in, to the Court (*e*).

Principles adopted in Equity with respect to trade marks.

The principles on which the Courts of Equity have long acted in cases where a valid trade mark has been affixed to the goods or to wrappers or vessels containing them—principles by which those cases must, as it seems, be governed for the future, before whichever branch of the

(*a*) 25 & 26 Vict. c. 27. But in some of the American Courts cases of doubtful right are still sent for trial at law; *e.g.*, *Seltzer* v. *Powell*, 8 Phila. 296.

(*b*) 25 & 26 Vict. c. 88, § 21.

(*c*) 38 & 39 Vict. c. 91; 39 & 40 Vict. c. 33; and 40 & 41 Vict. c. 37. See the old Rule 42, and *In re Orr-Ewing* (2), 28 W. R. 412.

(*d*) § 117 of Patents Act, 1883.

(*e*) *In re Normal Co., Ld.*, 35 Ch. D. 231. And see Patents Acts, 1883-8, §§ 62, 69. As to the position of the late Commissioners of Patents, whose functions are now transferred to the Board of Trade, see *In re Meikle*, 24 W. R. 1067; *In re Barrows*, 5 Ch. D. 353; *In re Rotherham*, 14 *ib.* 585.

High Court of Justice they may come (*a*)—are thus explained by Sir G. Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson (b)*.

"It is quite immaterial that the maker of the goods to which what I will call, for the sake of shortness, the trade mark is affixed, did not know that it was a trade mark, and had not the slightest intention of defrauding anybody. He must not put as a mark on goods, even though he intends to establish it as his own trade mark, that which is the known trade mark of other people, and he would be restrained by injunction, though he thought he himself had invented the trade mark, and *bonâ fide* intended it to designate goods of his own manufacture. And the reason is obvious: because the goods pass from hand to hand, and though he may act with the utmost *bona fides*, yet the ultimate purchasers might believe that they were the real goods, that is to say, that they were manufactured by the person entitled to the original trade mark. Therefore, in that case, knowledge that he is doing anything wrong is immaterial, even in the maker.

"Another element which is sometimes imported into these cases has also no material bearing: that is, that if the maker knows that they are not the goods of the person entitled to use the trade mark, and communicates that knowledge to the immediate purchaser, it makes, as I have said, no difference; and even if he does not know it, and tells the immediate purchaser that the goods are of his own manufacture, it will still not save him from an injunction, because, although the immediate purchaser from him is aware that the goods in question are not manufactured by any other person than the vendor, yet, as he passes them on, the representation does not necessarily pass on with them, and therefore the next purchaser, or the following or some other purchaser, or the public at large, who are the ultimate purchasers, would be as much deceived as if

(*a*) See Judicature Act of 1873, § 25. (*b*) 2 Ch. D. 434.

no such communication took place. Consequently, you have nothing more to do than to show that the trade mark has been taken" (*a*).

At first Equity followed the Common Law.

When trade-mark cases were first brought into the Court of Chancery, they were treated on the same principle as they were at Common Law, and redress was refused where actual intentional fraud was not alleged and substantiated. The existence of anything that could be called a right of property in a trade mark was denied, and a fear expressed that, if that should be admitted, a stronger monopoly than even a patent-right would be created (*b*).

Millington v. *Fox.*

In the year 1838, however, when the case of *Millington* v. *Fox* (*c*) came before Lord Cottenham, C., the Lord Chancellor perceived that when goods made by one man were put upon the market bearing the trade mark of another, the same evil effects were produced, whether the mark was so affixed for fraudulent purposes or with innocent intentions, since purchasers would buy A's goods in the belief that they were B's, and B would be deprived of the custom intended for him; so that A, whether by his own contrivance or not, would profit at the expense of B and the public. In that case it was accordingly held by the Lord Chancellor that the plaintiffs were entitled to an injunction, although he stated in express terms that

(*a*) And see per Lord Cairns, C., *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 391, and Lord O'Hagan, *ib.* 396; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454. So, in Scotland, "on an application for an interdict it is not only not necessary to prove any pecuniary damage, but it is not necessary to prove that any injury has been actually inflicted. A threat of injury is a sufficient ground for an application for an interdict; and in like manner a reasonable apprehension of injury from the proceedings of the parties complained against is also in many circumstances a very good ground for such an application." (Per the Lord President, in *Singer Manufacturing Co.* v. *Kimball & Morton*, Ct. Sess. Cas. 3rd Ser. XI., 267.) And in India "it is not enough to say that there was no fraudulent intention. That is no reason why an injunction should not be granted." (Per Phear, J., *Graham & Co.* v. *Kerr, Dods & Co.*, 3 Beng. L. R. App. 4.)

(*b*) *Blanchard* v. *Hill*, 2 Atk. 484; *Canham* v. *Jones*, 2 V. & B. 218.

(*c*) 3 My. & Cr. 338; and see the earlier case of *Gout* v. *Aleploglu*, 5 Leg. Obs. 495.

he saw no reason for thinking that there had been any fraudulent user by the defendant of the plaintiffs' mark (*a*).

Question as to foundation of jurisdiction.

The decision in this case gave rise to some difference of opinion among the judges, some holding that the jurisdiction of the Court of Chancery in these cases, like that of the Common Law Courts, was founded on intentional fraud, and denying any exclusive right in trade marks (*b*), while others held that, intentional fraud not being necessary for the injunction, the jurisdiction must be held to be founded on the protection of a right of property in the trade mark (*c*).

(*a*) See per Lord Blackburn in *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15.

(*b*) *Perry* v. *Truefitt*, 6 Beav. 66; *Croft* v. *Day*, 7 Beav. 84; *Foot* v. *Lea*, 13 Ir. Eq. 484; *Edelsten* v. *Vick*, 11 Hare, 78; *Collins Co.* v. *Brown*, 3 K. & J. 423; *Collins Co.* v. *Cowen*, 3 K. & J. 428; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; *McAndrew* v. *Bassett*, 33 L. J. Ch. 561; *Walton* v. *Crowley*, 3 Bl. C. C. 440, R. Cox, 166.

(*c*) *Farina* v. *Silverlock*, 6 De G. M. & G. 214; *Burgess* v. *Hills*, 26 Beav. 244; *Clement* v. *Maddick*, 1 Giff. 98; *Emperor of Austria* v. *Day*, 3 De G. F. & J. 217; *Welch* v. *Knott*, 4 K. & J. 747; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Hall* v. *Barrows*, 4 *ib.* 150; *McAndrew* v. *Bassett*, 4 *ib.* 380; *Leather Cloth Co.'s case*, 4 *ib.* 137; 11 H. L. C. 523; *Cartier* v. *Carlile*, 31 Beav. 292; *Moet* v. *Couston*, 33 *ib.* 578; *Barnett* v. *Leuchars*, 13 L. T. N. S. 495; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Collins Co.* v. *Reeves*, 28 L. J. Ch. 56; *Bradbury* v. *Beeton*, 39 *ib.* 57; *Rudde* v. *Norman*, L. R. 14 Eq. 348; *Hirst* v. *Denham*, *ib.* 542; *Smith* v. *Mason*, W. N. 1875, p. 62; *Apollinaris Co.* v. *Norrish*, 33 L. T. N. S. 242; *Cheavin* v. *Walker*, 5 Ch. D. 850; *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376; *Same* v. *Loog* (3), 8 *ib.* 15; *Grillon* v. *Guénin*, W. N. 1877, p. 14; *Ransome* v. *Graham*, 51 L. J. Ch. 897; *Cowen* v. *Hulton*, 46 L. T. N. S. 897; *Hatchard* v. *Mège*, 18 Q. B. D. 771; *Oakey & Sons* v. *Dalton*, 35 Ch. D. 700. So in Scotland—*Singer Manufacturing Co.* v. *Kimball & Morton*, Ct. Sess. Cas. 3rd Ser. XI., 267; in Ireland—*Kinahan* v. *Bolton*, 15 Ir. Ch. 75; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; in India—*Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185; in Canada—*Walker* v. *Alley*, 13 Grant, Up. Can. Ch. 366; in the United States—*Davis* v. *Kendall*, 2 R. I. 566, R. Cox, 112; *Clark* v. *Clark*, 25 Barb. 76, R. Cox, 206; *Dale* v. *Smithson*, 12 Abb. Pr. 237, R. Cox, 282; *Woodward* v. *Lazar*, 21 Cal. 448, R. Cox, 300; *Derringer* v. *Plate*, 29 Cal. 292, R. Cox, 324; *Bradley* v. *Norton*, 33 Conn. 157, R. Cox, 331; *Gillott* v. *Esterbrook*, 47 Barb. 455, R. Cox, 340; 48 N. Y. 374; *Burnett* v. *Phalon*, 9 Bos. 192, R. Cox, 376; *Filley* v. *Fassett*, 44 Mo. 173, R. Cox, 530; *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews. 321, R. Cox, 559; *Stonebraker* v. *Stonebraker*, 33 Md. 252; *State of Missouri* v. *Gibbs*, 56 Mo. 133; *Winsor* v. *Clyde*, 9 Phila. 513; *Blackwell* v. *Armistead*, 5 Am. L. T. 85; *Colman* v. *Crump*, 70 N. Y.

Deference to Common Law.

In *Motley* v. *Downman* (*a*) it was laid down broadly that the jurisdiction of the Court of Chancery was merely ancillary to that of the Common Law, and that the right to redress must be determined by the rules of the Common Law; and accordingly cases were frequently referred to the Common Law Courts for the determination of the right, before the equitable remedy was awarded (*b*). That practice, however, gradually died out as the principle of interference in the absence of intentional fraud came to be recognised, and Sir John Rolt's Act (*c*) finally put an end to it.

Principle of *Millington* v. *Fox* explained by V.-C. Wood.

The explanation given by Wood, V.-C., of the decision in *Millington* v. *Fox* (*d*) and other cases in which relief was given without proof of fraudulent user, was, that it was on the principle "that although a person had used another man's trade mark perfectly innocently, yet if he continued for one moment after he had been told of it to use another man's trade mark, he did so fraudulently, and if he sought to keep in his pocket profits which he had made by representing, however innocently, that his goods were another person's, after he had been told of the fact, it was fraud" (*e*).

By Lord Westbury.

From this view Lord Westbury, C., dissented (*f*), and the view now generally accepted as to the principles governing the action of the Courts of Equity was thus stated by him, in the *Leather Cloth Co.s' case* (*g*): "The representation

573; *Rillet* v. *Carlier*, 61 Barb. S. C. 435; *Gilman* v. *Hunnewell*, 122 Mass. 139; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Kidd* v. *Johnson*, 100 *ib.* 617; *Robertson* v. *Berry*, 50 Md. 591.

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

(*b*) *Perry* v. *Truefitt*, 6 Beav. 66; *Rodgers* v. *Nowill*, 6 Hare, 325; *Foot* v. *Lea*, 13 Ir. Eq. 484; *Farina* v. *Silverlock*, 1 K. & J. 509; and others. In some of the American States, *e.g.*, in Pennsylvania, the same practice is still followed: *Seltzer* v. *Powell*, 8 Phila. 256.

(*c*) 25 & 26 Vict. c. 27.

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

(*e*) *McAndrew* v. *Bassett*, 33 L. J. Ch. 561. See per Lord Cairns, in *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376-91, and per Lord Blackburn in that case (*ib.* 400), and in *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15.

(*f*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Leather Cloth Co.s' case*, 4 *ib.* 137; *Hall* v. *Barrows*, *ib.* 150; *McAndrew* v. *Bassett*, *ib.* 380.

(*g*) 4 De G. J. & S. 137.

which the defendant is supposed to make, that his goods are the goods of another person, is not actually made otherwise than by his appropriating and using the trade mark which such other person has an exclusive right to use in connection with the sale of some commodity; and if the plaintiff has an exclusive right to use any particular mark or symbol, it becomes his property for the purposes of such application, and the act of the defendant is a violation of such right of property, corresponding with the piracy of copyright or the infringement of a patent. I cannot therefore assent to the dictum that there is no property in a trade mark. It is correct to say that there is no exclusive ownership of the symbols which constitute a trade mark, apart from the use or application of them; but the word 'trade-mark' is the designation of marks or symbols when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called 'property.'—The true principle, therefore, seems to be that the jurisdiction of the Court in the protection given to trade marks rests upon property; and that the Court interferes by injunction, because that is the only mode by which such property can be effectually protected. The same things are necessary to constitute a title to relief in Equity in the case of the infringement of the right to a trade mark as in the case of the violation of any other kind of property. First, the plaintiff must prove that he has an exclusive right to use some particular mark or symbol in connection with some manufacture or vendible commodity; and, secondly, that this mark or symbol has been adopted or is used by the defendant so as to prejudice the plaintiff's custom and injure him in his trade or business" (*a*).

(*a*) In *Walker* v. *Alley*, 13 Grant, Up. Can. Ch. 366, Van Koughnet, Chancellor of Upper Canada, said: "Some difficulty may be created by the use of the word 'property' in trade marks. It may be said, 'What is property, unless it be something tangible?' I take property, when used in this connection and sense, to be a means by which

In what sense fraud is required in Equity.

Still, even though it be admitted that the Law of Trade Marks is based upon a right of property, fraud also is necessary to entitle the owner of the trade mark to redress (*a*). But the fraud does not consist in an intention to deceive on the part of the defendant, but in an actual deception, or in the creation of a probability of deception (*b*), independently of any fraudulent intention. "Imposition on the public," says Lord Westbury (*c*), "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 not likely to be mistaken, by the public for the mark of the plaintiff. But the true ground of the Court's jurisdiction is property."

Intention immaterial in Equity.

The exact language in which the principle on which the Court of Chancery has acted is to be described is really immaterial, and in fact "merely a question of nomenclature" (*d*), since the important and substantial point is completely established, that in cases of trade mark nothing more has to be done "than to show that the trade mark has been taken" (*e*).

Right of property in registered mark.

The right in a trade mark registered under the Trade Marks Acts or the present Patents Acts is strictly a right of property (*f*); the person entitled to it is the proprietor (*g*);

money or money's worth, in the shape of profit or otherwise, is created or obtained."

(*a*) See per Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-53.

(*b*) Compare per Hall, V.-C., in *Cope* v. *Evans*, L. R. 18 Eq. 138. And see *Kinney* v. *Basch*, Dig. 542; *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371.

(*c*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; and see per Lord Cranworth, C., in *Farina* v. *Silverlock*, 6 De G. M. & G. 214, and per Jessel, M. R., in *Chearin* v. *Walker* 5 Ch. D. 850. So in the Supreme Court of Pennsylvania, *Pratt's Appeal*, 117 Penn. St. 401.

(*d*) Per Wood, V.-C., *McAndrew* v. *Bassett*, 33 L. J. Ch. 561.

(*e*) Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434; and see *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434, and the cases collected at note (*c*) on p. 183, *suprà*.

(*f*) See *Eno* v. *Stephens*, Dig. 609.

(*g*) §§ 3, 4, 5 of the Act of 1875; §§ 62, 66, 71, 72, 76 of the Act of 1883.

he is entitled to the exclusive use of it (*a*); and though his rights in regard to it are in some respects less unlimited than those of owners of other kinds of property—*e.g.*, the inability to transfer it except in connection with the goodwill of the business (*b*)—still, subject to the provisions of the Patents Acts, he is entitled to deal with it as he chooses.

Elements necessary to found jurisdiction.

In trade-mark cases, "in order to found the jurisdiction of the Court," says the Lord Chancellor of Ireland (*c*), "there must be established, first, the existence of the trade mark; next, the fact of an imitation, whether a direct imitation, or one with such variations that the Court must regard them as merely colourable; and, thirdly, the fact that the imitations were made without licence (*d*) or anything that the Court could regard as acquiescence in their use." The law is the same in the three kingdoms, for, said Bacon, V.-C., in *Singer Manufacturing Co.* v. *Loog* (3) (*e*), "the law of Scotland does not in this respect (*i.e.*, with respect to trade marks) differ from the law of England." The principles which govern the one govern the other.

Proceedings in Equity.

In order to ensure a full disclosure of the facts bearing upon these points, the Court will grant, if necessary, discovery and inspection (*f*), and upon the satisfactory establishment of the plaintiff's case will award its appro-

(*a*) § 3 of the Act of 1875; § 76 of the Act of 1883.

(*b*) § 2 of the Act of 1875; § 70 of the Act of 1883.

(*c*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75. See *Linde* v. *Bensel*, 29 N. Y. Sup. Ct. 601.

(*d*) It has been held in America that if the defendant is the holder of a licence from the plaintiff, he cannot contest the validity of the plaintiff's mark, but that he may set up that he was induced to enter into the agreement by fraudulent representations: *Hilsen* v. *Libby*, 44 N. Y. Super. Ct. 12. And see the observations in that case with respect to pleading.

(*e*) 18 Ch. D. 395.

(*f*) It has been held in America that a defendant is not entitled, by alleging that the plaintiff's goods possess injurious properties, to compel the plaintiff to disclose in cross-examination the ingredients of which his goods are composed, though it seems that such questions may be allowed if the plaintiff has himself led up to them. *Tetlow* v. *Savournin*, 15 Phila. 170.

priate remedy of an injunction (*a*), framed in such terms as best to counteract the illicit designs of the infringer. And the injunction will be granted, even though the defendant has ceased to use the pirated trade mark (*b*), and has offered to undertake not to use any of the old labels in stock (*c*), or has actually retired from the business in which the pirated marks were used (*d*). But if a plaintiff continues the litigation after having received an offer of all he is entitled to get, he may fail to obtain his costs (*e*). The liability to account for profits is usually, as Romilly, M. R., said in *Cartier* v. *Carlile* (*f*), incident to the injunction (*g*), or the plaintiff may, at his option, have an inquiry as to damages in lieu of the account, but not both (*h*). The Court will further, where necessary, order the delivery up and destruction of the spurious labels, cards, or tickets (*i*), or the production of the goods wrongfully marked, for the purpose of the erasure and cancellation of the spurious marks (*k*). Destruction of the goods will not be ordered if it is possible without destruction to satisfactorily erase the spurious marks (*l*). In a case in the Supreme Court of

(*a*) In *Glen & Hall Manufacturing Co.* v. *Hall*, 61 N. Y. 226, a case of the class analogous to trade-mark cases, an injunction was granted against the original plaintiffs, on counter-claim. The injunction will be granted, notwithstanding an offer of submission by the defendants: *Geary* v. *Norton*, 1 De G. & Sm. 9; *Tonge* v. *Ward*, 21 L. T. N. S. 480.

(*b*) *Guinness* v. *Heap*, Dig. 617; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Frese* v. *Bachof* (1), 13 Bl. C. C. 234; and see *Reid* v. *Sibbald*, 18 Journ. of Jurisp. 392.

(*c*) *Guinness* v. *Heap*, Dig. 617.

(*d*) *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178.

(*e*) See *infrà*, p. 264.

(*f*) 31 Beav. 292.

(*g*) Unless the defendant can prove that he has bought and resold the improperly marked goods without being aware of the true ownership of the trade mark which he is shown to have infringed: *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Moet* v. *Couston*, 33 Beav. 578.

(*h*) *Neilson* v. *Betts*, L. R. 5 H. L. 1. See *Leidersdorf* v. *Flint* (2), 50 Wisc. 401.

(*i*) *Farina* v. *Silverlock*, 1 K. & J. 509, 6 De G. M. & G. 214, 4 K. & J. 650; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Apollinaris Co.* v. *Edwards*, Seton, 4th ed. 237; *Graveley* v. *Winchester*, *ib.* 257.

(*k*) *Dent* v. *Turpin*, 2 J. & H. 139; *Upmann* v. *Elkan*, L. R. 12 Eq. 140, L. R. 7 Ch. 130; *Jurgensen* v. *Alexander*, 24 How. Pr. 269; R. Cox, 298. In *Meriden Britannia Co.* v. *Parker*, 39 Conn. 450, 12 Amer. Rep. 401, it was held that goods already stamped might be sold, subject to the remedy at law.

(*l*) *Slazenger & Sons* v. *Feltham & Co.*, 6 P. R. 531.

Victoria (*a*) it was held that an agent, who had received from a foreign principal goods marked in imitation of the plaintiff's trade mark, could not be allowed to send back to his principal the goods as they were, since it was the plaintiff's right to have the fraudulent labels removed and destroyed.

Consideration shown for innocent infringer.

While, however, the Court will give protection where it is required, "it must not be forgotten that such protection by injunction when granted is, or may be, attended with loss to the defendant in rendering useless or depreciating in value articles to which the trade mark has already been affixed, and in compelling him otherwise to vary the mode in which he has been carrying on business" (*b*). And it has been thought that where it is proved that a defendant has adopted a trade mark in *bonâ-fide* ignorance of its infringing the plaintiff's rights, the Court will be satisfied with the least amount of alteration of the defendant's mark which will effectually distinguish it from the plaintiff's (*c*).

But innocent infringement checked.

Sufficient distinction must, however, be made; and in the even harder case, where a man has not affixed the spurious mark to his own goods at all, but has bought goods already stamped with a mark which he did not know to belong to any one, he must submit to an injunction, though he may not have to account for profits if he does not delay his submission (*d*). Where, however, A has, without notice of fraud, advanced money on goods fraudulently marked, he will not be prevented from asserting his rights by reason of the illicit mark (*e*).

Foreign fraudulent samples.

Although there is no jurisdiction in the English Courts

(*a*) *Siegert* v. *Lawrence*, 11 Vict. L. R. 47. And in New South Wales it was said that matches packed in boxes fraudulently labelled should be repacked before exposure for sale: *Bryant & May* v. *Heyde*, 7 N. S. W. Rep. (E.) 72. See *Upmann* v. *Elkan*, L. R. 7 Ch. 130.

(*b*) *Cope* v. *Evans*, L. R. 18 Eq. 138; and see *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298; *Bass* v. *Dawber*, 19 *ib.* 626; *Ransome* v. *Graham*, 51 L. J. Ch. 897.

(*c*) *Bass* v. *Dawber*, 19 L. T. N. S. 626.

(*d*) *Moet* v. *Couston*, 33 Beav. 578; *Orr-Ewing* v. *Chooneeloll Mullick*, Cor. 150.

(*e*) *Ponsardin* v. *Peto*, 33 Beav. 642. See *Rudderow* v. *Huntington*, 3 Sand. S. C. 252, R. Cox, 106.

to try a case in which a foreign subject has sent direct to another foreign country, or to a British colony or dependency, goods bearing an infringement of a trade mark used by a British firm in their trade with such country, colony or dependency, yet, if the spurious goods or samples of them have been sold in the United Kingdom, an action will lie (*a*).

Issue of writ for service in Scotland or Ireland.

In *Marshall* v. *Marshall* (*b*) there was an application by a person carrying on business in Scotland for leave to issue and serve out of the jurisdiction (viz. in Scotland) a writ in an action intended to be brought by him against another person carrying on business in Scotland, for selling his goods in England under a trade mark calculated to deceive, the object being that the action might be heard together with an application for registration of the trade mark by the defendant, which was opposed by the plaintiff; but leave was refused, on the ground that it was expedient that proceedings should be taken in Scotland, where the order of the Court could be enforced against the defendant personally, rather than in England, where it could only be enforced against his servants and agents. And similarly in *Kiahaan* v. *Kinahan* (*c*), where both parties were Irish. However, in *Burland & Co.* v. *Broxburn Oil Co., Ld.* (*d*), where a similar application was made by an English firm, who were desirous of taking proceedings against a Scotch company, who had their registered office in Glasgow, but had branch offices also in London, Manchester and Hull, and whom the plaintiffs alleged to have been infringing their trade mark by sending out marked goods from their English branches, and the defendants were applying in England to rectify the plaintiffs' registration, it was held that it was possible to effectually enforce in England against the property of the defendants any injunction that might be granted, and that, on the balance of convenience, leave should be given.

(*a*) *Rodgers & Sons, Ld.* v. *Rottgen*, 5 Times L. R. 678.
(*b*) 38 Ch. D. 330.
(*c*) 34 Sol. J. 473.
(*d*) 41 Ch. D. 542.

Scandal and inpertinence.

In asking for his remedy a plaintiff must not make scandalous and impertinent charges against the defendant. Where such charges were made exceptions for scandal and impertinence were allowed (*a*), and under the present practice the defendant would succeed on a motion to strike out such statements, under Order XIX., Rule 27.

Trial without a jury appropriate.

The appropriate mode of trial of cases in which, as in most trade-mark cases, law and fact are closely united, is by a judge without a jury; and therefore, where a defendant gave notice of trial of a trade-mark case before a judge and special jury, it was held that, notwithstanding the notice, the case must be heard without a jury (*b*). If the defendant allows the action to proceed to trial without applying for the questions at issue to be submitted to a jury, it will be too late for him to make such an application when the case comes on for trial (*c*). But where the defendants submitted to a perpetual injunction, leaving only the question of damages to be tried, the action was, on the plaintiffs' application, transferred to the Queen's Bench Division for trial with a jury (*d*).

Interlocutory injunction.

It is usual for the plaintiff in trade-mark cases to apply for an interlocutory injunction at an early period. When such an application is to be made, it is the duty of the plaintiff to make it speedily (*e*), and delay on his part in coming to the Court is liable to be construed as signifying that the case is one which he does not consider to be of an urgent nature, and which therefore does not deserve the special favour of the Court (*f*). The plaintiff is, however, entitled to delay long enough to secure the necessary

(*a*) *Christie* v. *Christie*, L. R. 8 Ch. 499.

(*b*) *Spratt's Patent* v. *Ward & Co.*, 11 Ch. D. 240; *Singer Manufacturing Co.* v. *Loog* (2), *ib.* 656.

(*c*) *Thomas* v. *Williams*, 14 Ch. D. 864.

(*d*) *Fennessy* v. *Rabbits & Sons*, 56 L. T. N. S. 138.

(*e*) Per Romilly, M. R., in *Chubb* v. *Griffiths*, 35 Beav. 127.

(*f*) *Pickford* v. *Grand Junction Railway Co.*, 3 Railway Cas. 538; *Flavel* v. *Harrison*, 10 Hare, 467; *Isaacson* v. *Thompson*, 20 W. R. 196; *Mallan* v. *Davis*, 3 Times L. R. 221; *Evans* v. *Smith*, *ib.* 390.

evidence to establish his case (*a*); and although no interlocutory injunction is asked for—as, for instance, where it is rendered unnecessary by reason of the defendant having discontinued the acts of which the plaintiff is complaining—the plaintiff is not precluded from his right to a perpetual injunction, if in other respects he has such a right (*b*), nor from his right to state, if true, that the defendant is acting without authority in what he is doing (*c*).

When granted.

In the older cases (*d*), the tendency of the Court was to refuse to grant an injunction on an interlocutory application, unless the clearest evidence of the plaintiff's right was producible, but rather to send that right to be tested at Common Law. That course of proceeding being now extinct (*e*), some relaxation has taken place, and, in particular, where there is reason to suspect intentional deceit on the part of the defendant, much less absolute proof of the plaintiff's title is required (*f*); and it occasionally happens that after an interlocutory injunction has been granted, it is held at the hearing that the evidence is insufficient to justify any relief being given (*g*). The interlocutory injunction will, however, not be granted where the defendant has innocently infringed, and has withdrawn the offending articles from sale and offered an undertaking

(*a*) *Lee* v. *Haley*, L. R. 5 Ch. 155; *Cave* v. *Myers*, Dig. 304.

(*b*) *Collins Co.* v. *Walker*, 7 W. R. 222.

(*c*) *Anderson* v. *Liebig's Extract of Meat Co., Ld.*, 45 L. T. N. S. 757.

(*d*) *E.g.*, *Spottiswoode* v. *Clarke*, 2 Ph. 154; *Stevens* v. *Keating*, 2 Ph. 333; *Motley* v. *Downman*, 3 My. & Cr. 1; *Merrimack Manufacturing Co.* v. *Garner*, 2 Abb. Pr. 318.

(*e*) Since Sir John Rolt's Act, 25 & 26 Vict. c. 27.

(*f*) *Radde* v. *Norman*, L. R. 14 Eq. 348. It has been held in America that a defendant, who demurs on the ground that the two marks are so different as to negative the probability of deception, will be held to admit for the purposes of the demurrer any charges of fraud in the plaintiff's pleadings, and that an injunction will therefore be granted against him: *Enoch Morgan's Sons' Co.* v. *Hunkele*, 16 U. S. Pat. Gaz. 1092. And if a defendant's defence and counter-claim contain any allegations of fact which the plaintiff does not desire to admit, he must deal specially with them: *Benbow* v. *Low* (2), 13 Ch. D. 553.

(*g*) *E.g.*, in *Degraves* v. *Whiteman*, 5 Vict. L. R. Eq. 304.

immediately on being served with the writ (*a*), nor where there is any considerable conflict (*b*), nor where the plaintiff has been guilty of delay (*c*); and if it is granted the plaintiff will be required to give an undertaking as to damages (*d*).

Where application for registration pending.

Where, on the plaintiff moving for an injunction to restrain an alleged infringement of a trade mark registered in 1886, it appeared that the defendant had used the mark since 1884, and was himself then applying for registration thereof, the motion was ordered to stand over generally in order that the question of the defendant's right to registration might be first decided (*e*).

Liberty given to move to dissolve.

Where an injunction was granted on motion, but the defendant alleged that he had not had sufficient time to answer the affidavits on the other side, Lord Langdale, M. R., directed that the order should be prefaced by a statement to that effect, and giving the defendant leave to move to dissolve the injunction (*f*).

(*a*) *Caruncho* v. *Highmoor*, 27 Sol. J. 199.

(*b*) *Green* v. *Rooke*, W. N. 1872, p. 49, L. J. N. of C., 1872, p. 54; *Farina* v. *Cathery*, L. J. N. of C., 1867, p. 134; *Hennessy* v. *Rohmann*, 36 L. T. N. S. 51; *Mitchell* v. *Henry*, 15 Ch. D. 181; *American Grocer Publishing Association* v. *Grocer Publishing Co.*, 51 How. Pr. 402; *Witthaus* v. *Braun*, 44 Md. 303; *Leclanche Battery Co.* v. *Western Electric Co.*, 21 Fed. Rep. 538; *Goodyear Rubber Co.* v. *Day*, 22 Fed. Rep. 44; and other cases. If an interlocutory injunction is asked for on the ground that the defendant claims a right to use the plaintiff's trade mark, but there is evidence that he is not in fact using the mark or threatening an immediate exercise of his alleged right of user, the motion will be ordered to stand to the hearing, as in *Linoleum Manufacturing Co.* v. *Nairn*, Dig. 536, or refused, with costs, as in *Davis* v. *Tylor*, M. R., July 27th, 1877 ("*Ferndale*" *coal*).

(*c*) *Isaacson* v. *Thompson*, 41 L. J. Ch. 101; *Chinn* v. *Thomas*, 5 Vict. L. R. Eq. 188. In the Scotch case of *Green* v. *Shepherd*, Ct. of Sess. Cas., 3rd Ser., IV. 1028, the plaintiff having by his summons asked for damages and an interdict, the Court refused a motion for an interim interdict, on the ground that the summons was framed on the footing that there was no case for an interim interdict, and that the plaintiff must first establish his right by recovering damages.

(*d*) In *Actien Gesellschaft Apollinaris Brunnen* v. *Somborn*, 14 Bl. C. C. 380, an American case, a bond was given to secure the possible damages.

(*e*) *Edwards* v. *Elkan*, 5 P. R. 70.

(*f*) *Holloway* v. *Holloway*, 13 Beav. 209.

Submission not relieved against.

In *Elsas* v. *Williams* (*a*) the defendant having consented, on the hearing of a motion for injunction, to submit to a perpetual injunction to restrain him from infringing a trade mark for buttons, a subsequent application by him, before the order was drawn up, to be relieved from his consent, on the ground that his German manufacturers had sold buttons bearing the mark in England before the plaintiff had done so, was refused, on the ground that there had not been such a mistake as to entitle the defendant to be relieved.

Stay of proceedings after submission.

Where an action was brought to restrain the use of the word "Diamond" and a diamond-shaped device, and the defendant consented, on motion, to a perpetual injunction as to the word, and subsequently, after the plaintiff had delivered his statement of claim, to a perpetual injunction as to the device, and the plaintiff waived damages or an account, it was ordered, on the defendant's motion, that, the defendant submitting and paying costs, further proceedings should be stayed, except for the purpose of enforcing the order (*b*).

Form of injunction.

The injunction may be granted in such a form as to restrain the imitation of the general style of the plaintiff's mark, while not interfering with the use of particular features (*c*), or, if granted so as to restrain the use of particular features, it may be limited so as not to interfere with the use of them absolutely and in all events (*d*); or, again, it may be granted in such terms as to restrain any imitation of a composite mark as a whole, or of any of the elements of which it is composed (*e*).

(*a*) 54 L. J. Ch. 336.

(*b*) *Curtis & Harvey* v. *Pape*, 5 P. R. 146.

(*c*) *Compagnie Laferme* v. *Hendrickx*, Dig. 512; *Wolfe* v. *Hart*, 4 Vict. L. R. Eq. 125; *Wolfe* v. *Alsop* (2), 12 Vict. L. R. (E.) 421.

(*d*) *Ford* v. *Foster*, L. R. 7 Ch. 611; *Braham* v. *Beachim* (1), 7 Ch. D. 848; *Siegert* v. *Findlater*, 7 Ch. D. 801; *Massam* v. *Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Dence* v. *Mason* (1), Dig. 534; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Whitstable (Free Fishers & Dredgers of)* v. *Elliott*, W. N. 1888, p. 27; *Hill* v. *Lockwood*, 32 Fed. Rep. 389.

(*e*) See *India Rubber Comb Co.* v. *Rubber Comb and Jewelry Co.*, 45 N. Y. Super. Ct. 258.

Appeal.

In the case of an appeal delay is no less fatal than in the proceedings in the Court below (*a*); but no appeal ought to be brought from a refusal to grant an interlocutory injunction if the defendant, while refusing to submit to an injunction or to give an undertaking, removes the cause of complaint (*b*). Where an injunction had been granted to restrain the sale by the defendant of "The Original Lazenby's Harvey's Sauce," an appeal against the decision was ordered to be advanced, on the ground of the irreparable damage the continuance of the injunction would occasion (*c*). It seems that when the Court of Appeal has overruled a demurrer or objection on a point of law, it will not stay the further hearing of the case with the evidence until after an appeal to the House of Lords from this decision on the point of law is decided (*d*).

Committal for contempt.

Where a defendant in a trade-mark action continues to use the prohibited mark, or a mark insufficiently altered from it (*e*), after an injunction has been issued against him, he renders himself liable to committal (*f*). In order to support the motion to commit, "it should appear clearly that the ordinary mass of customers, paying that attention which persons usually do in buying the article in question,

(*a*) See per Knight-Bruce, L. J., in *Burgess* v. *Burgess*, 3 De G. M. & G. 896.

(*b*) *Dale* v. *Smith*, W. N. 1882, p. 145.

(*c*) *Lazenby* v. *White*, L. R. 6 Ch. 89.

(*d*) See *In re Palmer* (2), 22 Ch. D. 88. In that case the question was with reference to an application to strike a mark off the register.

(*e*) *Devlin* v. *Devlin*, 69 N. Y. 212.

(*f*) *Rodgers* v. *Nowill*, 3 De G. M. & G. 614; *Gillis* v. *Hall*, R. Cox, 596. On August 8th, 1877, V.-C. Malins made an order to commit the defendant in *Dence* v. *Mason* (Dig. 534), who had, notwithstanding the injunction, continued to sell goods and issue labels using the name "Brand" thus—"Frank Mason & Co.'s ('Brand's') Essence of Beef," and so on. He was discharged on December 18th, on undertaking not to use the name "Brand" until the hearing of the action (Dig. 570). In *Devlin* v. *Devlin*, 69 N. Y. 212, the Supreme Court of New York imposed a fine. In *U. S.* v. *Roche*, 1 M'Crary, 385, it was held that the declaration that the U. S. Statute of 1870 was invalid did not affect the validity of an injunction granted independently of the Act, and that an attachment must issue against a defendant who had committed breaches of the injunction.

would be easily deceived" (*a*). It was said by Lord Langdale, M. R., in *Croft* v. *Day* (*b*), that "if the defendants were willing to make a proper distinction, and the plaintiffs refused to attend to their proposal, the Court would itself determine whether the proposed distinction was sufficient." If the defendant sets up acquiescence on the part of the plaintiff, he must make out a case amounting almost to such a licence as to entitle him to proceed against other infringers—such acquiescence, in fact, as to create a new right in him; and in default of such a licence, the order for committal will be made, unless the defendant satisfies the Court of his intention to use a trade mark which will not interfere with the plaintiff's rights (*c*). Where the contempt committed has not been gross, it is usual not to make an actual order for committal, but only to order the person in contempt to pay the costs of the motion for committal: *e.g.*, where an auctioneer, in contempt of an injunction, offered for sale "Vanity Fair" cigarettes, supposing the notice of motion served on him not to be properly authenticated, but did not actually effect any sale, V.-C. Malins made no order for committal, on his apologising, submitting to the injunction, and paying all the costs (*d*). But a defendant can only be ordered to pay the costs of a motion for committal, if his conduct has been such that a committal might

(*a*) *Swift* v. *Dey*, 27 N. Y. Super. Ct. 611, R. Cox, 319-24; and see per Lord Langdale, M. R., in *Croft* v. *Day*, 28 Leg. Obs. 378. In *Braham* v. *Beachim* (1), 7 Ch. D. 848, an injunction was granted to restrain the defendants from calling themselves "The Radstock Colliery Proprietors," or saying that they were the proprietors of collieries at Radstock; and it was afterwards held (*Braham* v. *Beachim* (2), Dig. 633) that the defendants had committed no breach of the injunction by styling themselves "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset." In *Dence* v. *Brand*, W. N. 1881, p. 31, it was held that the defendant had not committed a breach of an injunction restraining him from representing that he was the original inventor of essence of beef by stating that he was the original manufacturer of that article.

(*b*) 28 Leg. Obs. 378.

(*c*) *Rodgers* v. *Nowill*, 3 De G. M. & G. 614.

(*d*) *Marcovitch* v. *Bramble, Wilkins & Co.*, Dig. 595.

have been ordered (*a*). Where an injunction had been granted to restrain the infringement of a mark on cotton, in which a conspicuous feature consisted of a cross, from which the cotton had become known as "Cross Cotton," and the defendant adopted an altered label, containing the words "Cross Cotton," and otherwise calculated to deceive, Wood, V.-C., refused to order a committal, on the ground that the defendant had ingeniously avoided committing a breach of the injunction, and that the plaintiff had delayed to enforce his right for fifteen months; but he enlarged the terms of the injunction so as to effectually put a stop to the new fraud, and ordered the defendant to pay all the costs (*b*). Sometimes an application is made to commit the editor or publisher of a newspaper on the ground that he has published something prejudicial to the fair trial of a pending action for infringement; but such a motion in *Singer Manufacturing Co.* v. *Loog* (*c*), based on a newspaper paragraph stating that further proceedings would be taken on the conclusion of the action, was refused, on the ground that the paragraph would have no influence on the trial of the action.

Revivor.

An action to restrain the infringement of a trade mark is an action to protect property, and if the plaintiff dies, his representatives are entitled to continue it (*d*). On the other hand, when an injunction had been granted, without opposition by the defendant, the Superior Court of New York refused a motion by the defendant's administratrix to have the action continued against her, on the ground that it was not shown that the defendant had acquired any rights in the litigation, or that his estate would be prejudiced by the action not being continued (*e*).

Where two marks used.

It has sometimes happened that more marks than one have been used by a person on his goods, the infringe-

(*a*) *Dence* v. *Brand*, W. N. 1881, p. 31.
(*b*) *Cartier* v. *May*, Dig. 200.
(*c*) Dig. 635.
(*d*) *Oakey & Sons* v. *Dalton*, 35 Ch. D. 700.
(*e*) *Republic of Peru* v. *Reeves*, 40 N. Y. Super. Ct. 316.

ment of either of which would be visited by the Court with the penalties at its command. Thus, where A's soft soap was denoted, not only by a specific device, but also by the name "Excelsior," it was held that the infringement of the latter alone was punishable by the Court, the Vice-Chancellor remarking that he could not hold it to be any justification for a defendant to say that the plaintiff had two ways of identifying the goods, and he (the defendant) had only stolen one (*a*). And so in *Wheeler* v. *Johnston* (*b*), the V.-C. of Ireland said that "a man may have two, or three, or more trade marks, which he may put on his goods as he likes." But where it was shown that the goods to which a certain mark was affixed were known by a distinct name, and not by the mark, and the mark was not commonly used by the plaintiff before bill filed, the injunction was refused (*c*).

Name used with trade mark.

Moreover, the habitual use of his own name in combination with his verbal trade mark by the manufacturer of the "Eureka" shirts was held not to disentitle him to relief against defendants who had made use of the word "Eureka," though in combination with the name of their own firm (*d*). But where the name is the only distinctive part of the mark, and that is not taken, no injunction will be granted in respect of the use by the defendant of a non-distinctive part of the mark. There has, in fact, been no infringement (*e*).

(*a*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*b*) 3 L. R. Ir. 284.

(*c*) *Wilson* v. *Maxfield*, L. J. N. of C. 1875, p. 51. This was before the Trade Marks Registration Act, 1875, was passed.

(*d*) *Ford* v. *Foster*, L. R. 7 Ch. 611. So in *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57; and *Hoby* v. *Grosvenor Library Co.*, 28 W. R. 386.

(*e*) *E.g.*, it was held in Scotland that the fact that one firm called their goods "Wotherspoon's Victoria Lozenges," could not prevent another firm from styling theirs "Gray's Victoria Lozenges": *Wotherspoon* v. *Gray*, Ct. Sess. Cas., 3rd Ser., II. 38. So in the United States Patent Office, it was held that the use of the words "Pfeiffer's Egg Macaroni," before the United States Act of 1870, did not entitle the applicants to sever the mark and register the descriptive words "Egg Macaroni" alone, without the name, as having been a lawful trade mark at that time: *In re Dole Brothers*, 12 U. S. Pat. Gaz. 939.

Where, however, a manufacturing company affixed their special device to their machines, and also their name, the Master of the Rolls and Court of Appeal declined to restrain another company who manufactured similar goods bearing their own mark and name, but did not affix to them the plaintiffs' name, from using the plaintiffs' name as descriptive of the principle on which the machines were constructed (*a*); and this part of the decision was not disapproved by the House of Lords when they remitted to the Court below the question whether the name was in fact descriptive of the principle of the machines, which was afterwards decided against the plaintiffs in *Singer Manufacturing Co.* v. *Loog* (*b*).

Singer Manufacturing Co. v. *Wilson.*

Courts of Equity have sometimes had to decide somewhat nice questions as to who should be recognised as having a right to protection in equity in respect of a trade mark, such questions being usually raised by the right of the plaintiff in an action to restrain infringement being contested.

Questions of title to trade marks.

In *Motley* v. *Downman* (*c*), Lord Cottenham, C., was of opinion that a trade mark habitually applied to the iron manufactured at certain works could not be sold with the business by the tenants of the works, so as to give the purchasers an exclusive right as against the landlord of the works, or as against tenants of the works who had leased them after the purchasers of the business and trade mark had removed from those works and gone elsewhere.

Between landlord and tenant of iron works.

In another case (*d*) A, having for some time leased certain brick works, and also certain mines, from which fire-clay was taken for manufacture at the works, removed his business elsewhere, whereupon B commenced business

Successive lessees of brick works.

(*a*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434.

(*b*) 8 App. Cas. 15.

(*c*) 3 My. & Cr. 1. See *Dickson* v. *McMaster & Co.*, 18 Ir. Jur. 202; *Atlantic Milling Co.* v. *Robinson*, 20 Fed. Rep. 217.

(*d*) *Harper* v. *Pearson*, 3 L. T. N. S. 547. And see *Carmichel* v. *Latimer*, 11 R. I. 395, and *Armstrong* v. *Kleinhaus*, 1 Ky. L. Rep. 112; 82 Ky. 303.

at the brick works in question, but did not lease the same mines. A having filed a bill against B, as fraudulently representing (in effect) that the latter had succeeded to his business, Vice-Chancellor Wood, in the course of his judgment in favour of the plaintiff, took occasion to intimate that it would have been almost a matter of course to have granted an injunction to the owner of the mines of fire-clay used by A but not by B, if he had made application for it. This was, indeed, rather a case of fraudulent misrepresentation than of trade mark.

Owner and lessee of a spring.

If A is the owner of a natural spring, and B is the concessionnaire for a term of years, it seems that the name of the spring is the property of A, even though it was given to the spring by B, and that B is not entitled to sell water from another spring under the same name (*a*), nor, if his concession is limited to sales in specified countries, to interfere with the sale in those countries, under the name of the spring, of genuine water from the spring, though not imported by him (*b*).

Manufacturer and printer of cotton goods.

Where manufacturers of cotton cloths, which were afterwards printed elsewhere, sought to restrain other manufacturers who made and printed similar cloths, and marked them similarly to the goods made by the plaintiffs, it was held that the marks on the plaintiffs' goods were indicative of the printer and not of the manufacturer (*c*). And in *Wamsutta Mills* v. *Allen* (*d*) it was held that muslin manufacturers were entitled to restrain the use of a colourable imitation of their mark on shirts made from inferior muslin, which might, from the mark, have been identified with their manufacture.

Principal and agent.

Where a London tradesman, who dealt in goods supplied

(*a*) *Hill* v. *Lockwood*, 32 Fed. Rep. 389.

(*b*) *Apollinaris Co., Ld.* v. *Scherer*, 23 Bl. C. C. 459.

(*c*) *Amoskeag Manufacturing Co.* v. *Garner*, 55 Barb. 151, R. Cox, 541; and see *In re Sykes*, 43 L. T. N. S. 626. But see *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298. And compare *Goodfellow* v. *Prince*, 35 Ch. D. 9, as to the difference between manufacturer and importer.

(*d*) 12 Phila. 535.

to him by a foreign manufacturer, had invented a trade mark for those goods which stated the name of the foreign manufacturer, but made no reference to the London vendor, it was held by the Master of the Rolls that the latter could not restrain the use of the mark by a subsequent consignee of the same goods, though if the trade mark had referred to the goods having been of his selection, the case might have been different (*a*).

Manufacturer and exporter.

In another case (*b*), a combination mark, which was used on cotton goods manufactured by Ward, and consigned through Robinson, the exporting agent, to Galbraith, the merchant, at Rangoon, consisted of five separate stamps or labels, of which three had been used separately by Robinson, one (in a slightly different form) by Robinson and Galbraith, and the remaining one was used for the first time by the three on the goods which passed through the course of dealing above stated; and it was held on appeal that neither Ward nor Robinson had such an exclusive right to the combination as to be entitled to restrain the other from using it. And there are other cases in which both parties have been held to be entitled by long user to use the same mark (*c*); but for this to be so the user must have been substantial (*d*).

Exporter and merchant.

A question of a somewhat similar character arose in *In re Jones* (*e*). In that case cotton goods were habitually exported by Jones of Manchester to Manilla, for sale there on commission, through Andrews & Co., of Manchester and Manilla, one of the partners in which firm, named Rotschke, was resident at Manilla; and two trade marks

(*a*) *Hirsch* v. *Jonas*, 3 Ch. D. 584. See *Dence* v. *Mason* (1), Dig. 534; *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Thomson & Co.* v. *Robertson*, Ct. Sess. Cas, 4th Ser. XV. 880.

(*b*) *Robinson* v. *Finlay*, 9 Ch. D. 487. In this case, Bacon, V.-C., had held that the mark belonged to the exporter, and it seems that this may be so in a proper case. In *Godillot* v. *Hazard*, 81 N. Y. 263, the importer was recognised as the proprietor of the mark.

(*c*) *Day* v. *Neale*, V. C. B., May 24th, 1881; *Benbow* v. *Low* (4), 44 L. T. N. S. 875; and other cases cited at p. 188, note (*h*).

(*d*) *In re Hodson & Co.*, 26 Sol. J. 43.

(*e*) 53 L. T. N. S. 1.

were designed and used for the goods which passed through this course of trade. Each of the marks contained a representation of Andrews & Co.'s house of business in Manilla, and, besides this, one of the marks had the name "Andrews & Co.," and the other had that name and also the name "Robert Jones of Manchester" and Rotschke's crest, with a statement that it was Rotschke's trade mark. It was held by Chitty, J., and the Court of Appeal that there was no contract that, after the joint adventure came to an end, either party was to be entitled, as against the other, to use or register the trade marks, and that if there had been such a contract it could not have been enforced, since, having regard to the composition of the marks, the result would be to deceive the public.

Manufacturer and merchant.

The construction of an agreement between two parties with respect to a mark on brandy had to be determined by the Court in *In re Rivière* (*a*), in which it was held by Pearson, J., and the Court of Appeal that the true purport of the arrangement was that the mark in question, which had been used and registered by Rivière & Co., the French manufacturers, in France, before it was adopted by McDowell & Co., wine and spirit merchants, in Madras, was to be used exclusively by McDowell & Co. so long only as they took their brandy from Rivière & Co., and was only to be used by them on such brandy; and that on McDowell & Co. ceasing to take their brandy from Rivière & Co. the original right of the latter to the mark was to revive.

Shipper and shipowner.

In *Winson* v. *Clyde* (*b*), it was held that a firm who had carried on business as shippers of merchandise by ships which they did not own, but of which they had the entire management while loading and unloading, &c., and who had denominated each line of vessels used by them and plying in a particular direction by the name

(*a*) 53 L. T. N. S. 237. See *Lavergne* v. *Hooper*, Ind. L. R. 8 Mad. 149.

(*b*) 9 Phila. 513.

of "The Keystone Line for ——," had acquired a right of property in the name, and were entitled to restrain the use of the name by another firm who owned the ships employed by the former firm for a certain period on one of their lines, after the termination of the connection, the latter firm having had at best a revocable licence to use the name.

Master and servant.

A different point occurred in another case (*a*), in which, after the plaintiff company had for some two years been selling cigars of their own manufacture marked with the name "Grand Master," and paying all the expenses of the manufacture and marking, a member of the company, who was also their superintendent, registered the mark as his own, and sought to justify himself by alleging that he had invented the name, selected the tobacco for the brand of cigars, devised the shape for them, made the first ones himself, and personally affixed the first labels to the boxes; but it was held that in all these matters he had been simply acting as the servant of the company, and that the mark belonged to them.

Secret recipe.

Again, in *Cotton* v. *Gillard* (*b*), it was decided by the Master of the Rolls that a man had no right to use a trade mark applied to a sauce with the composition of which he was unacquainted, even though he had, as he believed, bought that right from the person entitled to the same; it followed that he could not prevent its use by the person acquainted with the secret, of which he had in fact been the inventor. But it has been held in America (*c*) that a person who has been accustomed to manufacture for another, in accordance with the latter's instructions, may receive an assignment of the trade mark which has been habitually used on the goods so

(*a*) *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183.

(*b*) 44 L. J. Ch. 90. Compare *Colleen* v. *Brunton*, 5 McLean, 256, R. Cox, 132; *Taylor* v. *Bemis*, 4 Biss. 406.

(*c*) *Witthaus* v. *Braun*, 44 Md. 303. See *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453.

manufactured. And it seems that where an article known by a particular name or mark has been manufactured by partners, of whom one has been acquainted with the secret of the process and the other not, the former cannot, after the dissolution of the partnership, restrain the other from using the name or mark, for the right therein of the one partner is equal to that of the other (*a*).

Registered trade marks.

With respect to registered trade marks, such difficulties can seldom arise in the future, since it is the registered proprietor who has, *primâ facie*, the exclusive right to the mark, and after five years has that right conclusively (*b*), subject only to the possibility of a rectification of the register (*c*). It is, therefore, of great importance that the registration should be effected in a form which will recognise all existing rights. Thus, in *Ex parte Hemming & Son* (*d*), in which recent occupiers of a needle mill were registering the name of the mill as their trade mark, a note was appended to the entry on the register, stating that the registered proprietors did not claim the exclusive right to the use of the name so as to prevent the owner or occupier for the time being from using the name for any legitimate purpose.

More than one proprietor.

It occasionally happens that a trade mark becomes vested in more than one person. The question then arises whether either of these is entitled to succeed in a suit against an infringer, to which the other person entitled is not a

(*a*) *Weston* v. *Ketcham* (1) and (2), 39 N. Y. Super. Ct. 54; 51 How. Pr. 455; and see *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218.

(*b*) Patents Act, 1883, § 76. In the Scotch case of *Dunnachie* v. *Young & Sons*, Ct. Sess. Cas. 4th ser. X. 874, the name "Glenboig" was used and registered by two companies trading as brickmakers on the Glenboig estate for the bricks made there, and a third firm carrying on the same business in the neighbourhood of the Glenboig estate began to use the name, alleging that it was descriptive of all bricks made of the seam of clay which ran through the Glenboig estate, and which they alleged that they were working. The Court of Session, however, decided against this contention, and granted an interdict at the suit of the two companies. See also *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas., 4th Ser., XI. 506.

(*c*) *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*d*) M. R., April 27th, 1881.

party. In a case of this description, Shadwell, V.-C., gave it as his opinion, that whether the plaintiff had the right in himself, or jointly with some other persons, he still had sufficient right to bring forward the case (*a*). In *Dent* v. *Turpin* (*b*), Wood, V.-C., decided in accordance with this view, saying that the plaintiff had a clear right to an injunction and the erasure of the spurious marks, without making the other person interested a party, while as to the account, only the plaintiff's share having been prayed for, that, though it might be difficult to ascertain, was yet ascertainable. In any case, the wrong-doer had no right to complain of any technical difficulty arising from his own wrongful act, though the result was to involve him in two suits instead of one. In *Southorn* v. *Reynolds* (*c*) he decided in the same way, saying that his previous decision had not been interfered with (*d*). So, in the Scotch case of *Dunnachie* v. *Young & Sons* (*e*), the name "Glenboig" was used and registered as the trade mark of one company, and as part of the trade mark of another company, and an interdict was granted in an action in which the two companies were co-plaintiffs, to restrain the use of the name by a third company.

Partnership trade mark.

It seems that where the use of a trade mark is improperly secured for himself by one member of a partnership, he being bound to obtain it for the partnership, he will be held to be a trustee of it for the benefit of the partnership (*f*).

Delondre v. *Shaw*.

In *Delondre* v. *Shaw* (*g*) it was held that, inasmuch as

(*a*) *Hine* v. *Lart*, 10 Jur. 106. See *Pratt's Appeal*, 117 Penn. St. 401.

(*b*) 2 J. & H. 139.

(*c*) 12 L. T. N. S. 75.

(*d*) And see *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; and *Newman* v. *Alvord*, 49 Barb. 588; R. Cox, 404; 51 Y. N. 189; and consider *Robinson* v. *Finlay*, 9 Ch. D. 487.

(*e*) Ct. Sess. Cas., 4th ser. X. 874.

(*f*) *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54; and see *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98; *In re Rust & Co.*, *ib.* 98; and *In re Farina* (4), *ib.* 99.

(*g*) 2 Sim. 237; and see *Page* v. *Townsend*, 5 Sim. 395.

one of the plaintiffs had no interest in the account (*a*), he was improperly joined as a co-plaintiff, the Court thus treating the injunction as ancillary to the account. In *Farina* v. *Silverlock* (*b*) the same question was raised, but without success, and no such objection would prevail at the present day (*c*).

Prize medallist.

In *Batty* v. *Hill* (*d*), an attempt was made by a prize medallist at the Exhibition of 1862 to restrain the use by the defendant, who had not been awarded a medal, of a label which had been prepared before the award, bearing the words "Prize Medal, 1862." The Vice-Chancellor was, however, of opinion that he could not interfere merely on the ground of a misrepresentation, and that the plaintiff was not entitled to claim the label as a trade mark for various reasons, among which was the fact that whatever rights the plaintiff could have must be shared with all those who had been awarded medals (*e*).

Infringement by servants.

The person sought to be enjoined in a trade-mark case is commonly a rival manufacturer, who is using the spurious mark to promote the sale of his own commodities. The

(*a*) It should be observed that the reason given by Mr. Bickersteth (afterwards Lord Langdale and M. R.), who argued the case, for the joinder of Pelletier as a co-plaintiff, was that, though having no interest in the medicine, he yet was entitled to prevent his name being used. It is further to be observed, that the subsequent decision of Lord Langdale, in *Clark* v. *Freeman*, 11 Beav. 112, does not conflict with the position taken up by him in *Delondre* v. *Shaw*, since Pelletier not only manufactured the medicine, but supplied it to Delondre, so that he had a pecuniary interest in the maintenance of his reputation. *Clark* v. *Freeman* was decided on the point that the plaintiff did not manufacture or sell pills.

(*b*) 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650.

(*c*) In *Millington* v. *Fox*, 3 My. & Cr. 338, the account was waived; and see *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Leather Cloth Co.* v. *American Leather Cloth Co.*, *ib.* 137; *Barnett* v. *Leuchars*, 13 L. T. N. S. 495; *Symonds* v. *Greene*, 28 Fed. Rep. 834; and many other cases. In fact, this is a common incident.

(*d*) 1 H. & M. 264.

(*e*) See Exhibition Medals Act, 1863 (26 & 27 Vict. c. 119); also *Taylor* v. *Gillies*, 59 N. Y. 331; and *Roper's, &c., Co.*, v. *Copeman's, &c., Association, Ld.*, 28 Sol. J. 218. But representations of prize medals have been registered as parts of old combination marks, both in England (see *In re Brook*, 26 W. R. 791, and *In re Farina* (2), 27 W. R. 456) and in America (see *In re Bush & Co.*, 10 U. S. Pat. Gaz. 164).

fact that the fraud has been committed by a servant of the trader makes no difference, for principals "are bound to know what their agents do, and if they do not know, they are responsible exactly as if they did know." Hence, where a defendant's manager had affixed to his master's goods, without the knowledge of the latter, as he alleged, a ticket infringing the rights of the plaintiff, an injunction was granted against the master, with costs (*a*). And, similarly, where a clerk had sold goods in a spurious wrapper, with a verbal representation that the goods and wrapper were genuine (*b*). But this does not relieve servants or agents from their personal responsibility (*c*).

Agents.

And English agents of foreign traders will be restrained from selling goods received from their principals falsely marked, to the injury of other manufacturers (*d*). And similarly in America with American agents of foreign manufacturers (*e*), and in the colonies (*f*). So, too, commission merchants, selling with the knowledge that the goods they sell are so marked as to deceive (*g*).

Engravers

The remedy will, however, not only be awarded against such persons as are to profit directly by the perpetration of a fraud, but also against all who connect themselves with and assist in the same. Thus, persons who engrave or print a trade mark for one not entitled to use it may be restrained.

Guinness v. *Ullmer*.

In *Guinness* v. *Ullmer* (*h*), where the defendants had supplied to one Taylor blocks engraved with the main part of the plaintiffs' trade mark, including their names, from which blocks Taylor had printed labels similar to the

(*a*) *Tonge* v. *Ward*, 21 L. T. N. S. 480; and see *Twentsche Stoom Bleekery Goor* v. *Ellinger & Co.*, 26 W. R. 70; *Atkinson* v. *Atkinson*, 85 L. T. (Journal) 229.

(*b*) *Low* v. *Hart*, 90 N. Y. 457.

(*c*) *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Estes* v. *Worthington* (2), 30 Fed. Rep. 465.

(*d*) *Farina* v. *Cathery*, L. J. N. of C., 1867, p. 134; *Siegert* v. *Findlater*, 7 Ch. D. 801; and see *Siegert* v. *Ehlers*, Dig. 432.

(*e*) *Roberts* v. *Sheldon*, 8 Biss. 398; *Carbolic Soap Co.* v. *Thompson*, 25 Fed. Rep. 625.

(*f*) *Siegert* v. *Lawrence*, 11 Vict. L. R. 47.

(*g*) *Coats* v. *Holbrook*, 2 Sandf. 586, R. Cox, 20.

(*h*) 10 L. T. (Old Series), 127.

plaintiffs', the Vice-Chancellor of England, Sir L. Shadwell, was of opinion that, as the matter complained of could not have happened without the prints which had been made from the blocks, the defendants had made themselves ancillary to the piracy, and he accordingly granted the injunction. It had been contended for the defendants that it was with a part only of the plaintiffs' mark that they had been concerned; but the Vice-Chancellor thought that if a thing contained twenty-five parts, and one only was taken, such an imitation would be sufficient to contribute to a deception, and that the law would hold those responsible who had contributed to the fraud. In *Farina* v. *Shaw* (*a*), and *Farina* v. *Silverlock* (*b*), injunctions were granted to restrain the printing of labels similar to those used by the plaintiff. In the latter case, on appeal (*c*), Lord Cranworth, C., dissolved the injunction, and sent the right to be tried at law (*d*); but this can no longer be done (*e*).

Spurious goods in innocent hands.

A different combination of circumstances arises when the goods improperly marked are in the charge of an innocent third party, for purposes of conveyance, storage, or the like. In such a case, although that person be merely a carrier receiving goods, which, though fraudulently marked, are not for his own use, nor to be sold by him for his own benefit, but have been received by him merely for the purposes of transmission to the persons to whom they are consigned, yet an injunction will issue to restrain him from parting with the goods spuriously marked (*f*). "It is the duty of the person in charge of the marked goods at once to give all the information required, and to undertake that the goods shall

(*a*) Decided by V.-C. Parker, and referred to in *Farina* v. *Silverlock*, 1 K. & J. 509-12. See 3 Eq. Rep. 886-90.

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

(*c*) 6 De G. M. & G. 214.

(*d*) Where the plaintiff obtained a verdict. See 4 K. & J. 650.

(*e*) 25 & 26 Vict. c. 27.

(*f*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130; and see *Rivero* v. *Norris*, Seton, 4th ed. 236; *Del Valle* v. *Mayer*, *ib.*; *Moet* v. *Pickering*, 8 Ch. D. 372.

not be removed or dealt with, unless the spurious brand has been removed, and to offer to give all facilities to the person injured for that purpose." He should also, on discovering the fraud, at once inform his correspondent abroad (*a*). If, on the other hand, the carrier declines to give information required by the injured party for the purpose of an action against the author of the fraud, even after the marked goods have passed out of his control, the person injured is entitled to succeed in an action brought against him to compel discovery (*b*). Supposing the carrier, &c., to give the required information and undertaking, and to seek to facilitate the proceedings, then, "if after that the person injured files a bill, though he will be entitled to all that he seeks in the shape of relief, as he might have got it all without suit, he will not get from the defendants the costs of the suit, and he may have to pay them (*c*). On the fact of the fraudulent mark being discovered, it is no redress for the carrier, &c., to send back the goods, or to offer to do so, for that would only put it in the power of the consignor to repeat his fraud; but if the carrier, &c., offers as an alternative to erase the mark, he has done all he can be reasonably required to do" (*d*).

Innocent mortgagee.

Where wines bearing a spurious trade mark were in the custody of a dock company, and an innocent third party had advanced money on the security of the wines, it was ordered by Romilly, M. R., that the wines should be delivered to the mortgagee, on the spurious brands being removed and destroyed (*e*).

(*a*) Per Romilly, M. R., and Lord Hatherley, C., in *Upmann* v. *Elkan*, L. R. 12 Eq. 140, and L. R. 7 Ch. 130.

(*b*) *Orr* v. *Diaper*, 4 Ch. D. 92.

(*c*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140. See *Moet* v. *Pickering*, 8 Ch. D. 372; *Upmann* v. *Forester*, 24 Ch. D. 231; *Upmann* v. *Currey*, 29 Sol. J. 735.

(*d*) Per Lord Hatherley, C., in *Upmann* v. *Elkan*, L. R. 7 Ch. 130. See also *Siegert* v. *Lawrence*, 11 Vict. L. R. 47, in Victoria, and *Bryant & May* v. *Heyde*, 7 N. S. W. Rep. (E.) 72, in New South Wales.

(*e*) *Ponsardin* v. *Peto*, 33 Beav. 642.

Wharfinger's lien.

In *Moet* v. *Pickering* (*a*) wharfingers were in possession of wines spuriously branded, but they had no knowledge that the brand was spurious, and they offered to act with respect to the wine as the Court should direct, upon having their charges and costs paid or provided for. The Court of Appeal held that they were entitled to a lien on the wine for their charges, and that, even if the plaintiffs in the action for infringement were entitled to any lien on the wine for their costs, which was doubted, that lien must at all events be postponed to that of the wharfingers; and the Court also held that the latter had not done anything to disentitle them to their costs, which must be paid in both Courts by the plaintiffs.

Warehousemen.

In *Hunt* v. *Maniere* (*b*), where warehousemen, at the request of the owners of a certain brand on wines, refused to deliver (*c*) to the indorsee of the dock warrants wines improperly marked with that brand, Romilly, M. R., restrained the indorsee from proceeding with an action at law against the warehousemen for their refusal. The jurisdiction of the old Court of Chancery to restrain actions at law is now gone, but the warehousemen would have a good defence in the Common Law Divisions to an action there commenced (*d*).

Questions of contract.

In exercising its jurisdiction to restrain breach and enforce specific performance of contract, the Court has sometimes had to deal with questions of trade mark, or akin thereto. Thus, where an injunction was granted to restrain the use of a man's name (*e*) otherwise than in accordance with a contract into which he had entered, or of

(*a*) 6 Ch. D. 770; 8 *ib.* 372.

(*b*) 34 Beav. 157.

(*c*) On the same day, but subsequently, an injunction was granted to restrain them from doing so.

(*d*) Judicature Act, 1873, § 24.

(*e*) *Ainsworth* v. *Bentley*, 14 W. R. 630; *Ward* v. *Beeton*, L. R. 19 Eq. 207; *Probasco* v. *Bouyon*, 1 Mo. App. 241; *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306; *Frazer* v. *Frazer Lubricator Co.*, 121 Ill. 147; *Brewer* v. *Lamar*, 69 Ga. 656, where, in the sale of the goodwill of the business of "Brewer's Lung Restorer," the vendor agreed not to use his name on any preparation for the same purpose, and he was restrained from selling a preparation as "Brewer's Sarsaparilla Syrup," and it was held that such a contract did not involve any restraint of trade.

an initial (*a*), or of the name of a business (*b*), or of a singer's voice (*c*), or of a publication (*d*).

Where, among other symbols, the arms, crest, and motto (the latter being the word "Excelsior") of one of the partners were used as trade marks of a partnership, and on dissolution of the partnership it was agreed that the other partner might use all the trade marks of the firm's except such private arms, crest, and motto, it was held that no breach of the agreement had been committed by the continuing partner in using the word "Excelsior," apart from the arms and crest, on some of his goods, since it had been so used alone previously as a trade mark, and it was not then used as a motto, but as a trade mark (*e*). *Steinthal* v. *Samson.*

Where, on a dissolution of partnership, it was agreed that neither partners should continue to use the firm's trade mark, which consisted of the letters "P. & O." within a scroll bearing an inscription, one of the members of the late firm was restrained from using a mark very similar to the old mark, the only practical difference being that the letters "P. S. & Co." were substituted for "P. & O." (*f*). And in a case of the same character, where, on a dissolution of partnership, one of the partners had assigned to the other his interest in the firm's stock of labels, which contained his name, and the other had covenanted not to print any more, except in a form expressive of the change in the firm, the latter was not allowed to register the old labels in Victoria, without alteration (*g*). Other cases.

Where a tobacco manufacturer agreed to pay a royalty Name of cigarettes.

(*a*) *Tudor* v. *Tudor*, W. N. 1873, p. 72; *Fullwood* v. *Fullwood*, 9 Ch. D. 176.

(*b*) *Hagg* v. *Darley*, 47 L. J. Ch. 567 ("Old Government Sanitary Company"); and see *McGowan Brothers' Pump & Machine Co.* v. *McGowan*, 2 Cinc. 313.

(*c*) *Lumley* v. *Wagner*, 5 De G. & Sm. 485; 1 De G. M. & G. 604; and see *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518, as to a singer's voice.

(*d*) *Clowes* v. *Hogg*, W. N. 1870, p. 268.

(*e*) *Steinthal* v. *Samson*, Dig. 546.

(*f*) *Osborne, Garrett & Co.* v. *Parton, Son & Co.*, V. C. B., July 25th, 1884.

(*g*) *Ex parte Grist & Bowring*, 11 Vict. L. R. 630.

for the use of a patent for improvements in the manufacture, and he proposed and the patentee assented to his using as the name for the cigarettes to be made from the tobacco the words "Sweet Caporal," "Caporal" alone having been previously used by the manufacturer on other cigarettes, it was held that after the manufacturer had discontinued the use of the patent he was under no contract not to use the name "Sweet Caporal" on other cigarettes (*a*).

Barrows v. *Pelsall Coal & Iron Co.*

In *Barrows* v. *Pelsall Coal & Iron Co.* (*b*), the plaintiffs used a trade mark consisting of the letters "B. B. H." in Roman type, with a crown, and the defendants, who had compromised a suit commenced for the purpose of restraining them from using the letters "B. B. S.," also in Roman type, with a crown, by undertaking to discontinue the use of the mark, were restrained by injunction from committing a breach of the contract by applying to register the letters "B. B. S." in italics, with a crown.

Fraudulent agreement.

The Court will not specifically enforce an agreement the object of which is to defraud the public by putting goods spuriously marked on the market (*c*), nor will it protect a person who has used his trade mark on spurious as well as on genuine goods (*d*), or has intended to commit fraud by buying the right to stamp on his own goods the name of another person who has acquired a reputation in the trade (*e*). And where an action for damages was brought against a person who had filled with inferior seed seed-bags which he had bought from the plaintiffs, marked with their labels, it was held on demurrer that the plaintiffs, having knowingly been parties to a fraud upon the public, were not entitled to recover (*f*).

(*a*) *Hornbostel* v. *Kinney*, 52 N. Y. Super. Ct. 41.
(*b*) Dig. 530.
(*c*) *Oldham* v. *James*, 13 Ir. Ch. 393; 14 *ib.* 81.
(*d*) *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218.
(*e*) *Samuel* v. *Berger*, 24 Barb. 163; R. Cox, 178. See *Roägers* v. *Philp*, 1 U. S. Pat. Gaz. 29; *In re Tolle*, 2 *ib.* 415.
(*f*) *Bloss* v. *Bloomer*, 23 Barb. 604; R. Cox, 200.

Contract with trade-mark owner for purchase of goods.

"Where the manufacture of a person or firm," said Cotton, L. J., in *Johnson* v. *Raylton* (*a*), "has acquired with the public a name or reputation, as Broadwood's or Erard's pianos, Purday's or Lancaster's guns, a purchaser from them of articles of which they are the makers is entitled to refuse any not made by the firm with whom he contracts. In such a case the purchaser relies on reputation or public opinion that the maker to whom he goes supplies good articles. In other cases, where a man contracts with a particular firm of makers for goods such as they make, in the absence of evidence that in the particular trade, or as regards particular goods, there is a known practice that a maker of whom the goods are ordered is at liberty, in the absence of such a stipulation, to supply goods of the kind, though made by other firms, I should come to the conclusion that the purchaser is induced to go to the particular firm of manufacturers by his reliance, in part at least, on the opinion which he forms, either on his own experience or from information of others, as to the average or general excellence of the goods which are manufactured by them. He is trusting to his own experience, or to that of his friends, as a purchaser who goes to a firm which has acquired a public reputation trusts to the opinion of the public." So that where a manufacturer has contracted to sell goods of his own manufacture and bearing his trade mark, the purchaser is justified in refusing to accept other goods, though of the same quality. But it seems that if what is wanted is the particular manufacturer's trade mark on the goods as a guarantee of quality, the proprietor of the mark is justified in placing that mark on goods not of his own make, since by so doing he makes himself responsible for the quality of them, just as if he had made them himself (*b*).

(*a*) 7 Q. B. D. 438.
(*b*) See per Brett, L. J., in S. C. But compare Merchandise Marks Act, 1887, § 3 (2).

Contract for purchase of goods with a specified mark.

Where a contract has been entered into for the purchase of goods of a particular stamp, the question arises whether the stamp was specified as indicative of a particular quality, or as possessing some value in itself, so that the goods would be of less value if stamped differently. Thus, in *Hopkins* v. *Hitchcock* (*a*), where iron stamped with "S. & H." and a crown had been contracted for, and iron stamped with "H. & Co." and a crown was supplied, the firm having become differently constituted, and having consequently marked their iron of the quality originally denoted by the former brand with the latter stamp in substitution for the former, it was decided that the contract turned upon the quality of the iron, and not upon the brand (*b*); if, however, the brand had possessed a special value, and the object of the purchase had been to resell the iron at a price which would have had to be lowered in the absence of the special mark, or even if it had been clear that the defendant had contracted for the brand for its own sake, and not as indicative of quality, it seems that the decision would have been the other way. Such questions must, however, depend in each case upon the terms in which the intention of the contracting parties is expressed; and it seems that a contract to supply goods bearing a particular trade mark may be implied from that trade mark being printed at the head of the order form (*c*).

Painter's name on paintings.

In the case of paintings, described in a catalogue as being the work of Claude Lorraine and Teniers, it was held by Lord Kenyon, C. J., that the description was merely an expression of the vendor's opinion, and not a warranty of the authenticity of the paintings (*d*); in a

(*a*) 14 C. B. N. S. 65.

(*b*) Compare *Nichol* v. *Godts*, 10 Ex. 191. Similarly, in *Gillespie & Co.* v. *Marshall*, Dig. 648, the question was discussed whether a contract to supply "Marshall's Canada Plates" was performed by the delivery of plates such as were usually supplied by Marshall, but which were not "Canada Plates" in the strict commercial sense.

(*c*) *Johnson* v. *Raylton*, 7 Q. B. D. 438.

(*d*) *Jendwine* v. *Slade*, 2 Esp. N. P. C. 572.

similar case, however, where the painter was said to be Canaletto, it was held by the Court of King's Bench to be for the jury to say whether or not the description amounted to a warranty (*a*). The paintings being so much more modern, it was more reasonable in this case to suppose that the vendor intended to make an assertion as to the fact of their authenticity, as within his own knowledge.

Merchandise Marks Act.

By the Merchandise Marks Act, 1887, any person selling or contracting to sell any goods bearing a trade mark, or trade description, is to be deemed to warrant the genuineness of the trade mark, or the correctness of the trade description, unless he expresses the contrary in signed writing, delivered to and accepted by the vendee (*b*).

By § 19 the punishment of an offender under that Act does not take away the civil remedy to which any person aggrieved by his conduct is entitled.

Risks incurred by infringement.

That under some circumstances an infringement of another person's trade mark may expose the infringer to liabilities even beyond those involved in an action brought to restrain the wrong, appears from the Victorian case of *In re Brebner* (*c*), in which an insolvent, who had wasted his means in litigation occasioned by his having infringed a trade mark, had his certificate suspended for a year.

(*a*) *Power* v. *Barham*, 4 Ad. & E. 473.

(*b*) 50 & 51 Vict. c. 28, § 17.

(*c*) 2 W. & W. (I. E. & M.) 12.

CHAPTER VII.

DEFENCES; DISCOVERY AND INSPECTION, ACCOUNT, DAMAGES, COSTS.

Defences.

Defences.

THE possible defences to an action to restrain an infringement of trade mark are numerous, some being of a somewhat special character. The following are some of the more important.

1. *Non-infringement.*

1. Non-infringement.

The first and usual defence is that the conduct on the part of the defendant, of which the plaintiff complains, has not been, in fact, such as to have for its object or its result the appropriation by the defendant of what was the plaintiff's due, the fruits of his enterprise and reputation: shortly, that the defendant has not infringed (*a*).

2. *No Registration or Certificate of Non-registration.*

2. No registration or certificate.

The trade mark, so called, may present some one or more of the essential particulars required by the Acts, and may not be objectionable in itself; but yet the fact of non-registration under the Acts will, if it is a mark capable of registration, whether it was or was not used before the 13th August, 1875, effectually debar the person who has

(*a*) *E.g.*, *Crawshay* v. *Thompson*, 4 Man. & G. 357; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Blackwell* v. *Crabb*, 36 L. J. Ch. 504; *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; *Blackwell* v. *Wright*, 73 N. Car. 310.

used it from obtaining the injunction, which would otherwise be awarded as a matter of course (*a*). And this is so, even though the trade-mark owner has taken all steps in his power to protect his rights, and the Patent Office is responsible for the delay (*b*). If, being incapable of registration, it is an old mark, a certificate of refusal to register will preserve the existing right to protection (*c*). If, being incapable of registration, it is a new mark, the Acts of 1883-8 do not appear to deprive the mark of protection for want of registration (*d*); but the definition is now wider than it was in the Act of 1875, and there can be but few, if any, marks which would be capable of protection at Common Law, and yet be incapable of registration. However, it does not at all appear that, when a case of actual intentional fraud can be proved, there is anything in the Acts to prevent proof of imitation of marks, though unregistered, &c., being given as corroborative evidence of the fraud (*e*). In such a case the state of things would be similar to that in which it is a mode of packing that has been imitated (*f*). The injunction which would not be granted to restrain the infringement of the unregistered and uncertified trade mark would, as it seems, be granted to restrain the intentional fraud, in which the imitation of marks was a mere incident.

(*a*) See Patents Act of 1883, § 77; also *Goodfellow* v. *Prince*, 35 Ch. D. 9, and *Hart* v. *Colley*, 44 Ch. D. 193. Registration is a "condition precedent to suing." Per Chitty, J., in *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398. It does not appear that in America it is equally essential to have obtained registration. See *Rodgers* v. *Philp*, 1 U. S. Pat. Gaz. 29.

(*b*) *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819.

(*c*) Patents Act 1883, § 77. See per Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 498. In *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434, a certificate of registration or of refusal to register does not appear to have been called for.

(*d*) Patents Act, 1883, § 77.

(*e*) The late Master of the Rolls has intimated from the bench that this view is correct; and see per Pearson, J., in *In re Riviere & Co.*, W. N. 1884, p. 75, and per Kay, J., in *In re Sanitas Co., Ld.*, 56 L. T. N. S. 166. Also *Hart* v. *Colley*, *ubi. sup.*, and the Canadian case of *Smith* v. *Fair*, 14 Ont. Rep. 729.

(*f*) *Woollam* v. *Ratcliff*, 1 H. & M. 259; *Edelsten* v. *Vick*, 11 Hare, 78; *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *Orr* v. *Diaper*, 4 Ch. D. 92; *Lever* v. *Goodwin*, 36 Ch. D. 1.

3. *The Plaintiff not the Registered Proprietor.*

3. Plaintiff not the registered proprietor.

The provision contained in § 77 of the Act of 1883 disabling trade-mark owners from obtaining protection for their marks, unless they have been registered in pursuance of the Acts, does not appear to prevent such owners from suing, so long as the mark is registered, whether it stands in their name or not; and this has in effect been so held in a case where a trade mark had been registered in the name of a firm, and a new firm took over the business and goodwill, and commenced an action for infringement before the trade mark had been transferred into their names (*a*). It is, however, provided by § 76 that "the registration of a person as proprietor of a trade mark shall be *primâ-facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act." So that, at all events after a trade mark has been registered for five years, and the registration has become conclusive evidence of the exclusive title of the registered proprietor, it would seem very difficult for a person who, though really entitled to the mark, was not the registered proprietor, to sue in respect of an infringement, without his first getting his name placed on the register as the proprietor, for which purpose it may be necessary first to rectify the register by the removal of the name already there.

The trade mark being duly registered, the objection which formerly prevailed, by which a trade mark was excluded from protection when there were no vendible goods in the market stamped therewith (*b*), will apparently

(*a*) *Ihlee* v. *Henshaw*, 31 Ch. D. 323.
(*b*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307.

be avoided, for application for registration is to be deemed to be equivalent to public use of the mark (*a*).

4. *Plaintiff's Trade Mark bad in itself.*

4. Plaintiff's trade mark bad.

This defence must for the future be founded mainly on the definition of a trade mark in the Act under which the mark was registered. Thus, marks registered or tendered for registration between August 13th, 1875, and December 31st, 1883, must comply with the definition in § 10 of the Trade Marks Registration Act, 1875; marks registered or tendered for registration between January 1st, 1884, and December 31st, 1888, must comply with the definition in § 64 of the Patents Act, 1883; marks registered or tendered for registration on or after January 1st, 1889, must comply with the last-mentioned definition as modified by § 10 of the Patents Act, 1888. If the mark sued on is a new mark and incapable of registration, so that § 77 of the Act of 1883 leaves its owner free to sue for an infringement without registration, the validity of the mark will be determined by the general law as to distinctiveness, &c. (*b*). But such cases cannot be numerous, and in the great majority of cases the point will be whether a mark which has been registered was rightly registered (*c*). Then the question arises whether the contention, that the mark does not comply with the conditions imposed upon marks tendered for registration, can be set up by way of defence, or whether a motion to rectify the register is necessary. That such a contention may be set up by way of defence when the mark has been registered for less than five years seems clear, since by § 76 registration is only *primâ-facie* evidence

(*a*) § 17 of Act of 1888, substituted for § 75 of Act of 1883. This is so also in the United States: *In re The Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, p. 248. See, however, *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*b*) See Chap. II., *supra*.

(*c*) If the registered mark, being a new mark, is held to be incapable of registration and to have been wrongly registered, the question of validity at Common Law may arise.

during the first five years, and to disallow the setting up of such a contention by way of defence within the five years would be to make the registration conclusive evidence from the outset.

When the case relates to a trade mark which has been registered for upwards of five years, the question seems much more difficult. The Court of Appeal seems to have suggested in one case (*a*) that registration is conclusive after five years, in the absence of a motion to rectify, and there is no doubt that the more prudent course is to apply for rectification. If this is granted, the plaintiff's action will fail, as his previous wrongful registration will afford no foundation for it (*b*). But it appears to be very doubtful whether, on the wording of the Acts of Parliament, a motion to rectify is required, where the defence is that the mark claimed is not within the definition section in the Act under which it was registered. Both in § 3 of the Act of 1875, and in § 76 of the Act of 1883, the exclusive right for which provision is made relates to the use of "a trade mark," and it can hardly be that that which the Act, by excluding it from the definition of "a trade mark," declares not to be a trade mark for the purposes of the Act, can yet participate in the privileges which are conferred on trade marks which the Act recognises. The process of registration, whether for five years or for any shorter period, can hardly make that "a trade mark" which does not contain at least one of the elements declared by the definition section to be essential, unless that section is to be entirely disregarded. This view was upheld by the Court of Appeal in *In re Palmer* (1) (*c*), in which the late Master of the Rolls fully discussed the point, and Lindley, L. J., said that "after careful examination of §§ 3, 5, and 10 of the Trade Marks

(*a*) *Apollinaris Co., Ld.* v. *Herrfeldt*, 4 P. R. 478.

(*b*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

(*c*) 21 Ch. D. 47.

Registration Act, 1875, I am satisfied that a mark which is not a trade mark, and which therefore ought never to have been registered, does not become a trade mark by being on the register for five years." The Vice-Chancellor of Ireland has taken the same view (*a*), and the same principle has been followed in Victoria (*b*). In America also the same conclusion has been arrived at, under the United States Statute (*c*).

5. *Trade Mark severed from Goodwill.*

5. Trade mark severed from goodwill.

It is a good defence to an action for infringement of trade mark, to prove that the plaintiff is not the owner of the business and goodwill concerned in the particular goods or classes of goods in respect of which the trade mark is registered (*d*).

6. *Licence.*

6. Licence.

The defendant may plead a licence from the plaintiff (*e*), or from a co-proprietor of the mark (*f*). In one American case (*g*) it was held that the plaintiffs, who had received an exclusive licence from the owner of a trade mark, were entitled to an injunction against the successors in business of persons who had been partners in business with the licensor, but had tacitly acquiesced in his retaining the sole right in the mark. However, the Court would not

(*a*) *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371.

(*b*) *Lewis* v. *Klapproth*, 11 Vict. L. R. (E.) 214; *Wolfe* v. *Alsop* (2), 12 Vict. L. R. (E.) 421; *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 752.

(*c*) *Moorman* v. *Hoge*, 2 Sawy. 78.

(*d*) See §§ 65 and 70 of Act of 1883. There can be no trade mark in gross: *Cotton* v. *Gillard*, 44 L. J. Ch. 90. See *In re Wellcome*, 32 Ch. D. 213; *Witthaus* v. *Braun*, 44 Md. 303; *Taylor* v. *Bemis*, 4 Biss. 406; *Weston* v. *Ketcham* (1), (2), 39 N. Y. Super. Ct. 54; 51 How. Pr. 555; *Skinner* v. *Oakes*, 10 Mo. App. 45; *Morgan* v. *Rogers*, 19 Fed. Rep. 596; *Smith* v. *Flair*, 14 Ont. Rep. 729.

(*e*) See Patents Act, 1883, § 87. It does not appear that this section can be intended to authorise the user of a trade mark on goods not being the goods of the trade-mark owner, or, at least, equivalent to them. See *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776.

(*f*) *Marshall* v. *Pinkham*, 52 Wisc. 572.

(*g*) *Kidd* v. *Johnson*, 100 U. S. Rep. 617. See *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337.

allow a licensee to defraud the public by the sale of goods under a mark which was similar to that on the licensor's own goods, while the goods themselves were not the goods or goods equivalent to the goods of the licensor (*a*).

It has been held in India (*b*) that plaintiffs, who had led the defendant to believe that they did not claim a certain trade mark, and that he was at liberty to use it, and had allowed him to build up a trade under it, were estopped by their own conduct from denying the defendant's right to use it.

7. *Delay and Acquiescence.*

7. Delay and acquiescence.

A man may by his own *laches* lose his right to that protection which he would have obtained at once, had he come to the Court with reasonable promptitude (*c*). In fact, that which has originally been a valid trade mark, the property of an individual or firm, entitled to protection, may become *publici juris*—that is to say, the use of it may be thrown open to the public—by its proprietor allowing his right to be so habitually infringed that the trade mark no longer conveys to those who see it the impression that the goods to which it is attached are of his manufacture (*d*). That this must necessarily be so, the reasoning of the Supreme Court of Victoria, in *Neva*

(*a*) *Oldham* v. *James*, 13 Ir. Ch. 393; 14 *ib.* 81; *Bloss* v. *Bloomer*, 23 Barb. 604, R. Cox, 200; *Samuel* v. *Berger*, 24 Barb. 163, R. Cox, 178; *Rodgers* v. *Philp*, 1 U. S. Pat. Gaz. 29; *In re Tolle*, 2 *ib.* 415.

(*b*) *Lavergne* v. *Hooper*, Ind. L. R. 8 Mad. 149.

(*c*) *Motley* v. *Downman*, 3 My. & Cr. 1; *Morison* v. *Moat*, 9 Hare, 241; *Flavel* v. *Harrison*, 10 Hare, 467; *Wason* v. *Waring*, 15 Beav. 151; *Attorney-General* v. *Sheffield Gas Consumers' Co.*, 3 De G. M. & G. 327; *Burgess* v. *Burgess*, *ib.* 896; *Farina* v. *Gobhardt*, 3 Eq. Rep. 891; *Chappell* v. *Sheard*, 2 K. & J. 117; *Coles* v. *Sims*, 5 De G. M. & G. 1; *Kinahan* v. *Bolton*, 15 Ir. Ch. 75; *Hovenden* v. *Lloyd*, 18 W. R. 1132; *Isaacson* v. *Thompson*, 41 L. J. Ch. 101; *Estcourt* v. *Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Amoskeag Manufacturing Co.* v. *Garner*, 55 Barb. 151, R. Cox. 541; *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; *Marshall* v. *Pinkham*, 52 Wisc. 572; and other cases cited below.

(*d*) *Ford* v. *Foster*, L. R. 7 Ch. 611; *Wheeler & Wilson* v. *Shakespeare*, 39 L. J. Ch. 36; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Rodgers* v. *Philp*, 1 U. S. Pat. Gaz. 29; *Filley* v. *Child*, 16 Bl. C. C. 376.

Stearine Co. v. *Mowling* (*a*), appears convincing. "Great stress," said Holroyd, J., "has been laid on this: that a person who is entitled to a distinctive trade name or mark is said to have acquired property in it, and that the property once acquired cannot be lost. But what is the nature of the property, if that be the right designation to give it? It is that, when an article has become known to the public generally by a particular name or mark, no other person has a right to simulate that name or mark so as to induce the public to believe that his goods are the goods of the inventor. If that be the reason, then the right, if it be acquired in that way, must be lost when the reason for it ceases. If the use of the name by another person will no longer induce that belief, then the right to the property must be gone." Thus, in *In re Hyde & Co.* (*b*), it was held that the words "Bank of England" had long ceased to be a trade mark in respect of sealing-wax, by reason of the user for six years of those words on sealing-wax by persons other than those who had originally adopted it, without interference by the latter, and the registration of the lapsed trade mark was accordingly rescinded.

Principle of this defence.

The principle on which the Court allows the plaintiff's delay to be pleaded by way of defence is thus stated by Wood, V.-C., in *Beard* v. *Turner* (*c*): "By not complaining at the time when you might complain (I do not say that it is your intention, we must judge of the intention by the necessary result), you are lying by, the man continuing to use your property, with the hope (and such is the prayer of your bill filed two or three years afterwards) of obtaining those profits which you stood by allowing him to make under this designation, without apprising him of your intention to make any such use of

(*a*) 9 Vict. L. R. (E.) 98. See *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. (E.) 98.
(*b*) 7 Ch. D. 724.
(*c*) 13 L. T. N. S. 746. And

it. On that ground it falls within the principle enunciated by Lord St. Leonards in the Irish case referred to, in which it is stated that it is a fraud to allow a plaintiff to avail himself of delay to obtain benefit for himself. In that case you will not grant him relief."

On motion for injunction.

In the case of a motion for an injunction "the argument as to acquiescence is no doubt very important. A short acquiescence may properly induce the Court not to interfere *ex parte*. A longer acquiescence may, under the circumstances, throw serious doubt upon the right of the plaintiff, and induce the Court not to interfere by any interlocutory order, even when applied for on notice" (*a*). And it is not sufficient for the plaintiff to commence proceedings promptly: if he wishes for an interlocutory injunction he must bring on his motion at once, or the Court will hold that he has shown by his own conduct that he does not consider such interference to be imperative (*b*).

At the hearing.

Where, however, the case has arrived at the hearing, the degree of delay or acquiescence must be much greater; there must be such an acquiescence as to amount, not only to a positive licence, but to an implication of an actual grant, before the parties can be for ever deprived of their rights (*c*). In *Fullwood*

(*a*) Per Lord Langdale, M. R., in *Goram* v. *Cheltenham Railway Co.*, 5 Beav. 233; and see *Isaacson* v. *Thompson*, 41 L. J. Ch. 101; *Flavel* v. *Harrison*, 10 Hare, 467; *Evans* v. *Smith*, 3 Times L. R. 390; *Mallan* v. *Davis*, 3 Times L. R. 221; *Chinn* v. *Thomas*, 5 Vict. L. R. Eq. 188; *Estes* v. *Worthington* (1), 23 Bl. C. C. 165. But compare the N. S. W. case of *Heyde* v. *Wittkowski*, 5 N. S. W. Rep. (E.) 74.

(*b*) *Pickford* v. *The Grand Junction Railway Co.*, 3 Railway Cas. 538.

(*c*) *Patching* v. *Dubbins*, Kay 11; *Gordon* v. *The Cheltenham Railway Co.*, 5 Beav. 233; *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285; and see *Lazenby* v. *White*, 41 L. J. Ch. 354; *Weaver* v. *Sanitary, &c., Co.*, L. J. N. of C. 1887, p. 144 (where the defendants had used the word for eleven years, to the plaintiff's knowledge); *Weaver* v. *Stiff*, L. J. N. of C. 1887, p. 144 (where the defendants had so used the mark for ten years); *Gillott* v. *Esterbrook*, 47 Barb. 455; R. Cox, 340; 48 N. Y. 374; *Filley* v. *Fassett*, 44 Mo. 173, R. Cox, 530; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Gamble* v. *Stephenson*, 10 Mo. App. 581; *Julian* v. *Hoosier Drill Co.*, 75 Ind. 408; *Holt* v. *Menendez*, 128 U. S. Rep.

v. Fullwood (2) (*a*), Fry, J., laid down that mere lapse of time, short of the statutory period fixed for the limitation of actions, would not deprive a plaintiff in an action for infringement of a trade mark, which is an action for the assertion of a legal right, of his right to the injunction. And in an American case (*b*), while it was held that a delay of twenty-five years effectually disentitled the plaintiffs to relief as against an innocent vendor of goods falsely marked, the question as to the rights of a trade-mark owner, after a similar delay, against a guilty manufacturer, was left open. In Victoria also it has been said that "in cases of fraud a much longer period of acquiescence would be necessary than where there was no fraud" (*c*). But a long delay may be regarded as rendering harmless that which might at an earlier period have been regarded as a misrepresentation (*d*).

Rights must be actively defended.

It is not a sufficient answer to a plea of delay on the part of the plaintiff for the plaintiff to allege continual assertions of his right. He must take some more decided measures. "What the plaintiffs mainly relied on was the continual claim on their part," says Turner, L. J. (*e*), "and no doubt they have not ceased to assert their claim; but I cannot agree to a doctrine so dangerous as that the mere assertion of a claim, unaccompanied by any act to give effect to it, can avail to keep alive a right which would otherwise be precluded" (*f*).

No delay where no knowledge.

But where a trade mark has been infringed, and the

182; *Lea* v. *Deakin*, 11 Biss. 23 (where the plaintiffs had previously failed in England in an action against the defendant's principal); *Collins Co.* v. *Ames & Sons*, 20 Bl. C. C. 542; *Funke* v. *Dreyfus*, 34 La. Ann. 80; *Blacknell* v. *McElwee*, 100 N. C. 150. The same was formerly the case on demurrer.

(*a*) 9 Ch. D. 176.

(*b*) *Rodgers* v. *Philp*, 1 U. S. Pat. Gaz. 29; and see *Wolfe* v. *Barnett*, 24 La. Ann. 97; *Sanders* v. *Jacob*, 20 Mo. App. 96.

(*c*) *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. (E.) 98; but compare *In re Heaton*, 27 Ch. D. 570.

(*d*) *Marquis of Londonderry* v. *Russell*, 3 Times L. R. 360.

(*e*) *Clegg* v. *Edmonton*, 8 De G. M. & G. 810.

(*f*) This dictum was approved and followed by Wood and Selwyn, L. JJ., in *Lehmann* v. *McArthur*, L. R. 3 Ch. 496; but see *Attorney-General* v. *Sheffield Gas Consumers' Co.*, 3 De G. M. & G. 327; and *Kinahan* v. *Bolton*, 15 Ir. Ch. 75.

owner has not been aware that this has been the case, he has been guilty of no delay in taking no steps to put an end to the fraud, and he will, therefore, not be deprived of his rights by reason of his having taken no proceedings while he was ignorant of the infringement (*a*). Hence, where a defence of delay is set up, the evidence must go to show, not merely that the plaintiff might have been aware of the infringement which was going on, but that he actually was so, and that it was with such knowledge that he remained quiescent (*b*).

Delay by retiring partner.

It has been held in America that if a member of a partnership retires therefrom without setting up any claim to an interest in the trade mark, and makes no objection to its being used by the continuing partner, he must be taken to acquiesce in its being appropriated by the latter (*c*); but that if, on the other hand, a partner submits to the appropriation of the firm trade mark by his partner, at a time when he is, in a measure, in the latter's power, by reason of the latter being in sole possession of an important secret used in the business, he will be held not to have lost his right (*d*); and that a continued user of the mark by the retiring partner, even on a spurious article, is evidence that he does not intend to give up his rights therein (*e*).

Delay for purpose of securing evidence.

Inasmuch as in a case where no proof of actual deception is produced, the Court has to try a hypothetical case, turning on the probabilities of deception, as to which witnesses could probably be brought forward by both sides,

(*a*) *Weldon* v. *Dicks*, 10 Ch. D. 247; *In re Farina* (2), 27 W. R. 456; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398; *Apollinaris Co.* v. *Herrfeldt*, 4 P. R. 478; *Williams* v. *Adams*, 8 Biss. 452; *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601; *Celluloid Manufacturing Co.* v. *Cellonite Manufacturing Co.* 32 Fed. Rep. 94. Compare *In re Heaton*, 27 Ch. D. 570.

(*b*) *Siegert* v. *Findlater*, 26 W. R. 462.

(*c*) *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337; *Simpson* v. *Wright* (1), 15 *ib.* 248; *Holt* v. *Menendez*, 128 U. S. Rep. 182.

(*d*) *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54.

(*e*) *Wright* v. *Simpson*, 15 U. S. Pat. Gaz. 968.

a person who believes others to be infringing his trade mark is entitled to wait until he can collect a sufficient number of cases to prove to the Court that the proceedings of which he complains do actually deceive the public; and his right to protection is not gone by reason of such delay (*a*). It seems that in *Rodgers* v. *Rodgers* (*b*), and *Estcourt* v. *Estcourt Hop Essence Co.* (*c*), the delay would have been condoned had it resulted in the production of satisfactory evidence of deception. On the other hand, where a plaintiff delayed his motion until December, having been in possession of sufficient evidence in May, the delay was fatal to the motion (*d*).

Delay in regard to motion to commit.

Where an injunction has been granted by the Court, there must, in order to deprive the party who has obtained the injunction of his right to move for committal upon the breach of it, be a case made out almost amounting to such a licence to the party enjoined to do the act enjoined against as would entitle him to maintain an action against others for doing that act (*e*).

Indulgence to defendant, plaintiff having delayed.

Even if the delay has not been such as to disentitle the plaintiff to his injunction, it may yet obtain some indulgence for the defendant; as, for instance, the permission to dispose of the wares on which he expended money in consequence of the plaintiff's delay (*f*).

Account or damages withheld.

Or, the injunction may be granted and the account of profits or damages, by which it is usually accompanied, withheld (*g*).

(*a*) *Lee* v. *Haley*, L. R. 5 Ch. 155; *Cave* v. *Myers*, Dig. 304.

(*b*) 31 L. T. N. S. 285.

(*c*) L. R. 10 Ch. 276.

(*d*) *Isaacson* v. *Thompson*, 41 L. J. Ch. 101.

(*e*) Per Turner, L. J., in *Rodgers* v. *Nowill*, 3 De G. M. & G. 614. In *Cartier* v. *May*, Dig. 200, a delay of eighteen months was one of the grounds on which the motion to commit was refused.

(*f*) *Clowes* v. *Hogg*, W. N. 1870 p. 268; S. C. on appeal, W. N. 1871, p. 40; *Anglo-Swiss Condensed Milk Co.* v. *Swiss Condensed Milk Co.*, W. N. 1871, p. 163.

(*g*) *Harrison* v. *Taylor*, 11 Jur. N. S. 408; *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Carver* v. *Bowker*, Dig. 581; *Holt* v. *Menendez*, 128 U. S. Rep. 182; *Low* v. *Fells*, 35 Fed. Rep. 361; and see *Beard* v. *Turner*, 13 L. T. N. S. 746.

Costs not given.

Lastly, the delay of the plaintiff may be punished by his being left to pay his own costs, though successful in his main contention (*a*). On the other hand, a defendant who has only defeated the plaintiff's claim by pleading the latter's delay, may fail to obtain thereby the costs of the proceedings occasioned by his own fraud (*b*).

8. *Plaintiff's Misrepresentation.*

8. Plaintiff's misrepresentation.

"The administration of Equity is founded on perfect truth" (*c*), and "when the owner of a trade mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not, in his trade mark, or in the business connected with it, be himself guilty of any false or misleading representation; for if the plaintiff makes any material false statement in connection with the property which he seeks to protect, he loses, and very justly, his right to claim the assistance of a Court of Equity. He must come there with clean hands" (*d*).

It is impossible to define what misrepresentation will disentitle the plaintiff to relief; all that can be said is,

(*a*) See *Millington* v. *Fox*, 3 My. & Cr. 338; *Beard* v. *Turner*, 13 L. T. N. S. 746; *Day* v. *Neale*, V. C. B., May 24th, 1881; *Perks* v. *Hall & Co.*, W. N. 1881, p. 111; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298.

(*b*) *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285.

(*c*) Per Lord Romilly, M. R., in *Cocks* v. *Chandler*, L. R. 11 Eq. 446.

(*d*) Per Lord Westbury, C., in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; and see *Edelston* v. *Vick*, 11 Hare, 78; *Post* v. *Marsh*, 16 Ch. D. 395; *Talbot* v. *Judges*, 3 Times L. R. 398; *Fetridge* v. *Wells*, 13 How. Pr. 385, R. Cox, 180; *Palmer* v. *Harris*, 60 Penn. 156, R. Cox, 523; *Laird* v. *Wilder*, 9 Bush, 131, 15 Amer. Rep. 707; *Wolfe* v. *Burke*, 56 N. Y. 115; *Consolidated Fruit Jar Co.* v. *Dorflinger*, 6 Am. L. T. N. S. 511; *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; *Seabury* v. *Grosvenor*, 14 Bl. C. C. 262; *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Connell* v. *Reed*, 128 Mass. 477; *Burton* v. *Stratton*, 12 Fed. Rep. 696; *McNair* v. *Cleave*, 10 Phila. 155; *Koehler* v. *Sanders*, 55 N. Y. Sup. Ct. 48; *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 752. Words which would be disentitled to protection in a court of justice by reason of their being calculated to deceive, are not to be registered under the Patents Act, 1883, § 73.

that "he that hath committed iniquity shall not have equity" (*a*).

Trade mark wrongfully adopted.

According to the American decisions (*b*), if it is proved that a plaintiff adopted his trade mark while an identical or similar trade mark was in use by another firm, he will himself be held to have acted wrongfully, and the trade mark so adopted will be refused protection.

Misstatements in plaintiff's marks.

The trade marks, labels, &c., of the plaintiff, who is complaining of fraud on the part of another, may themselves contain statements calculated to mislead and defraud the public, who are induced by such statements to buy goods which otherwise they would not buy. Thus, in *Pidding* v. *How* (*c*), the plaintiff sold tea which he termed "Howqua's Mixture," and which he put up in packets labelled with extravagant and false statements as to its origin and quality. Shadwell, V.-C. of E., declined to protect the plaintiff until he had established his title in a Court of Law, saying that it was a clear rule laid down by Courts of Equity not to extend their protection to persons whose case was not founded in truth.

Perry v. *Truefitt*.

In *Perry* v. *Truefitt* (*d*), the plaintiff sold "Perry's Medicated Mexican Balm," the secret of which he had bought from a Mr. Leathart. On his show-cards he falsely stated that the hair-mixture in question was made from a recipe of Von Blumenbach, and he also alleged in the same way that it was compounded from Mexican plants, which was not in the least borne out by evidence at the trial. Lord Langdale, M. R., agreeing with the observations of the Vice-Chancellor of England in *Pidding* v. *How* (*c*), did not think it a favourable case for the interposition of the Court, and ordered the matter to stand over, with liberty to bring an action.

(*a*) *Palmer* v. *Harris*, 60 Penn. St. 156, R. Cox, 523. See *Blackwell* v. *Armistead*, 5 Am. L. T. 85.

(*b*) *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576; *Parlett* v. *Guggenheimer*, 67 Md. 542; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776.

(*c*) 8 Sim. 477.

(*d*) 6 Beav. 66.

Leather Cloth Co.s' case.

In *Leather Cloth Co.* v. *American Leather Cloth Co.* (*a*), the House of Lords sustained the judgment of Lord Westbury, C. (*b*), and declined to protect the plaintiffs, who used a label or advertisement containing false statements as to the character and manufacture of their goods. Lord Westbury, C. (*b*), remarked, that he "could not receive it as a rule either of morality or of equity, that the plaintiffs were not answerable for a fraud because it might be so gross and palpable that no one was likely to be deceived by it. If there was a wilfully false statement, he would not stop to inquire whether it was too gross to mislead."

Cases in tobacco trade.

The tobacco trade has been fruitful in cases of this description. Thus, in *Wood* v. *Lambert* (*c*), John Wood & Son of London sold their English-made cigarettes sometimes in boxes labelled "cigarettes of the finest selected Turkish tobacco, manufactured by Jancal Tachta, Constantinople," sometimes in boxes labelled "St. Petersburg—P. Mavrogordato & Co.—cigarettes"; and it was held that the word "Eton," which had been used upon the boxes so labelled, was disentitled alike to registration and protection. So in *Newman* v. *Pinto* (*d*), where the plaintiff sold cigars in boxes branded with the Spanish words "La Pureza—Habana—Ramon Romnedo," and bearing labels on which appeared the words "La Pureza," the written signature of Ramon Romnedo (who was in fact a non-existent personage), and the arms of Spain and Havannah, and it was proved that the cigars, though made of Havannah tobacco, were imported from Bremen, and no evidence was given by the plaintiff as to the actual place of manufacture, it was held that the get-up of the goods was such as to represent that the cigars were manufactured in Havannah by Ramon Romnedo, and that the plaintiff, having failed to prove that this

(*a*) 11 H. L. C. 523.
(*b*) 4 De G. J. & S. 137.
(*c*) 32 Ch. D. 247.
(*d*) 57 L. T. N. S. 31.

representation was true, he was disentitled to sue in respect of his label, which was only used as part of the fraudulent get-up, which Bowen, L. J., described as "an elaborate concatenation of pictorial lies." In the United States also (*a*), and in Canada (*b*), labels used so as to represent that cigars not of Cuban manufacture were Cuban have been refused protection. And in a New South Wales case (*c*), where the defendant had been guilty of a similar misrepresentation, the judge not only granted an injunction at the instance of a trader whose mark had been pirated, but directed criminal proceedings for the fraud to be taken against the defendant.

Puffing.

In short, the Court will not protect a trade mark, label, &c., which contains, or has attached to it, a serious misstatement calculated to deceive (*d*). Mere puffing, however, or exaggerated statements as to the value, &c., of patent medicines, and similar preparations, will not disentitle their owners, since every one knows how to estimate the value of such statements correctly (*e*). Thus, in *Holloway* v. *Holloway* (*f*), the assumption of the title of "Professor" was disregarded; in *Metzler* v. *Wood* (*g*) it was held that the plaintiffs were not disentitled either by a representation that the publication was the 600th edition of the work, it being shown to be a trade custom to call 250 copies an edition; or by a statement that the

(*a*) *Palmer* v. *Harris*, 60 Penn. St. 156; *Schumacher & Ettlinger* v. *Schwenke* (2), 36 U. S. Pat. Gaz. 457.

(*b*) *Labbatt* v. *Trester*, 2 St. Dig. 726.

(*c*) *Heydo* v. *Witthowski*, 5 N. S. W. Rep. (E.) 74.

(*d*) In *Raggett* v. *Findlater*, L. R. 17 Eq. 29, costs were given against the plaintiff mainly on account of a misstatement by him.

(*e*) *Holloway* v. *Holloway*, 13 Beav. 209; *Comstock* v. *White*, 18 How. Pr. 421, R. Cox, 232; *Smith* v. *Woodruff*, 48 Barb. 438, R. Cox, 373. In America puffing has frequently been treated somewhat more severely: *Fowle* v. *Spear*, 7 Penn. L. J. 176, R. Cox, 67; *Heath* v. *Wright*, 3 Wall. Jr. 1, R. Cox, 154; *Fetridge* v. *Wells*, 13 How. Pr. 385, R. Cox, 180; *Fetridge* v. *Merchant*, 4 Abb. Pr. 156, R. Cox, 194; *Hobbs* v. *Français*, 19 How. Pr. 567, R. Cox, 287; *Phalon* v. *Wright*, 5 Phila. 464, R. Cox, 307; *Laird* v. *Wilder*, 9 Bush, 131; 15 Amer. Rep. 707; *Wolfe* v. *Burke*, 56 N. Y. 115. But see *Ellis* v. *Zeilon & Co.*, 42 Ga. 91.

(*f*) 13 Beav. 209.

(*g*) 8 Ch. D. 606.

work was specially revised by the author, the fact being that a previous edition which the present one followed had been so revised. In *Hogg* v. *Kirby* (*a*), the defendant, who had brought out what he intended to be taken for a continuation of the plaintiff's magazine, set up in his defence the fact that the plaintiff's magazine untruly professed to be by "William Granger, Esq." Lord Eldon granted the injunction; and it is certainly improbable that any one could be injured by the use of a name previously unknown (*b*).

Melachrino v. *Melachrino.*

Again, in *M. Melachrino & Co.* v. *R. Melachrino & Co.* (*c*), it was held that the plaintiffs were not disentitled, either because they placed the word "registered" on their trade mark as used, though it differed from the registered trade mark in having what were blank spaces in the latter filled in with coats-of-arms, nor because they sold their cigarettes as "Egyptian cigarettes," whereas on one occasion they had re-made in England with Egyptian tobacco a small quantity of cigarettes which had been damaged on the voyage from Egypt to England. And it has been held in America that the use of the word "imported" in connection with goods of home-manufacture does not disentitle the plaintiff, if the word is used without intention to deceive and does not produce that effect (*d*).

False statement in foreign language.

If the misrepresentation is in other respects such as to disentitle, the fact of its being made in a foreign language does not necessarily save the plaintiff from losing the rights which he would have had if no such statements had been made (*e*).

Use of predecessor's name.

The use of the name of his predecessor by one who has succeeded him in business, when such use will not lead to any other supposition than that the business is the

(*a*) 8 Ves. 215.
(*b*) And see *Dale* v. *Smithson*, 12 Abb. Pr. 237, R. Cox, 282; *Meriden Britannia Co.* v. *Parker*, 39 Conn. 450, 12 Amer. Rep. 401.
(*c*) Chitty, J., May 27th, 1888.
(*d*) *Funke* v. *Dreyfus*, 34 La. Ann. 80.
(*e*) *Palmer* v. *Harris*, 60 Penn. St. 156; R. Cox, 523.

same (*a*), or the use of his own name, without more, by one whose name happens to be the same as that of another manufacturer (*b*), is not such a misrepresentation as to disentitle such a person to relief against fraud. But where a trader has been in the habit of labelling his goods (*e.g.* a particular medicine) with statements which refer to himself personally, and his successor in business continues to use the same statements, "a Court of Equity will extend no aid to sustain a claim to a trade mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article, and as to the place where it is manufactured, both of which particulars were originally circumstances to guide the purchaser of the medicine" (*c*).

Collateral misrepresentations made by the plaintiff, as, for instance, in an advertisement in the newspapers, do not necessarily disentitle him to protection (*d*). Nor do misstatements of so trifling a character as not to mislead purchasers (*e*), or statements not made till after the institution of the action (*e*). Collateral misrepresentations.

It is not the province of the Court, however, to protect speculations which aim at inducing the public to buy Fraudulent speculation.

(*a*) *Leather Cloth Co.s' case*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Churton* v. *Douglas*, Johns. 174; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Massam* v. *Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Fulton* v. *Sellers*, 4 Brews. 42; *Pepper* v. *Labrot*, 8 Fed. Rep. 29; *Société, &c., de la Benedictine* v. *Micalovitch*, 36 Alb. L. J. 364. But see *Sherwood* v. *Andrews*, 3 Am. L. Reg. N. S. 588; *Partridge* v. *Menck*, 2 Sandf. Ch. 622; *Carmichel* v. *Latimer*, 11 R. I. 395; *Horton Manufacturing Co.* v. *Horton Manufacturing Co.*, 18 Fed. Rep. 816.

(*b*) *Holloway* v. *Holloway*, 13 Beav. 209; *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Turton* v. *Turton*, 42 Ch. D. 128; *Tussaud* v. *Tussaud*, 38 W. R. 503.

(*c*) Per U. S. Supreme Court in *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218. And see *Hazard* v. *Caswell*, 93 N. Y. 259; *Siegert* v. *Abbott*, 61 Md. 276; *Stachelberg* v. *Ponce*, 23 Fed. Rep. 430.

(*d*) *Curtis* v. *Bryan*, 2 Daly, 212, R. Cox, 434; and see *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*e*) *Siegert* v. *Findlater*, 7 Ch. D. 801. (But this case was questioned in *Siegert* v. *Abbott*, 61 Md. 276.) *Alexander* v. *Morse*, 14 R. I. 153; *Moxie Nerve Food Co.* v. *Baumbach*, 32 Fed. Rep. 205. Thus, in *Blackwell* v. *Armistead*, 5 Am. L. T. 85, a misstatement as to the date of commencement of the business, made in *bonâ-fide* error by a junior partner, was condoned.

one thing when they think they are buying another; and therefore, where both plaintiffs and defendant were engaged in speculations of that character, although the Court refused, on the ground of the plaintiffs' delay, to grant the injunction they prayed, it declined to give costs to the defendant, who was *in pari delicto* (*a*). And on similar grounds relief will be refused to a plaintiff who has used his trade mark on goods of inferior quality to those with which the mark has become associated (*b*), or who has used the mark beyond the limits to which he was confined on the assignment of it to him (*b*), or who adopted it in infringement of the rights of another (*c*).

Hogg v. *Maxwell.*

In *Hogg* v. *Maxwell* (*d*) the plaintiff registered, under the Copyright Acts, the title of an intended magazine in 1863, but did not bring out the work. In June 1866 the defendant registered the same name. The plaintiff discovered this in August. He then hastened on his own publication, which was first announced on September 24th, and published next day. In the meantime the plaintiff had, on the 19th, undertaken to advertise the defendant's intended magazine, but retracted the undertaking, and gave the defendant notice of his claim to the title on the 25th. Proceedings were taken by both parties with a view to an injunction, which was refused in both cases, the Court being of opinion, in *Hogg* v. *Maxwell*, that the plaintiff had got beforehand by improper means, which disentitled him to relief.

(*a*) *Estcourt* v. *Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; and see *In re Saunion & Co.*, Dig. 625; *Newman* v. *Pinto*, 57 L. T. N. S. 31; *Samuel* v. *Berger*, 24 Barb. 163, R. Cox, 178; *Bloss* v. *Bloomer*, 23 Barb. 604, R. Cox, 200; *In re American Sardine Co.*, 3 U. S. Pat. Gaz. 495; *In re Dole Bros.*, 12 *ib.* 939; *In re Warburg & Co.*, 13 *ib.* 44; *Ex parte Marsching & Co.*, 15 *ib.* 294; *Ex parte Knapp*, 16 *ib.* 318; *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337, with which compare *In re Green*, 8 U. S. Pat. Gaz. 729.

(*b*) *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218.

(*c*) *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576; *Parlett* v. *Guggenheimer*, 67 Md. 542; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776. And see *In re Heaton*, 27 Ch. D. 570.

(*d*) L. R. 2 Ch. 316.

Short weight.

The Court will not protect persons in carrying on a trade in which short measure is given systematically and knowingly (*a*). And in *Hennessy* v. *Wheeler* (*b*), the New York Court of Common Pleas refused relief to brandy merchants who sold their brandy in bottles containing quarts and pints of nominal measure, but really considerably less. But this decision was reversed on appeal, on the ground that the bottles were not bought on the faith of their containing any particular quantity of brandy, and that no one was proved to have been deceived or was likely to be so. Similarly, where the plaintiff admitted that his medical preparation was "sold only in quart bottles," and the bottles, though such as were commonly known in the trade as quart bottles, really contained substantially less, it was held that the misstatement was not such as to deprive the plaintiff of his right to protection (*c*).

9. *Word "Patent" improperly used by Plaintiff.*

9. Improper use of word "patent."

"It is impossible not to see," says Mellish, L. J., "that persons do try to use their right in trade marks for the purpose of getting a monopoly in particular articles, just as if they had a patent for the goods which they manufacture" (*d*). A special form of misrepresentation consists in the use by persons in their trade marks of words inducing the belief that they have a patent for the articles to which those trade marks are affixed; and the tendency which the use of such words has to procure for the persons using them an unfair monopoly, or to prolong a monopoly granted only for a limited time, causes it to be regarded with special disfavour. The importance of the point is forcibly pointed out by

(*a*) See per Giffard, L. J., in *Lee* v. *Haley*, L. R. 5 Ch. 155.

(*b*) 51 How. Pr. 457; 69 N. Y. 271.

(*c*) *Alexander* v. *Morse*, 14 R. I. 153.

(*d*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-56.

Wood, V.-C., in *Morgan* v. *McAdam* (*a*). He says: "All those who are induced to buy these crucibles thus described as 'Patent Plumbago Crucibles,' are to a certain extent deceived, because they are led to believe that the article is protected by a patent, and thus may be induced to purchase it from the plaintiffs, under the belief that there is a patent, and that the plaintiffs, or at least some limited number of persons, are the only persons authorised to sell it; and further, they are led to believe that if they should be minded to set up any manufactory of the same kind for themselves, they would be unable to do so in consequence of the plaintiffs being the possessors, either by way of licence or ownership, of a patent preventing the world at large from imitating the article which is sold by them under this particular designation" (*b*).

Plaintiff disentitled.

Where, therefore, the plaintiff has used in his trade mark the word "patent," or words to that effect, although, in point of fact, he has never had a patent for the goods to which the mark is applied, the Court will refuse to extend to him the protection which he has forfeited. Previously to Sir John Rolt's Act (*c*), liberty was given to the plaintiff to bring an action at law (*d*); but since then the action has been simply dismissed, with or without costs (*e*). And the course would be the same if the words were first inserted in the trade mark after the expiration of a patent which had existed (*f*). In *Sykes* v.

(*a*) 36 L. J. Ch. 228.

(*b*) And see per the same learned judge, in *Flavel* v. *Harrison*, 10 Hare, 467.

(*c*) 25 & 26 Vict. c. 27.

(*d*) *Flavel* v. *Harrison*, *ubi suprà*, 467.

(*e*) *Morgan* v. *McAdam*, 36 L. J. Ch. 228; *Lamplough* v. *Balmer*, W. N. 1867, p. 293; *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 352; *Nixey* v. *Roffey*, W. N. 1870, p. 227; and see *Ford* v. *Foster*, L. R. 7 Ch. 611. In *Stewart* v. *Smithson*, 1 Hilt. 119, R. Cox, 175, the Court of C. P. of New York refused to recognise this as a defence; but the word "patent" has been refused registration in America in connection with an article made under an expired patent (*In re Richardson*, 3 U. S. Pat. Gaz. 120), and in *In re Consolidated Fruit Jar Co.*, 14 *ib.* 269, the name of a patentee was refused registration. But see *Ex parte Consolidated Fruit Jar Co.*, 16 *ib.* 679.

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

Sykes (*a*), a patent had been taken out by the plaintiff's father. That patent was held to be invalid, on account of a defect in the specification, but the use of the word "patent" was not held to disqualify the plaintiff from recovering at law. The question does not seem, however, to have been fairly raised in that early case, and it has been held in America that marks containing a reference to a patent declared to be invalid could not be protected by injunction (*b*).

Retention of word after expiration of patent.

There has been some apparent difference of opinion in regard to the case in which the word "patent" has been inserted in the trade mark while the article was still patented, and has been retained there after the patent has run out. In such a case (*c*), Wood, V.-C., held that the plaintiffs were entitled to recover, the blocks for the labels having been made during the existence of the patent, when the representation was perfectly true. Lord Kingsdown, in discussing this judgment (*d*), said that he agreed with it if the word "patent" were only used as part of the designation of an article, but that he could not do so if the trade mark represented the article as protected by an existing patent. In a subsequent case (*e*), the Vice-Chancellor explained his meaning as being in harmony with that of Lord Kingsdown. "If originally you have a patent, and the article is in the market as a patent article, and you stamp all your goods which are sent out with these words 'patent pins,' or patent wire,' or whatever the particular article might be, at the end or the expiration of the patent it is not necessary, as I thought, to call in the whole of the previous stamps, and remodel the whole of your stamps, and have a new form of packing your article, in order that you may

(*a*) 3 B. & Cr. 541.

(*b*) *Consolidated Fruit Jar Co.* v. *Dorflinger*, 6 Am. L. T. N. S. 511.

(*c*) *Edelsten* v. *Vick*, 11 Hare, 78. And see *Leather Cloth Co.* v. *Hirschfeld* (1), 1 N. R. 551.

(*d*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523.

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

inform the world that the patent, which did exist, has expired. Of course it would be better, and those who are inclined to act with scrupulous honesty would take care, to put the date of their patent, which would obviate all difficulty (*a*), upon the articles which they designate as patented." In a later case (*b*), it was clearly established by the Court of Appeal that the principle enunciated by Lord Kingsdown is the rule of the Court, and that the use of the word "patent," so as to indicate an existing patent, is equally fatal, whether there has never been a patent for the article in question, or the patent which did exist has expired (*c*).

Word so used as not to deceive.

As has been seen, Lord Hatherley, when V.-C. (*d*), and Lord Kingsdown (*e*), were of opinion that when the word "patent" formed part of the name of an article, and did not operate so as to induce a belief in the existence of a patent, the trade mark in which the word appeared might be protected. A distinct decision to this effect was pronounced by James, V.-C., in *Marshall* v. *Ross* (*f*), where "patent thread" was compared by the learned judge to "patent leather boots" (*g*). And where the plaintiffs had described themselves as "patentees" of an article of which they had secured the exclusive manufacture by registration, though not by letters patent, it was held that they were not disentitled (*h*). In *Lauferty* v. *Wheeler* (*i*), it

(*a*) See *Consolidated Fruit Jar Co.* v. *Dorflinger*, 6 Am. L. T. N. S. 511; *Wilson* v. *Singer Manufacturing Co.*, 16 U. S. Pat. Gaz. 1091; *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337.

(*b*) *Cheavin* v. *Walker*, 5 Ch. D. 850. And see *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337; *New York Consolidated Card Co.* v. *Union Playing Card Co.*, 46 N. Y. Sup. Ct. 611.

(*c*) The penalties inflicted under § 105 of the Patents Act, 1883, for the improper use of the word "patent," are not, however, incurred by the continued use of the word upon goods for which a patent has previously been possessed.

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

(*e*) *Leather Cloth Co.s' case*, 1 H. L. C. 523.

(*f*) L. R. 8 Eq. 651.

(*g*) See the observations on this case, in *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 345. And see, too, *Ransome* v. *Graham*, 51 L. J. Ch. 897.

(*h*) *Cave* v. *Myers*, Dig. 304.

(*i*) 63 How. Pr. 488; 11 Daly 194.

was held that the plaintiff was not disentitled by reason of having described his goods as "Patent, Sept.," after being officially informed that his application for a patent had been allowed, but before the actual issue of letters patent. Similarly, it seems that a statement that a trade mark is registered before it in fact is so, does not disentitle the proprietor to sue, after registration has been effected (*a*), though it exposes the proprietor to a penalty (*b*), and may affect the costs of the action (*c*). Nor is the proprietor of a registered trade mark disentitled by the fact that he places the word 'registered' on his trade mark when in use, though spaces left blank in the mark as registered are filled in when it is in use (*d*).

When validity of patent doubtful.

A patentee is not bound to decide a doubt as to the validity of his patent adversely to himself, and consequently the plaintiff, in an action for infringement of a trade mark for boot-tips, was held not to be disentitled to relief by the fact that the word "patentee" appeared in his trade mark, he being the owner of an existing patent, notwithstanding that it had been shown that questions might be raised as to the validity of the patent, and the plaintiff had himself admitted that he had some doubt as to the validity (*e*).

Grossness of misrepresentation no excuse.

The fact that the misrepresentation is so gross as hardly to be capable of deceiving will not exonerate the person making it from the consequences. Thus, the use on untanned leather cloth of the words "tanned patented" was a ground for refusing assistance (*f*).

"Manufacturer and patentee."

Where a plaintiff described himself on his labels as "manufacturer and patentee," it was held that this was

(*a*) See per Brett, L. J., in *Read* v. *Richardson*, 45 L. T. N. S. 54.

(*b*) See Patents Act, 1883, § 105, *R.* v. *Morris*, Great Marlborough St. Police Court, Dec. 16th, 1886.

(*c*) *Harris* v. *Ogg*, 5 N. S. W. Rep. 114.

(*d*) *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(*e*) *Blakey* v. *Latham*, 85 L. T. (Journal) 47.

(*f*) *Leather Cloth Co.s' case*, 4 De G. J. & S. 137; 11 H. L. C. 523.

equivalent to describing the article as "patent," and the bill was dismissed, without costs (*a*). And in *Consolidated Fruit Jar Co.* v. *Dorflinger* (*b*), it was held that certain trade marks consisting of the words "Mason's Patent, November 30th, 1858," "Mason's Improved," and "The Mason Jar of 1858," were bad, the patent of 1858 being invalid by judicial decision.

Lamplough v. *Balmer.*

When a plaintiff used on his stopper labels with the words "Royal Letters Patent," the explanation that he had for twenty-five years paid the stamp duty on "patent medicines," and that he was only continuing to use the labels he had had on hand when he discovered his medicines did not belong to that class, was not accepted as satisfactory, and his motion for an injunction to restrain an imitator was refused (*c*).

Collateral use of word.

If, however, the plaintiff's trade is a perfectly honest trade, and the trade mark is a perfectly honest trade mark, the fact that the plaintiff has committed a purely collateral misrepresentation, by describing himself, though not in the trade mark itself, as "patentee," will not disentitle him to his remedy (*d*).

Patents Act, 1883.

By § 105 of the Patents Act, 1883 (*e*), it is provided

(*a*) *Nixey* v. *Roffey*, W. N. 1870, p. 227. And see Patents Act, 1883, § 105.

(*b*) 6 Am. L. T. N. S. 511.

(*c*) *Lamplough* v. *Balmer*, W. N. 1867, p. 293.

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

(*e*) This replaces § 7 of 5 & 6 Will. IV. c. 83. See *Myers* v. *Baker*, 3 H. & N. 802. In America a penalty is similarly assigned for the use of the word "Patented" on an unpatented article (U. S. Rev. St. § 4901. See *Wilson* v. *Singer Manufacturing Co.*, 16 U. S. Pat. Gaz. 1091; *Stimpson* v. *Pond*, 2 Curtis, 502). And an article which, together with patented elements, contains new and valuable unpatented elements, ought not, as a rule, to be termed "patented" (*Deverall* v. *Banker*, 45 U. S. Pat. Gaz. 591). But the penalty is only incurred if there is an intent to defraud (*Tompkins* v. *Butterfield*, 25 Fed. Rep. 556), and that question is for the jury (*Walker* v. *Hawxhurst*, 5 Bl. C. C. 494; *Deverall* v. *Banker*, 45 U. S. Pat. Gaz. 591); who are justified in convicting if they are reasonably satisfied upon the evidence as to the material facts, and proof beyond a reasonable doubt is not required; *Hawloetz* v. *Kass*, 25 Fed. Rep. 765; a corporation is responsible for the act of its superintendent in wrongfully describing an unpatented article as "patented," and will be liable to a penalty if he knew or should

that "any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered, which is not so, shall be liable for every offence on summary conviction to a fine not exceeding £5." And it is also provided that "a person shall be deemed, for the purposes of this enactment, to represent that an article is patented, or a design or a trade mark is registered, if he sells the article with the word 'patent,' 'patented,' 'registered,' or any word or words expressing or implying that a patent or registration has been obtained for the article, stamped, engraved or impressed on, or otherwise applied to the article." It has been held under this section that a person is subject to a penalty who represents an article to be patented, after he has applied for a patent and obtained provisional protection, but before the actual grant (*a*); and, similarly, where a person represents a trade mark to be registered, after he has applied for registration, and the application has been advertised in the "Trade Marks Journal," but before the actual registration (*b*).

Merchandise Marks Act.

By the Merchandise Marks Act, 1887, § 3 (1), a statement "as to any goods being the subject of an existing patent, privilege, or copyright," is, if untrue, a "false trade description" punishable under the Act. Under § 18, however, the provisions of the Act with respect to false trade descriptions are not to apply to the use of a trade description which "is lawfully and generally applied to goods of a particular class, or manufactured by a particular

have known that the article was not patented, but not if he *bonâ fide* believed it was so: *Tompkins* v. *Butterfield*, 25 Fed. Rep. 556. In *U. S.* v. *Morris* (2 Bond, 23), Leavitt, J., held that the statute did not apply unless the goods were patentable; but in *Oliphant* v. *Salem Flouring Mills* (5 Sawy. 128), Deady, J., held that it applied whether the goods were patentable or not.

(*a*) *R.* v. *Wallis*, 3 P. R. 1; *R.* v. *Crampton*, 3 P. R. 367.

(*b*) *R.* v. *Morris*, Great Marlborough St. Police Court, Dec. 16th, 1886.

method, to indicate the particular class or method of manufacture of such goods." This will protect such combinations as "patent thread," in *Marshall* v. *Ross* (*a*), or "patent leather boots."

Inoperative Defences.

Among the defences which have occasionally been set up in actions for infringement of trade mark, but without success, are the following:

Ignorance

Ignorance of the plaintiff's rights. This will not suffice to prevent the issue of the injunction (*b*); although it may have the effect of relieving the defendant from the necessity of accounting (*c*).

No intention to sell.

Absence of intention to sell the goods bearing the spurious mark is no defence (*d*).

No actual deception or fraud.

Absence of proof of actual deception or fraudulent intention is no defence, if in the opinion of the Court or jury there is such imitation as to be calculated to deceive (*e*).

Immediate purchasers not deceived.

It is no defence to prove that all the persons who bought from the defendant goods bearing the plaintiff's mark were well aware that they were not of the plaintiff's manufacture (*f*).

(*a*) L. R. 8 Eq. 651.

(*b*) *Burgess* v. *Hills*, 26 Beav. 244; *Geary* v. *Norton*, 1 De G. & S. 9; *Cartier* v. *Carlile*, 31 Beav. 292; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Moet* v. *Couston*, 33 Beav. 578; *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185; *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178; *Upmann* v. *Forester*, 24 Ch. D. 231; and other cases.

(*c*) *Edelsten* v. *Edelsten*, *ubi suprà*; *Moet* v. *Couston*, *ubi suprà*; *Rose* v. *Loftus*, 47 L. J. Ch. 576.

(*d*) *Upmann* v. *Forester*, 24 Ch. D. 231. See *Upmann* v. *Currey*, 29 Sol. J. 735.

(*e*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Cope* v. *Evans*, L. R. 18 Eq. 138; *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371; *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185; *Coats* v. *Holbrook*, 2 Sandf. Ch. 586, R. Cox, 20; *Taylor* v. *Carpenter*, 11 Paige, 292; 2 Sandf. Ch. 603, R. Cox, 45; *Coffeen* v. *Brunton*, 4 McLean, 516, 5 *ib.* 256; R. Cox, 82, 132; *Davis* v. *Kendall*, 2 R. I. 566, R. Cox, 112; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Shaver* v. *Shaver*, 54 Iowa, 208; *Williams* v. *Brooks*, 50 Conn. 278; and see Ch. IV., on Infringement.

(*f*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; *Edelsten* v. *Edelsten*, *ubi suprà*; *Rose* v. *Loftus*, 47 L. J. Ch. 576; *Singer Manufacturing Co.* v. *Loog*

Nor to say that the marks used indicate quality or pattern, if they also indicate a particular manufacturer or merchant (*a*). Indication of quality as well as manufacturer.

Nor to show that the words, of the use of which the plaintiff complains, are ambiguous and capable of being understood by different persons in different ways (*b*). Words ambiguous.

Nor to say that the plaintiff's entire mark has not been copied (*c*). Only part of mark taken.

Nor to say that the name, to the use of which by the defendant the plaintiff objects, is the defendant's own, if he has used it so as to deceive (*d*). Name used is defendant's own.

Nor to produce a colourable authority to use the name of a person having the same name as that used by the plaintiff in his business (*e*). Colourable authority.

Nor to say that the goods which the defendant is selling under the mark in question are goods manu- Goods plaintiff's own of different quality.

(3), 8 App. Cas. 15; *Balfour & Co.* v. *Kilburn & Co.*, 1 Hyde, 270; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454; and cases at p. 145 *suprà*.

(*a*) See cases at p. 69 *suprà*.

(*b*) *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15, per Lord Selborne, C.; *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., March 27th, 1888.

(*c*) *Ford* v. *Foster*, L. R. 7 Ch. 611; *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; *Shaver* v. *Shaver*, 54 Iowa, 208; and see cases at pp. 150-1 *suprà*.

(*d*) *Churton* v. *Douglas*, Johns. 174; *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Pullar* v. *Pullar*, Fry, J., April 9th, 1883; *Nicholls* v. *Kimpton*, 3 Times L. R. 674; *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888; *Warner* v. *Warner*, 5 Times L. R. 359; *Shaver* v. *Shaver*, 54 Iowa, 208; *India-Rubber Comb Co.* v. *Rubber Comb and Jewelry Co.*, 45 N. Y. Super. Ct. 258; *Rogers Manufacturing Co.* v. *Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495; *Russia Cement Co.* v. *Le Page*, 147 Mass. 206; *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306; and see cases at p. 138.

(*e*) *Perry* v. *Truefitt*, 6 Beav. 66; *Croft* v. *Day*, 7 Beav. 84; *Moet* v. *Clybourn*, Dig. 533; *Dence* v. *Mason* (1), Dig. 534; 41 L. T. N. S. 573; *Williams* v. *Johnson*, 2 Bos. 1; *Phalon* v. *Wright*, 5 Phila. 464; *Perks* v. *Hall & Co.*, W. N. 1881, p. 111; *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601; *Meriden Britannia Co.* v. *Parker*, 39 Conn. 450, 12 Amer. Rep. 401; *Wolfe* v. *Barnett*, 24 La. Ann. 97, 13 Amer. Rep. 111; *Melachrino & Co.* v. *Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *Birmingham Vinegar Brewery Co., Ld.* v. *Liverpool Vinegar Co., Ld.*, W. N. 1888, p. 139; *Williams* v. *Brooks*, 50 Conn. 278; *Rogers Manufacturing Co.* v. *Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495. But see *Beard* v. *Turner*, 13 L. T. N. S. 746; *Hallett* v. *Cumston*, 110 Mass. 29; *Ayer* v. *Rushton*, 7 Daly, 9; *Dence* v. *Brand*, W. N. 1881, p. 31.

factured by the plaintiff, if they are of a different quality from that of which the defendant represents them to be (*a*).

Equality in quality.

Nor to say that the spurious goods are equal in quality to the genuine ones, for the plaintiff's right is equally invaded (*b*).

Addition of defendant's name.

The defendant will not escape by showing that he has used his own name in conjunction with the mark or word which is alleged to be used in infringement of the plaintiff's rights (*c*).

Addition of address.

Nor by showing that he has always placed his own address on the goods (*d*).

(*a*) *Hennessy* v. *Kennett*, Dig. 556; *Hennessy* v. *White*, 6 W. W. & A'B. Eq. 216; *Hennessy* v. *Hogan*, *ib.* 225; *Gillott* v. *Kettle*, 3 Duer, 624.

(*b*) *Blofeld* v. *Payne*, 4 B. & Ad. 410; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (per Lord Westbury, C., "It is not necessary, for the injunction, to prove . . . that the credit of the plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief"); *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15, per Lord Blackburn; *Coats* v. *Holbrook*, 2 Sandf. Ch. 586, R. Cox, 20; *Taylor* v. *Carpenter*, 11 Paige, 292; 2 Sandf. Ch. 603, R. Cox, 45; *Partridge* v. *Menck*, 2 Barb. Ch. 101, 1 How. App. Cas. 558, R. Cox, 72; *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392; *Shaver* v. *Shaver*, 54 Iowa, 208; *Coffeen* v. *Brunton*, 5 McLean, 256, R. Cox, 132.

(*c*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376; *Siegert* v. *Findlater*, 7 Ch. D. 801; *Braham* v. *Bustard*, 1 H. & M. 447; *Ford* v. *Foster*, L. R. 7 Ch. 611; *Kinahan* v. *Bolton*, 15 Ir. Ch. 75; *Eno* v. *Stephens*, Dig. 609; *Rose* v. *Loftus*, 47 L. J. Ch. 576; *Field* v. *Lewis*, Dig. 280; *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57; *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70; *Lea* v. *Wolff*, 15 Abb. Pr. N. S. 1; *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402; *Siegert* v. *Ehlers*, Dig. 432; *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523; *Roberts* v. *Sheldon*, 8 Biss. 398; *Hier* v. *Abrahams*, 82 N. Y. 519; *Hegeman & Co.* v. *O'Byrne*, 9 Daly, 264; *Carroll* v. *Ertheiler*, 1 Fed. Rep. 688; *Fleischmann* v. *Schuckmann*, 62 How. Pr. 92. But compare *Cheavin* v. *Walker*, 5 Ch. D. 850; *Barrett* v. *Gomm*, 74 L. T. (Journal) 388; *Barrett* v. *White*, North, J., May 12th, 1883; *Magee Furnace Co.* v. *Le Barron*, 127 Mass. 115; *Thornton* v. *Crowley*, 47 N. Y. Super. Ct. 527; *Somerville* v. *Schembri*, 12 App. Cas. 453; *McCall* v. *Theal*, 28 Grant Up. Can. Ch. 48; *Pratt's Appeal*, 117 Penn. St. 401; *Moxie Nerve Food Co.* v. *Baumbach*, 32 Fed. Rep. 205; *Leonard & Ellis* v. *White's Golden Lubricator Co.*, 48 U. S. Pat. Gaz. 1401; *Bryant & May* v. *Heyde*, 7 N. S. W. Rep. (E.) 72.

(*d*) *Gray* v. *Taper Sleeve Pulley Works*, 16 Fed. Rep. 436.

Addition of word "Improved."

Nor by showing that he has used the word "Improved" in connection with his goods (*a*).

User by others.

Nor by showing that the same mark has been used by other persons on goods of another class (*b*), or by less than three firms besides the plaintiff on goods of the same class (*c*), or by different firms abroad, if not in England (*d*).

Fraudulent anticipation.

Nor by showing that another trader used the mark before the plaintiff, if that other trader's right to the mark has been adjudged to be gone by reason of misrepresentations contained in it (*e*).

Infringement by others.

Nor by showing that the plaintiff's trade mark has been infringed by others without his knowledge or acquiescence (*f*).

A plurality of marks or names.

It is no defence to say that the plaintiff uses more than one trade mark on the same goods (*g*), nor that his goods have been known by a variety of names (*h*).

Additions in practice to marks as registered.

Nor that the plaintiff in practice uses devices, &c., on his trade marks which are not registered as part of them—*e.g.*, filling in blank spaces with coats-of-arms (*i*).

Infringement in district of a licensee.

Nor that the infringement has been committed in a district in which the plaintiff has appointed a licensee (*k*).

(*a*) *Russia Cement Co.* v. *Le Page*, 147 Mass. 206; *Alexander* v. *Morse*, 14 R. I. 153; *Humphreys' Specific, &c., Co.* v. *Wenz*, 14 Fed. Rep. 250; *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

(*b*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *Somerville* v. *Schembri*, 12 App. Cas. 453; *Colman* v. *Crump*, 70 N. Y. 573; *Hegeman & Co.* v. *O'Byrne*, 9 Daly, 264; *Celluloid Manufacturing Co.* v. *Cellonite Manufacturing Co.*, 32 Fed. Rep. 94.

(*c*) *Dent* v. *Turpin*, 2 J. & H. 139; *Dunnachie* v. *Young & Sons*, Ct. Sess. Cas., 4th Ser. X. 874; and cases at p. 118.

(*d*) *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson* v. *Napper*, 35 Ch. D. 162; *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.). So in Canada: *Smith* v. *Fair*, 14 Ont. Rep. 729.

(*e*) *Parlett* v. *Guggenheimer*, 67 Md. 542.

(*f*) *Fird* v. *Foster*, L. R. 7 Ch. 611; *Taylor* v. *Carpenter*, 3 Story, 458, R. Cox, 14; *Filley* v. *Fassett*, 44 Mo. 173, R. Cox, 530.

(*g*) *Braham* v. *Bustard*, 1 H. & M. 447; *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284.

(*h*) *Orr-Ewing & Co.* v. *Johnston & Co.* 13 Ch. D. 434.

(*i*) *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.); *Melachrino* v. *Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(*k*) *Moxie Nerve Food Co.* v. *Baumbach*, 32 Fed. Rep. 205.

Puffing.

Mere exaggerated statements of the merits of medical or other compounds on the part of the plaintiff, which do not amount to fraud, will not exonerate the defendant from the consequences of his own fraud (*a*). Nor will other statements by the plaintiff, which, though not absolutely correct, cannot mislead in any important respect (*b*)—*e.g.*, an allegation that the plaintiff's mark was registered before registration had actually been effected (*c*); or the putting the word "registered" on the mark as used, though spaces left blank in the mark as registered are filled in (*d*).

Slight delay.

The defendant will not escape by alleging laches on the part of the plaintiff in prosecuting his action, if no greater delay has taken place than was requisite to enable necessary evidence to be obtained (*e*).

Infancy.

Infancy is no defence, for "if an infant practises a fraud, he is liable for the consequences" (*f*), and he will be in the same position as an adult with respect to the payment of costs (*g*). And so with a married woman having separate estate (*h*).

Defendant's mark registered.

Registration of the defendant's mark at Stationers' Hall, or in the trade marks register (*c*), is no defence (*i*).

Interference with defendant's business.

Nor is it any defence to say that an injunction, if granted, would interfere with the defendant's business, or with that of other manufacturers, since they will be able to trade as they please, with the sole exception of using the plaintiff's trade mark (*k*).

(*a*) *Holloway* v. *Holloway*, 13 Beav. 209; *Metzler* v. *Wood*, 8 Ch. D. 606; *Comstock* v. *White*, 18 How. Pr. 421. See cases at p. 231.

(*b*) *Siegert* v. *Findlater*, 7 Ch. D. 801.

(*c*) *Read* v. *Richardson*, 45 L. T. N. S. 54.

(*d*) *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(*e*) *Lee* v. *Haley*, L. R. 5 Ch. 155; *Cave* v. *Myers*, Dig. 304. See *McLean* v. *Fleming*, 96 U. S. Rep. 245.

(*f*) Per Plumer, V.-C., in *Cory* v. *Gertoken*, 2 Madd. 49.

(*g*) *Chubb* v. *Griffiths*, 35 Beav. 127.

(*h*) *Nicholls* v. *Kimpton*, 3 Times L. R. 674.

(*i*) *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57. And see cases at p. 157.

(*k*) *Ransome* v. *Graham*, 51 L. J. Ch. 897. See *Cope* v. *Evans*, L. R. 18 Eq. 138; *Bass* v. *Dawber*, 19 L. T. N. S. 626.

Discovery and Inspection.

Discovery.

The plaintiff in a trade-mark case sometimes thinks it advisable, for the purposes of his action, to obtain from the defendant a disclosure of certain particulars of his business—as, for instance, of the names of customers to whom the goods alleged to be marked with the plaintiff's trade mark have been sold, or on whose account such goods have been conveyed.

Principles on which given.

The principles on which this advantage is given or withheld are thus stated by Lord Hatherley, C. (*a*): "The Court does not, when discovery is a matter of indifference to the defendant, weigh in golden scales the question of materiality or immateriality; but where the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other, it is bound to protect the defendant against undue inquisition into his affairs. The question of materiality must be tested by reference to the case made by the plaintiff's pleadings, and to what will be in issue at the hearing."

Not given where oppressive.

"The more strict the Court is in compelling a full answer, the more necessary it is that the Court should be vigilant in seeing that the process of the Court is not made use of in an oppressive manner" (*b*). Where, therefore, the L.JJ. were of opinion that the discovery asked was such as the plaintiff, even if he failed at the hearing, might yet afterwards use in a manner prejudicial to the defendant, and were not satisfied that there was any real prospect of its being of material service to the plaintiff at the hearing, they reversed the order of the

(*a*) *Moore* v. *Craven*, L. R. 7 Ch. 94.

(*b*) Per Selwyn, L. J., in *Lockett* v. *Lockett*, L. R. 4 Ch. 341. And see *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. N. S. 46.

Vice-Chancellor of Lancaster, by whom such discovery had been granted (*a*).

Benbow v. *Low.*

So in *Benbow v. Low* (*b*) the defendants exhibited interrogatories requiring the plaintiffs to state (*inter alia*) what quantities of soap had been sold by them bearing the name in dispute, between the dissolution of the original partnership and the date of the action, distinguishing between the quantities sold in each year, and between the quantities sold in England and in the United States and in the continent of Europe; and Bacon, V.-C., and the Court of Appeal held that the plaintiffs were justified in refusing to answer, as the question was framed, not for the ordinary purposes of discovery, but in order to get at the details of a part of the plaintiff's evidence.

Given when necessary.

On the other hand, "the Court, while it takes care that no oppressive use is made of its forms of procedure, must take care that parties are not allowed to refuse discovery which they ought to make" (*c*). Where, therefore, a defendant who, having been the agent in London of the plaintiff, an American sewing-machine maker, continued, after dismissal, to advertise himself as the plaintiff's agent, and to sell as "the Howe Sewing Machine" machines not made by the plaintiff, and refused to give discovery of all the machines sold by him, with the prices, profits, names of purchasers, and other particulars, on the ground that he would thereby disclose the names of his customers and the secrets of his trade, Romilly, M. R., held that the discovery might be extremely material to the plaintiff, and ordered it to be given (*d*). Again,

(*a*) *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90. "If the Court sees that all fair and legitimate purposes will be answered by a restricted discovery, it will so restrict it;" per Hall, V.-C., in *Orr* v. *Diaper*, 4 Ch. D. 92, commenting on this case.

(*b*) 16 Ch. D. 93.

(*c*) Per Giffard, L. J., in *Thompson* v. *Dunn*, L. R. 5 Ch. 576. And see *Renard* v. *Levinstein*, 10 L. T. N. S. 94; *Russell* v. *Crichton*, Ct. Sess. Cas., 1st Ser. XV., 1270; *Union Paper Collar Co.* v. *Metropolitan Collar Co., Ld.*, 3 Daly, 171; *Byass* v. *Sullivan*, 21 How. Pr. 50.

(*d*) *Howe* v. *McKernan*, 30 Beav. 547.

where the plaintiff obtained an injunction against the defendants, and the defendants offered to submit to an injunction and pay costs, and then moved to stay proceedings, the answer to the plaintiff's interrogatories not having yet been given, Wood, V.-C., said that the plaintiff had a right to ascertain the facts in his own way, by the answer of the defendants to his interrogatories, and that until the defendants had put in their answer, it was impossible for the Court to say whether or not he had done rightly in rejecting the terms offered by the defendants. The motion was dismissed, with costs (*a*).

Leather Cloth Co. v. *Hirschfeld*.

In *Leather Cloth Co.* v. *Hirschfeld* (*b*), a decree having been made directing the defendant to account for all goods sold by him with a particular stamp, it was decided by the same learned judge that the defendant was compellable to disclose the names of all persons to whom he had sold any such goods, and that if he could not say to which of his customers the stamped goods were sold, he was then (but not otherwise) compellable to disclose the names of all customers to whom he had sold goods which he would not swear positively were unstamped.

Fennessy v. *Clark*.

In *Fennessy* v. *Clark* (*c*), an action for an injunction to restrain an infringement of trade mark, and for damages on an account, after an order had been made for the trial of issues of fact before a judge and jury, and before the plaintiff had elected between damages and an account, the plaintiff took out a summons for a fuller statement by the defendant of the number of his sales and for inspection of his books; but the application was refused as being premature.

Action for discovery.

In *Orr* v. *Diaper* (*d*) the plaintiffs discovered that the defendants, who were shippers, had exported large quantities

(*a*) *Stephens* v. *Brett*, 10 L. T. N. S. 231.
(*b*) 1 H. & M. 295.
(*c*) 37 Ch. D. 184.
(*d*) 4 Ch. D. 92.

of goods packed and marked in imitation of theirs for certain persons unknown. Being unable to discover the infringers, they applied to the defendants for discovery, and this being refused, instituted an action against them, in which discovery was prayed. The defendants having demurred, on the ground that no relief was prayed or intended to be prayed against them, Hall, V.-C., held that the fact that the plaintiffs required the information for the purposes of an action against the infringers was sufficient, without their intending to bring an action against the shippers, and granted the discovery.

Discovery under Merchandise Marks Acts.

By the Merchandise Marks Act, 1862 (*a*), any person who had sold, &c., any goods marked with a spurious trade mark, was bound, within forty-eight hours after delivery of a demand in writing, to give full information in writing of the name and address of the person from whom he obtained the goods, and of the time when he obtained them. In case of refusal, a justice of the peace might summon and fine the person refusing, and such refusal was *primâ-facie* evidence that the person refusing was acquainted with the illegal circumstances.

This provision is not repeated in the Act of 1887, but by § 2 (2) (*b*) a person who sells or exposes for sale goods having a forged trade mark or false trade description applied thereto is guilty of an offence against the Act, unless he proves, among other things, "that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained" the goods; and § 12 authorises the issue of a search-warrant.

Inspection under Judicature Acts.

In *Hennessy* v. *Rohmann* (*b*), Malins, V.-C., granted inspection of cases and bottles used by the defendants. In *Smith* v. *Harris* (*c*), the plaintiff in a trade-mark case

(*a*) 25 & 26 Vict. c. 88, § 6.

(*b*) 36 L. T. N. S. 51. This was under Order LII., r. 3, of the Rules of Court then in force, now Order L., r. 3.

(*c*) 48 L. T. N. S. 869.

alleged by his statement of claim that he had for many years used the word "Glenlivet" on his invoices, letters, billheads, and whiskey casks, and, on the defendant's application, he was ordered to produce for inspection the invoices, letters and billheads in his possession so marked, but not the casks.

Particulars.

In the last-mentioned case the defendant alleged by his statement of defence that the plaintiff had for many years been well aware of the word "Glenlivet" being widely used in the trade in connection with other makes of whiskey; and the Court of Appeal ordered (*a*) the defendant within an appointed time to deliver particulars of the names of the persons alleged to have used the word with the plaintiff's knowledge, and the times when and places where they had done so, and ordered that, if the defendant should not do so, the paragraph in the defence should be struck out. Again, in *Humphries* v. *Taylor Drug Co.* (1) (*b*) the plaintiff in a trade-mark action having alleged by his statement of claim that persons had been deceived, he was ordered to deliver particulars of the names and addresses of the persons alleged to have been deceived.

Account.

Account.

A most important part of the remedy given in Equity for the infringement of the rights of the owner of a trade mark is the account of the profits, by which such profits as have been dishonestly acquired by a defendant by means of the reputation of another are restored to the plaintiff, whose they ought to have been at first. The principle is the same as where a man is made to account for the profits which he has improperly received, arising from the fraudulent manufacture of a secret medicine (*c*), or the publication of a newspaper (*d*).

(*a*) Feb. 6th, 1884.
(*b*) 39 Ch. D. 693.
(*c*) *Green* v. *Folgham*, 1 S. & S. 398.
(*d*) *Giblett* v. *Read*, 9 Mod. 459.

Incident to injunction.

"The liability to account for the profits is incident to the injunction" (*a*), and "on authority and principle it is clear that if a man manufactures goods and knowingly marks them with the trade mark of another person, he is accountable for the profits so made" (*b*), and that, whether he manufactures on his own account, or only puts up goods for others (*c*).

Wherever another's mark is placed on the goods by the defendant.

So long as the defendant is aware that he is using a trade mark, which is not his, the fact that he does not know to whom the trade mark belongs which is on the goods he is selling does not in the slightest degree affect the right of the owner to an injunction and an account of profits. And since the defendant cannot himself have placed on the goods another's trade mark without being aware that he was infringing some one's trade-mark rights, though he may not have known exactly whose it was, he will be accountable in all cases in which he has himself placed the mark on the goods (*d*).

Not always so, where he bought goods ready marked.

But where the defendant has bought marked goods and resold them in ignorance that the trade mark on them was forged, although the plaintiff will be entitled to his injunction, he will not necessarily be entitled to an account, except in respect of any user by the defendant after he became aware of the prior ownership (*e*). On this principle, in *Ellin* v. *Slack* (*f*), a defendant who had bought and resold goods bearing a mark which infringed the plaintiff's trade mark, but without knowledge of the infringement, and who, on hearing of the infringement, had at once desisted from any further sales and offered to submit to

(*a*) Per Romilly, M. R., in *Cartier* v. *Carlile*, 31 Beav. 292.

(*b*) Per Romilly, M. R., in *Moet* v. *Couston*, 33 Beav. 578. See *Carver* v. *Bowker*, Dig. 581. The account only extends to goods actually sold under the spurious mark, not to goods manufactured but not sold. See *Stonebraker* v. *Stonebraker*, 33 Md. 252.

(*c*) *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601.

(*d*) *Cartier* v. *Carlile*, *ubi suprà*; *Moet* v. *Couston*, *ubi suprà*. And see S. C. 10 L. T. N. S. 395.

(*e*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Moet* v. *Couston*, 33 Beav. 578.

(*f*) 24 Sol. J. 290.

a perpetual injunction with costs, was relieved from accounting.

Account sometimes useless.

In many cases the main object of the action is to obtain the injunction, the account being of very secondary importance (*a*); and occasionally the injury suffered by the plaintiff, and the profits received by the defendant, have been so small that the account has not formed part of the relief awarded, so that the old rule that the injunction was subordinate to the account (*b*) no longer holds good.

No account where laches.

As a plaintiff may be disentitled to his injunction by reason of his own laches, so he may be disentitled by the same reason to the account of profits. If he permits the defendant to continue his infringement for a prolonged period, he will not then be allowed to treat him as his salesman, and claim an account (*c*). But if the plaintiff has not been aware of the fact of the defendant's user, the length of that user will not deprive him of his right to an account (*d*).

Offer of submission.

Where a defendant offered, among other things, to account for profits, but the plaintiff, declining the offer of submission, insisted upon his own terms, including an account, the Court granted the account, but only upon the plaintiff's request, and at his peril in respect of costs, in case it should turn out that the account furnished by the defendant of his own accord was accurate (*e*).

Subdivided account.

In *Dent* v. *Turpin* (*f*), where a defendant had infringed a trade mark, which had become by bequest the property of two different persons, and those persons brought distinct actions against the defendant, the prayer in each case

(*a*) *Pierce* v. *Franks*, 15 L. J. Ch. 122; *Burgess* v. *Hately*, 26 Beav. 249; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; *McAndrew* v. *Bassett*, *ib.* 380; *Barnett* v. *Leuchars*, 13 L. T. N. S. 495; *Shipwright* v. *Clements*, 19 W. R. 599, &c.

(*b*) *Delondre* v. *Shaw*, 2 Sim. 237.

(*c*) *Beard* v. *Turner*, 13 L. T. N. S. 746; *Harrison* v. *Taylor*, 11 Jur. N. S. 408; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298; *Holt* v. *Menendez*, 128 U. S. Rep. 182; *Low* v. *Fells*, 35 Fed. Rep. 361.

(*d*) *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601.

(*e*) *Nunn* v. *D'Albuquerque*, 34 Beav. 595.

(*f*) 2 J. & H. 139.

including an account and payment of such share of the profits as should be shown to be attributable to the individual plaintiff's share, it was held that such an account and payment could be granted.

Extent of account.

As to the extent of the account, it will not be given for a period of more than six years before the commencement of the action, and it will not include every species of profit made by the defendant during that period, but only so much as is properly attributable to the use of the plaintiff's trade mark (*a*). But the defendant must account for the whole of the profits so made without any limitation to the extra profits made by the wrongful use of the trade mark (*b*), even though he may have sustained a loss on his business as a whole (*c*). And the plaintiff is entitled to those profits, and those profits only, and it is immaterial whether he himself would, if the defendant had not infringed, have made profits either greater or less than those (*c*). The account must extend to the whole of the goods sold under the particular mark or in the particular get-up (*d*), and, at all events in case of fraud, to sales prior to the plaintiff's registration, as well as to sales since then (*e*). If the defendant was at first ignorant that he was using a trade mark, the account may be made to commence from the date when he became aware of that fact (*f*); and where the defendant had himself been guilty of misrepresentation, and the defendant's business was carried on upon so much larger a scale than the plaintiff's as to render it impossible to suppose that the use of the plaintiff's mark had alone brought the defendant his customers, the account was only given from the date of filing the bill, and not earlier (*g*).

(*a*) *Cartier* v. *Carlton*, 31 Beav. 292.

(*b*) *Benkert* v. *Feder*, 34 Fed. Rep. 534.

(*c*) *Atlantic Milling Co.* v. *Rowland*, 27 Fed. Rep. 24.

(*d*) *Lever* v. *Goodwin*, 36 Ch. D. 1.

(*e*) *Smith* v. *Fair*, 14 Ont. Rep. 729.

(*f*) *Moet* v. *Couston*, 33 Beav. 578; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185.

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

Account directed at plaintiff's risk.

An account of profits is frequently directed at the plaintiff's risk (*a*). Where an account had been directed of the sale and profits of a book published in infringement of the plaintiff's rights, notwithstanding an affidavit by the defendant that about half of 11,000 copies printed had been sold, and the account showed that 9000 copies had been sold, but that instead of a profit there had been a small loss, it was held that the affidavit had been shown to be untrustworthy, and that the plaintiff was justified in requiring the account to be taken, and was entitled to the costs thereby occasioned (*b*).

Election between account and damages.

The acceptance of an account of profits by the plaintiff operates as a condonation of the infringement; so that a plaintiff must elect between the account and an inquiry as to damages, but cannot insist on both (*c*), though he may at the outset claim both, reserving his election till a later stage (*d*).

Damages.

Damages.

It is in the option of a successful plaintiff in a trade-mark action to elect between an account of profits and an inquiry as to damages, although, as before stated, he cannot have both (*e*). Damages being the appropriate remedy at Common Law, while the account of profits was peculiar to Equity, the result, and probably the cause of the great majority of trade-mark cases being brought into Equity, has been that an account has been commonly awarded, and not damages. This has been the case notwithstanding that the Courts of Equity have had the power of giving relief in the shape of damages (*f*), since

(*a*) As an inquiry as to damages may be. See *Tonge* v. *Ward*, 21 L. T. N. S. 480.

(*b*) *Dicks* v. *Jackson*, Chitty, J., March 31st, 1884.

(*c*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*d*) See *Leidersdorf* v. *Flint* (2), 50 Wisc. 401.

(*e*) *Neilson* v. *Betts*, L. R. 5 H. L. 1. See *Leidersdorf* v. *Flint* (2), 50 Wisc. 401.

(*f*) Thus, inquiries as to damages were given in *Cheavin* v. *Walker*, 5 Ch. D. 850-61; and *Graveley* v. *Winchester*, Seton, 4th ed. 257.

in most cases the account forms the most convenient remedy.

When given.

Some of the remarks made in reference to the account apply in respect of damages: thus, the defendant is liable in damages for the user of what he has reason to know, or suppose to be, a forged trade mark, though he may be ignorant of the owner; but not necessarily for user of a mark which he did not at all know to be forged (*a*); while, on the other hand, the plaintiff may be held to be disentitled to damages by reason of his own delay (*b*).

Special damage need not be proved.

For damages to be recovered it is not necessary that special damage should be proved; it is sufficient to show that the plaintiff's right has been invaded, in which case some damages, even if only nominal, will be given (*c*). And it has been held in New Zealand that more than nominal damages may be awarded for a fraudulent imitation, even without proof of special damage (*d*).

Measure of damages.

The measure of damages which can be recovered when special damage is proved is not yet clearly settled by authority; but in *Leather Cloth Co.* v. *Hirschfeld* (*e*), it was held by Wood, V.-C., that it would not be assumed in the absence of evidence that the amount of goods sold by the defendant under the fraudulent trade mark would have been sold by the plaintiff but for the defendant's unlawful use of the plaintiff's trade mark; for how could the Court assume that the persons who bought what the plaintiff averred were inferior articles, at an inferior price, would necessarily, if they had not done so,

(*a*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Cartier* v. *Carlile*, 31 Beav. 292; *Moet* v. *Couston*, 33 Beav. 578; 10 L. T. N. S. 395. Thus, in *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178, it was held that, though an injunction must be granted with costs, yet, as the defendants had acted perfectly *bonâ fide*, no damages could be given.

(*b*) *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298; *Holt* v. *Menendez*, 128 U. S. Rep. 182.

(*c*) *Blofeld* v. *Payne*, 4 B. & Ad. 410; and see *Sykes* v. *Sykes*, 3 B. & Cr. 541; *Morison* v. *Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385; and cases at p. 179, n. (*a*).

(*d*) *Littlejohn & Son* v. *Mulligan*, 3 N. Z. L. R. (Sup. Ct.) 446.

(*e*) L. R. 1 Eq. 229. See *Davenport* v. *Rylands*, L. R. 1 Eq. 302.

have bought the superior articles at the higher prices? In America, however, it has been said that "every consideration of reason, justice, and sound policy demands that one who fraudulently uses the trade mark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trade mark on the plea that it is impossible to determine how much of the profit is due to the trade mark and how much to the intrinsic value of the commodity. The fact that it is impossible to apportion the profit renders it just that he should lose the whole" (*a*); and the usual practice in America appears to be to assess damages at the amount of the profits which the plaintiffs would have made if they had sold the same quantity of the genuine goods as the defendants had sold of the spurious ones (*b*), or, at all events, at the amount of the actual profits reaped by the defendants from the infringement (*c*). The observation, however, seems just, that the measure of damages is really the injury done to the plaintiffs, and not the profits made by the defendants (who in the case referred to were selling at lower prices than the plaintiffs) (*d*); and in an Indian case (*e*), where it was shown that the price of the plaintiff's goods had been necessarily lowered in consequence of the defendants' fraudulent competition, it was held that the amount of the reduction in price gave the measure of damages. So it was said in *Atlantic Milling Co.* v. *Robinson* (*f*) that the extent to which the defendants' infringement had interfered with the plaintiff's sales was the measure of damages.

Where a defendant offered submission in terms which Offer of submission.

(*a*) Per Crockett, J., in *Graham* v. *Plate*, 40 Cal. 593, 6 Amer. Rep. 639.

(*b*) *Hostetter* v. *Vowinkle*, 1 Dill. 329; *Faber* v. *Hovey*, Dig. 481.

(*c*) *Graham* v. *Plate*, *ubi suprà*; *Peltz* v. *Eichele*, 62 Mo. 171.

(*d*) *Vulcan Match Co.* v. *Jebsen & Co.*, 1 Kyshe, 650. See *Addington* v. *Cullinane*, 28 Mo. App. 238.

(*e*) *Manockji Petit Manufacturing Co.* v. *Mahalaxmi Spinning & Weaving Co., Ld.*, Ind. L. R. 10 Bomb. 617.

(*f*) 20 Fed. Rep. 217.

were rejected by the plaintiff, the latter was allowed an inquiry as to damages at his own risk (*a*).

Costs—(i.) *in Actions.*

General rule as to costs—follow event.

The same general principles on which costs are given in other cases prevail in those in which a question of trade mark is at issue. Thus, the primary rule is that costs follow the event: that is to say, that where a plaintiff succeeds, he will get his costs (*b*); where he is unsuccessful, he will have to pay costs (*c*). The fact that merely nominal damages have been awarded will not deprive a successful plaintiff of his right to his costs, since a question of his right has been involved (*d*). And where a plaintiff had registered a label containing common words, without a disclaimer, it was held that this was not such a wrongful act as to disentitle him to costs as against the defendants, who had used an identically similar label (*e*).

Relief sometimes granted without costs.

Costs, however, being in the discretion of the Court, the Court will, under some circumstances, grant the injunction, but without costs, as where the plaintiff has persisted in litigation which had become unnecessary (*f*), or where the successful plaintiff has been guilty of delay (*g*). So, again, where forwarding agents, who had been made the medium for importing spuriously marked cigars, had not participated in the fraud, had offered to give what

(*a*) *Tonge* v. *Ward*, 21 L. T. N. S. 480. See *Dicks* v. *Jackson*, Chitty, J., March 31st, 1884.

(*b*) *Chappell* v. *Davidson*, 2 K. & J. 123; *Farina* v. *Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650; *Collins Co.* v. *Walker*, 7 W. R. 222; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *McAndrew* v. *Bassett*, 4 *ib.* 380.

(*c*) *Woollam* v. *Ratcliff*, 1 H. & M. 259; *Williams* v. *Osborne*, 13 L. T. N. S. 498; *Morgan* v. *McAdam*, 36 L. J. Ch. 228; *Bass* v. *Dawber*, 19 L. T. N. S. 626; *Lucke* v. *Webster*, M. R., April 4th, 1879; *Watt* v. *O'Hanlon*, 4 P. R. 1.

(*d*) *Morison* v. *Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385. But in a similar case the Canadian Court gave no costs: *Bondier* v. *Depatie*, 3 Dorion 233.

(*e*) Per Kekewich, J., in *Newman* v. *Pinto*, 57 L. T. N. S. 31.

(*f*) *Millington* v. *Fox*, 3 My. & Cr. 338; *Moet* v. *Couston*, 33 Beav. 578; *Hudson* v. *Bennett*, 12 Jur. N. S. 519.

(*g*) *Millington* v. *Fox*, 3 My. & Cr. 338; *Beard* v. *Turner*, 13 L. T. N. S. 746; *Perks* v. *Hall & Co.*, W. N. 1881, p. 111; *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298.

information they could, and had submitted to act as the Court should direct (*a*).

Relief granted, plaintiff to pay costs.

Under some circumstances the plaintiff may obtain his injunction and yet have to pay the costs of some defendants, as where a dock company was innocently in possession of spuriously marked goods (*b*). And again, where wine bearing a spurious brand was in the possession of wharfingers, it was held by the Court of Appeal that they were entitled to their costs of being made defendants to an action for infringement, notwithstanding that they had submitted to act as the Court should direct only upon having their charges and costs paid or provided for (*c*).

Relief refused, no costs.

On the other hand, while the relief claimed by the plaintiff is refused, the defendant may still be left to pay his own costs, as where the plaintiff has lost his remedy by lapse of time (*d*), or improper use of the word "patentee" (*e*), or other similar reasons (*f*), the defendant's fraudulent intention being evident; or, more commonly, where the defendant's conduct, though not so clearly fraudulent as to entitle the plaintiff to an injunction, has yet been so suspicious and uncandid as to call for some punishment (*g*). Thus, where the Vice-Chancellor considered that the defendant had acted fraudulently, but thought himself bound by a decision of the Court of

(*a*) *Upmann* v. *Elkan*, L. R. 7 Ch. 130. See *Moet* v. *Pickering*, 8 Ch. D. 372.

(*b*) *Upmann* v. *Elkan*, *ubi suprà*.

(*c*) *Moet* v. *Pickering*, *ubi suprà*.

(*d*) *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285.

(*e*) *Nixey* v. *Roffey*, W. N. 1870, p. 227. And where a plaintiff company was held to be disentitled to an injunction by reason of the wrongful use of the word "patent," and the defendant, as having been the company's manager, was in some sense responsible for this, he was deprived of the costs which would otherwise have been given him: *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 345.

(*f*) *E.g.*, *Fetridge* v. *Wells*, 13 How. Pr. 385, R. Cox, 180.

(*g*) *Edgington* v. *Edgington*, 11 L. T. N. S. 299; *Bass* v. *Dawber*, 19 L. T. N. S. 626; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *Wylam* v. *Clarke*, W. N. 1876, p. 68; *Robineau* v. *Charbonnel*, W. N. 1876, p. 160; *Borthwick* v. *Evening Post*, *Ld.*, 37 Ch. D. 449. See *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820; also *Tallcot* v. *Moore*, 13 N. Y. Sup. Ct. 106; *Degraves* v. *Whiteman*, 5 Vict. L. R. Eq. 304; *Hop Bitters Manufacturing Co.* v. *Luke*, 10 Vict. L. R. (E.) 234.

Appeal on the motion to dismiss the bill, he did so without costs (*a*). Where the defendant had filled with his own lime-juice bottles brought to him for the purpose, though they were stamped with the plaintiff's name, and the plaintiff brought an action, making charges which amounted to fraud, but which the Court did not consider to be justified, though the defendant had done that which he was not entitled to do, and the defendant gave an undertaking not to repeat the offence, no order was made, and each party was left to pay his own costs (*b*). Frequently the costs of interlocutory proceedings will be made costs in the cause, as where, on motion for injunction, the plaintiff failed on the score of delay (*c*).

Apportionment of costs.

In some cases a portion only of the relief asked for has been granted, and the costs have either been apportioned in a manner corresponding to the amount of success achieved, or each party has been left to pay his own costs. Thus, where a plaintiff company succeeded on the question of imitation of labels and wrappers, but failed as to trade mark, the plaintiffs were given their costs up to the motion for injunction, each party having to bear his own after that (*d*). In *Day* v. *Neale* (*e*) no costs were given on either side, the plaintiffs having asked for an injunction in respect of several trade marks, in only two of which they had an exclusive right, and having delayed to take proceedings for more than two years, while the defendants were in the wrong as to the two marks. In *Metzler* v. *Wood* (*f*) the plaintiffs, who succeeded on the main question of imitation of the title of their publication, were deprived of half their costs, on

(*a*) *Wotherspoon* v. *Currie*. See L. R. 5 H. L. 510.

(*b*) *Rose* v. *Loftus*, 47 L. J. Ch. 576; and see *Perks* v. *Hall & Co.*, W. N. 1881, p. 111. So in N. S. W., where the successful party had untruly marked his goods as if the mark were registered: *Harris* v. *Ogg*, 5 N. S. W. Rep. (E.) 114.

(*c*) *Isaacson* v. *Thompson*, 41 L. J. Ch. 101. And see *Brook* v. *Evans*, 2 L. T. N. S. 740; *Wallis* v. *Wallis*, 4 Dr. 458.

(*d*) *Compagnie Laferme* v. *Hendrickx*, Dig. 512. And see *Jackson & Co.* v. *Napper*, 35 Ch. D. 162.

(*e*) V. C. B. May 24th, 1881.

(*f*) 8 Ch. D. 606.

the ground of their having made claims as to copyright which failed. Where a plaintiff succeeded in establishing a limited right in a word, and also that the defendant had acted fraudulently, but he failed to show a general right in the word, and that certain labels used by the defendant were deceptive, the defendant was ordered by the Irish Court to pay the general costs of the suit, but the plaintiff was ordered to pay and set off against his own costs the costs of all the affidavits of the defendant's witnesses (except that of the defendant himself), since they had been addressed to the part of the case on which the plaintiff failed (*a*). In a Bombay case (*b*), in which six marks were in question, and the defendants succeeded as to all but one, which they had offered to give up within six days after the commencement of the suit, it was held that the defendants must only pay their own costs with regard to that mark, and one-sixth of the plaintiffs' costs up to and including the day on which the offer was made, and that all the remaining costs of both parties must be paid by the plaintiffs. Where a defendant had untruly alleged that he was the first to use a word in dispute, and that the plaintiff had copied from him, no costs were given, though the action was dismissed (*c*).

Costs of unfounded charges, &c.

If a plaintiff makes charges which he is unable to substantiate, he may obtain an injunction with costs, and yet have to pay all costs occasioned by the making of that charge (*d*). In the same way, if a plaintiff insists upon having an account taken, after the defendant has given full information, the plaintiff will have to pay the costs of that account if it turn out to have been unnecessary (*e*).

Scale of costs when defendant submits.

When a defendant in a trade-mark action submits to a perpetual injunction with costs, the mere fact of his

(*a*) *Wheeler* v. *Johnston*, 3 L. R. Ir. 284.

(*b*) *Wallace & Co.* v. *King & Co.*, Bombay High Ct., April 30th, 1879.

(*c*) *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820.

(*d*) *Pierce* v. *Franks*, 15 L. J. Ch. 122; *Standish* v. *Whitwell*, 14 W. R. 512; *Wylam* v. *Clarke*, W. N. 1876, p. 68.

(*e*) *Nunn* v. *D'Albuquerque*, 34 Beav. 595.

having submitted constitutes no special ground, under R. S. C., 1883, Order LXV., r. 9, for directing the costs to be taxed on the higher scale, but in such a case the Court will refuse to punish him for submitting at once, and will leave the costs to be taxed on the lower scale (*a*). But there may be cases in which costs will be given on the higher scale—*e.g.*, where the action has been fought out at great length (*b*).

Costs of motion to commit.

A motion to commit for breach of an injunction is not unfrequently made without any intention of obtaining an order for actual committal, but the defendant can only be ordered to pay the costs of such a motion if the facts would have warranted a committal (*c*). But where an order for committal was rescinded by the Court of Appeal, no costs were given the defendant, on account of the equivocal conduct of some of his agents (*c*). Where a motion to commit was dismissed on the ground of delay, as well as that the actual terms of the injunction had not been disobeyed, though its spirit had been, the Vice-Chancellor, while refusing the motion, enlarged the injunction and made the defendant pay the costs (*d*). In a case in which the Supreme Court of New York had fined a defendant for contempt, the Court of Appeals, while considering itself bound by the decision of the Supreme Court as to the fact of the breach, yet thought the decision so doubtful that it gave no costs of the appeal (*e*).

Costs of appeals.

The costs of appeals are usually governed by the same principle as those in the Courts of First Instance, and follow the event. Thus, in *McLean* v. *Fleming* (*f*), in which the U. S. Circuit Court considered the plaintiff to be entitled to an injunction and an account, but the Supreme Court reversed the decision with respect to the

(*a*) *Hudson* v. *Osgerby*, 50 L. T. N. S. 323.

(*b*) *Great Tower St. Tea Co.* v. *Smith*, 6 P. R. 165.

(*c*) *E.g.*, *Denee* v. *Brand*, W. N. 1881, p. 31.

(*d*) *Cartier* v. *May*, Dig. 200.

(*e*) *Devlin* v. *Devlin*, 69 N. Y. 212.

(*f*) 96 U. S. Rep. 245.

account, on the ground of the plaintiff's own laches, it was held that the plaintiff must have his costs in the Court below, but the defendant (appellant) his costs of the appeal. The costs of an unnecessary appeal must be paid by the appellant. Thus, where a respondent appeared at the hearing of an appeal, after having received notice from the appellant that no alteration would be asked in the order in the Court below with respect to his costs, which the appellant had been ordered to pay, that respondent was left to pay the costs of such appearance (*a*). And where, in an action for imitation of the name of the plaintiffs' journal, the plaintiffs brought on an appeal from the decision of the judge directing the motion for an injunction to stand to the hearing, after the defendants had changed the name of their publication, the plaintiffs were ordered to pay the costs of the appeal, notwithstanding that the defendants had refused to submit to an injunction, or to give an undertaking as to their original title (*b*). In *Newman* v. *Pinto* (*c*) the plaintiff, who had succeeded in the Court of First Instance, was held by the Court of Appeal to be disentitled to relief on the ground of misrepresentations contained in his trade mark; but the defendants, who had used the same trade mark, containing the same misrepresentations, were not allowed the general costs of the action, but only the costs of the appeal.

Costs in case of compromise.

One of the main objects which the Court has in view in the exercise of its jurisdiction is "to repress unnecessary litigation, and to keep litigation within those bounds which are essential to enable the parties to vindicate and establish their rights" (*d*). Although, therefore, a plaintiff whose rights have been attacked is not bound to rely on the assurance of his assailant that the act will

(*a*) *Upmann* v. *Elkan*, L. R. 7 Ch. 130.

(*b*) *Dale* v. *Smith*, W. N. 1882, p. 145.

(*c*) 57 L. T. N. S. 31.

(*d*) Per Lord Cottenham, C., in *Millington* v. *Fox*, 3 My. & Cr. 338.

not be repeated, but is entitled to the protection of an injunction (*a*), yet if he, immediately after the suit is commenced, is offered and may obtain all he seeks, and still thinks proper to go on with the suit, the Court may give him his decree, but will not give him the costs of the suit so unnecessarily prosecuted (*b*). The defendant is, however, the aggressor, since the litigation has been first occasioned by his unwarrantable interference with the plaintiff's rights in respect of his trade mark, and this is equally the case whether the aggression was made with knowledge or in ignorance of those rights of the plaintiff. The defendant must therefore offer all the plaintiff has a right to obtain, and the offer must include all the costs which have been occasioned by his improper conduct (*c*). Thus, where in a patent case an injunction was granted, the defendants having previously promised to commit no further infringement and to pay the costs of preparing the bill, Knight Bruce, V.-C., gave the plaintiffs their costs at the hearing, since the defendants ought to have offered, on the injunction being obtained, to pay all costs up to that time (*d*). The same result followed where a defendant, who had offered to pay the taxed costs as between party and party, but refused to pay them as between solicitor and client, put in his answer,

(*a*) *Geary* v. *Norton*, 1 De G. & S. 9; *Routh* v. *Webster*, 10 Beav. 561; *Tonge* v. *Ward*, 21 L. T. N. S. 480; *Coats* v. *Holbrook*, 2 Sandf. Ch. 586, R. Cox, 20; *Radway* v. *Coleman*, 15 Grant Up. Can. Ch. 50; *Guardian Fire and Life Assurance Co.* v. *Guardian and General Insurance Co., Ld.*, 50 L. J. Ch. 252.

(*b*) Per Wigram, V.-C., in *Colburn* v. *Simms*, 2 Hare, 560, commenting on *Millington* v. *Fox*; and see *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Hudson* v. *Bennett*, 12 Jur. N. S. 519; *Upmann* v. *Elkan*, L. R. 12 Eq. 140, 7 Ch. 130; *Williams* v. *Osborne*, 13 L. T. N. S. 498.

(*c*) *Fradella* v. *Weller*, 2 R. & M. 247; *Kelly* v. *Hooper*, 1 Y. & C. Ch. 197; *Geary* v. *Norton*, 1 De G. & S. 9; *Burgess* v. *Hills*, 26 Beav. 244; *Burgess* v. *Hately*, 26 Beav. 249; *Wallis* v. *Wallis*, 4 Dr. 458; *Collins Co.* v. *Walker*, 7 W. R. 222; *Moet* v. *Couston*, 33 Beav. 578; *Nunn* v. *D'Albuquerque*, 34 Beav. 595; *Coats* v. *Holbrook*, 2 Sandf. 586, R. Cox, 20; *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178.

(*d*) *Geary* v. *Norton*, *ubi suprà*. See *Lochgelly Co.* (*Limited*) v. *Lumphinnans Iron Co.*, Ct. Sess. Cas., 4th Ser. VI. 482.

and then, the plaintiff offering to accept the costs as between party and party, declined to pay the costs of the answer (*a*). But if an innocent infringer withdraws all marked articles from sale, and offers an undertaking immediately upon being served with the writ, and the plaintiff afterwards moves for an injunction, the motion will be refused with all costs, less the costs of the writ, which will have been incurred before the defendant's offer (*b*).

Notice to infringer.

It has been thought that a person whose trade mark has been infringed should give notice to the infringer of his intention to take proceedings, so as to give him an opportunity of explaining his conduct or submitting (*c*); and if he does so, and a fair offer is made, he should not hasten to incur needless expense (*d*), or he may be punished in respect of costs. Lord Romilly, M. R., was, however, of opinion (*e*) that, the defendant having been the aggressor, the plaintiff would be justified in filing his bill without making any application to the defendant; and in *Upmann* v. *Elkan* (*f*) he indicated his adherence to the same view, saying that he did not mean to lay down that the person whose trade mark had been imitated might not file a bill without making any inquiry at all. In the later case of *Upmann* v. *Forester* (*g*), Chitty, J., decided in accordance with this opinion, giving costs to a plaintiff who had moved for an injunction without giving any previous notice, though the defendant had acted perfectly innocently, and would have submitted if

(*a*) *Kelly* v. *Hooper*, 1 Y. & C. Ch. 197.

(*b*) *Carnecho* v. *Highmoor*, 27 Sol. J. 199.

(*c*) *Chappell* v. *Davidson*, 2 K. & J. 123; *Wallis* v. *Wallis*, 4 Dr. 458; *Twentsche Stoom Bleekery Goor* v. *Ellinger & Co.*, 26 W. R. 70.

(*d*) *Williams* v. *Osborne*, 13 L. T. N. S. 498. And see the opinion of Jessel, M. R., cited in *Upmann* v. *Forester*, 24 Ch. D. 231, and *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(*e*) In *Burgess* v. *Hately*, 26 Beav. 249. In *Field* v. *Lewis*, Dig. 280, Wood, V.-C., granted an injunction with costs, though no notice had been given before bill filed. And see *Coats* v. *Holbrook*, 2 Sandf. Ch. 586, R. Cox, 20; and *Sawyer* v. *Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601.

(*f*) L. R. 12 Eq. 140; L. R. 7 Ch. 130.

(*g*) 24 Ch. D. 231.

notice had been given him. And he stated that this was also the opinion of Jessel, M. R. (*a*). The reason assigned by Chitty, J., for this decision appears to be that, if the plaintiff were to give notice to the defendant, and the defendant were to submit, the plaintiff would lose his costs; but it might be thought that the plaintiff would be sufficiently secured in this respect by the rule above stated, that an offer of submission must, to be effectual, include an offer of all costs occasioned to the plaintiff, and that no injustice would be done to the plaintiff, but a very possible injustice to an innocent defendant might be minimised, by requiring notice to be given. And in *Upmann* v. *Currey* (*b*), a case very similar to *Upmann* v. *Forester* (*c*), the innocent defendant offered in court to empty and deliver up or destroy the boxes in which the cigars had been sold to him, and which were labelled (but without his knowledge) in imitation of the plaintiff's boxes, and Smith, J., refused an injunction, and gave no costs on either side.

Infancy does not excuse from costs.

A plea of infancy will not excuse an infant infringer from paying the costs which his conduct has occasioned (*d*). And so with a married woman having separate estate (*e*).

Costs occasioned to a third party by defendant's fraud.

A person who has induced another person to manufacture for him goods marked with the trade mark of a third person is liable to repay to the person he has made the instrument of his fraud the costs of legal proceedings brought about by the infringement, including any sum which that person may have reasonably paid to compromise the matter (*f*).

(*a*) See per Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238, and *Barrett* v. *Gomm*, 74 L. T. (Journal) 388. Also *Hennessy* v. *Day*, 55 L. T. N. S. 161. So *Siegert* v. *Lawrence*, 11 Vict. L. R. 47, in Victoria.

(*b*) 29 Sol. J. 735.

(*c*) 24 Ch. D. 231.

(*d*) *Cory* v. *Gertcken*, 2 Madd. 43; *Chubb* v. *Griffiths*, 35 Beav. 127.

(*e*) *Nicholls* v. *Kimpton*, 3 Times L. R. 674.

(*f*) *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537.

Costs—(ii.) *in Registration Cases.*

Costs in registration cases.

When an application for the registration of a trade mark is opposed and brought before the Court, the costs are usually ordered to be paid by the unsuccessful party, as having been occasioned by his wrongful claim or opposition. Thus, where a claim was made to register and use a trade mark, which would have been an infringement of an existing mark, the persons who wrongly claimed the mark were ordered to pay the costs of cross-adjourned summonses, as well as of an action for an injunction which had been rendered necessary by the claim (*a*). And in *In re Rosing* (*b*), the Cutlers' Co. of Sheffield, who had opposed an application in what they believed to be the interest of the public (and whose opposition succeeded in the Court of Appeal), were ordered by V.-C. Bacon to pay the costs of their opposition, which failed before him.

No costs.

If, on the other hand, each party is partially successful, no costs will be given on either side (*c*). And where application was made for the registration of a label containing descriptive words, and the applicants disclaimed some of the descriptive words, but not all, and conducted their case on the footing that registration would give them an exclusive right to such words, the Court of Appeal held that though the registration must be granted, and would not have the effect of giving any such right, the litigation had nevertheless been caused by the applicants, and no costs could be given them (*d*). And in *In re Dunn* (*e*), in which the Court of Appeal reversed the refusal of the Court below to allow registration, they

(*a*) *Davis* v. *Tylor*, M. R., April 24th, 1879. See *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *In re Grossmith*, 60 L. T. N. S. 612; *In re Burgoyne*, 61 L. T. N. S. 39.

(*b*) 54 L. J. Ch. 975.

(*c*) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398.

(*d*) *In re Hudson*, 32 Ch. D. 311. And see *In re Swift Specific Co.*, P. R. 352.

(*e*) 41 Ch. D. 444.

only gave costs of the appeal, and none of the hearing below.

Costs paid by successful applicant.

Where an applicant took advantage of the precise wording of the Act of 1875 to obtain registration as a part of his trade mark of words to the exclusive use of which he was not entitled, and the application was unsuccessfully opposed, Jessel, M. R., held that, notwithstanding the success of the applicant, he must still pay the costs of the application, as he was taking advantage of the Act to do that which the Act did not intend him to do (*a*).

Costs of comptroller.

Where the comptroller (formerly the registrar) is served with notice of an application to the Court, he is entitled to appear on the hearing of the application, and to receive his costs of so doing, since it is proper that he should know what order is made (*b*).

When he opposes.

Where the comptroller opposes an application, and his opposition fails, he will not usually be required to pay the costs of the successful applicant (*c*); and the rule has in fact been established that the comptroller will generally receive his costs, whether successful or unsuccesful (*d*), but where the case is a test case, each party may be left to pay his own costs (*d*). Formerly it seems that costs might be given against him if he opposed in a case in which the Court pronounced the applicant's mark, not only to be distinct from the mark which the comptroller supposed it to resemble, but to be so distinct that the comptroller was acting wrongly in objecting (*e*). And in one case (*f*) in which the comptroller's objection succeeded no costs were given him, because he had not merely submitted the claim to the Court, but had

(*a*) *In re Maignen*, 28 W. R. 759.

(*b*) This has been repeatedly so laid down: *e.g.*, *In re Orr-Ewing* (2), 28 W. R. 412.

(*c*) *In re Rotherham*, 14 Ch. D. 585.

(*d*) *In re Van Duzer*, 34 Ch. D. 623; *In re Leaf, Sons & Co.*, 34 Ch. D. 632.

(*e*) *In re Patent Plumbago Crucible Co.*, M. R., August 1st, 1879.

(*f*) *In re Jones Bros.*, V.-C. H., July 10th, 1880.

actively disputed it and filed evidence. But no reliance can now be placed on these decisions.

Extent of costs.

Since, by the terms of the old Rule 16 (*a*), an opposed application did not stand for the determination of the Court until the comptroller informed the applicant that the opponent had given security, no costs incurred before that point in the proceedings, but only those incurred after it, could formerly be given by the Court or be included in an order to pay costs (*b*); and it has been held that the Court cannot even now give a successful opponent the costs of the proceedings in the Registry Office, under either § 69 or § 90 of the Patents Act, 1883 (*c*).

Costs of application to remove.

If a person registers as his property a trade mark to which he is not entitled, he will, as a rule, have to pay the costs of the necessary application to remove it from the register (*d*), though there may be exceptional cases in which this rule will not be followed: as if the mark was originally his property, but has become common through the common piracy of the trade, and they have delayed to apply for removal for some time after his registration, and have then done so without notice to him, he being a foreigner (*e*); or if the mark is removed from the register on the application of a person who has copied it, and who has only applied for rectification under stress of an action for infringement (*f*). Again, where a mark was removed from the register by the Court of Appeal on a ground which had not been raised in the Court below, and the applicant had acted in a fraudulent manner, no costs were given in either Court (*g*). As a rule, a person who fails in an

(*a*) Since repeated in § 69 of the Patents Act, 1883, as amended.

(*b*) *In re Brandreth*, 9 Ch. D. 618.

(*c*) *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278.

(*d*) *In re Hyde & Co.*, 7 Ch. D. 724; *In re Palmer* (3), 24 Ch. D. 504; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274; *In re Vignier*, 6 P. R. 490.

(*e*) *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(*f*) *In re Perry, Davis & Son*, 58 L.T.N.S. 695; *Humphries* v. *Taylor Drug Co.* (2), 59 L.T.N.S. 820. See *In re Gianaclis*, 58 L. J. Ch. 782.

(*g*) *Thompson* v. *Montgomery*, 41 Ch. D. 35.

application to rectify will have to pay the costs of the application (*a*).

Security for costs.

Where a firm of shipowners had been restrained, as carriers, from parting with cases of mineral waters containing bottles alleged to bear infringements of the plaintiffs' labels, and an American resident claimed to be the owner of the goods, and applied for leave to re-ship them to Hamburg, it was held that he must give security for the costs of his application (*b*). And where an application for the registration of a trade mark was made by a foreign resident and opposed, it was held that he must give security for costs, and that, unless he did so within seven days, his application must be refused without further order (*c*).

Costs of opposition leading to abandonment of application.

When an application for registration is abandoned after notice of opposition, the comptroller has power to award costs to the opponent (*d*).

(*a*) *In re Atkins Filter & Engineering Co., Limited*, 3 P. R. 164.
(*b*) *Apollinaris Co.* v. *Wilson*, 31 Ch. D. 632.
(*c*) *In re Hurter*, W. N. 1887, p. 71.
(*d*) P. A. 1883-8, § 69 (5).

CHAPTER VIII.

CASES ANALOGOUS TO THOSE OF TRADE MARK.

Cases not strictly trade mark cases.

In addition to the cases in which there has been an infringement of trade mark properly so called, a variety of cases have been decided in which the Court has restrained the practice of fraud by one person at the expense of another, the means adopted to perpetrate the fraud resembling to some extent the infringement of a trade mark, but yet being distinguishable therefrom.

Cases of true trade mark.

A trade mark is a technical matter, and for there to be an infringement of trade mark there must be a valid trade mark in existence—that is to say, there must not only be such a device in existence as is capable of forming a trade mark, but it must be actually attached to vendible articles in the market (*a*), or must (at least, if first used since the Trade Marks Act of 1875) be properly registered under the Patents Act, 1883 (*b*).

Cases not of true trade mark.

Where, however, there has been a representation that one thing is another, by means of which one person has secured custom intended for another, so that both the purchaser and the genuine trader have been defrauded, there the Court will interfere and protect the right of both parties to trade freely without fraudulent deceptions, although the fraud has taken another form than that of imitating a trade mark.

Trade name.

An important class of cases of this description consists

(*a*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307. See also *In re Leonard & Ellis*, 26 Ch. D. 288.

(*b*) See the Patents Act, 1883, § 77, as amended by the Act of 1888. Also *Edwards* v. *Dennis*, 30 Ch. D. 454.

of cases in which there has been a wrongful assumption by one person or firm of the trade or firm name under which a reputation has been gained by another person or firm, and which has therefore become a very important part of the goodwill of the business of such person or firm (*a*), although when used as a name, and not as a mark on vendible goods, it is not used as a trade mark. The imitation of such a name falsely represents not merely a certain class of goods, but the entire business, to be that of one not the true proprietor.

No exclusive right in name apart from business.

"In this country," says Lord Chelmsford (*b*), "we do not recognise the absolute right of a person to a particular name, to the extent of entitling him to prevent the assumption of that name by a stranger. The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name, after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or at least of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction." But a man who has never carried on business under a particular name cannot, even though he has some kind of right to use that name, interfere with its being used by another. Thus, where the plaintiff was the mortgagee of the goodwill of a business, including the right to use the name under which the business was carried on, but had never exercised his right so to do (*c*).

Name by which goods identified.

There is another kind of trade name besides the trade name which is synonymous with firm name—viz., the trade name which is applied, not to the firm by whom the goods are manufactured and sold, but to the goods themselves; and it was with immediate reference to a trade

(*a*) Per Wood, V.-C., in *Churton* v. *Douglas*, Johns. 174.

(*b*) *Du Boulay* v. *Du Boulay*, L. R. 2 P. C. 441.

(*c*) *Brazley* v. *Soares*, 22 Ch. D. 660.

name of this description (*a*), though the principles laid down by him are equally applicable to both classes of trade names, that Lord Blackburn (*b*), after referring to frauds committed by the infringement of trade marks, went on to say: "There is another way in which goods not the plaintiff's may be sold as and for the plaintiff's. A name may be so appropriated by user as to come to mean the goods of the plaintiff, though it is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark, properly so called, or within the recent statutes. Where it is established that such a trade name bears that meaning, I think the use of that name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not the plaintiff's, may be the means of passing off those goods as and for the plaintiff's, just as much as the use of a trade mark; and I think the law (so far as not altered by legislation) is the same. And I think it settled by a series of cases that both trade marks and trade names are in a certain sense property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed so that they are no longer strictly correct."

Property in trade name questioned

It cannot yet be said to be generally admitted that a right of property can be acquired in a trade name. The present Vice-Chancellor of Ireland said in a recent case (*c*) that "it has been repeatedly held that there is no property in the name of a firm, or of an individual, or of a place of business; and that the only right of an individual or firm to the sole use of a trade name, as distinguished from a trade mark, is this, that when a name has become identified, by adoption and user, with a particular trade

(*a*) "Singer" sewing machines.

(*b*) In *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15. And see *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. (E.) 98.

(*c*) *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371.

or manufacture or business, the person who has so used or adopted it can obtain the aid of this Court to restrain the use of it by others in such a way as to lead customers or the public to think that the trade or business of the person so using it is his trade or business." And he went on to say that in a registered trade mark there is a larger right. The distinction, however, does not appear to be of much practical importance, as it is now admitted on all hands that if a trade name is so imitated as to render deception probable, relief will be granted, and the test of infringement of a trade mark, in which the right of property is undoubted, is the production of such a probability of deception (*a*).

Unregistered trade name protected.

The non-registration of trade names of the kind primarily referred to by Lord Blackburn is no bar to an action for the wrongful imitation of them (*b*); and where a trade mark consisting of the words "Stone ale" alone had been expunged from the register as not being registrable, an injunction to restrain the use of those words was nevertheless granted (*c*).

Fraud not necessary to be proved.

It was formerly sometimes supposed, and was held by the late Master of the Rolls and the Court of Appeal in *Singer Manufacturing Co.* v. *Wilson* (*d*), that for an action to restrain the use of a trade name to be successful fraud must be proved; on the ground that when a trade mark was once affixed to the goods it passed with the goods from hand to hand, thus silently repeating to each successive purchaser the original misrepresentation of the original infringer, while the improper use of a name not affixed to the goods was not the necessary consequence of being in possession of marked goods, but was the individual act of each person who used it in respect of the goods; so that there might be held to be an infringement of a trade

(*a*) Per Lord Westbury in *Hall* v. *Barrows*, 4 De G. J. & S. 150.
(*b*) *In re Sanitas Co., Ld.*, 58 L. T. N. S. 166.
(*c*) *Thompson* v. *Montgomery*, 41 Ch. D. 35.
(*d*) 2 Ch. D. 434.

mark when, in analogous circumstances, there would be no infringement of a trade name. And when the case of *Singer Manufacturing Co.* v. *Wilson* was remitted by the House of Lords to the Court of First Instance (*a*), on the ground of insufficiency of evidence, some of the law peers seem to have thought that different principles of law might possibly be applicable to trade marks and trade names. But Lord Cairns, C. (*b*), said, "It may well be that if an imitated trade mark is attached to the article manufactured, there will, from that circumstance, be the certainty that it will pass into every hand into which the article passes, and be thus a continuing and ever present representation with regard to it; but a representation made by advertisements that the articles sold at a particular shop are articles manufactured by A B (if that is the legitimate effect of the advertisements, which is a separate question) must, in my opinion, be as injurious in principle, and may possibly be quite as injurious in operation, as the same representation made upon the articles themselves." And in *Singer Manufacturing Co.* v. *Loog* (*c*), Lord Blackburn took the view that the law of trade marks and trade names when not affected by legislation was the same.

False representation sufficient.

Whether there is or is not property in a trade name, as Lord Blackburn suggested (*d*), it is a fraud on the part of one person to attract to himself the custom intended for another, by a false representation, direct or indirect, that the business carried on by himself is identical with that of the other person by whose ability and exertions the name has acquired the reputation it possesses (*e*). The question is not whether the defendants' business is represented as

(*a*) 3 App. Cas. 376.

(*b*) *Ib.* 389. And see *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371.

(*c*) 8 App. Cas. 15. As to the differences between trade marks and trade names in Massachusetts, see *Bowman* v. *Floyd*, 85 Mass. 76.

(*d*) And see per the Court of Session in *Singer Manufacturing Co.* v. *Kimball & Morton*, Ct. of Sess. Cas. 3rd Ser. XI. 267; also *Boulnois* v. *Peake*, 13 Ch. D. 513.

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

being similar to the plaintiffs', but whether it is represented as being that very identical business (*a*). If such a false representation has been made, whatever may have been the motive of the persons making it, when proceedings are taken in consequence of it, "all the Court requires is to be satisfied that the names are so similar as to be calculated to produce confusion between the two —so calculated to do it that, when it is drawn to the attention of those adopting the name complained of that that would be the result, it is not honest for them to persevere in their intention, though originally the intention might not have been otherwise than honest" (*b*).

Act originally innocent may become fraudulent.

"The question is this," said Cotton, L. J., in the Court of Appeal (*c*),—"whether the defendant has represented that the goods manufactured by him were manufactured by the plaintiffs, or whether he has done anything calculated so to represent. I quite agree that it is unnecessary that a fraudulent intention in issuing the circulars complained of should be established. If the natural consequence of those things, even in circumstances not known to him, is that they will represent the goods to be those of another person, it is wrongful, and, as this Court says, a fraud in him, to continue the user after those circumstances are brought to his knowledge. We must consider whether he has represented, or done that which is reasonably calculated to give that misrepresentation." In the same spirit, Wood, V.-C., had laid down long previously (*d*) that if the plaintiffs had represented to the defendants that the course which the latter had been taking was calculated to deceive the public, and, "after

(*a*) *Cruttwell* v. *Lye*, 17 Ves. 335; *Churton* v. *Douglas*, Johns. 174; *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512; *Hirsch* v. *Hirsch & Co.*, 80 L. T. (Journal) 283.

(*b*) Per James, L. J., in *Hendriks* v. *Montagu*, 17 Ch. D. 638.

(*c*) In *Singer Manufacturing Co.* v. *Loog* (3), 18 Ch. D. 417.

(*d*) In *Williams* v. *Osborne*, 13 L. T. N. S. 498. And see *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371; *Magee Furnace Co.* v. *Le Barron*, 127 Mass. 115, and *Holt* v. *Menendez*, 128 U. S. Rep. 182.

such representation, the defendants persisted in continuing the use of the name in the same manner, then, on the plaintiffs bringing the case before the Court, the Court would be justified in saying that that which was not fraudulent at first became so by the defendants' persisting in the same course, and that therefore the plaintiffs would be entitled to the relief they claimed."

But deception must be probable.

The circumstances must, however, be such as to satisfy the Court that deception is probable, and where that is not adequately made out, relief will be refused. Thus, in *Goodfellow* v. *Prince* (*a*), a London wine merchant agreed with a firm of French wine growers to import from them a particular growth of champagne under a label bearing the assumed name "Le Court et C^ie^, Reims," and sold considerable quantities of wine in England under the label, and another London wine merchant began to import champagne from a different French grower and to sell it in England under a label also bearing the assumed name of "Le Court et C^ie^"; and it was held by the Court of Appeal that, whether the use of the name by the defendant might or might not represent that his wine was manufactured by the same French grower who manufactured the plaintiff's wine, there was nothing to show that it represented that the wine was imported by the same importer. And in *Bodega Co., Ld.* v. *Owens* (*b*), the V.-C. of Ireland held on motion that, there being in Ireland only one establishment of the plaintiff company known as a Bodega, which was in Dublin, there was no such probability of deception, if the defendant were allowed to open a "Bodega" in Belfast, as to call for an injunction to prevent the latter from so doing. But at the hearing of the action, on further evidence, an injunction was granted.

This may be affected by lapse of time

Lapse of time may be material in considering whether deception is probable. Thus, where the Marquis of Londonderry and his predecessors in title, owners of

(*a*) 35 Ch. D. 9. (*b*) 23 L. R. Ir. 371.

the Londonderry collieries in the county of Durham, had for many years been in the habit of selling their coal in London, wholesale but not retail, and the defendant, a coal merchant, had, with the knowledge of the Marquis and his predecessors in title, been in the habit, since 1861, of selling retail a particular quality of coal, not obtained from the Londonderry collieries, under the name of "Londonderry Wallsend," or "Londonderry W. E.," and the Marquis had begun in February 1885 to sell retail in London coal got from a particular seam under the name of "Londonderry Wallsend," an injunction to restrain the defendant from selling his coal by the names which he had been accustomed to use was refused, on the ground that, having regard to the lapse of time, there was no misrepresentation, notwithstanding that the plaintiff's title formed part of the names, and that he was the owner of the Londonderry collieries (*a*).

Name of company.

When the name which is alleged to have been imitated is that of a company, and is composed of such words as are in ordinary use in the language, very clear evidence indeed of probability of deception will be required for an action for infringement to be successful. Thus, where a bill was filed by the London and Provincial Law Assurance Society against the London and Provincial Joint Stock Life Assurance Company (*b*), the injunction was refused, an action at law being directed; and in suits by the Colonial Life Assurance Company against the Home and Colonial Assurance

(*a*) *Marquis of Londonderry* v. *Russell*, 3 Times L. R. 360; and see *Ford* v. *Foster*, L. R. 7 Ch. 611-28, per Mellish, L. J.

(*b*) *London and Provincial Law Assurance Society* v. *London and Provincial Joint Stock Life Assurance Co.*, 17 L. J. Ch. 37. In *Purser* v. *Brain*, 17 L. J. Ch. 141, it was held that the circulars of "The London Patent Manure Co." were clearly fraudulent imitations of those of "The London Manure Co.," but the case was sent to a jury for the purpose of deciding whether the plaintiffs' user of their title had been sufficiently long. And in *Lawson* v. *Bank of London*, 18 C. B. 84, a case at Common Law, the plaintiff was defeated on the ground of a want of averment in the declaration that he was a banker or had ever carried on that business; but Willes, J., remarked that he was not prepared to say that the defendant would not be liable if the cause of complaint were properly alleged."

Company, Limited (*a*), and by the London Assurance Company against The London and Westminster Assurance Corporation, Limited (*b*), the injunction was simply refused. In *Lee* v. *Haley* (*c*) the plaintiffs were coal merchants, trading under the name of The Guinea Coal Company, and having their business premises at No. 22, Pall Mall. The defendant had been in their service as manager, and on leaving them set up in business at Beaufort Buildings, Strand, under the name of the Pall Mall Guinea Coal Company. From Beaufort Buildings he removed to No. 48, Pall Mall. In that case fraud was held to be proved, and the injunction was granted; but the Court being of opinion that the only reasonable chance of successful deceit depended upon the residence of the defendant in Pall Mall, the injunction against the user by the defendant of his trade name as above was restricted to Pall Mall. In a case (*d*) where the plaintiff company sold white lead in kegs marked "Brooklyn White Lead Company," or "Co.," and the defendant, who had formerly marked his "Brooklyn White Lead, pure, 100 lbs.," changed the name to "Brooklyn White Lead and Zinc Company," it was held

(*a*) *Colonial Life Assurance Co.* v. *Home and Colonial Assurance Co.*, 33 Beav. 548.

(*b*) *London Assurance Co.* v. *London and Westminster Assurance Corporation*, 32 L. J. Ch. 664.

(*c*) L. R. 5 Ch. 155.

(*d*) *Brooklyn White Lead Co.* v. *Masury*, 25 Barb. 416, R. Cox, 210. And see *Churton* v. *Douglas*, Johns. 174. In *Hendriks* v. *Montagu*, 17 Ch. D. 638, an injunction was granted at the instance of "The Universal Life Assurance Society" to restrain the use of the name "The Universe Life Assurance Association, Ld.," on the ground of similarity; in *Simpson* v. *Anglo-Indian Tea Co., Ld.*, V. C. B., May 4th, 1883, the defendant company was not allowed to trade under the name which it had taken, which was the same as that under which the plaintiff was trading; in *Guardian Fire & Life Assurance Co.* v. *Guardian & General Insurance Co., Ld.*, 50 L. J. Ch. 252, it was held that the defendant company's name was likely to deceive, but that the name of "The Guardian Horse, Vehicle and General Insurance Co." might fairly be taken; in *Capital & Counties Bank, Ld.* v. *Capital & County Deposit Bank*, Chitty, J., Feb. 9th, 1884, an injunction was granted to restrain the use of the latter name; in *Accident Insurance Co., Ld.* v. *Accident, Disease & General Insurance Corporation, Ld.*, W. N. 1884, p. 191, Pearson, J., granted an injunction, and on appeal an order was taken by consent, the defendants agreeing to place some other word than "accident" at the head of their title; in *Thompson* v.

that, though he was entitled to continue to mark his goods "Brooklyn White Lead and Zinc," he had no right to add "Company" or "Co."

Descriptive name of company.

In *Australian Mortgage, Land, & Finance Co.* v. *Improved French Dye-Cleaning & Dyeing Co., Ld.*, 30 Sol. J. 753, the plaintiff was carrying on business at Brixton as "The French Dyeing & Cleaning Co.," and the defendants were carrying on business in Great Portland Street under the name above, and using the address "Brixton" on their trade papers, and an injunction was granted. So, also, in *Sanitas Co., Ld.* v. *Condy*, 4 P. R. 195, 533, in which the plaintiffs were "The Sanitas Co., Ld.," and the defendant began to trade as "The Condisanitas Co."; in *Holmes, Booth & Haydens* v. *Holmes, Booth & Attwood Manufacturing Co.*, 37 Conn. 278, the defendants were restrained from using the names of Holmes and Booth. In *Newby* v. *Oregon Central Railway Co.*, 1 Deady, 609, it was held that the original Oregon Central Railway Co. would be entitled to restrain the assumption of its name by a new company, though a single bondholder in the former company was not entitled to sue until the company had refused to do so. And see *Braham* v. *Beachim*, 7 Ch. D. 848 ("Radstock Colliery Proprietors"); *Campbell* v. *Hollins*, Dig. 548 ("Minton & Co."); *Batchellors* v. *Batchellor Manufacturing Co.*, 12 Amer. Rep. 414 n.; *Gray* v. *Taper Sleeve Pulley Works*, 16 Fed. Rep. 436, where the defendants were restrained from trading under the name they had assumed, which had been previously used by the plaintiffs, though they were entitled to make and sell "taper sleeve pulleys"; *McGowan Bros. Pump & Machine Co.* v. *McGowan*, 2 Cinc. 313; *Celluloid Manufacturing Co.* v. *Cellonite Manufacturing Co.*, 32 Fed. Rep. 94, where the names were as above; *Myers* v. *Kalamazoo Buggy Co.*, 54 Mich. 215 ("The Kalamazoo Waggon Co.," and "The Kalamazoo Buggy Co."). See *Plant Seed Co.* v. *Michel Plant Seed Co.*, 23 Mo. App. 519. In the following cases injunctions were refused:—*London & County Banking Co.* v. *Hampshire & North Wilts Bank*, Dig. 618, in which the defendant company was proposing to take the name of "The Capital & Counties Bank"; *Merchant Banking Co. of London* v. *Merchants' Joint Stock Bank, Ld.*, 9 Ch. D. 560; *Army & Navy Co-operative Society, Ld.* v. *Junior Army & Navy Stores, Ld.*, Dig. 640; *Australian Mortgage, Land & Finance Co.* v. *Australian & New Zealand Mortgage Co.*, W. N. 1880, p. 6; *Midland Electric Light & Power Co.* v. *Brush Midland Electric Light & Power Co.*, 26 Sol. J. 465; *Provident Association of London, Ld.* v. *London & Provincial Provident Association, Ld.*, 30 Sol. J. 753; *Bumsted* v. *General Reversionary Co., Ld.*, 4 Times L. R. 621, where the plaintiff sued on behalf of "The General Reversionary & Investment Co.," who carried on an extensive business in London, with country agents, and the defendants were setting up a small business at Liverpool; *Goodyear Rubber Co.* v. *Goodyear India-rubber Glove Manufacturing Co.*, 128 U. S. Rep. 598; and see *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766 ("Condy's Fluid Co."); *Massam* v. *Thorley's Cattle Food Co.*, 14 Ch. D. 748 ("Thorley's Cattle Food Co."); *Tussaud* v. *Tussaud*, 38 W. R. 440; *Ottoman Calvey Co.* v. *Dane*, 95 Ill. 203, in which the plaintiff company was held not entitled to restrain the defendants from trading under the same name in Illinois, notwithstanding that the defendants were incorporated in Michigan and the plaintiffs in Illinois, the defendants having

Australian & New Zealand Mortgage Co. (*a*), the Court of Appeal pointed out the difficulty of monopolising the exclusive use of a name which correctly described the nature of a company's business, or the locality of its operations. And in *India & China Tea Co.* v. *Teede* (*b*), it was held that a firm of tea merchants were entitled to assume the name of "The India & China Packet Tea Co." notwithstanding that the name of the plaintiff company was as above, the name assumed by the defendants being simply descriptive, and there being no evidence of deception.

The Companies Act, 1862.

By § 20 of the Companies Act, 1862 (*c*), it is enacted that "no company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved, and testifies its consent in such manner as the registrar requires; and if any company, through inadvertence or otherwise, is, without such consent as aforesaid, registered by a name identical with that by which a subsisting company is registered, or so nearly resembling the same as to be calculated to deceive, such first-mentioned company may, with the sanction of the registrar, change its

been the first to trade under the name in Illinois; *Lehigh Valley Coal Co.* v. *Hamblen*, 23 Fed. Rep. 225, in which a Pennsylvania company, doing business in Illinois and other states, was held not entitled to restrain the formation of another company in Illinois under the same name; but it was intimated that the question would remain open whether relief would be granted if the new company should be formed and should improperly take away business from the plaintiffs. So in *Drummond Tobacco Co.* v. *Randle*, 114 Ill. 412, the plaintiff company failed to restrain the incorporation of another company as "The Drummond-Randle Tobacco Co."; in *McNair* v. *Cleave*, 10 Phila. 155, the plaintiffs, trading as the "Galaxy Publishing Co.," were held not to be entitled to the exclusive use of the name, because it represented, contrary to the fact, that they were incorporated as a company.

(*a*) W. N. 1880, p. 6. So also, per the Supreme Court of the U. S. in *Goodyear Rubber Co.* v. *Goodyear India-rubber Glove Manufacturing Co.*, 128 U. S. Rep. 598. And see *Koehler* v. *Sanders*, 55 N. Y. Sup. Ct. 48 ("International Banking Co.").

(*b*) W. N. 1871, p. 241.

(*c*) 25 & 26 Vict. c. 89.

name" (*a*). This section does not authorise a company to use or register a name so nearly resembling one previously used by another company as to be calculated to deceive, even though the name of the earlier company has not itself been registered (*b*); and, on the other hand, since the section only affects the registration of the name of a company, the rights of a company to a name which has been registered cannot be attacked *under the section*, whatever may be the rights outside the section of another company which has previously used the name (*c*).

Name of individual.

If the trade name which has been imitated is that of an individual, and this has been assumed by another person of different name, little is required to prove the fraud. In fact, the assumption of another's name is almost sufficient proof if taken alone (*d*). But in *Olin* v. *Bate* (*e*), the plaintiff Olin failed to succeed in restraining the defendant Bate from carrying on the same profession (the medical) in the same town as himself under the name of Olin, the defendant having so done before the plaintiff came to the town in question. And where "Liebig's Extract of Meat" had come to be the proper designation of an article first invented by Baron Von Liebig, Field, J., affirmed by the Court of Appeal and the House of Lords, declined to restrain a manufacturer of the article from styling his preparation "'Baron' Liebig's Extract of Meat," and placing on the pots a photograph of the Baron (*f*).

(*a*) As to the registration of names of companies under the U. S. Trade Marks Acts, see *In re Rowe & Post*, 9 U. S. Pat. Gaz. 496; *In re India Rubber Comb Co.*, 8 *ib.* 905; *India Rubber Comb Co.* v. *Meyer*, 8 *ib.* 905; *India Rubber Comb Co.* v. *Rubber Comb & Jewelry Co.*, 45 N. Y. Super. Ct. 258; *In re Rubber Clothing Co.*, 10 U. S. Pat. Gaz. 111, and Appendix —, *infrà*.

(*b*) *Hendriks* v. *Montague*, 17 Ch. D. 638. See *Tussaud* v. *Tussaud*, 38 W. R. 440.

(*c*) *Merchant Banking Co. of London* v. *Merchants' Joint Stock Bank, Ld.*, 9 Ch. D. 560.

(*d*) Per Turner, L. J., in *Burgess* v. *Burgess*, 3 De G. M. & G. 896. See *Binninger* v. *Wattles*, 28 How. Pr. 206, R. Cox, 318.

(*e*) 98 Ill. 55; 38 Amer. Rep. 78.

(*f*) *Liebig's Extract of Meat Co., Ld.* v. *Anderson*, W. N. 1882, p. 147; *ib.* 1883, p. 185; H. L., July 16th, 1885.

Assumed name.

Sometimes the plaintiff's name is itself an assumed or fanciful one: thus the use of the name "Christy's Minstrels" has been restrained (*a*); and that of the name "The Oldfield Lane Doctor" (*b*); and in *Isaacson* v. *Thompson* (*c*) the plaintiff kept a millinery establishment, as "Madame Elise," which name being imitated by the defendant, an injunction would have been awarded, had not the plaintiff's own delay disentitled her to relief.

Man's own name. Use not restrained unless fraudulent.

In some cases the use of a man's own name may be such as to deceive, and where this is so the person aggrieved is entitled to obtain an injunction against such use of the name (*d*); but he must prove clearly the fraudulent intent, and "it is a question of evidence in each case whether there is false representation or not" (*e*). It is not sufficient in such cases to show that the use of the name, though honest, may cause confusion. Thus, in *Turton & Sons, Ld.* v. *Turton* (*f*) the plaintiffs carried on an old-established business in Sheffield as Thomas Turton & Sons, Ld., and the defendant John Turton, who had for

(*a*) *Christy* v. *Murphy*, 12 How. Pr. 77, R. Cox, 164; *Montague* v. *Moore*, Seton, 4th ed. 238.

(*b*) *Milner* v. *Reed*, Dig. 328.

(*c*) 41 L. J. Ch. 101.

(*d*) *Churton* v. *Douglas*, Johns. 174; *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Fullwood* v. *Fullwood*, W. N. 1873, pp. 93, 185; *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176; *Holloway* v. *Holloway*, 13 Beav. 209; *Pullar* v. *Pullar*, Fry, J., April 9th, 1883; *Melachrino & Co.* v. *Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888; *Nicholls* v. *Kimpton*, 3 Times L. R. 674; *Birmingham Vinegar Brewery Co., Ld.* v. *Liverpool Vinegar Co., Ld.*, W. N. 1888, p. 139; *Atkinson* v. *Atkinson*, 85 L. T. (Journal), 229; *Warner* v. *Warner*, 5 Times L. R. 359; *Tussaud* v. *Tussaud*, 38 W. R. 440; *Holmes* v. *Holmes*, 37 Conn. 278, 9 Amer. Rep. 324; *Gillis* v. *Hall*, R. Cox, 596; *Devlin* v. *Devlin*, 69 N. Y. 212; *Shaver* v. *Shaver*, 54 Iowa, 208; *India Rubber Comb Co* v. *Rubber Comb & Jewelry Co.*, 45 N. Y. Super. Ct. 258; *Landreth & Sons* v. *Landreth*, 22 Fed. Rep. 41; *Gage* v. *Canada Publishing Co.* 11 Can. Sup. Ct. 306; *Rogers Manufacturing Co.* v. *Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495; *Frazer* v. *Frazer Lubricator Co.*, 121 Ill. 147. See *Christie* v. *Christie*, L. R. 8 Ch. 499; *McGowan Bros. Pump & Machine Co.* v. *McGowan*, 2 Cinc. 313.

(*e*) Per Turner, L. J., in *Burgess* v. *Burgess*, *ubi suprà*. And see *Turton & Sons, Ld.* v. *Turton*, 42 Ch. D. 128; *Rogers* v. *Rogers*, 53 Conn. 121.

(*f*) 42 Ch. D. 128. And see *Rogers* v. *Rogers*, *ubi suprà*; *Iowa Seed Co.* v. *Dorr*, 70 Iowa, 481; *Rogers Manufacturing Co.* v. *Simpson*, 54 Conn. 527; *Brown Chemical Co.* v. *Myer*, 31 Fed. Rep. 453.

some years carried on a similar business in the same town as John Turton & Co., took his two sons into partnership, and changed his trade name to John Turton & Sons; and although some confusion was proved, the Court of Appeal held that, the name adopted being a true statement of the composition of the firm, and there being no proof or even allegation of fraud, no injunction could be granted. Lord Esher, M. R., said, "If all that a man does is to carry on the same business (as another trader), and to state how he is carrying it on, that statement being the simple truth, and he does nothing more with regard to the respective names, he is doing no wrong. He is doing what he has an absolute right by the law of England to do; and you cannot restrain a man from doing that which he has an absolute right by the law of England to do." And Cotton, L. J., added: "The Court cannot stop a man from carrying on his own business in his own name, although it may be the name of a better known manufacturer, when he does nothing at all in any way to try and represent that he is that better known and successful manufacturer." But where a person has allowed another to use his name, and acquire a reputation under it, he will not afterwards be allowed himself to use his name so as to deceive, nor to empower others to use it so as to produce that result, nor will such others be permitted so to use it. Thus, where one Holbrook, an employé of the Birmingham Vinegar Brewery Co., Ld., had allowed the company to use his name for twelve years as part of the title of their goods—*e.g.* "Holbrook's Worcestershire Sauce," "Holbrook's London Relish," "Holbrook's Pure Pickles"—he was not allowed, on leaving their service and entering that of the Liverpool Vinegar Co., Ld., to give the latter a right to use his name as part of the same titles, nor were they allowed so to use it (*a*).

(*a*) *Birmingham Vinegar Brewery Co., Ld.* v. *Liverpool Vinegar Co., Ld.*, W. N. 1888, p. 139.

Evidence of fraudulent intention was supplied in one case (*a*) by a removal by the defendant into the neighbourhood in which the plaintiff was carrying on his business, and the addition of "and Co." to the name "H. Fullwood," the plaintiff's trade name being "R. J. Fullwood & Co"; and in another case (*b*), in which the same person was plaintiff, by a representation that the business of M. Fullwood and E. Fullwood, trading as "E. Fullwood & Co.," had been established in 1785, and was carried on at Hoxton, those facts being true of the business of R. J. Fullwood & Co., but not of that carried on by the defendants. In a third case (*c*), the defendant, who had sold his business and the goodwill, including the name, "John Douglas & Co.," recommenced business, and employing the three managing men of his former business, styled his new business "John Douglas & Co.," and sent round circulars informing the public that his firm was so well known that it was unnecessary to say anything about it; thus, in fact, "representing himself to be the owner of that which he had sold." So, too, it was held to be fraud for a person who had recently come into the neighbourhood of the "Carriage Bazaar" in Baker Street, and set up a "Carriage Repository," to

Evidence of fraud.

(*a*) *Fullwood* v. *Fullwood*, W. N. 1873, pp. 93, 185. So where the plaintiff carried on business as "Newman & Co." and the defendant bought a similar business carried on as "H. Newman," and changed the name to "Newman & Co.": *Holt* v. *Smith*, 4 Times L. R. 329. And where the plaintiff dealt in "Warner's Safe Cures," and the defendant, who was also named Warner, bought the goodwill of "Ashton's Gout and Rheumatic Cure," and changed the name to "Warner's Gout and Rheumatic Cure": *Warner* v. *Warner*, 5 Times L. R. 359.

(*b*) *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176. And see *Glen & Hall Manufacturing Co.* v. *Hall*, 61 N. Y. 226. Where Robert Minton Taylor, formerly a member of the firm of Minton, Hollins & Co., set up for himself as Robert Minton Taylor & Co., and, on being threatened with legal proceedings, undertook to trade only as Robert Minton Taylor, it was held that a purchaser of R. M. Taylor's business could not carry it on under the style of "The Minton Brick and Tile Co.": *Campbell* v. *Hollins*, Dig. 548.

(*c*) *Churton* v. *Douglas*, Johns. 174. But see the American cases of *Howe* v. *Searing*, 10 Abb. Pr. 264, R. Cox, 244; *Reeves* v. *Denicke*, 12 Abb. Pr. N. S. 92; and *Booth* v. *Jarrett*, 52 How. Pr. 169.

change that name to the "New Carriage Bazaar," with some incorrect additions (*a*). But where the plaintiff had been for eight years in the habit of engaging Dr. Richter to conduct concerts in London, which the plaintiff advertised and made popular by the name of "Richter Concerts," and in 1887 Dr. Richter declined to continue to act with the plaintiff, and agreed to conduct concerts in London for the defendant, who began to advertise them as "Richter Concerts," it was held that the name "Richter Concerts" meant concerts conducted by Dr. Richter, and was properly applied to the proposed concerts, and that no injunction could be granted (*b*).

Change of name copied.

Where the plaintiff had changed his name to Frank Leslie, and his son had, by his orders, assumed the same name, and the plaintiff had afterwards brought out "Frank Leslie's Illustrated News," and other publications of the titles of which his new name formed part, it was held that there was no ground for restraining the publication by the son of "Frank Leslie Junior's Sporting and Dramatic Times" (*c*). On the other hand, where Dr. Trust had changed his name to Gouraud, but his sons had not changed their name, the latter were restrained from selling a preparation with a statement that it was prepared by Dr. Gouraud's sons, there being a representation which, though not strictly false, was yet calculated to mislead (*d*).

Deceptive circulars.

Again, a fraudulent intention may be shown to exist by the production of deceptive circulars so framed by the defendant as to represent his business to be identical with or a continuation of that carried on by the plaintiff; and such a fraud will be restrained (*e*). Thus, in *Mogford* v.

(*a*) *Boulnois* v. *Peake*, 13 Ch. D. 513. And see *Cave* v. *Myers*, Dig. 304; *Atkinson* v. *Atkinson*, 85 L. T. (Journal) 229; and *Glen & Hall Manufacturing Co.* v. *Hall*, 61 N. Y. 226.

(*b*) *Franke* v. *Chappell*, 57 L. T. N. S. 141.

(*c*) *England* v. *New York Publishing Co.*, 8 Daly, 375.

(*d*) *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627.

(*e*) *Churton* v. *Douglas*, Johns. 174; *Stevens* v. *Paine*, 18 L. T. N. S. 600; *Purser* v. *Brain*, 17 L. J. Ch. 141; *Christie* v. *Christie*,

Courtenay (*a*), the defendant issued a circular of which the effect was to represent that he was carrying on the business which he had previously carried on in partnership with the plaintiff, although under the partnership articles the entire goodwill vested in the plaintiff on dissolution.

Opening letters.

So, too, one person will not be allowed to defraud another by opening letters addressed to him, and executing orders intended for him (*b*). Where, however, various acts of misrepresentation by the defendant were alleged, pointing to an intention to simulate the plaintiff, but only one case was made out, in which the defendant had opened a letter addressed to the plaintiff, answered it in his own name, and endeavoured to obtain the custom offered by that letter to the plaintiff, it was held that, though this raised grave suspicion of the defendant's motives, yet it was not sufficient ground for an injunction. The defendant, however, was refused his costs (*c*).

Fraudulent partnership.

Nor will fraud be permitted to be perpetrated under cover of a partnership got up for the purpose of fraud (*d*). Thus, in *Clayton* v. *Day* (*e*), an ironmonger's assistant named Day, and a general shopkeeper named Martin, were not allowed to carry on the business of blacking manufacturers under the name of "Day and Martin,"

L. R. 8 Ch. 499; *Burrows* v. *Foster*, 1 N. R. 156; *Graveley* v. *Winchester*, Seton, 4th ed. 257; *Selby* v. *Anchor Tube Co.*, W. N. 1877, p. 191.

(*a*) 45 L. T. N. S. 303.

(*b*) *Scheile* v. *Brakell*, 11 W. R. 796; Seton, 4th ed. 253; *Witt* v. *Corcoran*, *ib.* 257; *England* v. *Curling*, 8 Beav. 129; *Vernon* v. *Hallam*, 34 Ch. D. 748.

(*c*) *Edgington* v. *Edgington*, 11 L. T. N. S. 299.

(*d*) *Croft* v. *Day*, 7 Beav. 84; *Moet* v. *Clybourn*, Dig. 533; *Schweitzer* v. *Atkins*, 37 L. J. Ch. 847; *Dence* v. *Mason*, Dig. 534, 41 L. T. N. S. 573; *Dence* v. *Brand*, W. N. 1881, p. 31; *Holmes* v. *Holmes*, 37 Conn. 278; 9 Amer. Rep. 324.

(*e*) 26 Sol. J. 43, 76 L. T. (Journal) 79. But in America a fictitious partnership has been permitted to give to one of two partners, who had become the successor to the partnership business, a right to use the same trade name which had been formerly used by the partnership, and which consisted of the united names of the two former partners; although, apart from the fictitious partnership, he would have been prevented from so doing by the Massachusetts Gen. Stat. c. 56, which requires the consent of a former partner, or of his personal representative, to the continued use of his name in the business, and such consent was refused: *Hallett* v. *Cumston*, 110 Mass. 29.

though they were left free to trade as "Martin and Day." Similarly, in *Melachrino* v. *Melachrino Egyptian Cigarette Co.* (*a*), the plaintiff's cigarettes being well known as "Melachrino cigarettes," a person named Poulides took a brother of the plaintiff into his service, under an agreement by which Poulides was to have the right to use his name and Poulides then opened a business close to the plaintiffs, under the name of The Melachrino Egyptian Cigarette Co., and used the name "Melachrino" in various ways calculated to deceive, and an injunction was granted. Again, in *M. Melachrino & Co.* v. *R. Melachrino & Co.* (*b*), Poulides, the defendant in the previous action, went to Egypt as soon as an interlocutory injunction had been granted in that action, and induced a person named Melachrino, who was not connected with the plaintiffs, but was a tobacconist in a small way of business in Alexandria, to enter into partnership with him and come to England to establish a business under the name of "R. Melachrino & Co.," the plaintiffs being "M. Melachrino & Co.," and they used various fraudulent devices. An injunction was again granted.

Vendor of business may recommence business.

On the sale of the goodwill of a business, the vendor, in the absence of a special stipulation on the point, retains the right of recommencing business, even in his own name, however similar that may be to the trade name of the business the goodwill of which has been sold; provided that he scrupulously abstains from doing anything to induce the public to believe that his new business is in fact the old one which he has sold. If, however, he does anything calculated to induce the belief that his new business is not merely similar to, but is identical with, the old one, the purchaser of the old business is entitled to restrain him by injunction (*c*).

(*a*) 4 P. R. 215.
(*b*) Chitty, J., May 27th, 1888.
(*c*) *Cruttwell* v. *Lye*, 17 Ves. 335; *Churton* v. *Douglas*, Johns. 174; *Johnson* v. *Helleley*, 34 Beav. 63; *Hudson* v. *Osborne*, 39 L. J. Ch. 79. *Tudor* v. *Tudor*, W. N. 1873, p. 72, depended on an express stipulation in the deed under which the plaintiff retired from the business.

Dissolution of partnership.

On the dissolution of a partnership, if the whole concern and the goodwill are sold, the trade name is sold with them (*a*). But if the partners merely divide the partnership assets, and there are no express stipulations in the articles as to the disposal of the trade name, then each is at liberty to use the old name just as the partnership did before (*b*); at all events, if no injury will be thereby caused to a partner whose name the firm have used (*c*). Where there are express stipulations in a deed, the parties are of course bound. Thus, in *Day* v. *Finch* (*d*) a member of the dissolved firm of "Benjamin Finch & Co.," who had agreed to carry on business after the dissolution in his own name only, was restrained from continuing to use the words "and Co." after the name "Benjamin Finch." But where, on a dissolution of partnership, it was agreed that neither partner was to use the firm name, but that each was to be at liberty to manufacture the same articles as had been manufactured by the firm, and one of the partners set up in business on his own account and put up over his shop the name "Hodgson, late of Matthews & Hodgson," the words "late of" being in small type, it was held that no breach of the agreement had been committed (*e*); and where a business carried on as "Madame Élise" was purchased under an agreement which recited (inaccurately) that the business had been carried on as "Madame Élise & Co.," and gave the purchaser the right to use that name, it was held that the purchaser was not entitled to trade as "Madame Élise" simply (*f*).

(*a*) *Banks* v. *Gibson*, 34 Beav. 566. See *Hoffman* v. *Duncan*, Seton, 4th ed. 256; *Witt* v. *Corcoran*, *ib.* 257.

(*b*) *Ib.* See *Clark* v. *Leach*, 32 Beav. 14; *Dence* v. *Mason*, Dig. 534; *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Levy* v. *Walker*, 10 Ch. D. 436; *Rogers* v. *Taintor*, 97 Mass. 291.

(*c*) *Scott* v. *Rowland*, 20 W. R. 508; *Levy* v. *Walker*, 10 Ch. D. 436; *Fenton* v. *Levy*, 29 Sol. J. 735; *Chappell* v. *Griffith*, 53 L. T. N. S. 459. *Gray* v. *Smith*, 43 Ch. D. 208. See *Chatteris* v. *Isaacson*, 57 L. T. N. S. 177.

(*d*) 25 Sol. J. 354. And see *Tudor* v. *Tudor*, W. N. 1873, p. 72; *Vernon* v. *Hallam*, 34 Ch. D. 748; *Brewer* v. *Lamar*, 69 Ga. 656.

(*e*) *Matthews* v. *Hodgson*, 2 Times L. R. 899.

(*f*) *Chatteris* v. *Isaacson*, 57 L. T. N. S. 177.

Rights of retiring partner.

If, again, on the dissolution of partnership, one partner takes over the whole concern by arrangement, he must compensate the other partner for his interest in the trade name (*a*), and the retiring partner is at liberty to set up a similar business in his own name, even on adjoining premises (*b*).

Scott v. *Scott*.

In *Scott* v. *Scott* (*c*), R. & W. Scott carried on business in partnership in Nithsdale, and in Glasshouse Street, Regent Street, as "R. & W. Scott." The partnership being dissolved, the agreement for the dissolution contained no stipulation by either party not to continue the business, but neither of the parties was to use the name of the firm, except so far as might be necessary for winding up the partnership affairs. W. Scott retiring from the business, and setting up for himself in the neighbourhood of Nithsdale, R. Scott retained the London premises of the late firm, and made them over with his business to the defendants Scott & Nixon. The inscription used by the late firm over their house at Glasshouse Street having been "R. & W. Scott of Nithsdale," the defendants replaced this by "Scott & Nixon, late R. & W. Scott of Nithsdale." Upon this W. Scott filed a bill against them, and on motion for injunction, the injunction was granted to restrain the defendants from permitting that inscription to remain, and from representing their business to be in continuance of that carried on by the late partnership of R. & W. Scott (*d*).

Representations that plaintiff has retired.

The injury caused by the defendants to the plaintiffs is even greater than in an ordinary case of misappropriation of a trade name, when the representations made by the defendants go to show that the plaintiffs have retired from business, and that the defendants have succeeded to the business formerly carried on by them. Thus, where

(*a*) *Banks* v. *Gibson*, 34 Beav. 566.

(*b*) *Bond* v. *Milbourn*, 20 W. R. 197; *Mogford* v. *Courtenay*, 45 L. T. N. S. 303.

(*c*) 16 L. T. N. S. 143.

(*d*) See *Selby* v. *Anchor Tube Co.*, W. N. 1877, p. 191.

the defendants had acquired a lease of works at which the plaintiffs had formerly manufactured bricks, but not of the mines from which the brick-clay used by the plaintiffs had been obtained, and then issued cards and circulars, styling themselves "E. J. & J. Pearson (late Harpers & Moore)," and otherwise representing themselves to have succeeded to the business of the plaintiffs, who were, as a matter of fact, carrying on their business on other works, the defendants were restrained by injunction from their misrepresentations (*a*); and Wood, V.-C., expressed an opinion that, on application by the owner of the mines of fire-clay used by the plaintiffs, but not by the defendants, the issue of an injunction would have been almost a matter of course.

Former firm or employer may be stated.

A person who has been a member or employé of a firm of reputation, and who sets up in business on his own account, is entitled, unless he has contracted not to do so (*b*), to derive what benefit he may from a fair statement of the fact of his former employment (*c*), which is usually expressed by the addition after his own name of the name of his former firm or employer, with the words "late of," or "late with." But such statement must be made in an unambiguous way, and not in such a manner as to induce the belief that the tradesman in question is selling the goods of his former firm or employer. For the purposes of

(*a*) *Harper* v. *Pearson*, 3 L. T. N. S. 547; also *Scott* v. *Scott*, 16 L. T. N. S. 143; *Stevens* v. *Paine*, 18 L. T. N. S. 600; *Reeves* v. *Denicke*, 12 Abb. Pr. N. S. 92; *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627. And as to a representation of one business being a continuation of another, see *Churton* v. *Douglas*, Johns. 174; *Burrows* v. *Foster*, 1 N. R. 156; *Witt* v. *Corcoran*, Seton, 4th ed. 257; *Graveley* v. *Winchester*, *ib.* 257; *Montague* v. *Moore*, *ib.* 238; *Selby* v. *Anchor Tube Co.*, W. N. 1877, p. 191; *England* v. *Curling*, 8 Beav. 129; *Vernon* v. *Hallam*, 34 Ch. D. 748; *Hoxie* v. *Chaney*, 143 Mass. 592.

(*b*) *Wolmershausen* v. *O'Connor*, 36 L. T. N. S. 921.

(*c*) See per Wood, V.-C., in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; also *Clark* v. *Leach*, 32 Beav. 14; *Emerson* v. *Badger*, 101 Mass. 82; *Boswell* v. *Mathie*, Ct. Sess. Cas. 4th Ser. XI. 1072; *Van Wyck* v. *Horowitz*, 46 N. Y. Sup. Ct. 237; *Wolfe* v. *Alsop* (1), 10 Vict. L. R. (E.) 41; and cases *infrà*. But see *Selby* v. *Anchor Tube Co.*, W. N. 1877, p. 191.

the plaintiff's right to relief it is a matter of indifference whether or not the defendant has acted with a fraudulent intention; if what he has done is, though unintentionally, calculated to deceive "the unwary, the heedless, the incautious portion of the public" (*a*), the plaintiff is entitled to protection just as much as if there were intentional fraud.

Glenny v. *Smith.*

In *Glenny* v. *Smith* (*b*) the defendant, who had been in the plaintiff's service, opened a shop in Oxford Street, where he placed his own name over the door, but on the brass plates and on the awning the words, "from Thresher & Glenny," "from" being in much smaller letters than the plaintiff's name. It further appeared that the defendant's own name over the door was quite hidden when the awning was let down. Kindersley, V.-C., granted an injunction (*c*).

Hookham v. *Pottage.*

In *Hookham* v. *Pottage* (*d*), the parties had been tailors in partnership at Oxford, the defendant having been formerly the plaintiff's manager, and afterwards taken into partnership by him. On the dissolution of the partnership it was arranged that the plaintiff was to continue the business, the defendant receiving from the plaintiff such an amount as should be found to be due to him. The plaintiff, in continuing the business, styled himself "Hookham & Co.," and the defendant setting up close to him, put over his shop, "S. Pottage, from Hookham & Pottage." There was some evidence of deception, and Malins, V.-C., granted an injunction, which decision was upheld by the Court of Appeal.

Other cases.

In *Foot* v. *Lea* (*e*), an older case, the Master of the Rolls

(*a*) V.-C. Kindersley, in *Glenny* v. *Smith*, 2 Dr. & Sm. 476.

(*b*) *Ubi suprà.*

(*c*) See, too, *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Dence* v. *Mason* (1), Dig. 534; *Colton* v. *Thomas*, 2 Brews. 308, R. Cox, 507; *Boswell* v. *Mathie*, Ct. Sess. Cas. 4th Ser. XI. 1072; *Wolfe* v. *Alsop*, 12 Vict. L. R. (E.) 421.

(*d*) L. R. 8 Ch. 91. And see *Selby* v. *Anchor Tube Co.*, W. N. 1877, p. 191.

(*e*) 13 Ir. Eq. 490. And see *Matthews* v. *Hodgson*, 2 Times L. R. 899.

in Ireland was of opinion that there was no attempt to deceive on the part of the defendant, who had used show-boards and labels on which his own name was followed by "late of Lundy, Foot & Co.," the latter name being of equal size with the defendant's, and he accordingly refused the injunction, with leave to bring an action at law. In *Williams* v. *Osborne* (*a*), Wood, V.-C., was of a similar opinion, and dismissed the bill, and, on account of the extreme haste with which it had been filed, with costs. In a more recent case (*b*), the defendants, who had been forewomen in the plaintiff's shop in Paris, used on their window blinds in Bond Street, the words "Ex 1ères de la," in small letters, followed by "Maison Boissier de Paris," in large letters, to signify their former employment; and although V.-C. Malins declined to restrain the use of those words, notwithstanding that they were not generally understood in London as equivalent to "from," he left the defendants to pay their own costs.

Name of establishment.

Deception of the same kind will be restrained when what is imitated is not a name of an individual or firm, but a designation of the place at which the business of an individual or firm is carried on, and by which it is known and recognised. Thus, "Osborne House" (*c*), "The Carriage Bazaar" (*d*), "The Bodega" (*e*), "The New York Dental Rooms" (*f*). But in such cases the plaintiff must prove that there is something distinctive in the appellation which he has given to his establishment, since no relief can be given him if that appellation is merely descriptive, as "The Antiquarian Book Store" (*g*), "The

(*a*) 13 L. T. N. S. 498.
(*b*) *Robineau* v. *Charbonnel*, W. N. 1876, p. 160.
(*c*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79.
(*d*) *Boulnois* v. *Peake*, 13 Ch. D. 513.
(*e*) *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371, at the hearing of the action.
(*f*) *Sanders* v. *Utt*, 16 Mo. App. 322 (the rooms were in St. Louis, Mo.). See *Sanders* v. *Jacob*, 20 Mo. App. 96.
(*g*) *Choynski* v. *Cohen*, 39 Cal. 501, R. Cox, 593.

Mammoth Wardrobe" (*a*), "The Tower Palace" (*b*), "Misfits Parlours" (*c*); and he must also prove that the result of the defendant's acts is to represent that his business is identical with that carried on by the plaintiff, as in *Cave* v. *Myers* (*d*), where the defendant, whose shop was in a corner house close to the establishment of the plaintiffs, Messrs. Cave, adopted for his shop the name of "Cavendish House," and had it so painted up that "Cave" appeared on the side of the street in which was the plaintiff's shop, and the remainder round the corner, and *Genin* v. *Chadsey* (*e*), where the plaintiff was the proprietor of "The Captain's Live-and-Let-Live Oyster and Dining Saloon," and the defendant set up "G. W. Chadsey & Co.'s Great Eastern Live-and-Let-Live Dining Saloon." On the other hand, it was held (*f*) that "Great I X L Auction company" was not likely to be mistaken for "I X L General Merchandise Auction Store," and where the defendant had put up a sign with the words "Depôt of the Cherry Pectoral Company," and inside his premises a notice, "Ayer's Cherry Pectoral, One Dollar; Rushton's Cherry Pectoral, Fifty Cents. Which will you have?" it was held that the defendant had done no more than trade in fair competition with the plaintiff, as he was entitled to do (*g*); but when fraud is proved or admitted, it will be restrained (*h*).

Sign-board.

In *Walker* v. *Alley* (*i*) it was decided that the name and sign of "The Golden Lion" was so connected with the plaintiff's dry goods business that it could not be taken by another trader; and the Chancellor of Upper

(*a*) *Gray* v. *Koch*, 2 Mich. N. P. 119.
(*b*) *Armstrong* v. *Kleinhaus*, 1 Ky. L. Rep. 112; 82 Ky. 303.
(*c*) *Cohn* v. *Kahn*, 26 Alb. L. J. 342.
(*d*) Dig. 304.
(*e*) Cited in *Dixon Crucible Co.* v. *Guggenheim*, R. Cox, 567. And see *Hoby* v. *Grosvenor Library Co.*, 28 W. R. 386 ("Grosvenor Library"); *Wheeler* v *Johnston*, 3 L. R. Ir. 284 ("Cromac Springs"); and *Glen & Hall Manufacturing Co.* v. *Hall*, 61 N. Y. 226, 19 Amer. Rep. 278 ("No. 10, South Water Street, Rochester, New York").
(*f*) *Lichtenstein* v. *Mellis*, 8 Oreg. 464.
(*g*) *Ayer* v. *Rushton*, 7 Daly, 9.
(*h*) *Cohn* v. *Kahn*, 26 Alb. L. J. 342.
(*i*) 13 Grant. Up. Can. Ch. 366.

Canada said that "where it is clear to the Court that the defendant himself intended an advantage by the use of a particular sign or mark in use by another, and believes he has obtained it, or, in other words, that the defendant himself thought the use of it was calculated to advertise him at the expense of the plaintiff, and this was his object in using it, and where such has been the effect of the user, I think the Court should say to him, 'Remove that sign; its use by you may, as you intend, damage the plaintiff. It cannot be necessary or valuable to you for any other purpose. You have your choice of many signs which, as a mere attraction, or to give your store a marked designation, must answer a fair business purpose equally well.'"

No right in name of private house or telegraphic address.

Apart from a business of some kind, no exclusive right can be acquired in the name of a house, any more than in the name of a person, and no right of action arises from the annoyance occasioned by a person renaming his residence after the neighbouring residence of another householder (*a*). And where an abbreviated telegraphic address ("Street, London") had been used for many years by a business firm, and another firm of a different character afterwards adopted the same telegraphic address, it was held that the confusion which ensued was *damnum absque injuriâ*, and that no injunction could be granted (*b*).

Hotel.

The same principle which governs the names of business establishments has been extended to hotels, and a proprietor of one already established has been held entitled to protection against the setting up of hotels in the same neighbourhood under a similar title. Thus, "The Irving House" (*c*), "The What Cheer House" (*d*), and "The McCardel House" (*e*), have been protected.

(*a*) *Day* v. *Brownrigg*, 10 Ch. D. 294.

(*b*) *Street* v. *Union Bank of Spain & England*, 30 Ch. D. 156.

(*c*) *Howard* v. *Henriques*, 3 Sand. S. C. 725, R. Cox, 129.

(*d*) *Woodward* v. *Lazar*, 21 Cal. 448, R. Cox, 300; *Gamble* v. *Stephenson*, 10 Mo. App. 581.

(*e*) *McCardel* v. *Peck*, 28 How. Pr. 120, R. Cox, 312.

Must be distinctive.

On the other hand, the Scotch Court of Session has held that the proprietor of "The Station Hotel" was not entitled to interfere with the use of the name "The Royal Station Hotel" for another hotel in the same neighbourhood, the plaintiff's name not being distinctive, and the defendant's name being sufficiently distinguished by the insertion of the word "Royal" (*a*).

Name goes with building.

But it seems that where a name has been attached to a building it passes with it, and cannot be retained or dealt with by the former owner apart from the building. Thus, in *Booth* v. *Jarrett* (*b*), the founder of "Booth's Theatre," who had gained a reputation for it by his skill in acting, and had named it after himself, attempted, without success, to prevent the continued use of the name by a person into whose possession the theatre had subsequently come, the name having passed to the defendant with the building and goodwill. Again, in *Mason* v. *Queen* (*c*) the proprietor of the "Waverley Hotel," Glasgow, sold his premises to a railway company, who compensated him for the removal. He afterwards assigned the goodwill of his business and trade name to the plaintiff, who was carrying on another hotel in a different part of Glasgow, the name of which was thereupon changed to the "Waverley." The railway company did not require the actual site of the old hotel for their purposes, and subsequently let it to the defendant, who reopened the hotel under the name of the "Old Waverley Hotel," and it was held that the plaintiff was not entitled to restrain the defendant from so doing. In *Woods* v. *Sands* (*d*) it was held that the founder of "Woods' Hotel," who had sold and afterwards repurchased his interest in it, had recovered by the reassignment his exclusive right in the name, and the use of it by another person was prohibited. So, in *Armstrong* v. *Kleinhaus* (*e*) the

(*a*) *Charleson* v. *Campbell*, Ct. of Sess. Cas., 4th Ser. IV. 149.
(*b*) 52 How. Pr. 169.
(*c*) 23 Scot. L. Rep. 641.
(*d*) Dig. 467.
(*e*) 1 Ky. L. Rep. 112; 82 Ky. 303.

tenant of a business house which he had called "The Tower Palace," was held to have no right in the name capable of being transferred to a different building elsewhere. And in *Pepper* v. *Labrot* (*a*) it was held that the name "Oscar Pepper's Old Crow Distillery" had become attached to the distillery, and that Oscar Pepper's son and successor in business, on whose bankruptcy the distillery was sold, was not entitled to interfere with the use by the purchaser of the name "Oscar Pepper" as part of the name of the distillery. But in one Canadian case (*b*) the purchasers of "The Western or Mason's Hotel" were protected in their exclusive right to the name, as against the vendor, who had reoccupied his former premises after the purchaser had been driven out by a fire.

Name of hotel on conveyances.

In the same way, the proprietor of the "Prescott House" Hotel was held entitled to restrain the use of the name by a coach proprietor upon his coaches, an agreement between the latter and a former owner of the hotel being treated as having been in the nature of a revocable licence, which had been revoked upon the sale of the hotel to the plaintiff (*c*). And not only the proprietors of such establishments have been protected in respect of the names by which they have been known, but other persons who have contracted with such proprietors for the exclusive conveyance of visitors to and from their hotels, have been held entitled to restrain the use by others not so authorised upon their vehicles and servants' clothing of the name of the establishment with which they were connected (*d*).

Similar cases.

So, again, the name of a line of steamships (*e*), of

(*a*) 8 Fed. Rep. 29.

(*b*) *Massop* v. *Mason*, 18 Grant Up. Can. Ch. 453.

(*c*) *Deiz* v. *Lamb*, 29 N. Y. Super. Ct. 537.

(*d*) *Stone* v. *Carlan*, 13 Mo. L. R. 360, R. Cox, 115; *Marsh* v. *Billings*, 7 Cush. 322, R. Cox, 118. And compare *Knott* v. *Morgan*, 2 Keen, 213.

(*e*) *Winsor* v. *Clyde*, 9 Phila. 513 ("Keystone Line").

collieries (*a*), and of particular waggons (*b*), has been protected.

Name not used in ordinary business.

Closely connected with the cases which concern the rights of an individual or firm in the trade name under which his or their business is carried on, are the cases in which it has been sought by one person to restrain the unauthorised use of his name by another, though he does not himself use that name over a shop, or, in fact, as a trade name usually so called.

Where articles are produced under a certain name.

Where a person produces certain articles, and a representation is made by another that articles not the production of that person are in fact produced by him, there is an injury to the right of property in the name, which has in fact, though not used as a trade mark, yet come to be the producer's means of selling the articles produced.

Author.

Thus, an author is entitled to protection for the name which sells his works for him. In *Lord Byron* v. *Johnston* (*c*), the defendant, who had advertised for sale poems which he represented to be by the plaintiff, but as to which he declined to swear to his belief in their genuineness, was restrained by injunction. And in *Besant* v. *Moffatt & Paige* (*d*) a well-known writer was protected against the use of his name in connection with a book for which he was not responsible.

Humourist.

In *Clemens* v. *Such* (*e*), a humorous writer, whose works were published under the *nom de plume* of "Mark Twain," was held to be entitled to restrain the unauthorised use of that designation by another person. And in *Clemens* v. *Belford* (*f*) it was held that the name might not be connected with matter not written by the plaintiff, though it might be attached to a reprint of matter written by him and not copyrighted. But in *Munro* v. *Beadle* (*g*)

(*a*) *Braham* v. *Beachim*, 7 Ch. D. 848 ("Radstock Collieries").
(*b*) *Shaver* v. *Shaver*, 54 Iowa, 08 ("Shaver Waggons").
(*c*) 2 Mer. 29.
(*d*) 84 L. T. (Journal) 152.
(*e*) Dig. 429.
(*f*) 11 Biss. 459.
(*g*) 46 U. S. Pat. Gaz. 448.

it was thought that one writer of detective stories could not restrain another from using the descriptive name of "Sleuth."

So, again, a legal writer is entitled to prevent the issue as his of works or editions not of his production. In *Archbold* v. *Sweet* (*a*) the plaintiff was the author of a book on a legal subject, of which he had sold the copyright to the defendant. The plaintiff refusing to re-edit the book, the defendant had it edited by another, and the plaintiff thereupon came forward to complain of the inaccuracies which he alleged to be contained in the new edition. Lord Tenterden, C. J., after remarking on the close analogy between that case and those in which an inferior article was sold in the name of a well-known manufacturer, the injury being in the latter case to the sale of the goods, in the former to the character of the author, laid down to the jury that if the new edition, in the form in which it was put forth, would be understood by purchasers who paid reasonable attention to its contents to be by the plaintiff, their verdict must be in his favour.

Legal writer.

So, again, a painter will be protected from having exhibited as his a picture which he has not painted (*b*), and a medical man who compounds medicines from having spurious medicines sold as his (*c*).

Painter.

Medical man.

In all such cases the plaintiff must, of course, show that deception is probable, or he cannot succeed in obtaining the relief he seeks. Thus, where an artist painted a picture, and another person exhibited a diorama imitated from it, it was held that there could be no deception or injury, though if the plaintiff's picture had been a diorama the case would have been different (*d*). So where a person who wrote songs under the name of Claribel sought to restrain the publication of a song described as "written by

Deception must be probable.

(*a*) 1 M. & Rob. 162.
(*b*) *Martin* v. *Wright*, 6 Sim. 297.
(*c*) *Clark* v. *Freeman*, 11 Beav. 112.
(*d*) *Martin* v. *Wright*, 6 Sim. 297.

Claribel," no mention being made of the composer's name, though the music given was not that of Claribel, it was decided that the words "written by" did not imply that the music was also composed by Claribel, and the injunction was refused (*a*).

Clark v. *Freeman.*

The decision in *Clark* v. *Freeman* (*b*) has been much discussed with respect to the right a man has in his name. In that case the plaintiff, Sir James Clark, was an eminent physician, who filed a bill to restrain the advertisement and sale by the defendant of certain pills termed by him "Sir J. Clarke's Consumption Pills," the advertisements being so framed as to be calculated to induce the public to buy the pills as being of the plaintiff's invention. Lord Langdale, M. R., refused to grant the injunction, on the ground that there was no injury to property; but apparently not without some doubt, since he gave leave for the case to be mentioned again to him if cases in support of the bill could be produced. He did not, however, think the cases mentioned to him (*c*) sufficient to warrant him in granting the injunction, but at the same time he remarked that if "Sir James Clark had been in the habit of manufacturing and selling pills, it would have been very like the other cases in which the Court had interfered for the protection of property." The principle on which Lord Langdale's decision was based was that the Court would not interfere where the name pirated by the defendant had not become known to the public in connection with a manufactured article, but was merely a name under which an individual had acquired a certain reputation (*d*). It is evident, however, that the sale of quack medicines under the name of an eminent physician would tend to destroy his reputation and the confidence

(*a*) *Barnard* v. *Pillon*, W. N. 1868, p. 94; and see *Seeley* v. *Fisher*, 11 Sim. 581; and *Archbold* v. *Sweet*, 1 M. & Rob. 162.

(*b*) 11 Beav. 112.

(*c*) *Lord Byron* v. *Johnston*, 2 Mer. 29; and *Routh* v. *Webster*, 10 Beav. 561.

(*d*) See *Delondre* v. *Shaw*, 2 Sim. 237.

of his patients in him, and thereby to cause him a far more severe pecuniary loss than would be incurred by the sale of a few boxes of pills or copies of a book being lost to him. Later judges have, therefore, been of opinion that the case in question "might have been decided in favour of the plaintiff, on the ground that he had a property in his own name" (*a*).

Contracts in respect of names.

Whatever rights a man may, irrespective of contract, have in his own name, so as to be able to prevent the unauthorised use of it by another, it is always open to him to modify those rights by contract, whether by way of permitting others to use his name in a certain manner (*b*), or by way of restraining his own use of it to a certain extent (*c*). Thus, where a publisher had sold to the defendants the copyright of an annual, entitled "Beeton's Christmas Annual," he himself entering into their service, it was held that the defendants were entitled to continue the annual publication under that same name, even after the plaintiff had ceased to remain in their employ, and had become unwilling for his name to be used by them in connection with a work not of his production (*d*). But it seems that, although a contract by which a man binds

(*a*) Per Cairns, L. J., in *Maxwell* v. *Hogg*, L. R. 2 Ch. 307. In *Springhead Spinning Co.* v. *Riley*, L. R. 6 Eq. 561, Malins, V.-C., went even farther. And in *In re Riviere*, 26 Ch. D. 48-53, Lord Selborne, C., observed "that case has seldom been cited but to be disapproved; could not a professional man be injured in his profession by having his name associated with a quack medicine?" In *Williams* v. *Hodge & Co.*, 84 L. T. (Journal) 134, a very similar case, Kay, J., said that the decision in *Clark* v. *Freeman* "was rather a surprising one, and one which he had always thought was not sufficiently considered"; but he did not feel himself at liberty to disregard it on an interlocutory application, in the absence of authority to the contrary. The expressions of opinion of Lord Cairns, Lord Selborne and Malins, V.-C., had apparently not been brought to his notice. Lord Westbury, C., however, spoke of the decision at all events without disapprobation: *Leather Cloth Co.s' case*, 4 De G. J. & S. 137.

(*b*) *Ward* v. *Beeton*, L. R. 19 Eq. 207. See *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Hallett* v. *Cumston*, 110 Mass. 29; *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178; *Coe* v. *Bradley*, 9 U. S. Pat. Gaz. 541.

(*c*) *Ainsworth* v. *Bentley*, 14 W. R. 630; *Ward* v. *Beeton*, *ubi suprà*; *Peltz* v. *Eichele*, 62 Mo. 171; *Coe* v. *Bradley*, 9 U. S. Pat. Gaz. 541.

(*d*) *Ward* v. *Beeton*, *ubi suprà*. See *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

himself to limit in some way his use of his own name can be enforced, a contract so binding him cannot be made by the representative of his estate in bankruptcy, and if such a contract has been entered into, the bankrupt will be entitled to disregard it (*a*).

Name of editor.

The name of the editor of a publication, appearing upon the title page, forms no part of the title. Romilly, M. R., refused, therefore, to restrain the proprietors of a paper, who had agreed with their editor not to alter the title of their paper without mutual consent, from omitting the publication on the title page of the editor's name as such (*b*).

Where name is used so as to injure.

It is clear that a man has a right to prevent the unauthorised use of his name by another person, apart from any special manufacture, where such use of it might involve him in legal or other difficulties. Thus, in *Routh* v. *Webster* (*c*) a bill was filed to restrain the provisional directors of a joint-stock company, called "The Economic Conveyance Company," from using the plaintiff's name in their prospectuses as a trustee of the company without his authority. The defendants setting up by way of defence that what had been done had been done inadvertently, and stating their intention of discontinuing their misrepresentations, the Master of the Rolls granted the injunction, holding that the defendants were not entitled "to use the name of any person they pleased, representing him as responsible in their speculations, and to involve him in all sorts of liabilities, and then to be allowed to escape the consequences by saying they had done it by inadvertence," and also that the plaintiff was in nowise bound to surrender his right to the injunction, trusting to the assurances of the defendants as to their intentions for the future. This decision has been generally

(*a*) *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453; and see *Walker* v. *Mottram*, 19 Ch. D. 355.

(*b*) *Crookes* v. *Potter*, 6 Jur. N. S. 1131.

(*c*) 10 Beav. 561.

approved as an "authority for preventing the improper use of a man's name against his will; not for the restraint of a libel, for no libel was involved" (*a*).

Where, however, a man's name has been used against his will in such a manner as to be libellous, or where statements have been made disparaging the goods sold under his name or trade mark, or threatening persons dealing in his goods, a more difficult question is raised, and one which has not always been answered in the same way. With respect to libels, Lord Cottenham, C., said (*b*), that the Libel Act "appointed a jury as the proper tribunal for trial of injuries to the person by libel or defamation; and that the liberty of the press consisted in the unrestricted right of publishing, subject to the responsibilities attached to the publication of libels, public or private." The principle that the publication of a libel was a crime, and that the Court of Chancery had no jurisdiction to prevent the commission of crimes, except in such cases as those relating to the protection of infants, was laid down by Lord Eldon in 1818 (*c*), and after that time Equity judges frequently stated that it was not within the proper scope of their authority to restrain the publication of libels (*d*). There were, indeed, cases

Trade libel.

(*a*) Per Lord Cairns, C., in *Prudential Assurance Co.* v. *Knott*, L. R. 10 Ch. 142. In *Webster* v. *Webster*, 3 Swanst. 490 n. the injunction was refused because there was no injury to be apprehended. In *Tudor* v. *Tudor*, W. N. 1873, p. 72, there was an express contract. See *Bullock* v. *Chapman*, 2 De G. & Sm. 211; *Dixon* v. *Holden*, L. R. 7 Eq. 488; *Reid* v. *Sibbald*, 18 Journ. of Juris. 392; and cases *infrà*.

(*b*) *Fleming* v. *Newton*, 1 H. L. C. 376. This case was a Scotch one, and the Lord Chancellor was speaking with reference to the Scotch Libel Act, but his remarks are equally applicable to cases arising in England, and under Order XXXVI., rule 2 of the Rules of 1883, a defendant in a libel case can still insist upon a jury.

(*c*) *Gee* v. *Pritchard*, 2 Swanst. 413.

(*d*) *Martin* v. *Wright*, 6 Sim. 297; *Seely* v. *Fisher*, 11 Sim, 581; *Clark* v. *Freeman*, 11 Beav. 112; *Emperor of Austria* v. *Day*, 2 Giff. 628, 3 De G. F. & J. 217 (in particular per Turner, L.J.); *Mulkern* v. *Ward*, L. R. 13 Eq. 619; *Browne* v. *Freeman*, W. N. 1873, p. 178; *Prudential Assurance Co.* v. *Knott*, L. R. 10 Ch. 142; *Fisher* v. *Apollinaris Co.*, *ib.* 297. The same view has been taken in India: *Shepherd* v. *Trustees of the Port of Bombay*, Ind. L. R. 1 Bomb. 132; and in America: *Mauger* v. *Dick*, 55 How. Pr. 132.

in which it was thought that where an injury was occasioned or threatened to a right of property by a libellous statement, the Court had jurisdiction to interfere to protect that right of property (*a*), but, practically speaking, cases which involved the consideration of libellous statements were left to the Courts of Common Law (*b*).

Effect of the Judicature Act, 1873.

The Judicature Act, 1873, however, introduced a new element into the discussion by enacting (§ 25, subs. 8) that "an injunction may be granted by an interlocutory order of the Court in all cases in which it shall appear to the Court to be just or convenient that such order should be made"; and in *Thorley's Cattle Food Co.* v. *Massam* (*c*), Vice-Chancellor Malins suggested that this enactment had conferred upon the Court more extensive powers than those which it previously possessed, and that an injunction might have been granted by virtue of those powers to restrain an injurious and unjust statement. Numerous cases have since been decided with respect to the effect of the section, in some of which expressions were employed which were calculated to lead to the belief that the power to grant injunctions where it was thought to be "just or convenient" conferred a power to grant injunctions in cases in which no legal remedy previously existed (*d*). It is now, however, settled—and this is not opposed to the observations before referred to—that the right view is that the section has enlarged the powers of the Court, not by enabling the Court to grant relief in cases where none was obtainable before in

(*a*) This was especially the view of Malins, V.-C. See *Dixon* v. *Holden*, L. R. 7 Eq. 488; *Springhead Spinning Co.* v. *Riley*, L. R. 6 Eq. 561; *Rollins* v. *Hinks*, L. R. 13 Eq. 355; *Axmann* v. *Lund*, L. R. 18 Eq. 330. And see also *Emperor of Austria* v. *Day*, 3 De G. F. & J. 217; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *James* v. *James*, L. R. 13 Eq. 421.

(*b*) For the principles by which the Courts of Common Law were guided, see *Wren* v. *Weild*, L. R. 4 Q. B. 730; *Western Counties Manure Co.* v. *Lawes Chemical Manure Co.*, L. R. 9 Ex. 218.

(*c*) 6 Ch. D. 582.

(*d*) See *Beddow* v. *Beddow*, 9 Ch. D. 89; *Quartz Hill Consolidated Gold Mining Co.* v. *Beall*, 20 Ch. D. 501.

any of the Superior Courts, but by way of giving each branch of the High Court power to grant relief in cases which could previously be brought only in the same or a different form before some other branch of the Court (*a*); so that, as Cotton, L. J., said in the case of *North London Railway Co.* v. *Great Northern Railway Co.* (*b*), "where there is a legal right which was, independently of the Act, capable of being enforced either at law or in equity, there, whatever may have been the previous practice, the High Court may interfere by injunction in protection of that right."

Conditions necessary for injunction.

The injunction may be granted to restrain the continued publication of a libel which has been found to be so by the verdict of a jury (*c*), or it may be granted to restrain the publication of statements which have not been submitted to a jury (*d*). But where the Court is asked to grant an injunction, especially on an interlocutory application, without the assistance of a jury, the jurisdiction which it possesses so to do is one which must be exercised very carefully (*e*), and it ought not to be exercised unless the statements of which complaint is made are proved to be untrue (*f*), unless they are injurious to the plaintiff (*g*),

(*a*) *Day* v. *Brownrigg*, 10 Ch. D. 294; *Ward* v. *Drat*, L. J. N. of C. 1878, p. 67; *Gaskin* v. *Balls*, 13 Ch. D. 324; *Dicks* v. *Brooks*, 15 Ch. D. 22 (per Bacon, V.-C.).

(*b*) 11 Q. B. D. 30.

(*c*) *Saxby* v. *Easterbrook*, 3 C. P. D. 339; *Hinrichs* v. *Bernides*, W. N. 1873, p. 11.

(*d*) As in *Thomas* v. *Williams*, 14 Ch. D. 864.

(*e*) *Quartz Hill Consolidated Gold Mining Co.* v. *Beall*, 20 Ch. D. 501; *Armstrong* v. *Armit*, 2 Times L. R. 887; *Coulson & Sons* v. *Coulson & Co.*, 3 Times L. R. 846; *Liverpool Household Stores Association* v. *Smith*, 37 Ch. D. 170. See *Marks* v. *Conservative Newspaper Co., Ld.*, 3 Times L. R. 244.

(*f*) *Halsey* v. *Brotherhood*, 15 Ch. D. 514; 19 *ib.* 386; *Burnett* v. *Tate*, 45 L. T. N. S. 743; *Anderson* v. *Liebig's Extract of Meat Co., Ld.*, *ib.* 757; *Quartz Hill, &c., Co.* v. *Beall*, *ubi suprà*; *Benbow* v. *Low* (1), 23 Sol. J. 819; *Roper's, &c., Co.* v. *Copeman's, &c., Association, Ld.*, 28 *ib.* 218; *Armstrong* v. *Armit*, 2 Times L. R. 887; *Coulson & Sons* v. *Coulson & Co.*, 3 Times L. R. 846; *Liverpool Household Stores Association* v. *Smith*, 37 Ch. D. 170; *Poulett* v. *Chatto & Windus*, 32 Sol. J. 24. And see *Clover* v. *Royden*, L. R. 17 Eq. 190.

(*g*) *Dicks* v. *Brooks*, 15 Ch. D. 22; and see *Brook* v. *Evans*, 2 L. T. N. S. 740; *Bullock* v. *Chapman*, 2 De G. & Sm. 211.

with reference to his trade or property (*a*), and are so clearly libellous that a contrary verdict of a jury would be set aside as unreasonable (*b*), unless it is proved that the defendant intends to continue to make them (*c*), and that the injury will be irreparable, *i.e.* incapable of compensation by damages (*d*), and unless (in cases of privilege) express malice is also established (*e*). Thus, in *Halsey* v. *Brotherhood* (*f*) the defendant had threatened intending purchasers from the plaintiff, alleging that the plaintiff was manufacturing in infringement of his, the defendant's, patent rights; and Jessel, M. R., and the Court of Appeal held that an injunction could not be granted unless the defendant persisted in making the statements after they had been proved to be false. In *Colley* v. *Hart* (*g*) it was held by North, J., that there was no jurisdiction to restrain the defendant from issuing a circular to the plaintiff's customers, alleging that the plaintiff was infringing his trade marks, and threatening proceedings. And in *Anderson* v. *Liebig's Extract of Meat Co., Ld.* (*h*), Chitty, J., refused to restrain the company (who were taking proceedings to stop the plaintiff from selling his goods as "Baron Liebig's Extract of Meat" and using on the pots a photograph of the Baron) from circulating letters among the plaintiff's customers, stating that he was using the name and photograph without authority, on the

(*a*) See per Lindley, L. J., in *Coulson & Sons* v. *Coulson & Co.*, 3 Times L. R. 846, with which compare the statement by North, J., in *Pollard* v. *Photographic Co.*, 40 Ch. D. 345.

(*b*) *Coulson & Sons* v. *Coulson & Co.*, *ubi suprà*; *Liverpool Household Stores Association* v. *Smith*, 37 Ch. D. 170.

(*c*) *Quartz Hill, &c., Co.* v. *Beall*, 20 Ch. D. 501.

(*d*) *Armstrong* v. *Armit*, 2 Times L. R. 887.

(*e*) *Quartz Hill, &c., Co.* v. *Beall*, *ubi suprà*; *Burnett* v. *Tate*, 45 L. T. N. S. 473; *Armstrong* v. *Armit*, *ubi suprà*; *Coulson & Sons* v. *Coulson & Co.*, 3 Times L. R. 846; *Liverpool Household Stores Association* v. *Smith*, 37 Ch. D. 170.

(*f*) 15 Ch. D. 514; 19 *ib.* 386. See the New York case of *Wolfe* v. *Burke*, 56 N. Y. 115. The precise question raised in *Halsey* v. *Brotherhood* is now settled by § 32 of the Patents Act, 1883, under which numerous cases have been decided, but the general question of injunctions to restrain trade libels remains.

(*g*) 6 P. R. 17.

(*h*) 45 L. T. N. S. 757.

ground that the company was not shown to be acting otherwise than *bonâ fide*, or to be stating that which was untrue.

When granted.

On the other hand, where the necessary facts are present, an injunction will be granted, as in *Thorley's Cattle Food Co.* v. *Massam* (2) (*a*), where it was established that the plaintiffs and defendants were both in possession of and entitled to use the same secret recipe in their respective businesses, and Malins, V.-C., and the Court of Appeal granted an injunction to restrain the defendants from publicly advertising that they alone were acquainted with the secret.

Survival of cause of action.

Where the plaintiff in an action for slander of title to a trade mark and his property therein, dies, the cause of action survives to his legal personal representative (*b*).

Misrepresentations by subsequent manufacturer.

The same principle on which misrepresentations by an original manufacturer with respect to the goods and business of a subsequent manufacturer are restrained, applies with even greater force to similar misrepresentations by the latter, and while it is open to any one to manufacture an unpatented article with the process of manufacture of which he has become acquainted, and also to describe it by the name applied to it by the original inventor so soon as that name shall have become *publici juris*—that is to say, descriptive of a specific article, but not of a specific maker—yet at the same time such subsequent manufacturer is not entitled to carry on an unfair competition in trade with the original maker or his successors in business, by means of assertions or representations that his own article is the only genuine one, or that the article of the original maker or his successors is spurious (*c*).

(*a*) 14 Ch. D. 763; and see *Hill* v. *Hart-Davies*, 21 Ch. D. 798; *Hermann Loog, Ld.* v. *Bean*, 26 Ch. D. 306; *Hayward & Co.* v. *Hayward & Sons*, 34 Ch. D. 198; *Punch* v. *Boyd*, 16 L. R. Ir. 476.

(*b*) *Hatchard* v. *Mège*, 18 Q. B. D. 771.

(*c*) *James* v. *James*, L. R. 13 Eq. 421; *Thomas* v. *Williams*, 14 Ch. D. 864; *Liebig's Extract of Meat Co., Ld.* v. *Anderson* (2), 55 L. T. N. S. 206; *Hirsch* v. *Hirsch & Co.*, 80 L. T. (Journal) 283; *Briton Life Association, Ld.* v. *Roberts*, 2 Times L. R. 319.

"Original."

And where such an assertion or representation is embodied in the title of the later manufacturer's article by its being styled the "original"—an appellation which would naturally suggest the idea of the article in question being the make of the original manufacturer—such fraudulent representation will usually be restrained (*a*). But in the entire absence of evidence as to deception, Wood, V.-C., refused to grant an injunction in a similar case (*b*), and from the result of later litigation between the same parties (*c*) it is clear that the presumption against a person who styles an article of his own manufacture, but not of his invention, "the original," may be rebutted. In *Dence* v. *Mason* (1) (*d*) the defendant was restrained from styling himself the original maker of the "essence of beef," Malins, V.-C., holding that even if he had been the first to actually compound the article, which was not satisfactorily proved, he was not entitled to make such statements as those complained of, since he was in the employ of the plaintiff's predecessor in business at the time when he said he made it for the first time. In *Fullwood* v. *Fullwood* (2) (*e*) the defendants attempted to represent their business to be the original one, by assuming for it the date of establishment of the business which was really the first.

False representation of agency.

A dealer may not represent, contrary to the fact, that he is agent for a manufacturer (*f*); neither may a

(*a*) *Cooke* v. *Chandler*, L. R. 11 Eq. 446; *Lazenby* v. *White*, 41 L. J. Ch. 354. So in *M. Melachrino* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888, where the defendants had placed on their labels the words "R. Melachrino & Co. Original Egyptian cigarettes." And see *Hagg* v. *Darley*, 47 L. J. Ch. 567.

(*b*) *Browne* v. *Freeman*, 12 W. R. 305.

(*c*) *Browne* v. *Freeman*, W. N. 1873, p. 178. This was, however, before the cases under the Judicature Act, 1873, which see *suprà*.

(*d*) Dig. 534; 41 L. T. N. S. 573.

(*e*) 9 Ch. D. 176. And see *Green* v. *Rooke*, W. N. 1872, p. 49; *Wheeler* v. *Johnston*, 5 L. R. Ir. 284; *Whitney* v. *Hinkley*, 5 Grant Up. Can. Ch. [illegible]; *Dowson* v. *Mason*, 18 *ib.* 456; *Maxwell* v. *Wright*, 73 N. Car. [illegible]; *Woods* v. *Sands*, Dig. 467.

(*f*) *Howe* v. *McKernan*, 30 Beav. 547.

manufacturer represent, contrary to the fact, that a dealer is acting as agent for him (*a*).

Deceptive labels and notices.

In other cases the attempt to deceive has been made in different forms: thus, in an early case (*b*), the defendant attempted to attract to himself the custom intended for the plaintiffs by an ingenious variation of their labels, his own labels being facsimiles of those of the plaintiffs, with only the difference that, whereas theirs contained the sentence "Manufactured by Day and Martin," his bore the words "Equal to Day and Martin's," the "Equal to" being in very small type. So, in an American case (*c*), a dentist formerly employed by the Colton Dental Association, on setting up in business for himself, described himself in his notice as "formerly operator at the Colton Dental Rooms," "formerly operator at the" being printed very small. And in another American case (*d*) a former partner in a firm of dentists trading as "Morgan and Schuyler," continued to carry on business at the old premises as "B. F. Schuyler, successor to Morgan and Schuyler," the words preceding the old firm name being in such small letters as to be almost invisible. In *Mallan* v. *Davis* (*e*) a dentist, who had practised for several years in Praed St. with the words "Old-established Dentist" over the door, left that address; and the defendant, who practised as a dentist at another house in Praed St., put up a notice stating that the old-established dentist could be consulted there; and it was held that he had acted in a way calculated to deceive, but no injunction was granted, there having been a delay of three months, and the defendant giving an undertaking to combine his own name in a conspicuous way with the description.

(*a*) *Coleman* v. *Flavel*, 12 Sawy. 220.

(*b*) *Day* v. *Binning*, C. P. Cooper, 489; 1 Leg. Obs. 205. See *Wolfe* v. *Alsop* (1) & (2), 10 Vict. L. R. (E.) 41, 12 *ib.* 421.

(*c*) *Colton* v. *Thomas*, 2 Brews. 308, R. Cox, 507.

(*d*) *Morgan* v. *Schuyler*, 79 N. Y. 490.

(*e*) 3 Times L. R. 221.

Franks v. *Weaver.*

Again, in *Franks* v. *Weaver* (*a*), the plaintiff sold a medicine which he had invented, and which he termed "Franks' Specific Solution of Copaiba," in bottles enclosed in wrappers, on which were printed directions for use, and testimonials. The defendant, an agent of the plaintiff, sold a preparation of his own, labelled "Chemical Solution of Copaiba." The label went on to state that the plaintiff had invented the "Specific Solution," and then gave the testimonials printed by the plaintiff as commendatory of the plaintiff's medicine, and also the same directions for use as those given by the plaintiff. In *Sedon* v. *Senate* (*b*), a person who had sold a medicine to another, set up a new medicine under a similar description, and in his advertisement adopted verses which had been attached to the original medicine. In all these cases, except *Mallan* v. *Davis* (*c*), injunctions were granted.

Directions for use.

With respect to directions for the use of the article, it seems that, as Malins, V.-C., said in *Massam* v. *Thorley's Cattle Food Co.* (1) (*d*), if the article produced by one person is the same as that produced by another, and the former is quite at liberty to produce the same article, then the directions used by the latter are the correct directions for the use of the former's article, and he can only repeat them. In fact, if he could not give the appropriate directions for using the article which he is entitled to make, his liberty to manufacture would be unduly interfered with. The decision in the above case was, however, reversed by the Court of Appeal (*e*) on the general question of representation, the imitation of the directions being referred to as an indication of fraudulent intention, and any trader who uses the same directions as another

(*a*) 10 Beav. 297. And see *Siegert* v. *Findlater*, 7 Ch. D. 801; *Siegert* v. *Ehlers*, Dig. 432; *Dunbar* v. *Glenn*, 42 Wisc. 118.

(*b*) 2 V. & B. 220. And see *Wotherspoon* v. *Gray*, Ct. Sess. Cas. 3rd Ser. II. 38, where the interdict was refused.

(*c*) 3 Times L. R. 221.

(*d*) 6 Ch. D. 574, 581. And see per Cotton, L. J., in *In re Leonard & Ellis*, 53 L. J. Ch. 611.

(*e*) 14 Ch. D. 748.

ought to take great care to prevent the possibility of deception.

To describe articles formerly patented by the name of the former patentee is not necessarily fraudulent, since the name may be used as indicative of a principle of construction (*a*); but in an American case (*b*) an injunction was granted to restrain the defendant from marking goods of his own make as being made under the plaintiff's subsisting patent, notwithstanding an allegation by the defendant that the patent was invalid.

Name of patentee.

The imitation of a peculiar manner of making up and packing goods may, in combination with other circumstances, be held to prove a fraudulent intention; and it seems that, even in the absence of other circumstances of fraud, if the imitation is very significant, and the evidence very conclusive, an injunction will be awarded (*c*).

Mode of packing.

The manner in which the Court interferes by way of injunction to prevent unfair competition in trade is well illustrated by a case which has always attracted a good deal of attention—that of the omnibus companies (*d*). In that case the plaintiffs were the proprietors of a line of omnibuses painted in a particular manner, with the words "Conveyance Company" and "London Conveyance Company" upon them. The defendant ran omnibuses similarly painted, and dressed his servants in livery imitated from that of the plaintiffs' employés. On his being required to alter this, he made some mere colourable

Imitation of line of omnibuses.

(*a*) *Wheeler & Wilson Manufacturing Co.* v. *Shakespear*, 39 L. J. Ch. 35; *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15; and other cases in Ch. 4.

(*b*) *Washburn & Moen Manufacturing Co.* v. *Haish*, 9 Biss. 141.

(*c*) See *Edelsten* v. *Vick*, 11 Hare, 78; *Woollam* v. *Ratcliff*, 1 H. & M. 259; *Anglo-Swiss Condensed Milk Co.* v. *Swiss Condensed Milk Co.*, W. N. 1871, p. 163; *Lever* v. *Goodwin*, 36 Ch. D. 1; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Frese* v. *Bachof* (1), 13 Bl. C. C. 234; S. C. (2), 14 *ib.* 432. See also *Orr* v. *Diaper*, L. R. 4 Ch. D. 92.

(*d*) *Knott* v. *Morgan*, 2 Keen, 213. See also *Stone* v. *Carlan*, 13 Mo. L. R. 360, R. Cox, 115; *Marsh* v. *Billings*, 7 Cush. 322, R. Cox, 118; *Deiz* v. *Lamb*, 29 N. Y. Sup. Ct. 537.

alterations, but really left the matter as it stood at first. Lord Langdale, M. R., on the case coming before him on motion to dissolve an interlocutory injunction, said that he had not the least doubt that the defendant intended to represent his omnibuses to the public as those of the plaintiffs. He said "it was not to be said that the plaintiffs had any exclusive right to the words 'Conveyance Company' or 'London Conveyance Company,' or any other words; but they had a right to call upon that Court to restrain the defendant from fraudulently using precisely the same words and devices which they had taken for the purpose of distinguishing their property, and thereby depriving them of the fair profits of their business by attracting custom on the false representation that carriages, really the defendant's, belonged to and were under the management of the plaintiffs." This case was not at all a case of trade mark, though reference has been made to it as such; the Master of the Rolls expressly denied any exclusive right in the words painted on the vehicles, and personally altered the terms of the injunction so as to avoid creating such a right. In the language of Wood, V.-C. (*a*), "the defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances: the wrong lay in their accumulation, not in any one of them alone." The value of the case really consists in the example it affords of the way in which the aggregation of a number of circumstances, individually comparatively harmless, may produce a result injurious to an individual and obnoxious to the law; and also of the manner in which the law will interfere to protect the interests of honest trade.

Etchings.

Where A had surreptitiously obtained possession of some etchings by B, and had advertised them for exhibition, and a catalogue of them, Lord Cottenham, C., held that

(*a*) *Woollam* v. *Ratcliff*, 1 H. & M. 259.

there was a title to relief alike on the ground of injury to property and on that of breach of trust (*a*).

Trade secrets.

As to the cases which have been decided in respect of trade secrets, the general rule may be stated as being that any person who has, without the use of unfair means, become acquainted with the mode of compounding a secret unpatented preparation, may make and sell the compound, provided he does not lead the public to suppose that his preparation is the manufacture of the original discoverer or of his successors in business; and he may even call the compound made by himself by the same name as that given by the original discoverer to his, so long as he does not sell his own goods as and for those of another (*b*). On the other hand, where the knowledge of the secret process has been acquired by means of a breach of trust, neither the person who has committed the breach of trust, nor any one to whom he has imparted his discovery, will be allowed to make use of the information so surreptitiously acquired (*c*).

Contract not to use or divulge another's secret.

Again, "there is no doubt whatever that where a party who has a secret in a trade employs persons under contract express or implied, or under duty express or implied, those persons cannot gain the knowledge of that secret and then set it up against their employer" (*d*); and, stating it generally, where one person has entered into a contract, express

(*a*) *Prince Albert* v. *Strange*, 1 Mac. & G. 25. See *Pollard* v. *Photographic Co.*, 40 Ch. D. 345.

(*b*) *James* v. *James*, L. R. 13 Eq. 421; *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298; *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Carter* v. *Goetze*, 2 Keen, 581; *Singleton* v. *Bolton*, 3 Doug. 293; *Williams* v. *Williams*, 3 Mer. 157; *Canham* v. *Jones*, 2 V. & B. 218. And see the comments on that case in *Morison* v. *Moat*, 9 Hare, 241. But of course, when the name has become a trade mark, no one but the proprietor can use it. The question is whether the name is descriptive of the article or distinctive of the manufactory. See *Massam* v. *Thorley's Cattle Food Co.* (2), 14 Ch. D. 748.

(*c*) *Williams* v. *Williams*, 3 Mer. 157; *Yovatt* v. *Winyard*, 1 Jac. & W. 394; *Tipping* v. *Clarke*, 2 Hare, 383; *Morison* v. *Moat*, 9 Hare, 241, 21 L. J. Ch. 248; *Estcourt* v. *Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Portal* v. *Hine*, 4 Times L. R. 330.

(*d*) Per Lord Cranworth, L. J., in *Morison* v. *Moat*, 21 L. J. Ch. 248.

or implied (*a*), with another person, to keep that other person's secret, and not to divulge it, nor to use it for his own advantage, he will be restrained by an injunction from so divulging or using the secret in question (*b*); and so will a person who is acting in collusion with him (*c*); and a contract by which, on the sale of a trade secret, the vendor has bound himself not to use that secret, is not invalid as being in restraint of trade (*d*). Where the defendant, who had become acquainted with a trade secret, stood by and allowed the plaintiff to purchase it, without disclosing that he was acquainted with it, it was held that he was estopped from setting up his previous knowledge against the plaintiff, and an injunction was granted to restrain him from using it (*e*).

Name of secret manufacture.

Where the defendant is availing himself of a breach of faith or of contract by means of the use of a certain designation for his goods, in such a case the defendant will be restrained from the use of such designation, although the plaintiff may have no exclusive right in the same, apart from such special circumstances (*f*).

(*a*) See *Tipping* v. *Clarke*, 2 Hare, 383; *Weston* v. *Hemmons*, 2 Vict. L. R. Eq. 121.

(*b*) *Sedon* v. *Senate*, 2 V. & B. 220; *Bryson* v. *Whitehead*, 1 S. & S. 74; *Green* v. *Folgham*, *ib.* 398; *Tipping* v. *Clarke*, 2 Hare, 383; *Morison* v. *Moat*, 9 Hare, 241, 21 L. J. Ch. 248; *Hagg* v. *Darley*, 47 *ib.* 567; *Portal* v. *Hine*, 4 Times L. R. 330; *Whitney* v. *Hichling*, 5 Grant Up. Can. Ch. 605; *Weston* v. *Hemmons*, 2 Vict. L. R. Eq. 121; *Peabody* v. *Norfolk*, 98 Mass. 452; *Salomon* v. *Hertz*, 40 N. J. Eq. 400. But in the last case it was held that the defendant ought not to be restrained from divulging where or from whom the plaintiff bought his materials, or to whom he sold his goods, or the prices at which he bought and sold. In *Newbery* v. *James*, 2 Mer. 446, Lord Eldon declined to issue an injunction, on the ground that the Court could have no means of judging as to its infringement.

(*c*) *Portal* v. *Hine*, 4 Times L. R. 330; *Peabody* v. *Norfolk*, 98 Mass. 452; *Salomon* v. *Hertz*, 40 N. J. Eq. 400.

(*d*) *Bryson* v. *Whitehead*, 1 S. & S. 74; *Hagg* v. *Darley*, 47 L. J. Ch. 567; *Jarvis* v. *Peck*, 10 Paige 118. And see *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 352; *Allsopp* v. *Wheatcroft*, L. R. 15 Eq. 59; *Brewer* v. *Lamar*, 69 Ga. 656. In *Vickery* v. *Welch*, 19 Pick. 523, the Sup. Ct. of Mass. held that a person who had agreed to sell a secret process ought to have covenanted to communicate the secret to the purchaser and to no one else.

(*e*) *Champlin* v. *Stoddart*, 37 N. Y. Sup. Ct. 300.

(*f*) *Morison* v. *Moat*, 9 Hare, 241. And see *Green* v. *Folgham*, 1 S. & S. 398; *James* v. *James*,

Cannot be used in ignorance of true recipe.

No one will be allowed to use the name of a well-known article, with the secret recipe of which he is unacquainted, upon goods of his own make, so as to represent the spurious goods to be genuine (*a*); but it seems that if a person has an equal right to the use of the name with the person who is acquainted with the secret in accordance with which the goods are manufactured, the latter, at all events, cannot restrain him from the use of the mark, whatever remedy may be open to the public (*b*). If the person of whom complaint is made is acquainted with the secret process, and has been accustomed to use it, the objection to his use of the name does not arise (*c*), and such a person will not be restrained from using it at the suit of a person who has no right to use the recipe in the district in which the defendant trades (*d*).

Secret passes with owner's personal estate.

After the death of an inventor of a secret process, his son, who had learnt the secret in his employ, continued to make the article, but did not take out administration to the father, and it was held that without becoming his father's personal representative, he could acquire no right to prevent the use of the secret by another (*e*).

Green v. *Folgham.*

The manner in which the Court deals with a secret process is well exemplified by the case of *Green* v. *Folgham* (*f*). There the grandfather of the plaintiffs and defendant possessed the secret of a recipe for an ointment called "Dr. Johnson's Ointment for the Eyes." This secret he settled on his daughter at her marriage, and directed that at the death of the survivor of her and

L. R. 13 Eq. 421; *Estcourt* v. *Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Weston* v. *Hemmons*, 2 Viet. L. R. Eq. 121. In *Canham* v. *Jones*, 2 V. & B. 218, and *Green* v. *Rooke*, W. N. 1872, p. 49, L. J. N. of C., 1872, p. 54, no fraud was proved.

(*a*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90; *Ansell* v *Gaubert*, Dig. 163.

(*b*) *Weston* v. *Ketcham* (1), 29 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455.

(*c*) *Witthaus* v. *Braun*, 44 Md. 303; and see *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453.

(*d*) *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218.

(*e*) *Hovenden* v. *Lloyd*, 18 W. R. 1132. And see *Singleton* v. *Bolton*, 3 Doug. 293.

(*f*) 1 S. & S. 398.

her husband it should be sold for the benefit of the children. The daughter communicated the secret to her eldest son and destroyed the recipe. On a bill being filed against the eldest son by the younger children, Leach, V.-C., decreed an account of the profits made by the defendant since his mother's death by the sale of the ointment, a reasonable allowance being made him for his time and trouble in preparing and vending the same. And the Vice-Chancellor went on to remark that if the secret could be made a subject of sale, the plaintiffs would be next entitled to ask from the Court that a sale should be directed accordingly. But inasmuch as the Court had no possible means either to communicate the secret to a purchaser with certainty, or to protect him in the enjoyment of it, a sale was, he said, impracticable (*a*). But, he continued, although the Court could not direct a sale, it had the power of taking a course which, in point of advantage, would be equivalent to the plaintiffs. It could inquire what would be the value of the secret to sell, provided it could be made the subject of sale; and the annual profits which had actually been made by the sale of the ointment from the death of the mother would be a fair criterion by which that value might be estimated; and the Vice-Chancellor accordingly decreed the value to be ascertained at law, as at the date of the decree.

Fraudulent secret.

In connection with this subject it should be mentioned that when, as is frequently the case, the article manufactured by the secret process is a quack medicine, or an article intended to deceive the public, the Court will not struggle to protect the secret or to punish those who invade it (*b*).

Literary production.

The rights which are possessed by the owner of a magazine, newspaper, or other literary publication, are of a very similar character to those which a person has in the

(*a*) See *Newbery* v. *James*, 2 Mer. 446.

(*b*) *Williams* v. *Williams*, 3 Mer. 157; *Estcourt* v. *Estcourt Hop Essence Co.*, L. R. 10 Ch. 276.

goodwill of a business carried on by him. Just as a name affixed to a shop conveys to customers the idea of a certain degree of excellence, with which the articles sold by the person using that name are associated in their minds; so the title prefixed to a periodical, or its general appearance, conveys to those who take it up the impression that the contents of that publication will be found to be up to the standard to which former editions of the simulated publication have attained. Like goods bearing a trade mark, literary publications carry with them wherever they go the guarantee for their quality, and the representations conveyed by their titles are made to all into whose hands they may come, not merely to the original purchaser. With the doctrine of trade marks that of the titles of literary works has also progressed, so that in this also it has been said that "a publisher or author has either in the title of his work, or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trade mark, and may, like a trader, claim the protection of a Court of Equity against such a use or imitation of the name, mark, or designations as is likely, in the opinion of the Court, to be a cause of damage to him in respect of that property" (*a*).

Hogg v. *Kirby*.

The earliest of the cases with respect to the titles of publications was *Hogg* v. *Kirby* (*b*), before Lord Eldon, C., in 1803. The plaintiff was the proprietor of a monthly magazine, called "The Wonderful Magazine," which was in fact edited by the plaintiff, though the defendant's name was used as that of the publisher. At the completion of the fifth number, the defendant refused to allow the longer use of his name, and the arrangement was

(*a*) Per Miller, J., in *Robertson* v. *Berry*, 50 Md. 591. See, however, *Walter* v. *Emmott*, 54 L. J. Ch. 1059.

(*b*) 8 Ves. 215. And see the early Scotch cases of *In re Edinburgh Correspondent Newspaper*, Ct. Sess. Cas., 1st Ser. I. 407 n., and *Constable & Co.* v. *Brewster*, *ib.* III. 215.

accordingly discontinued, and the accounts between the parties finally settled. The plaintiff then put out a notice stating that he would publish the sixth number, which he did; but on the following day a new magazine was published by the defendant, under the same title as the old one, but with the addition of "New Series Improved, printed for Kirby & Scott," and it was announced that it was intended to issue this monthly. The plaintiff then instituted a suit to check the piracy, and was able to point to several circumstances, in addition to the title, which indicated an intention of inducing the belief that the work was in fact a continuation of the plaintiff's. Lord Eldon, in his judgment, after alluding to the circumstance that the plaintiff's counsel had argued the case on the several grounds of copyright, fraud, and contract, said that he should state the question to be, "not whether the defendant's work was the same as the plaintiff's, but, in a question between those parties, whether the defendant had not represented it to be the same,"—in fact, resting the case upon fraud on the part of the defendant. His Lordship held that the defendant's intention did appear to be to represent his work as a continuation of the plaintiff's, "taking the credit which had been acquired by that to his own" (*a*), and the injunction was accordingly granted, but in such terms as to extend only to the pretence of the defendant's work being a continuation of the plaintiff's (*b*).

Spottiswoode v. Clarke.

In *Spottiswoode* v. *Clarke* (*c*), where the plaintiff published "The Pictorial Almanack," and the defendant "Old

(*a*) See *Longman* v. *Winchester*, 16 Ves. 269, in which Lord Eldon explained his decision in the present case.

(*b*) In *Strahan* v. *King*, Dig. 539, the proprietors of the "Contemporary Review" sought to restrain their publishers and a former assistant editor from issuing the "Nineteenth Century," alleging among other things that the defendants were representing the latter to be the plaintiffs' Review; the Vice-Chancellor, however, held that the charges failed, and refused to grant an injunction. And see *Clowes* v. *Hogg*, W. N. 1870, p. 268; *ib.* 1871, p. 40.

(*c*) 2 Ph. 154.

Moore's Pictorial Almanack," there being certain similarities between the wrappers of the two works, Lord Cottenham, denying that trade marks had anything to do with the case, said that it was difficult to believe that no fraud was intended, but that if such were the case, the attempt was very clumsy. And he felt so much doubt as to the legal right that, on the balance of convenience, he dissolved the injunction which had been granted by the Vice-Chancellor of England, giving the plaintiff leave to bring an action, and ordering the defendant to keep an account.

Title of periodical.

In both of the above cases fraud was the *ratio decidendi*, the actions of the defendants being examined with a view to the discovery of their motives and intentions. But at the present date the rule is that even though one person may have adopted in ignorance and *bonâ fide* a name coincident or nearly coincident with that employed by another person, yet he is bound to discontinue the use of that name so assumed as soon as he is made acquainted with the fact of its earlier employment, and the previous employer of the name is entitled to obtain an injunction against him, unless by his own laches or other default he has lost the rights which he otherwise would have had. The principle enunciated by Wood, V.-C., in *McAndrew* v. *Bassett* (*a*), would be equally applicable to the case of a title of a periodical: that is to say, that although A may have innocently used the title employed by B, yet if he continues to trade upon B's reputation after being made aware of his error, he does so fraudulently.

Fraudulent intention need not be proved.

The modern doctrine was thus stated by the L.JJ. in the "Sporting Life" case (*b*): "It appears to us that there is nothing analogous to copyright in the name of a newspaper, but that the proprietor has a right to prevent

(*a*) 33 L. J. Ch: 561. And see *Williams* v. *Osborne*, 13 L. T. N. S. 498; and *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15 (per Lord Blackburn).

(*b*) *Kelly* v. *Hutton*, L. R. 3 Ch. 708.

any other person from adopting the same name for any other similar publication." And in *Clement* v. *Maddick* (*a*), in which case the plaintiffs were the publishers of "Bell's Life," and the defendants the originators of a "Penny Bell's Life," it was said by Stuart, V.-C., that "This is an application in support of the right to property. It has been argued on behalf of the defendants that, unless a fraudulent intention is made out, the plaintiffs are not entitled to an injunction. That is a view of the law to which I cannot accede. Lord Cottenham, in the case of *Millington* v. *Fox* (*b*), has declared that where a trade mark has been innocently and even unconsciously made use of to the injury of another, the owner of the trade mark is entitled to the protection of this Court."—"The defendants' whole case appears to rest on the fact that they intended to commit no fraud; that they had no fraudulent intention in adopting the words 'Bell's Life,' and thought that by prefixing the word 'Penny' to the title they had sufficiently warned the public that they were not purchasing the plaintiffs' paper. But the absence of fraudulent intention is no defence against an application to the Court for an injunction by the person whose property has been injured," and where deception is probable, an injunction will be granted (*c*). In *Walter* v.

(*a*) 1 Giff. 98.

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

(*c*) Thus, injunctions were granted in the following cases:—*Edmonds* v. *Benbow*, Dig. 33 ("The Real John Bull" imitated by "The Old Real John Bull"); *In re The Edinburgh Correspondent Newspaper*, Ct. of Sess. Cas. 1st Ser. I. (new ed.) 107 n. ("The Edinburgh Correspondent," name copied); *Constable & Co* v. *Brewster*, Ct. of Sess. Cas. 1st Ser. III. 215 (new ed. 152) ("The Edinburgh Philosophical Journal" by "The New Series of the Edinburgh Philosophical Journal"); *Prowett* v. *Mortimer*, 2 Jur. N. S. 414 ("The John Bull and Britannia" by "The True Britannia"); *Ingram* v. *Stiff*, 5 Jur. N. S. 947 ("The London Journal" by "The London Daily Journal"); *Chance* v. *Sheppard*, Dig. 317 ("The Bedfordshire Express and General Advertiser for the Counties of Cambridge, Hertfordshire, Huntingdonshire, and Middlesex" by "The Bedfordshire Express and General Advertiser for the County"); *Corns* v. *Griffiths*, W. N. 1873, p. 93 ("The Iron Trade Circular—Ryland's" by "The Iron Trade Circular—edited by Samuel Griffiths"); *Metzler* v. *Wood*, 8 Ch. D. 606 ("Henry's Royal Modern Tutor

Emmott (*a*), however, the Court of Appeal did not take the same view as to the jurisdiction in such cases being founded on property, and Cotton, L. J., said that "the principle upon which the Court has to decide these cases is this: It is not a question of property; it is the question whether what has been done by the defendant is in reason calculated to induce people to take his goods as those of the plaintiff, or, in other words, to pass off his goods, whatever they may be, as the goods of the plaintiff." And Bowen, L. J., said, "The principle which is involved seems to me to be the right of the Court, and the duty of the Court, to prevent damage being done to the business of a person who is lawfully carrying on his business, by acts, conduct, or representations, consisting either of acts or language, which are calculated to deceive the public, and persons who otherwise would deal with the plaintiff." However, even in this case it was not suggested that a fraudulent intention was necessary to enable relief to be given; and if that is so, the question whether property is or is not involved seems of little practical importance.

for the Pianoforte" by "Hemy's New and Revised Edition of Jousse's Royal Standard Pianoforte Tutor"); *Hutchings* v. *Sheard*, W. N. 1881, p. 20 ("The Violin School, by J. D. Loder" by "J. D. Loder's Celebrated Violin School, edited, revised, and enlarged by T. Westrop"); *Primrose Press Agency* v. *Knowles*, L. J. N. of C. 1886, p. 43 ("Church and State" in each case); *Reed* v. *O'Meara*, 21 L. R. Ir. 216 ("The Grocer and Oil Trade Review" imitated by "The Grocer and Wine Merchant and Irish Brewer and Distiller." An injunction was granted to restrain the word "Grocer," into which the plaintiffs' title was commonly abbreviated, from being used as the first and principal part of the defendants' title); *Matsell* v. *Flanagan*, 2 Abb. Pr. N. S. 459; R. Cox, 367 ("The National Police Gazette" by "The United States Police Gazette"); *Potter* v. *McPherson*, 28 N. Y. Sup. Ct. 559 ("Payson, Dunton, and Scribner's National System of Penmanship" by "Independent National System of Penmanship"); *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306 ("Beatty's Headline Copy Book" imitated by "Beatty's New and Improved Headline Copy Book"); *Carey* v. *Goss*, 11 Ont. Rep. 619 ("The Commercial Traveller and Mercantile Journal," commonly abbreviated to "The Commercial Traveller," and "The Traveller," by "The Traveller"). And see *Keene* v. *Harris*, 17 Ves. 338; *Walter* v. *Head*, 25 Sol. J. 742, 757 (imitations of "The Times"), and *American Grocer Publishing Association* v. *Grocer Publishing Co.*, 32 N. Y. Sup. Ct. 393 (imitations of "The American Grocer").

(*a*) 54 L. J. Ch. 1059.

Even if the theory that there is property in the name of a newspaper is admitted, that right is not invaded without a probability of deception being produced.

But deception must be probable.

While, however, the fact that the defendant has adopted a title calculated to deceive is sufficient to entitle the plaintiff to his remedy, without it being necessary for him to go into the defendant's motives, he must prove the probability of deception, and if he cannot do this he will fail, even though there may be circumstances pointing to a fraudulent intention. Thus, where the proprietors of the "Era," one of the principal writers in which paper used the pseudonym of "Touchstone," sought to restrain the publication of "Touchstone, or the New Era," and alleged certain further resemblances between the two papers, the Court of Appeal rescinded the injunction which had been granted, on the ground that no deception could occur (*a*). And where the plaintiff sought to restrain the defendant from using the name "Post Office Directory," and it was

(*a*) *Ledger* v. *Ray*, Dig. 550. And no injunctions were granted in *Bradbury* v. *Beeton*, 39 L. J. Ch. 57 ("Punch" and "Punch and Judy"); *Dicks* v. *Yates*, 18 Ch. D. 76 ("Splendid Misery, or East End and West End, by C. H. Hazlewood," and "Splendid Misery, by the author of Lady Audley's Secret, Vixen, &c."); *Dale* v. *Smith*, W. N. 1882, p. 145 ("The Plumber and Decorator and Journal of Gas and Sanitary Engineering" and "The Decorator, Plumber, and Gasfitter's Journal"); *Dale* v. *General Newspaper Co.*, 1 Times L. R. 177 (same as above, and "The Plumbing and Decorating, Sanitary, Water, and Gas Engineering Chronicle"); *Cowen* v. *Hulton*, 46 L. T. N. S. 897 ("The Newcastle Daily Chronicle" and "The Sporting Chronicle and Prophetic Bell"); *Walter* v. *Emmott*, 54 L. J. Ch. 1059 ("The Mail" and "The Morning Mail." Here the style and price of the two papers were very different); *Jaffray* v. *Emmott*, V. C. B., July 3rd, 1885 ("The Birmingham Daily Mail" and "The Morning Mail"); *Borthwick* v. *The Evening Post, Ld.*, 37 Ch. D. 449 ("The Morning Post" and "The Evening Post"); *Brett* v. *Bowles*, L. J. N. of C. 1890, p. 43; affirmed by C. A. April 30th, 1890 ("The Princess' Novelettes" and "The Princess"); *Snowden* v. *Noah*, Hopk. 347, R. Cox, 1 ("The National Advocate" and "The New York National Advocate"); *Bell* v. *Locke*, 8 Paige, 75, R. Cox, 11 ("The Democratic Republican New Era" and "The New Era"); *Stephens* v. *De Conto*, 30 N. Y. Super. Ct. 343, R. Cox, 442 ("La Cronica" and "El Cronista"); *Osgood* v. *Allen*, 1 Holmes, 185 ("Our Young Folks, an Illustrated Magazine for Boys and Girls," and "Our Young Folks' Illustrated Paper"); *Talcot* v. *Moore*, 13 N. Y. Sup. Ct. 106 ("The Little Red Book" and "The Red and White Book"); *Dunway Publishing Co.* v. *North-West Printing Co.*, 11 Oreg. 322 ("The New North-West" and "The North-West News").

shown that the name had been used by others than the plaintiff, and that the defendant had had the assistance of post office servants, it was held that no injunction could be granted (*a*). So, where both plaintiff and defendant sold under the name of "Castle Album" albums illustrated with pictures of castles, it was held that the name was descriptive of the thing, and that, even if the name were capable of appropriation at all, no injunction would be granted to protect it, unless it were proved that it was recognised as denoting exclusively the plaintiff's albums (*b*). Even if the title is not descriptive, and has been taken without alteration by the defendant, no injunction will be granted unless the plaintiff's paper has been long enough on sale to have acquired some reputation under the name (*c*). And the plaintiff must come with clean hands (*d*).

Titles of literary works protected generally.

Although the title of a periodical publication as a newspaper, magazine, or almanack, most closely resembles a trade mark, on account of its repeated and continued use from time to time upon articles of a certain class, the protection afforded by the Court is extended to the title of any kind of literary production. Thus, the publishers of "The Birthday Scripture Text Book" succeeded in obtaining an injunction against persons who had brought out "The Children's Birthday Text Book," Lord Romilly, M. R., remarking that the defendants were not entitled to publish a work "with such a title, or in such form as to binding or general appearance, as to be a colourable imitation of that of the plaintiffs" (*e*). And so, where the title of a song was imitated in such a manner as to

(*a*) *Kelly* v. *Byles*, 13 Ch. D. 682.

(*b*) *Sohove* v. *Schmincke*, 33 Ch. D. 546.

(*c*) *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 Ch. D. 139.

(*d*) *Talbot* v. *Judges*, 3 Times L. R. 398.

(*e*) *Mack* v. *Petter*, L. R. 14 Eq. 431. See *Weldon* v. *Dicks*, 10 Ch. D. 247. Also *Estes* v. *Williams*, 22 Bl. C. C. 364; *Estes* v. *Belford*, *Clarke & Co.*, 30 U. S. Pat. Gaz. 99; *Estes* v. *Leslie* (1), 23 Bl. C. C. 476; *ib.*. (2), 29 Fed. Rep. 91; *Estes* v. *Worthington* (3), 24 Bl. C. C. 371; in all of which cases the plaintiffs were the American grantees from the original English publishers of an exclusive right in the publication.

be calculated to induce the public to buy the spurious publication in mistake for the genuine, the continuance of the fraud was restrained (*a*).

Incidents of title of publication.

The right which exists in the title of a publication is a right of property (*b*), a chattel interest (*c*), capable of assignment (*d*) or bequest (*e*), passing, in the event of its proprietor's bankruptcy, to his trustee, but incapable of seizure by a sheriff (*f*), and which, in the event of a dissolution of partnership between joint proprietors, must be sold for the purpose of the proceeds of the sale being included in the assets of the partnership (*g*).

No copyright in title.

Although the term copyright has been sometimes applied to the right in the title of a publication (*h*), there "cannot in general be any copyright in the title or name of a book"(*i*), but copyright and trade mark are things "totally distinct" (*k*), and registration under the Copyright Acts gives no further right to protection than exists independently of such registration (*l*).

(*a*) *Chappell* v. *Sheard*, 2 K. & J. 117; *Chappell* v. *Davidson*, *ib.* 123. But in *Isaacs* v. *Daly*, 39 N. Y. Super. Ct. 511, it was held that no injunction could be granted to restrain the use of the word "Charity" as the name of a play, the word being one of general application, and the use by the defendant *bonâ fide*.

(*b*) *Clement* v. *Maddick*, 1 Giff. 98; *Kelly* v. *Hutton*, L. R. 3 Ch. 708. But this was disputed in *Walter* v. *Emmott*, 54 L. J. Ch. 1059.

(*c*) Per Wood, L. J., in *Kelly* v. *Hutton*, *ubi suprà*.

(*d*) *Longman* v. *Tripp*, 2 Bos. & P. N. R. 67; *Ex parte Foss*, 2 De G. & J. 230; *Kelly* v. *Hutton*, L. R. 3 Ch. 708; *Clowes* v. *Hogg*, W. N. 1870, p. 268; *ib.* 1871, p. 40; *Ward* v. *Beeton*, L. R. 19 Eq. 207; *Snowden* v. *Noah*, Hopk. 347; R. Cox, 1.

(*e*) *Keene* v. *Harris*, 17 Ves. 338. In *McCormick* v. *McCubbin*, Ct. Sess. Cas. 1 Ser. I. 541 (New Ed. 496) it was held by the Court of Session that the executors of the proprietor of a half-share in a newspaper were entitled to proceed to a sale of his share.

(*f*) *Ex parte Foss*, 2 De G. & J. 230.

(*g*) *Bradbury* v. *Dickens*, 27 Beav. 53; *Dayton* v. *Wilkes*, 17 How. Pr. 510; R. Cox, 224.

(*h*) *E.g.* per Lord Romilly, M. R., in *Mack* v. *Petter*, L. R. 14 Eq. 431, per Malins, V.-C., in *Weldon* v. *Dicks*, 10 Ch. D. 247, per Bacon, V.-C., in *Dicks* v. *Yates*, 18 Ch. D. 76.

(*i*) Per James, L. J., in *Dicks* v. *Yates*, 18 Ch. D. 76. And see *Kelly* v. *Hutton*, L. R. 3 Ch. 708; *Correspondent Newspaper Co.* v. *Saunders*, 11 Jur. N. S. 540; *Primrose Press Agency* v. *Knowles*, L. J. N. of C. 1886, p. 43; *Schove* v. *Schmincke*, 33 Ch. D. 546; *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 Ch. D. 139; *Osgood* v. *Allen*, 1 Holmes 185.

(*k*) Per Jessel, M. R., in *Dicks* v. *Yates*, 18 Ch. D. 76. In *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306, it was said that the name of a newspaper was not a trade mark.

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

Must be actual user.

Just as a trade mark must, in order to be entitled to protection, be affixed to a vendible article in the market (*a*), so a title of a publication must be actually used. The mere intention, previous to publication, of using a particular name as the title of a literary work, even if followed by the registration of the proposed title as copyright, the advertisement of the forthcoming work, or the actual preparation of its contents, confers no right to protection, for, "in the case of advertisement, followed by publication, the party publishing has given something to the world, and there is some consideration for the world's giving him a right; but in the case of mere advertisement, he has neither given, nor come under any obligation to give, anything to the world, so that there is a total want of consideration for the right which he claims" (*b*). So, in one case (*c*), the defendants had registered their newspaper at Stationers' Hall on December 24th, 1885, but did not publish the first number till January 16th, 1886; while in the meantime the plaintiffs had registered on January 1st, 1886, and begun to sell on January 2nd, 1886, a newspaper under the same name, and it was held that an injunction must be granted for the protection of the plaintiffs, who had been the first to actually use the title. The user must, however, be substantial (*d*). Where, on the other hand, a book has been once published under a particular title, it seems that the right in the title remains, notwithstanding that the book has been long out of print, and has, in fact, been treated as obsolete (*e*).

307. In the American case of *Jollie* v. *Jaques*, 1 Bl. C. C. 618, it was, however, held that the right to the title of a work, the copyright of which turned out to be invalid, must fail with the copyright. See *Osgood* v. *Allen*, 1 Holmes 185; *Isaacs* v. *Daly*, 39 N. Y. Super. Ct. 511; *Scoville* v. *Toland*, 6 West. L. J. 84; and *Hirsch* v. *Jonas*, 3 Ch. D. 584.

(*a*) Or registered, since the Trade Marks Act of 1875.

(*b*) Per Turner, L. J., in *Maxwell* v. *Hogg*, L. R. 2 Ch. 307. And see *Correspondent Newspaper Co.* v. *Saunders*, 11 Jur. N. S. 540.

(*c*) *Primrose Press Agency* v. *Knowles*, L. J. N. of C. 1886, p. 43.

(*d*) *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 Ch. D. 139.

(*e*) *Weldon* v. *Dicks*, 10 Ch. D. 247. Compare *Estes* v. *Worthington* (3), 24 Bl. C. C. 371.

CHAPTER IX.

GOODWILL.

Value of goodwill.

So early as the time of Lord Hardwicke (*a*) it was fully recognised that the goodwill of a trade might be of considerable value, and by the beginning of the present century it was said at the bar (*b*) to be a matter of common experience that contracts for the sale of a goodwill were enforced by actions at law at every sittings.

Connection between goodwill and trade marks.

The connection between goodwill and trade marks is very intimate. Thus, where in a suit for specific performance of a contract for sale of a business (*c*), one of the subjects of the contract was "goodwill, &c.," Romilly, M. R., said that those words united such things as were necessarily connected with and belonged to the goodwill, many of which were easily pointed out; for instance, the use of trade marks. Such things would be included in the words "et cætera," and would be included in the conveyance. The sale of a business carries with it the goodwill and trade marks (*d*), and the sale of a business and goodwill

(*a*) *Giblett* v. *Read*, 9 Mod. 459.
(*b*) *Bunn* v. *Guy*, 4 East, 190.
(*c*) *Cooper* v. *Hood*, 26 Beav. 293.
(*d*) *Shipwright* v. *Clements*, 19 W. R. 599; *Singer Manufacturing Co.* v. *Loog* (3), 8 App. Cas. 15-33 (per Lord Blackburn); *Merry* v. *Hoopes*, 111 N. Y. 415; *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306. And see *Hall* v. *Barrows*, 4 De G. J. & S. 150. In *Young* v. *Jones Bros. & Co.*, 3 Hughes 274, the American Court held the contrary. In *Churton* v. *Douglas*, Johns. 174, V.-C. Wood went so far as to say that the question of trade mark was in fact the same as the question of firm name, which, it was obvious, was an important part of the goodwill, and in *Young* v. *Jones Bros. & Co.*, *ubi suprà*, it was said that "rights in the trade mark are analogous to rights in the goodwill of a partnership." See, too, *England* v. *Curling*, 8 Beav. 129; *Dickson* v. *McMaster & Co.*, 18 Ir. Jur. 202; *Congress & Empire Spring Co.* v. *High Rock Congress Spring Co.*, 57 Barb. 526, R. Cox, 599; *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews. 321, R. Cox, 559; *Sohier* v. *Johnson*, 111 Mass. 238; *Witthaus* v. *Braun*, 44 Md. 303; *Ex parte Young*, Dig. 537; *Fulton* v. *Sellers*, 4 Brews. 42; *Hazard* v. *Caswell*, 47 N. Y. Super. Ct. 537.

carries with it the right to the trade name (*a*), and the words "assets and effects of every kind and nature," in a bill of sale of a business, cover the trade marks used in the business (*b*). Again, a trade mark cannot exist in gross and apart from the goodwill of the business with which it has been connected (*c*).

Connection recognised by Registration Act of 1875, and Patents Act, 1883.

This close connection was fully recognised in the Trade Marks Registration Act, 1875 (*d*), by the second section of which it was provided that a registered trade mark should be assigned and transmitted only in connection with the goodwill of the business concerned in such particular goods or classes of goods, and should be determinable with such goodwill. By the third section the right of the registered proprietor to the exclusive use of the trade mark was made subject to the provisions in respect of its connection with the goodwill. These provisions are now repeated in §§ 70 and 76 of the Patents Act, 1883 (*e*).

What constitutes goodwill.

"Goodwill, I apprehend," said Wood, V.-C., in the important case of *Churton* v. *Douglas* (*f*), "must mean every advantage, every positive advantage, if I may so express it, as contrasted with the negative advantage of the late partner not carrying on the business himself, that has been acquired by the old firm in carrying on its business, whether connected with the premises in which the business was previously carried on, or with the name of the late firm, or with any other matter carrying with it

(*a*) Per James, L. J., in *Levy* v. *Walker*, 10 Ch. D. 436. See *Thompson* v. *Mackinnon*, 2 Steph. Dig. 726.

(*b*) *Morgan* v. *Rogers*, 19 Fed. Rep. 596. And see *Russia Cement Co.* v. *Le Page*, 147 Mass. 206; *Hozie* v. *Chaney*, 143 Mass. 592; *Mackinnon* v. *Thompson*, 5 Can. Leg. News 396.

(*c*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90; *In re Wellcome*, 32 Ch. D. 213; *Smith* v. *Fair*, 14 Ont. Rep. 729; *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews. 321, R. Cox, 559; *Derringer* v. *Plate*, 29 Cal. 292, R. Cox, 324; *Witthaus* v. *Braun*, 44 Md. 303; *Taylor* v. *Bemis*, 4 Biss. 406; *Kidd* v. *Johnson*, 100 U. S. Rep. 617; *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455; *Morgan* v. *Rogers*, 19 Fed. Rep. 596.

(*d*) 38 & 39 Vict. c. 91.

(*e*) 46 & 47 Vict. c. 57.

(*f*) Johns. 174. And see per Hagans, J., in *McGowan Bros. Pump & Machine Co.* v. *McGowan*, 2 Cinc. 313.

the benefit of the business,"—"Very frequently the goodwill of a business or profession, without any interest in land connected with it, is made the subject of sale, though there is nothing tangible in it" (*a*). And it carries with it the benefit of such matters as a covenant by a servant not to carry on a similar business within prescribed limits (*b*).

Formerly treated as always local.

Previously to the case of *Churton* v. *Douglas* (*c*), the language of various eminent judges as to what constituted "goodwill" had rather tended to connect the goodwill with the premises on which the business was carried on, than with the business carried on there, probably because that language, though in general terms, was directed to the circumstances of the case then in course of decision (*d*). Thus, Lord Eldon, C., in *Cruttwell* v. *Lye* (*e*), describes goodwill as "nothing more than the probability that the old customers will resort to the old place" (*f*). Leach, M. R., describes it (*g*) as "an advantage attaching to the possession of the house" in which the business had been carried on; and Lord Langdale, M. R. (*h*), as "the chance or probability that custom will be had at a certain place of business in consequence of the way in which that business has been previously carried on" (*d*). In *King* v. *Midland Railway Co.* (*i*), Giffard, V.-C., gave effect to this view by holding that the assignees in liquidation of a mortgagor, whose business premises were taken by a railway company, were entitled to no part of the purchase

(*a*) Per Pollock, C. B., in *Potter* v. *The Commissioners of Inland Revenue*, 10 Ex. 147.

(*b*) *Jacoby* v. *Whitmore*, 49 L. T. N. S. 335; *Shorell* v. *Winkup*, 60 L. T. N. S. 389.

(*c*) Johns. 174.

(*d*) See *Churton* v. *Douglas*, *ubi suprà*.

(*e*) 17 Ves. 335.

(*f*) In this case Sir A. Piggott, in the course of his argument, said that "goodwill" was "the advantage belonging to a house long accustomed to carry on a particular trade." See, too, per Plumer, V.-C., in *Harrison* v. *Gardner*, 2 Madd. 198.

(*g*) In *Chissum* v. *Dowes*, 5 Russ. 29.

(*h*) In *England* v. *Downs*, 6 Beav. 269.

(*i*) 17 W. R. 113. See *Rutter* v. *Daniel*, 30 W. R. 724, 801; *Mitchell* v. *Read* (2), 26 N. Y. Sup. Ct. 418.

money, as having been paid in respect of the goodwill of the business, as against the mortgagee of the premises, whose debt exceeded the purchase money; but that the goodwill was incident to the mortgaged premises and passed with them.

The judgment in *Churton* v. *Douglas* has now established that the dictum of Lord Eldon in *Cruttwell* v. *Lye* (*a*) must be read as meaning that goodwill is the probability that the old customers will buy the old goods from the old firm or their successors in business, whether the means of identification be the place of business or otherwise (*b*). The customers of a large wholesale house cannot be supposed to pay much attention to the exact site of the establishment; and "there may even be a species of goodwill which may be the subject of bargain and sale, although not dependent on the business being carried on in any particular place: for instance, in the case of what are called quack medicines" (*c*). Not so now.

While, however, there may be a species of goodwill not intimately connected with a particular spot, in many trades there can hardly be any goodwill apart from the premises on which business has been carried on. Thus, "it is quite plain that the goodwill of a public-house passes with the public-house. In such a case the goodwill is the mere habit of the customers resorting to the house. It is not what is called a personal goodwill" (*d*). Such a goodwill carries with it the public-house licences, since without them the business cannot be carried on (*e*). And wherever Local connection important.

(*a*) 17 Ves. 335.

(*b*) And compare *Labouchere* v. *Dawson*, L. R. 13 Eq. 322; *Cooper* v. *Metropolitan Board of Works*, 25 Ch. D. 472.

(*c*) Brett, J., in *Llewellyn* v. *Rutherford*, L. R. 10 C. P. 456. The goodwill of a newspaper is another example. See *Boon* v. *Mess*, 70 N. Y. 465, and the observations of Lindley, L. J., in his work on Partnership. See, too, *Potter* v. *The Commissioners of Inland Revenue*, 10 Ex. 147; *Hunter* v. *Dannenhoffer*, 82 N. Y. 499; and *Barker* v. *Connecticut Mutual Life Insurance Co.*, 15 Fed. Rep. 312.

(*d*) Per Jessel, M. R., in *Ex parte Punnett*; *In re Kitchin*, 16 Ch. D. 226. See *Mitchell* v. *Read* (2), 26 N. Y. Sup. Ct. 418, and *Mason* v. *Queen*, 23 Scot. L. Rep. 641.

(*e*) *Rutter* v. *Daniel*, 30 W. R. 724, 801.

there is a connection between the goodwill and a particular locality it will be of great consequence; and a house of little value in itself, at a rack-rent, may have a peculiar value attached to it from the fact of a long-established business having been carried on there (*a*).

Another view of goodwill.

Looked at from another point of view, the goodwill may be said to be the money value of what has just been described as the goodwill (*b*).

Goodwill in learned professions.

While the value of most businesses is determined partly by the personal qualifications of the proprietor, partly by those of his subordinates, partly (sometimes principally) by local situation, partly, it may be, by yet other considerations, there is one class of business in which the personal character and ability of the head of the establishment are of paramount and almost exclusive importance. That class comprehends the medical and legal, or "learned" professions.

Division into personal and local.

Adverting to this distinction, Sir J. Cross, in *Ex parte Thomas* (*c*), divided goodwill into personal and local, adding that there might be a goodwill partly personal and partly local (*d*). But the employment of the word "local" as descriptive of one of the two principal heads under which goodwill falls seems open to objection, on the ground that it tends to produce the misconception exposed and removed by Vice-Chancellor Wood, in *Churton* v. *Douglas* (*e*), and to unduly narrow the meaning to be assigned to "goodwill," which, as has been seen, comprehends, not merely the advantage of local situation, but every positive advantage connected with an established trade.

(*a*) *Parsons* v. *Hayward*, 31 L. J. Ch. 666; *Llewellyn* v. *Rutherford*, L. R. 10 C. P. 456. See *Cooper* v. *Metropolitan Board of Works*, 25 Ch. D. 472, per Cotton, L. J.

(*b*) *Austen* v. *Boys*, 2 De G. & J. 626; *Llewellyn* v. *Rutherford* (Brett, J.), *ubi suprà*.

(*c*) 2 Mont. D. & De G. 294; and see *Ex parte Punnett*, 16 Ch. D. 226.

(*d*) This division corresponds to that of trade marks into personal and local, made by Romilly, M. R., in *Hall* v. *Barrows*, 32 L. J. Ch. 548, which, however, was not indorsed by Lord Westbury, C. See 4 De G. J. & S. 150.

(*e*) Johns. 174.

Division into goodwill of profession and of trade.

The two classes of goodwill may more satisfactorily be distinguished, from the classes of pursuit to which they respectively relate, as the goodwill of a profession on the one hand, and that of a trade on the other. It is, indeed, true that the goodwill of a trade, the more usual kind, possesses so many characteristics which that of a profession has not, that the latter has been thought to be hardly entitled to the name of goodwill at all (*a*), and in *Arundell* v. *Bell* (*b*), Jessel, M. R., went so far as to say that "there is nothing analogous to the goodwill in an ordinary trade, which you can sell, in the case of a partnership of living solicitors;" but, on the other hand, there are points of resemblance in which both classes are governed by the same general rule, and there is a convenience in following an established phraseology.

Contract by attorney to transfer goodwill enforced.

In *Bunn* v. *Guy* (*c*), the Lord Chancellor was impressed by the difference between the goodwill of a profession and that of a trade, and caused the opinion of the Court of King's Bench to be taken as to whether a contract by a practising attorney (among other things) to relinquish his business and recommend his clients to two other attorneys, for valuable consideration, and not to practise within certain limits, and to permit them to use his name for a certain time, was good at law, so that the vendor could recover in an action. The answer was that the contract was good in law.

Decision doubted.

This decision did not long remain uncriticised. In *Bozon* v. *Farlow* (*d*), Grant, M. R., refused to grant specific performance of an agreement for the sale of an attorney's business, the terms of the agreement not being sufficiently specified to enable the Court to give the

(*a*) See *Auston* v. *Boys*, 2 De G. & J. 626, and *Bain* v. *Munro*, Ct. Sess. Cas. 4th Ser. V. 416, per Lord Curriehill.

(*b*) 52 L. J. Ch. 537. And see per Denman, J., in *James* v. *James* (2), 60 L. T. N. S. 569.

(*c*) 4 East, 190, in 1803. See the medical cases of *Rawlinson* v. *Clarke*, 14 M. & W. 187; *Smith* v. *Smith*, 4 Wend. 468; *Butler* v. *Burleson*, 16 Vt. 176.

(*d*) 1 Mer. 459.

purchaser the proper return for his money, and he took the opportunity of questioning the propriety of a sale of an attorney's business, which depended so much on the incumbent's own character. And in *Farr* v. *Pearce* (*a*), Leach, V.-C., strongly supported the personal character of a profession as contrasted with a commercial business.

Sale of solicitor's practice.

Where, however, a solicitor had actually sold his practice for valuable consideration, and undertaken not to practise as a solicitor in Great Britain for twenty years, Lord Langdale, M. R., granted an injunction to restrain him from so practising, and from endeavouring to induce any persons who were the clients of the former and then present firm to cease to employ that firm (*b*). But an assignment of the goodwill of a solicitor's practice does not carry with it the right to his clients' papers (*c*).

Thornbury v. *Bevill.*

In a case (*d*) which was "not quite a case of dissolution of partnership, but something between a dissolution of the partnership and a purchase of an attorney's business and firm name," Knight-Bruce, V.-C., having refused specific performance of the alleged contract, on the ground of non-acceptance by the plaintiff, said that, "notwithstanding the case of *Bunn* v. *Guy* (*e*), from which he did not mean to express dissent, decided as it was by judges of high authority, he was not prepared to say that it was fit that a Court of Equity should enforce an agreement between two solicitors that one on retiring from the business should permit the other to carry on the business in his name. Whether such an agreement were or were not within the strict policy of the law, it might be doubtful whether the Court of Chancery ought to assist it."

Partnership between solicitors dissolved.

But where, on a dissolution by two solicitors of a *bonâ fide* partnership between them, it was agreed that one should carry on the business under the old firm name,

(*a*) 3 Madd. 74.
(*b*) *Whittaker* v. *Howe*, 3 Beav. 383.
(*c*) Per Denman, J., in *James* v. *James*, 60 L. T. N. S. 569.
(*d*) *Thornbury* v. *Bevill*, 1 Y. & C. Ch. 554.
(*e*) 4 East, 190.

paying the other certain annuities, it was held by Wood, V.-C., that the agreement contained nothing illegal or contrary to public policy (*a*).

Rights on dissolution.

Again, on a dissolution of a professional partnership, a retiring partner is not entitled to compensation in respect of his share in the goodwill (*b*), and a surviving partner may continue the business (*c*).

Goodwill of deceased solicitor.

In *Spicer* v. *James* (*d*), a country attorney having died intestate, his administrator carried on the business until the intestate's son came of age, when he handed over the business to the son. The son becoming insolvent, a bill for an account of profits, and insisting that a sum was due to the intestate's estate in respect of the goodwill, was filed against the administrator by a creditor of the son, but was dismissed by Leach, M. R., on the ground that the goodwill of an attorney's business was not a subject of administration. So, in *Arundell* v. *Bell* (*e*), the Court of Appeal decided that the estate of a solicitor, who had retired from a partnership and shortly afterwards died, was not entitled to any allowance in respect of his interest in the goodwill of the business; and Jessel, M. R., said that "as a general rule there is nothing in the nature of a partnership asset to be sold which can fairly be termed goodwill in a ordinary partnership between solicitors."

Estate of professional man interested in proceeds of goodwill.

Where, however, the widow of a surgeon-dentist, being one of his executors, sold the goodwill of his business with an introduction to patients, Knight-Bruce, V.-C., held that either the whole, or, at all events, some part of the price paid, belonged to the testator's estate (*f*). But in the similar Scotch case of *Bain* v. *Munro* (*g*), it was held by the Lord Ordinary and Court of Session that the price which was paid was in fact the price of the widow's

(*a*) *Aubin* v. *Holt*, 2 K. & J. 66.
(*b*) *Austen* v. *Boys*, 2 De G. & J. 626; *Farr* v. *Pearce*, 3 Madd. 74.
(*c*) *Ib.* And see *Milner* v. *Reed*, Dig. 328; *Chappell* v. *Griffith*, 53 L. T. N. S. 459.
(*d*) Collyer on Partnorship, 2nd ed., p. 104.
(*e*) 52 L. J. Ch. 537.
(*f*) *Smale* v. *Graves*, 3 De G. & S. 706.
(*g*) Ct. Sess. Cas. 4th Ser. V. 416.

recommendation, and that she was entitled to retain it for her own benefit.

Goodwill of professional business.

Recapitulation.

The goodwill of a professional business may, in short, be sold, and a breach of a contract to sell may be a ground for damages, but the authorities are against the enforcement of the specific performance of such a contract, though when the sale is complete, the terms of the sale will be carried into execution. Such a goodwill, in the case of a partnership, survives to the surviving partner, and is not a subject of compensation to an outgoing partner. Special stipulations will, however, be enforced. Such a goodwill will not be considered in the administration of the proprietor's estate unless actually sold; but if that has been done, the price paid or some part of it may be attributed to the estate.

Goodwill of a trade.

"The goodwill of a trade," said Tindal, C. J. (*a*), "is a subject of value and price. It may be sold (*b*), bequeathed (*c*), or become assets in the hands of the personal representatives of a trader" (*d*). A sale may be conditional (*e*), and may be effected by a mortgagee (*f*). Though incapable, by reason of its incorporeal nature, of seizure by a sheriff (*g*), goodwill is "goods and chattels within the Bankruptcy Acts (*h*), and may be dealt with by the trustee in bankruptcy just as the bankrupt's other property" (*i*). It is also "property" within the Stamp Acts (*k*).

(*a*) In *Hitchcock* v. *Coker*, 6 Ad. & E. 438-54.

(*b*) See *Darbey* v. *Whitaker*, 4 Dr. 139; *Churton* v. *Douglas*, Johns. 174; *Cooper* v. *Hood*, 26 Beav. 293; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Shipwright* v. *Clements*, 19 W. R. 599; *Howe* v. *Searing*, 10 Abb. Pr. 264; R. Cox, 244.

(*c*) See *Keene* v. *Harris*, 17 Ves. 338; *Robertson* v. *Quiddington*, 28 Beav. 529.

(*d*) See *Worral* v. *Hand*, Peake 105; *Dakin* v. *Cope*, 2 Russ. 170; *Chissum* v. *Dewes*, 5 Russ. 29; *McCormick* v. *McCubbin*, Ct. Sess. Cas. 1st Ser. I. 541.

(*e*) *Boon* v. *Moss*, 70 N. Y. 465.

(*f*) *Ex parte Punnett*; *In re Kitchin*, 16 Ch. D. 226.

(*g*) *Ex parte Foss*, 2 De G. & J. 230; *Holmore* v. *Smith*, 35 Ch. D. 436.

(*h*) *Longman* v. *Tripp*, 2 Bos. & P. N. R. 67; *Ex parte Foss*, *ubi suprà*.

(*i*) See *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1; *Iowa Seed Co.* v. *Dorr*, 70 Iowa 481.

(*k*) *Potter* v. *The Commissioners of Inland Revenue*, 10 Ex. 147. And see *Morgan* v. *Perhamus*, 36 Ohio St. 517.

Universally valuable.

The valuable character of goodwill is not confined to a few trades, but is recognised throughout the commercial world. Thus, among the cases on this subject which have come before the Courts, instances are to be found in which the traders were public-house keepers (*a*), brewers (*b*), bankers (*c*), tailors (*d*), mercers (*e*), dyers (*f*), milliners (*g*), upholsterers (*h*), pencil-makers (*i*), tobacco-brokers (*k*), snuff-makers (*l*), paper-makers (*m*), provision merchants (*n*), cheesemongers (*o*), glass-blowers (*p*), glass-stainers (*q*), manufacturing chemists (*r*), commission agents (*s*), iron-masters (*t*), carriers (*u*). The goodwill of a newspaper or magazine, consisting of the right to use the title under which reputation has been acquired by a publication, is another instance of valuable goodwill (*x*).

Firm name part of goodwill.

"The name of a firm," says Wood, V.-C., in *Churton* v. *Douglas* (*y*), "is a very important part of the goodwill of the business carried on by the firm. A person says, 'I have always bought good articles at such a house

(*a*) *Coslake* v. *Till*, 1 Russ. 376; *Spratt* v. *Jeffery*, 10 B. & C. 249; *Ex parte Thomas*, 2 Mont. D. & De G. 294; *Treed* v. *Mills*, L. R. 1 C. P. 39; *Llewellyn* v. *Rutherford*, L. R. 10 C. P. 456; *Ex parte Punnett*; *In re Ketchin*, 16 Ch. D. 226.

(*b*) *Cooper* v. *Watson*, 3 Doug. 413; *Wade* v. *Jenkins*, 2 Giff. 509; *Hall* v. *Hall*, 20 Beav. 139.

(*c*) *Smith* v. *Everett*, 27 Beav. 446.

(*d*) *Newling* v. *Dobell*, 38 L. J. Ch. 111; *Parsons* v. *Hayward*, 31 L. J. Ch. 666.

(*e*) *Morris* v. *Moss*, 25 L. J. Ch. 104.

(*f*) *Bryson* v. *Whitehead*, 1 S. & S. 74.

(*g*) *Shackle* v. *Baker*, 14 Ves. 468.

(*h*) *Chissum* v. *Dewes*, 5 Russ. 29.

(*i*) *Banks* v. *Gibson*, 34 Beav. 566.

(*k*) *Davies* v. *Hodgson*, 25 Beav. 177.

(*l*) *Hammond* v. *Douglas*, 5 Ves. 539.

(*m*) *Potter* v. *The Commissioners of Inland Revenue*, 10 Ex. 147.

(*n*) *Scott* v. *Mackintosh*, 1 V. & B. 503.

(*o*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79.

(*p*) *Featherstonhaugh* v. *Fennick*, 17 Ves. 298.

(*q*) *Scott* v. *Rowland*, 20 W. R. 508.

(*r*) *Turner* v. *Major*, 3 Giff. 442.

(*s*) *Macdonald* v. *Richardson*, 1 Giff. 81.

(*t*) *Cooper* v. *Hood*, 26 Beav. 293; *Hall* v. *Barrows*, 4 De G. J. & S. 150.

(*u*) *Cruttwell* v. *Lye*, 17 Ves. 335.

(*x*) *Giblett* v. *Read*, 9 Mod. 459; *Keene* v. *Harris*, 17 Ves. 338; *Longman* v. *Tripp*, 2 Bos. & P. N. R. 67; *Ex parte Voss*, 2 De G. & J. 230; *Marshall* v. *Watson*, 25 Beav. 501; *Bradbury* v. *Dickens*, 27 Beav. 53; *McCormick* v. *McCubbin*, Ct. Sess. Cas. 1st Ser. I. 541; *Snowden* v. *Noah*, Hopk. 347; R. Cox, 1; *Dayton* v. *Wilkes*, 17 How. Pr. 510; R. Cox, 224.

(*y*) Johns. 174.

of business; I know it by that name, and I send to the house of business identified by that name for that purpose.' There are cases every day in this Court with reference to the use of the name of a particular firm, connected generally, no doubt, with the question of trade mark. But the question of trade mark is in fact the same question. The firm stamps its name on the articles. It stamps the name of the firm which is carrying on the business on each article, as a proof that they emanate from the firm; and it becomes the known firm to which applications are made, just as much as when a man enters a shop in a particular locality. And when you are parting with the goodwill of a business, you mean to part with all that good disposition which customers entertain towards the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it. You cannot put it anything short of that. That the name is an important part of the goodwill of a business is obvious, when we consider that there are at this moment large banking firms, and brewing firms, and others, in this metropolis, which do not contain a single member of the individual name exposed in the firm" (*a*).

Sale of goodwill.

Goodwill is a subject of sale (*b*), and may fetch a considerable price. There was formerly a doubt whether a contract for the sale of a goodwill would be specifically enforced in Equity (*c*), but this question was set at rest

(*a*) And see *Lewis* v. *Langdon*, 7 Sim. 421; *Banks* v. *Gibson*, 34 Beav. 566; *Bond* v. *Milbourn*, 20 W. R. 197; *Scott* v. *Rowland*, 20 W. R. 503; *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Levy* v. *Walker*, 10 Ch. D. 436; *Beazley* v. *Soares*, 22 Ch. D. 660; *Gray* v. *Smith*, 43 Ch. D. 208; *Rogers* v. *Taintor*, 97 Mass. 291; *Sohier* v. *Johnson*, 111 Mass. 238; *Peterson* v. *Humphrey*, 4 Abb. Pr. 394; R. Cox, 212; and *Howe* v. *Searing*, 10 Abb. Pr. 264; R. Cox, 244.

(*b*) See, among other cases, *Bunn* v. *Guy*, 4 East, 190; *Smale* v. *Graves*, 3 De G. & S. 706; *Cooper* v. *Hood*, 26 Beav. 293; *Bradbury* v. *Dickens*, 27 Beav. 53; *Churton* v. *Douglas*, Johns. 174; *Ex parte Punnett*; *In re Kitchin*, 16 Ch. D. 226; *Buckingham* v. *Waters*, 14 Cal. 246; *Williams* v. *Wilson*, 4 Sandf. Ch. 379; *Barker* v. *Connecticut Mutual Life Insurance Co.* 15 Fed. Rep. 312.

(*c*) *Baxter* v. *Connolly*, 1 Jac. & W. 580. And see *Coslake* v. *Till*, 1 Russ. 376; *Bozon* v. *Farlow*, 1 Mer. 459; *Cassidy* v. *Metcalf*, 1 Mo. App. 593.

by Kindersley, V.-C., in *Darbey* v. *Whitaker* (*a*). "It is said there can be no specific performance of a contract to purchase a goodwill. No doubt you cannot have a specific performance of a contract to purchase a goodwill alone, unconnected with business premises, by reason of the uncertainty of the subject-matter. But when a goodwill is entirely or mainly annexed to the premises, and the contract is for the sale of the premises and goodwill, there is not the slightest ground for doubt that such a contract is a fit matter for a decree in a suit for specific performance." It seems, however, that there may be cases in which a contract for sale of a goodwill would be specifically enforced, the business and goodwill being included together, though there was no such dependence on the business premises (*b*). Such would be the case with the goodwill of a quack medicine or a newspaper, which is practically independent of locality (*c*). The connection between the business and the goodwill is such that the sale of the business (*d*), or of a share in the business (*e*), as a going concern, carries with it the goodwill, or the corresponding share in the goodwill, even without its being specifically mentioned, and so does the sale of a hotel or public-

(*a*) 4 Dr. 139. As to the relation between the lease of a trader's premises and the goodwill of his business, see *Dougherty* v. *Van Nostrand*, Hoff. 68.

(*b*) Thus, Romilly, M. R., says in *Robertson* v. *Quiddington*, 28 Beav. 529: "Goodwill is never a tangible thing unless it is connected with the *business* itself, from which it cannot be separated. I never knew a case in which it has been so treated." In *England* v. *Downs*, 6 Beav. 269, and *Morris* v. *Moss*, 25 L. J. Ch. 194, the goodwill of a business was held, under the circumstances, to pass with the stock, and not with the premises. And see *Woodward* v. *Lazar*, 21 Cal. 448; R. Cox, 300. In *Llewellyn* v. *Rutherford*, L. R. 10 C. P. 456, the price of the goodwill was held to belong to the previous lessee, under the contract between him and the lessor.

(*c*) See *Bryson* v. *Whitehead*, 1 S. & S. 74; *Llewellyn* v. *Rutherford*, L. R. 10 C. P. 456 (per Brett, J.); *Snowden* v. *Noah*, Hopk. 347; R. Cox, 1.

(*d*) *Shipwright* v. *Clements*, 19 W. R. 599. And see *Rolt* v. *Bulmer*, W. N. 1878, p. 119; *Reynolds* v. *Bullock*, 47 L. J. Ch. 773; *Boon* v. *Moss*, 70 N. Y. 465.

(*e*) *Churton* v. *Douglas*, Joh 174.

house (*a*). And if the goodwill is sold, the trade name goes with it (*b*).

Rights of vendor of goodwill.

After sale may set up new business.

As to the rights of the vendor after the sale of his business and goodwill, "it has been settled that there is no implied covenant of any kind" (*c*), and in the absence of any express restrictive covenant, the vendor is at liberty to set up a business of precisely the same description as that of which he has sold the goodwill, and that next door to the place where his former business was carried on, and to state his connection with that former business (*d*); but he is not entitled to represent that he is carrying on the same identical business, either by direct representations, or by assuming the trade name under which the business he has sold acquired its reputation, or the trade marks by which its goods have become known in the market (*e*); nor can he after the sale give a right to others to use the trade marks (*f*). If the trade name consisted simply of the vendor's own name, the restraint upon his continuing to use that name will have to depend upon the evidence of that user being fraudulent (*g*), but in the absence of such evidence, the *bonâ fide* use by a man of his own name will not be prohibited (*h*). But

(*a*) *Ex parte Punnett; In re Kitchin*, 16 Ch. D. 226.

(*b*) *Banks* v. *Gibson*, 34 Beav. 566; *Churton* v. *Douglas*, *ubi suprà*; *Levy* v. *Walker*, 10 Ch. D. 436; *Gray* v. *Smith*, 43 Ch. D. 208.

(*c*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79. And see *Harrison* v. *Gardner*, 2 Madd. 198; *Churton* v. *Douglas*, Johns. 174.

(*d*) *Clark* v. *Leach*, 32 Beav. 14; *Hookham* v. *Pottage*, L. R. 8 Ch. 91; *Shipwright* v. *Clements*, 19 W. R. 599; *Cassidy* v. *Metcalf*, 1 Mo. App. 593.

(*e*) *Shackle* v. *Baker*, 14 Ves. 468; *Cruttwell* v. *Lye*, 17 Ves. 335; *Kennedy* v. *Lee*, 3 Mer. 441-52; *Sedon* v. *Senate*, 2 V. & B. 220; *Harrison* v. *Gardner*, 2 Madd. 198; *Churton* v. *Douglas*, Johns. 174; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Labouchere* v. *Dawson*, L. R. 13 Eq. 322; *Ginesi* v. *Cooper*, 14 Ch. D. 596; *Leggott* v. *Barrett*, 15 *ib.* 306; *Walker* v. *Mottram*, 19 *ib.* 355; *Dawson* v. *Beeson*, 22 *ib.* 504; *Massop* v. *Mason*, 18 Grant Up. Can. Ch. 453; *Peltz* v. *Eichele*, 62 Mo. 171; *Bergamini* v. *Bastian*, 35 La. Ann. 60; *Myers* v. *Kalamazoo Buggy Co.*, 54 Mich. 215; *Hoxie* v. *Chaney*, 143 Mass. 592; *Frazer* v. *Frazer Lubricator Co.*, 121 Ill. 147; *Porter* v. *Mumford & Gorman*, 65 Ga. 11.

(*f*) *Sohl* v. *Geisendorf*, 1 Wils. (Ind). 60.

(*g*) *Churton* v. *Douglas*, Johns 174; *Holloway* v. *Holloway*, 13 Beav. 209.

(*h*) *Burgess* v. *Burgess*, 3 De G.

where the trade name in question consisted of the name of the defendant, John Douglas, with the addition "and Co.," it was held that the use of that was an important ingredient in the case, as proving fraudulent intention (*a*). And so where the name of the firm had been "Benjamin Finch & Co.," and on dissolution B. Finch agreed to carry on business only under his own name, he was restrained from trading as "Benjamin Finch & Co." (*b*).

Solicitation of former customers.

The rights of the vendor of a business and goodwill with respect to soliciting his former customers and dealing with them has been the subject of much difference of judicial opinion. In *Labouchere* v. *Dawson* (*c*) Lord Romilly, M. R., laid down a stringent rule, saying that when the vendor of a goodwill has established a new firm for the purpose of carrying on a business similar to that which has been sold, "the new firm is entitled to publish any advertisement he pleases in the papers, stating that he is carrying on such business. He is entitled to publish any circulars to all the world to say that he is carrying on such a business; but he is not entitled, either by private letter, or by a visit, or by his traveller or agent, to go to any person who was a customer of the old firm, and solicit him not to continue his business with the old firm, but to transfer it to him, the new firm" (*d*). And Jessel, M. R., was of opinion that this doctrine should be extended so as to entitle the purchaser of the goodwill of a business to restrain the vendor from having any dealings

M. & G. 896; *Bond* v. *Milbourn*, 20 W. R. 197; *Turton* v. *Turton*, 42 Ch. D. 128.

(*a*) *Churton* v. *Douglas*, *ubi suprà*, and see *Fullwood* v. *Fullwood* (1), W. N. 1873, p. 185; *Devlin* v. *Devlin*, 69 N. Y. 212; *Zimmerman* v. *Erhard*, 93 N. Y. 74; *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1. In *Bond* v. *Milbourn*, 20 W. R. 197 (very shortly reported) it seems that the plaintiff would have been entitled to an injunction at all events against the use of the words "and Co." by the defendant, if that had been the relief prayed.

(*b*) *Day* v. *Finch*, 25 Sol. J. 354.

(*c*) L. R. 13 Eq. 322. See *Selby* v. *Anchor Tube Co.*, W. N. 1877, p. 191. Also *Angier* v. *Webber*, 14 Allen 211; *Dwight* v. *Hamilton*, 113 Mass. 175; *Muncey* v. *Butterfield*, 133 Mass. 492.

(*d*) As to the surrender of a business by A "for the benefit" of B, see *Clark* v. *Leach*, 32 Beav.

with his former customers, irrespective of whether he had solicited their custom or not (*a*).

Leggott v. *Barrett.*

The restrictions thus imposed on the vendor have been gradually removed, until it may now be said that nothing is left of them. The first step in this direction was taken by the Court of Appeal in *Leggott* v. *Barrett* (*b*), in which case it was held that the vendor could not be restrained from dealing with his old customers, even where he had solicited a renewal of their custom.

Walker v. *Mottram.*

The question next arose with reference to the case in which the goodwill has not been voluntarily alienated by the person entitled to it, and the distinction between this case and the case of a voluntary sale was clearly pointed out in *Walker* v. *Mottram* (*c*), in which Jessel, M. R., and the Court of Appeal held that a trader, the goodwill of whose business had been sold by his trustees in liquidation, could not be prevented from actually soliciting his former customers. "An assignment of a business and its goodwill, without more, appears to us," said Lush and Lindley, L.JJ., "to pass now just as much as and no more than in the days of Lord Eldon. As against the assignor it confers on the assignee the exclusive right to carry on the business assigned, and, as incidental to this, it also confers on him the exclusive right to represent himself as carrying on that business, and consequently the right, not only to sue the assignor for damages if he has infringed these rights, but also to restrain him from infringing them if he manifests an intention to infringe them. Moreover, to this extent a bankrupt who does not concur in his trustee's assignment is in no better position than a bankrupt who does. Every bankrupt, whether he concurs or not, is bound by every lawful disposition of his property by the trustee, and whatever rights such a

14; and also *Harrison* v. *Gardner*, 2 Madd. 198; and *Churton* v. *Douglas*, Johns. 174.

(*a*) *Ginesi* v. *Cooper & Co.*, 14 Ch. D. 596.
(*b*) 15 Ch. D. 306.
(*c*) 19 Ch. D. 355.

disposition confers on a purchaser must be respected by the bankrupt, whether he joins in the conveyance or not. But, in our opinion, the right of a purchaser of the goodwill of a business from the trustee in bankruptcy does not extend to restrain the bankrupt (even if he joins in the conveyance) from *bonâ fide* commencing a fresh business, and from seeking assistance in it from his old friends and customers. It would, in our opinion be contrary to the policy of the bankruptcy laws to extend *Labouchere* v. *Dawson* (*a*) to such a case. It is not necessary to overrule that decision; we leave it where it is, that is to say, it will still be applicable to voluntary sales. But we do not think it ought to be extended to alienations which are compulsory" (*b*). On this principle it was held by the Court of Appeal in *Dawson* v. *Beeson* (*c*) that an expelled partner was entitled to solicit the customers of his old firm.

Pearson v. *Pearson.*

The final step was taken by Baggallay and Cotton, L. JJ., in *Pearson* v. *Pearson* (*d*), in which it was definitely laid down that *Labouchere* v. *Dawson* (*a*) was wrongly decided, and that a vendor of a business and goodwill cannot, in the absence of an express restrictive covenant, be restrained from soliciting the old customers of the business. This decision appears to conclude the question, so far as the Supreme Court is concerned (*e*); but after the great fluctuation of judicial opinion, the express dissent of Lindley, L. J., from the decision, and the forcible arguments of Jessel, M.R., in the opposite direction, it seems too much to say that this point can be regarded as finally settled without a judgment of the House of Lords.

Vendor restrained,

Although there is no implied covenant on the sale of a goodwill, without more, that the vendor will not set up

(*a*) L. R. 13 Eq. 322.
(*b*) See *Holmbold* v. *Holmbold Manufacturing Co.*, 53 How. Pr. 453; *Hegeman & Co.* v. *Hegeman*, 8 Daly 1; *Iowa Seed Co.* v. *Dorr*, 70 Iowa, 481.
(*c*) 22 Ch. D. 504.
(*d*) 27 Ch. D. 145.
(*e*) See *Vernon* v. *Hallam*, 34 Ch. D. 748. And compare *Bergamini* v. *Bastian*, 35 La. Ann. 60; *Bassett* v. *Percival*, 5 Allen 345; *Hoxie* v. *Chaney*, 143 Mass. 592.

though no express covenant.

a similar business in the same neighbourhood, yet where a vendor had received in payment for his share of a goodwill a sum calculated by arbitrators upon the understanding (to which he had assented) that he would not carry on business in the same street, it was held to be contrary to Equity that he should carry on business in that street, and he was accordingly enjoined (*a*).

Express restrictive covenant usual.

In the sale of a business and goodwill, it is customary to insert an express restrictive covenant, which will be binding on the vendor, restraining him from setting up the same trade within a certain limit of time or space, or using his name or allowing it to be used for that purpose (*b*); and this has become so usual that where (*c*), in a contract for sale, one of the items was "goodwill, &c.," Romilly, M. R., held that in the "&c." would be included, amongst other things, a covenant by the vendor not to carry on a similar business in Great Britain, for a reasonable time, to be limited in the conveyance, having regard to the nature of such undertakings. Such a covenant may even have the effect of compelling the vendor to quit his trade altogether for the period specified, as was held by Lord Mansfield, C. J., and the Court of King's Bench, in *Cooper* v. *Watson* (*d*); and it has been held that a breach of a covenant "not to carry on or be

(*a*) *Harrison* v. *Gardner*, 2 Madd. 198. See *Cassidy* v. *Metcalf*, 1 Mo. App. 593.

(*b*) *Cooper* v. *Watson*, 3 Doug. 413; *Bryson* v. *Whitehead*, 1 S. & S. 74; *Williams* v. *Williams*, 2 Swanst. 253; *Whittaker* v. *Howe*, 3 Beav. 383; *Turner* v. *Evans*, 2 De G. M. & G. 740; *Nowling* v. *Dobell*, 38 L. J. Ch. 111; *Wolmershausen* v. *O'Connor*, 36 L. T. N. S. 921; *Haulinson* v. *Clarke*, 14 M. & W. 187; *Rolfe* v. *Rolfe*, 15 Sim. 88; *Shipwright* v. *Clements*, 19 W. R. 599; *Lee* v. *Ehrhart*, 19 L. T. N. S. 637; *Hagg* v. *Darley*, 47 L. J. Ch. 567; *Vickery* v. *Welch*, 19 Pick. 523; *Smith* v. *Smith*, 4 Wend. 468; *Sander* v. *Hoffman*, 64 N. Y. 248; *Peltz* v. *Eichele*, 62 Mo. 171; *Butler* v. *Burleson*, 16 Vt. 176; *Baumgarten* v. *Broadaway*, 77 N. Car. 8; *Woods* v. *Sands*, Dig. 467; *Morgan* v. *Perhamus*, 36 Ohio St. 517; *Williams* v. *Wilson*, 4 Sandf. Ch. 379; *Gillis* v. *Hall*, 2 Brows. 342; R. Cox, 580; and similarly upon the sale of a trade mark together with the right to manufacture according to a secret recipe: *Filkins* v. *Blackman*, 13 Bl. C. C. 440.

(*c*) *Cooper* v. *Hood*, 26 Beav. 293. See *Jacoby* v. *Whitmore*, 49 L. T. N. S. 335.

(*d*) 3 Doug. 413.

concerned or interested in" a certain business, was committed by the vendor entering into the service of a nephew, who carried on the same trade, under the same name, within the proscribed limits (*a*). Again, a covenant not to carry on a certain business directly or indirectly within the counties of C., A., and M., was broken by soliciting orders on three occasions within C., though the offices of the new business were outside the limits (*b*). A vendor of a business, who has covenanted not to carry on such a business, will not be allowed to do so under the pretext of acting as a commission merchant (*c*), and the fact that former customers have requested the vendor to supply them does not prevent his so doing from being a breach of his covenant (*d*). But where the defendant was shown to have so acted in a few instances only, and with the plaintiff's knowledge and consent, and in fact at his request, it was held that there was no breach (*e*).

Damages in respect of improper solicitation.

In an American case (*f*) it was held that a person who had retired from a firm by sale of his interest, and had agreed not to trade in C. under the old firm name, but had nevertheless traded there under the same name, and had solicited former customers of the firm, must pay damages calculated, not upon the total amount of improper solicitation of such customers, but upon the amount of business which could be proved to have been lost through such solicitation.

Covenant to make profitable.

"Where a man sells the goodwill of a trade, and covenants to make it as profitable as he can, the actual profit made is not that which the vendee is bound to take; but he will have an action of covenant, if he can establish his

(*a*) *Newling* v. *Dobell*, 38 L. J. Ch. 111. See *Rolfe* v. *Rolfe*, 15 Sim. 88, and compare *Lee* v. *Ehrhart*, 19 L. T. N. S. 637, where there was held to be no breach.

(*b*) *Turner* v. *Evans*, 2 De G. M. & G. 740. And see *Smith* v. *Smith*, 4 Wend. 468; *Butler* v. *Burleson*, 16 Vt. 176; *Sander* v. *Hoffman*, 64 N. Y. 248.

(*c*) *Richardson* v. *Peacock*, 26 N. J. Eq. 40.

(*d*) *Sander* v. *Hoffman*, *ubi sup.*

(*e*) *Rawlinson* v. *Clarke*, 14 M. & W. 187.

(*f*) *Burckhardt* v. *Burckhardt*, 36 Ohio St. 261.

title to more, through the default of the vendor" (*a*). But no such covenant will be implied where it is not expressed; thus the sale of the goodwill of a school involves no personal effort on the part of the vendor to influence the attendance of pupils (*b*). Where a servant has covenanted not to carry on a business similar to his master's within certain limits, the benefit of the covenant passes to a purchaser of the goodwill of the business (*c*).

Rights of purchaser of goodwill.

The purchaser of a business and goodwill is entitled to all the advantages of the reputation and connection of the business as previously conducted, except such benefit as the vendor, on setting up a *bonâ fide* new business, as he is at liberty to do if there is no covenant to the contrary, may derive from the fact of his being known to have belonged to the former business; and the purchaser is entitled to restrain the vendor by injunction from interfering with what he has sold. With respect to the right of the purchaser to continue to trade under the old trade name, it has been thought that, at all events if it consisted in whole or in part of the name of the vendor, injury (*d*), or at least inconvenience (*e*), might result to the latter from its continued use by the purchaser, and in *Scott* v. *Rowland* (*f*) Wickens, V.-C., granted an injunction to restrain the purchaser of the business of "John Scott & Co." from trading under that name. So in *Thynne* v.

(*a*) Per Lord Eldon, C., in *Scott* v. *Mackintosh*, 1 V. & B. 503.

(*b*) *McCord* v. *Williams*, 96 Penn. St. 78.

(*c*) *Jacoby* v. *Whitmore*, 49 L. T. N. S. 335; *Showell* v. *Winkup*, 60 L. T. N. S. 389.

(*d*) Per Wickens, V.-C., in *Scott* v. *Rowland*, 20 W. R. 508, and Hall, V.-C., in *Levy* v. *Walker*, 10 Ch. D. 436. See *Chatteris* v. *Isaacson*, 57 L. T. N. S. 177; *Thynne* v. *Shove*, 89 L. T. (Journal) 84.

(*e*) Per Wood, V.-C., in *Churton* v. *Douglas*, Johns. 174.

(*f*) 20 W. R. 508. And see *Lewis* v. *Langdon*, 7 Sim. 421; *Turner* v. *Major*, 3 Giff. 442; *Dence* v. *Mason*, 41 L. T. N. S. 573; *Dickson* v. *McMaster & Co.*, 18 Ir. Jur. 202-12; *Howe* v. *Searing*, 10 Abb. Pr. 264, R. Cox, 214; *Peterson* v. *Humphrey*, 4 Abb. Pr. 394, R. Cox, 212; *McGowan Bros. Pump and Machine Co.* v. *McGowan*, 2 Cinc. 313; *Reeves* v. *Denicke*, 12 Abb. Pr. N. S. 92. In *Tudor* v. *Tudor*, W. N. 1873, p. 72, and *Probasco* v. *Bouyon*, 1 Mo. App. 241, there was an express contract. For decisions on the Massachusetts Gen. Stat. c. 56, requiring the concurrence of an ex-partner or his personal representatives in the continued use of his

Shove (*a*), where the business had been carried on in the name of "A. Thynne." In *Banks* v. *Gibson* (*b*), however, Romilly, M. R., said that the firm name was an asset of the business, and would pass as a trade mark upon a sale of the business and goodwill; and it seems that the question of the purchaser's right to use the name, where it can be done without injury to the vendor, must now be taken to be settled in the affirmative by the decision of the Court of Appeal in *Levy* v. *Walker* (*c*), in which Jessel, M. R., and James and Bramwell, L. JJ., denied that any liability could be occasioned to the vendor by the use of his name, and held that the plaintiff (Mrs. Levy), who, while Miss Charbonnel, had traded in partnership with the defendant as "Charbonnel & Walker," was not entitled to restrain the defendant, who had bought the goodwill of the business as a going concern, from continuing to use the old name. James, L. J., said: "It should never be forgotten in these cases that the sole right to restrain anybody from using any name that he likes in the course of any business he chooses to carry on is a right in the nature of a trade mark: that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not—which is intended to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent misstatement, deprive me of the profits of the business which would otherwise come to me.' That is the principle, and the sole principle, on which this Court

Levy v. *Walker.*

name by the continuing or surviving partners, see *Bowman* v. *Floyd*, 85 Mass. 76; *Rogers* v. *Taintor*, 97 *ib.* 291; *Morse* v. *Hall*, 109 *ib.* 409; *Hallett* v. *Cumston*, 110 *ib.* 29; *Sohier* v. *Johnson*, 111 *ib.* 238. By the New York statute the purchaser of a business and goodwill is not entitled to trade under the old name, but only to describe himself as successor to the old firm. See *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1.

(*a*) 89 L. T. (Journal) 84.

(*b*) 34 Beav. 566.

(*c*) 10 Ch. D. 436. And see *Webster* v. *Webster*, 3 Swanst. 490 n.; *Clark* v. *Leach*, 32 Beav. 14; *Bond* v. *Milbourn*, 20 W. R. 197; *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Coulson & Sons* v. *Coulson & Co.*, 3 Times L. R. 846; *Tussaud* v. *Tussaud*, 38 W. R. 440; *Phelan* v. *Collender*, 13 N. Y. Sup. Ct. 244; *Booth* v. *Jarrett*, 52 How. Pr. 169; *Woods* v. *Sands*, Dig. 467; *Mossop* v. *Mason*, 18 Grant Up. Can. Ch. 453.

interferes. The Court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion of that business by somebody else. It does not interfere to prevent the world outside from being misled into anything. If there is any misleading, that may be for the Criminal Courts of the country to take notice of, or for the Attorney-General to interfere with; but an individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he has a right to restrain any one else from injuring his business by using that name. . . . But there is another point upon which I myself cannot entertain any doubt: which is this,—that the assignment of the goodwill and business of Charbonnel & Walker did convey the right to use the name of Charbonnel & Walker, and the exclusive right to use that name, as between the vendor and the purchaser of that business. Whether it would prevent another person from afterwards using the name of Charbonnel, I do not say; but the trade name, made up of parts of two real names, as the Master of the Rolls says, the trade name of Charbonnel & Walker (whether it was entirely a fictitious name can make no difference) was the name of the business, and that business was sold. That was a name with which every article sold might have been impressed, just as in the case of *Millington* v. *Fox* (*a*), where the name was continued as part of the designation of the article sold. I think it right to say that the sale of the goodwill and business conveyed the right to the use of the partnership name as a description of the articles sold in that trade, and that that right is an exclusive right as against the person who sold it, and an exclusive right as against all the world, so that no other person could represent himself as carrying on the same business." But where a partner retiring without assigning the goodwill to the continuing partner, the latter cannot continue to use the name of the retiring partner (*b*).

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

(*b*) *Gray* v. *Smith*, 43 Ch. D. 208.

The purchaser of the goodwill is, *à fortiori*, entitled to represent himself as continuing the old business: thus, where the business of John Douglas & Co. was sold, it was held that the purchasers alone had the right to describe themselves as "late John Douglas & Co.," and the vendor was restrained from calling his new firm "John Douglas & Co.," that being an interference with that right (*a*). But a purchaser has no right to use the name of the business he has bought in such a way as to create confusion in the minds of the public (*b*); and it is a fraud for a person to purchase the goodwill of a small business in order to gain a right to use a name generally identified with a different and important business (*c*). In *Warner* v. *Warner* (*d*) it was held that not only had the purchaser of the goodwill of a business in proprietary medicines the right to continue to use the old name, but that the change of the name to the purchaser's own name, so as to assimilate it to the name of an old rival business, should be restrained by injunction. And where a business has been carried on under a name somewhat resembling that under which a similar old-established business is carried on, the purchaser of the newer business must not change the name of his business so as to assimilate it to that of the older business (*e*). The mortgagee of the goodwill of a business, including the right to use the name under which the business is carried on, has no such right in that name as to be able to restrain the use of it by another person, if he has himself never traded under it (*f*). Rights of purchaser.

Where, in a purchase of a business and goodwill, it was Implied contract to keep up business.

(*a*) *Churton* v. *Douglas*, Johns. 174. And see *Lewis* v. *Langdon*, 7 Sim. 421; *McGowan Bros. Pump and Machine Co.* v. *McGowan*, 2 Cinc. 313; *Phelan* v. *Collender*, 13 N. Y. Sup. Ct. 244. But see *Howe* v. *Searing*, 10 Abb. Pr. 264; R. Cox, 244; *Reeves* v. *Denicke*, 12 Abb. Pr. N. S. 92; *Young* v. *Jones Bros. & Co.*, 3 Hughes, 274.

(*b*) *Chinn* v. *Thomas*, 5 Vict. L. R. Eq. 188.

(*c*) *Perks* v. *Hall & Co.*, W. N. 1881, p. 111.

(*d*) 5 Times L. R. 359.

(*e*) *Holt* v. *Smith*, 4 Times L. R. 329.

(*f*) *Beazley* v. *Soares*, 22 Ch. D. 660.

agreed that the purchaser should pay the vendor at the end of each of the first ten years a certain proportion of the profits, but there was no special agreement by the purchaser to keep up the business, it was held by Erle, C. J., and the Court of Common Pleas, that the purchaser had entered into an implied contract to keep up the business, at all events for the ten years over which the instalments were to extend (*a*). It seems that while such an implied contract would give a right to damages if broken, it could not be specifically enforced in Equity (*b*), though carrying on a similar business under a different style could be restrained (*c*).

Goodwill of mortgaged property.

In some cases questions have been raised with respect to the ownership of the goodwill of a business carried on on mortgaged premises. This has most frequently been when the mortgaged premises have been taken under compulsory powers, so that it has been necessary to decide to whom, or in what proportions, the purchase money was payable. The principle which governs such cases was thus laid down by Cotton, L. J. (*d*). "Goodwill is a word of which few people understand the meaning. It is obvious that to certain kinds of goodwill a mortgagee will be entitled. The goodwill which attaches to a house increases the value of that house, and therefore the mortgagee is entitled to that. By that I mean, for instance, there is a well-known public-house, and from its position being well known, people go to it; or a well-known shop, from its being situated in a good thoroughfare, people go to it. The goodwill is attaching to the house, and adds to the value of the house. But there may

(*a*) *McIntyre* v. *Belcher*, 14 C. B. N. S. 654. Compare *Harrison* v. *Gardner*, 2 Madd. 198.

(*b*) *Lewis* v. *Langdon*, 7 Sim. 421.

(*c*) *Evans* v. *Hughes*, 18 Jur. 691. And see *Turner* v. *Major*, 3 Giff. 442.

(*d*) *Cooper* v. *Metropolitan Board of Works*, 53 L. J. Ch. 109 (this passage is given rather less fully at 25 Ch. D. 479), and see *Chissum* v. *Dewes*, 5 Russ. 29; *King* v. *Midland Railway Co.*, 17 W. R. 113; *Pile* v. *Pile*, 3 Ch. D. 36; *Ex parte Punnett; In re Kitchin*, 16 *ib.* 226.

be other goodwills attaching to the personal reputation which a man has made for himself. That, of course, does not go to the mortgagee, but is a thing personal to the man whose skill and whose name have acquired that goodwill. It does not follow at all that because it is called 'goodwill' the mortgagee will be entitled to it. So far as it is incident to the house, and is connected with the house, and increases the value of the house, it goes as part of the value of the house to the mortgagee."

Goodwill s partnership assets.

In a case of partnership, the goodwill of a business, newspaper, &c., including the firm name, is partnership assets, and, on a sale of the partnership business, must be sold with it, for the benefit of the partners or their creditors (*a*), and a receiver may be appointed until the sale (*b*).

Disposal on dissolution.

On a dissolution of partnership the business and goodwill may be disposed of in three different ways: by sale, for the benefit of the partners or their creditors; by the whole concern, including the trade name, being taken by one partner at a valuation; or by a simple division of the tangible assets of the partnership, in which case each is at liberty to use the trade name just as the partnership did previously (*c*), or at all events to state his connection with the old firm (*d*). But where a partnership was entered into for a certain term, an injunction was granted to restrain one of the partners from carrying on business with others under the old partnership name, the partnership term not having expired (*e*).

(*a*) *Bradbury* v. *Dickens*, 27 Beav. 53; *Banks* v. *Gibson*, 34 Beav. 566; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *McCormick* v. *McCubbin*, 1 Ct. Sess. Cas. 1st ser. I. 541; *Dayton* v. *Wilkes*, 17 How. Pr. 510; R. Cox, 224.

(*b*) *Marten* v. *Van Schaick*, 4 Paige, 479; *Williams* v. *Wilson*, 4 Sandf. Ch. 379.

(*c*) *Banks* v. *Gibson*, 34 Beav. 566; *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766; *Levy* v. *Walker*, 10 Ch. D. 436; *Fenton* v. *Lery*, 29 Sol. J. 735; *Chappell* v. *Griffith*, 53 L. T. N. S. 459; *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2) 51 How. Pr. 455; *Myers* v. *Kalamazoo Buggy Co.*, 54 Mich. 215; *Smith* v. *Imus*, 32 Alb. L. J. 455.

(*d*) *Clark* v. *Leach*, 32 Beav. 14; *Hookham* v. *Pottage*, L. R. 8 Ch. 91; *Dickson* v. *McMaster & Co.*, 18 Ir. Jur. 202; *Peterson* v. *Humphrey*, 4 Abb. Pr. 394; R. Cox, 212. See *Matthews* v. *Hodgson*, 2 Times L. R. 899.

(*e*) *England* v. *Curling*, 8 Beav. 129.

Compensation governed by articles.

On a dissolution of a partnership governed by articles, the retiring partner will not be entitled to compensation for his share in the goodwill, except in accordance with the articles (*a*). Thus, in a case where provision was not made for such compensation, it was held that the premises on which the business had been carried on for many years, and which the continuing partner was entitled on dissolution to take at a valuation, were to be valued without regard to the fact of previous occupation, as, if that were taken into account, it would have the effect of making the partner in question pay for the goodwill (*b*).

What terms include goodwill.

But for a retiring partner to be entitled to compensation for his share in the goodwill, it is not necessary for the word "goodwill" to be mentioned in the article governing the distribution of the partnership property. In *Hall* v. *Hall* (*c*), indeed, it was held that a provision in the articles for the valuation, on the determination of the partnership, of the "property, credits and effects," and "the stock in trade and effects," did not include the goodwill; and so in *Dickson* v. *McMaster & Co.* (*d*), with respect to the term "stock in trade, goods, chattels and effects." But those cases must be taken to be overruled by the cases in which the terms "stock belonging to the partnership" (*e*), "property and effects" (*f*), and "effects and things" (*g*), have been held to include goodwill.

Stewart v. *Gladstone.*

Where, however, the partnership articles of a firm of commission merchants provided that a retiring partner

(*a*) *Hall* v. *Hall*, 20 Beav. 139; *Kennedy* v. *Lee*, 3 Mer. 441-52; *Farr* v. *Pearce*, 3 Madd. 74; *Stewart* v. *Gladstone*, 10 Ch. D. 626.

(*b*) *Burfield* v. *Rouch*, 31 Beav. 241. But see *Dougherty* v. *Van Nostrand*, Hoff. 68.

(*c*) 20 Beav. 139.

(*d*) 18 Ir. Jur. 202.

(*e*) *Hall* v. *Barrows*, 4 De G. J. & S. 150.

(*f*) *Reynolds* v. *Bullock*, 47 L. J. Ch. 773.

(*g*) *Barrow* v. *Barrow*, 27 L. T. N. S. 431; *Rolt* v. *Bulmer*, W. N. 1878, p. 119; and see *Shipwright* v. *Clements*, 19 W. R. 599. Where the interest of a deceased partner is purchased by the surviving partner at a valuation, under the Ohio statute, the value of the goodwill must be included. *Rammelsberg* v. *Mitchell*, 29 Ohio St. 22.

should receive the share in the partnership property to which he was entitled upon the basis of annual accounts taken, under another article, of the partnership "estate and effects," provision being made thereby for a fair valuation and appraisement of all the particulars included in such accounts, which might be in their nature susceptible of valuation, but no mention being made of the goodwill of the business, it was held by the Court of Appeal that, the share of partners in the goodwill of a commission business not being ordinarily estimated in calculating their annual shares of profits, and that not having been the practice in the case before them, the goodwill could not be taken into account and valued as being included in the partnership "estate and effects" (*a*).

Goodwill included in valuation.

On the other hand, where the articles of partnership provided that the goodwill should belong to the partners in the proportion of their shares in the business, but should not be taken into account in the accounts of the partnership, and that on the determination of the partnership a general account and valuation of the property and effects of the partnership should be taken, the partnership being dissolved by the death of one of the partners, it was held by Stuart, V.-C., that the goodwill must be included in the valuation of the partnership property (*b*).

One partner cannot monopolise goodwill, when no articles.

In *Featherstonhaugh* v. *Fenwick* (*c*), it was decided that on a dissolution of a partnership, not provided for by articles, one partner could not secure to himself the whole benefit of the goodwill by claiming to take the share of the other at a valuation, or requiring him to remove his proportion from the premises, or clandestinely obtaining a renewal to himself of the lease of the premises occupied by the partnership; but where the goodwill goes with the premises, it has been held in America that the partners

(*a*) *Stewart* v. *Gladstone*, 10 Ch. D., 626.

(*b*) *Wade* v. *Jenkins*, 2 Giff. 509.

(*c*) 17 Ves. 208; and so in *Mitchell* v. *Read* (1), 61 N. Y. 128. As to a trade mark, see *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54.

who quit the premises have no claim in respect of goodwill against a partner who remains on the premises (*a*); and where, under a power contained in the articles, a majority of the partners in a firm expelled another partner, it was decided that in the valuation of the amount to which he was entitled, the value of the goodwill could not be taken into account (*b*).

Estate of dead partner shares in partnership profits until settlement.

If, after a dissolution of partnership by the death of a partner, "the surviving partners think proper to make that which is in Equity the joint property of the deceased and them the foundation and plant of increased profit, if they do not think proper to settle with the executors and put an end to the concern, they must be understood to proceed upon the principle which regulated the property before the death of their partner" (*c*); that is to say, capital belonging to the estate of the deceased partner having been risked, such a proportion of the total profits as are attributable to that capital will belong to that estate.

Subject to circumstances.

But in the computation of what profits are attributable to that capital a variety of circumstances have to be taken into consideration: thus, "the nature of the trade, the manner of carrying it on, the capital employed, the state of the account between the partnership and the deceased partner at the time of his death, the conduct of parties after his death, all of which may materially affect the rights of the parties" (*d*).

Similarly with goodwill.

In the same manner, on the death of a partner, the

(*a*) *Musselman and Clarkson's Appeal*, 62 Penn. St. 81.

(*b*) *Stewart* v. *Gladstone*, 10 Ch. D. 626.

(*c*) Per Lord Eldon, C., in *Crawshay* v. *Collins*, 15 Ves. 227. And see *Featherstonhaugh* v. *Fenwick*, 17 Ves. 298; *Heathcote* v. *Hulme*, 1 Jac. & W. 122; *Brown* v. *De Tastet*, Jac. 284; *Cook* v. *Collingridge*, Jac. 607; *Macdonald* v. *Richardson*, 1 Giff. 81; and *Parsons* v. *Hayward*, 31 L. J. Ch. 666.

(*d*) Per Wigram, V.-C., in *Willett* v. *Blanford*, 1 Hare, 253. And see *Simpson* v. *Chapman*, 4 De G. M. & G. 154, where these remarks were highly approved by Turner, L. J., and it was held that, under the circumstances of the case, nothing was due to the estate of the deceased partner.

goodwill ought, if there is no provision regulating its destination in such an event, to be sold for the benefit of the partnership, and if that is not done, the continuing partners will have to account to the estate of the deceased partner for his share in the goodwill.

Goodwill does not survive.

There is, indeed, a distinct decision (*a*) by Lord Loughborough, C., that upon a dissolution of a partnership without articles the goodwill survives to the surviving partner. This position was, however, doubted by Lord Eldon, C., in *Crawshay* v. *Collins* (*b*); and it is now thoroughly established that the goodwill is partnership assets. "The goodwill of a trade, although inseparable from the business, is an appreciable part of the assets of a concern, both in fact and in the estimation of a Court of Equity. Accordingly, in reported cases, Lord Eldon held that a share of it properly and as of right belonged to the estate of the deceased partner. It does not survive to the remaining partners, unless by express agreement; but it may by agreement, as it may be agreed that any particular portion of the partnership assets shall so survive. Goodwill manifestly forms a portion of the subject-matter which produces profits, which constitutes partnership property, and which is to be divided between the surviving partners and the estate of the deceased partner, according to the terms of the contract, and when that is silent, according to their shares in the concern" (*c*). The share of the deceased partner in the concern is not, however, the sole guide to the interest of his estate in the goodwill. The various circumstances alluded to by Wigram, V.-C., in *Willett* v. *Blanford* (*d*) must be

(*a*) *Hammond* v. *Douglas*, 5 Ves. 539. And see *Lewis* v. *Langdon*, 7 Sim. 421; *Robertson* v. *Quiddington*, 28 Beav. 529; *Young* v. *Jones Brothers & Co.*, 3 Hughes, 274.

(*b*) 15 Ves. 227.

(*c*) Per Romilly, M. R., in *Wedderburn* v. *Wedderburn*, 22 Beav. 84. And see *Macdonald* v. *Richardson*, 1 Giff. 81; *Bradbury* v. *Dickens*, 27 Beav. 53; *Smith* v. *Everett*, 27 Beav. 446; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *McCormick* v. *McCubbin*, Ct. Sess. Cas. 1st ser. I. 541; *Dougherty* v. *Van Nostrand*, Hoff. 68; *Dayton* v. *Wilkes*, 17 How. Pr. 510; R. Cox, 224.

(*d*) 1 Hare, 253.

considered. Thus, where at the time of the death of one of two partners the partnership was insolvent, and the deceased partner indebted to the partnership, and the surviving partner subsequently carried on the business with such energy and success that he was able at a later period to sell the goodwill for £1700, it was held by Jessel, M. R., that the surviving partner was only liable to account to the estate of his deceased partner for the value of a moiety of the goodwill at the time of the latter's death (*a*).

Firm name.

With respect to the trade name, Shadwell, V.-C., in *Lewis* v. *Langdon* (*b*), expressed an opinion that it survived, but the decision in that case only amounted to this: that one of three executors of a deceased partner in the firm of "Brookman & Langdon" had no right to set up in business as "Brookman & Langdon," and that the surviving partner, who was carrying on business as "James Lewis & Co., successors to Brookman & Langdon," had sufficient interest in the name of the old firm to restrain an unauthorised use of it (*c*); and it seems that one member of a firm cannot, on the death of his partner, monopolise all the benefit to be derived from the use of the firm name (*d*), although, if he purchases the interest of his deceased partner from the latter's executors, he will be entitled to the exclusive use of the old firm name (*e*).

Firm continued by certain partners.

When, on a dissolution of partnership, the goodwill of the business becomes the property of some of the former partners, with it they acquire the right of representing

(*a*) *Broughton* v. *Broughton*, 44 L. J. Ch. 526. And compare *Simpson* v. *Chapman*, 4 De G. M. & G. 154.

(*b*) 7 Sim. 421. See *Milner* v. *Reed*, Dig. 328.

(*c*) In this respect, *Hine* v. *Lart*, 10 Jur. 106, and *Dent* v. *Turpin*, 2 J. & H. 139, seem to be in point, as in those cases the plaintiff had a certain right, but not an exclusive right, in the trade marks. See *Scott* v. *Scott*, 16 L. T. N. S. 143.

(*d*) A decided opinion to this effect is expressed in Lindley on Partnership. And see *Fenn* v. *Bolles*, 7 Abb. Pr. 202.

(*e*) *Phelan* v. *Collender*, 13 N. Y Sup. Ct. 244.

their remodelled business as being the continuation of the old one; and they are at liberty to express this by styling themselves "B. & C., late A. and B.," or "B. & C., successors to A. & B.," or by using any similar words (*a*). If they continue to use the style of the old business, "A. & B.," as before, then, as regards the partner by whose retirement or death the dissolution has been brought about, it does not appear that he or his estate will be exposed to loss or inconvenience, or that he or his representatives have any ground for complaint (*b*); and, as regards the public, it seems that the use of the old name does not, as a rule, constitute any false representation, the only statement being that the new firm is carrying on the business of the old one (*c*). Such continued user, however, will not be permitted when it can be only for an improper and fraudulent purpose, and in order to deceive the public (*d*); nor where the partnership has been only contrived with a view to giving the purchaser of a professional business the means of appropriating to himself the personal reputation of the vendor (*e*).

Rights on dissolution by retirement or by death and sale of goodwill.

When a partner has retired from a business, his share and interest therein being taken over by the continuing partners, or when, on the death of a partner, the partnership business has been sold, the retiring or surviving partner, as the case may be, has full liberty to set up a precisely similar business to that which the partnership carried on, but he must not represent it to be the same

(*a*) *Churton* v. *Douglas*, Johns. 174; *Lewis* v. *Langdon*, 7 Sim. 421; *Hookham* v. *Pottage*, L. R. 8 Ch. 91; *Peterson* v. *Humphrey*, 4 Abb. Pr. 394; R. Cox, 212; *McGowan Brothers' Pump & Machine Co.* v. *McGowan*, 2 Cinc. 313; *Phelan* v. *Collender*, 13 N. Y. Sup. Ct. 244; *Young* v. *Jones Brothers & Co.*, 3 Hughes, 274. But see *Reeves* v. *Denicke*, 12 Abb. Pr. N. S. 92.

(*b*) See *Levy* v. *Walker*, 10 Ch. D. 436, and cases at p. 345-6, *suprà*.

(*c*) *Banks* v. *Gibson*, 34 Beav. 566; *Aubin* v. *Holt*, 2 K. & J. 66. And see *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Phelan* v. *Collender*, 13 N. Y. Sup. Ct. 244; *Probasco* v. *Bouyon*, 1 Mo. App. 241; *Oakes* v. *Tonsmierre*, 4 Woods, 547.

(*d*) *Denco* v. *Mason*, Dig. 534; 41 L. T. N. S. 573.

(*e*) *Thornbury* v. *Bevill*, 1 Y. & C. Ch. 554. And see *Oakes* v. *Tonsmierre*, 4 Woods, 547.

business (*a*). To use the language of Fry, J., in *Moqford* v. *Courtenay* (*b*) "the rights of a late partner who has no interest in the goodwill of the old business, to carry on trade are somewhat refined. They amount shortly to this—that he may carry on a similar trade or similar business; he cannot carry on the identical business. He is at liberty to do everything which flows from the right to carry on a similar business; he is prohibited or liable to be restrained from doing anything which conduces to his carrying on the identical business; but what acts come within either of those classes is a question of very considerable nicety." To this extent the rights of an expelled partner are the same as if he had retired voluntarily (*c*). In the valuation, therefore, of the share of a retiring or dead partner, which is to be taken over by the surviving partner, this fac should be taken into consideration, as it may materially affect and even destroy the value of the share (*d*); and when the business is to be sold, that fact should be stated in the particulars of sale, in order that the purchaser may be able to buy with a full knowledge of the facts (*e*). In *Smith* v. *Everett* (*f*), the survivor of two partners in a banking business sold the business, and it was held that the estate of the deceased partner was entitled to a share of so much of the purchase money as was attributable to the goodwill. Romilly, M. R., directed that this value should be ascertained, regard being had to the facts that: 1st, the partnership premises belonged to the survivor;

(*a*) *Kennedy* v. *Lee*, 3 Mer. 441-52; *Harrison* v. *Gardner*, 2 Madd. 198; *Churton* v. *Douglas*, Johns. 174; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Clark* v. *Leach*, 32 Beav. 14; *Bond* v. *Milbourn*, 20 W. R. 197; *Hookham* v. *Pottage*, L. R. 8 Ch. 91; *Selby* v. *Anchor Tube Co.*, W. N. 1877, p. 191; *Wolmershausen* v. *O'Connor*, 36 L. T. N. S. 921; *Leggott* v. *Barrett*, 15 Ch. D. 306; *Rammelsberg* v. *Mitchell*, 29 Ohio St. 22; *Cottrell* v. *Babcock Printing Press Manufacturing Co.*, 35 Alb. L. J. 129.

(*b*) 45 L. T. N. S. 303.

(*c*) *Dawson* v. *Beeson*, 22 Ch. D. 504.

(*d*) *Mellersh* v. *Keen*, 28 Beav. 453; *Davies* v. *Hodgson*, 25 Beav. 177; *Rammelsberg* v. *Mitchell*, *ubi suprà*.

(*e*) *Cook* v. *Collingridge*, Jac. 607; *Hall* v. *Barrows*, 4 De G. J. & S. 150. And see the form settled by the L.JJ. in *Johnson* v. *Helleley*, 2 De G. J. & S. 446.

(*f*) 27 Beav. 446.

2ndly, the survivor had the right to carry on the business of a banker on the same premises after the sale of the goodwill; 3rdly, the sole right of issuing bank notes survived to him.

Retiring or surviving partner may state former connection.

Unless he has specially contracted not to do so (*a*), a retiring or surviving partner may advertise generally the facts that he was connected with the former business, and that he is establishing a new business, and is not debarred from soliciting the customers of his former firm (*b*), and he may style himself "formerly" or "late" of the firm, and, if he occupies the premises formerly occupied by the firm, may state that they were so occupied; but he may not describe himself as "successor to" the old firm.

And the termination of that connection.

A retiring partner may advertise the discontinuance of his participation in a periodical issued by the partnership, but he is not at liberty to advertise its discontinuance generally, any more than he might represent the partnership to have ceased to carry on business, upon his own retirement (*c*). And where an ex-partner knowingly allowed his former firm to continue to use his name, it was held that he was estopped from denying his partnership as against a person who had acted in the belief that he was still a partner (*d*).

Necessary announcements may be made.

While, however, a retiring partner is not at liberty to depreciate the property, his share in which has passed to others (*e*), a partner who has bought the share of his partner may, even before the purchase is in all respects

(*a*) *Wolmershausen* v. *O'Connor*, 36 L. T. N. S. 921.

(*b*) *Pearson* v. *Pearson*, 27 Ch. D. 145; *Vernon* v. *Hallam*, 34 Ch. D. 748. See *Bradbury* v. *Dickens*, 27 Beav. 53; *Clark* v. *Leach*, 32 Beav. 14; *Labouchere* v. *Dawson*, L. R. 13 Eq. 322; *Graveley* v. *Winchester*, Seton, 4th ed., 257; *Burrows* v. *Foster*, 1 N. R. 156; *Selby* v. *Anchor Tube Co.*, W. N. 1877, p. 191; *Leggott* v. *Barrett*, 15 Ch. D. 306; *Walker* v. *Mottram*, 19 *ib.* 355; *Dawson* v. *Beeson*, 22 *ib.* 504; *Morgan* v. *Schuyler*, 79 N. Y. 490.

(*c*) *Bradbury* v. *Dickens*, 27 Beav. 53. In *England* v. *Curling*, 8 Beav. 129, an injunction was granted to restrain a partner from publishing notices of the dissolution of the partnership during the term for which it was to subsist.

(*d*) *Richards* v. *Hunt*, 65 Ga. 342. So in *Backus* v. *Taylor*, 84 Ind. 503.

(*e*) *Bradbury* v. *Dickens*, *ubi supra*.

completed, publish statements which are necessary to induce others to join him, and to enable him to carry on the business, though, in the opinion of the selling partner, that may have a prejudicial effect on what is still in a sense the partnership property (*a*).

Business carried on in separate districts.

Where two partners, having been in the habit of carrying on the partnership business, each in a separate district, agreed to dissolve partnership, the premises, stock, and goodwill to be sold, or until sale to vest in a receiver, Stuart, V.-C., restrained one partner from carrying on the business on his own account in one district, and directed him to account for the profits (*b*).

Right of election protected.

Again, where it was provided by the partnership articles that, on the death of one of the partners, his personal representative should have the right to elect, within three months, to take the deceased partner's share in the business, Wood, V.-C., restrained the surviving partner from carrying on the business under any other firm or style than that used in the lifetime of the deceased partner, for three months, or until election by his representative (*c*). But it seems that though the Court can restrain the surviving partner from carrying on the business in any other name, it has no means of compelling him to carry it on in the original name (*d*).

Valuation of goodwill.

The value of a goodwill, or share of a goodwill, is usually estimated at so many years' purchase upon the amount of the profits (*e*); thus, in *Mellersh* v. *Keen* (*f*), it was fixed at one year's purchase of the net annual profits, calculated on an average of three years (*g*).

(*a*) *Marshall* v. *Watson*, 25 Beav. 501.

(*b*) *Turner* v. *Major*, 3 Giff. 442.

(*c*) *Evans* v. *Hughes*, 12 Jur. 691.

(*d*) *Lewis* v. *Langdon*, 7 Sim. 421.

(*e*) *Austen* v. *Boys*, 2 De G. & J. 626.

(*f*) 28 Beav. 453.

(*g*) As to other circumstances to be considered, see *Smith* v. *Everett*, 27 Beav. 446; *Johnson* v. *Helleley*, 34 Beav. 63; 2 De G. J. & S. 446.

APPENDIX A.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883-8, AND THE RULES AND INSTRUCTIONS THEREUNDER.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883 (*a*).
46 & 47 VICT., C. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

[*25th August*, 1883.]

BE it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.
PRELIMINARY.

Part I.
Preliminary.

Short title.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

Division of Act into parts.

2. This Act is divided into parts, as follows:—

Part I.—PRELIMINARY.
Part II.—PATENTS.
Part III.—DESIGNS.
Part IV.—TRADE MARKS.
Part V.—GENERAL.

Commencement of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December, one thousand eight hundred and eighty-three (*b*).

(*a*) The parts of this Act which have been expunged by the later Acts are printed in italics, and the provisions which have been introduced are printed in brackets.

(*b*) The Act of 1888, except where otherwise provided, commenced on the 1st January, 1889 (§ 28).

PART II. (SECS. 4-46).

PATENTS.

PART III. (SECS. 47-61).

DESIGNS (*a*).

(*a*) For § 51, requiring articles bearing a registered design to be marked so as to denote the fact of registration, see Appendix p. 596.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

Application for registration.

62.—(1.) The comptroller (*a*) may, on application by or on behalf of any person (*b*) claiming to be the proprietor (*c*) of a trade mark (*d*), register the trade mark (*e*).

(2.) The application (*f*) must be made in the form set forth in the first schedule to this Act, or in such other form (*g*) as may be from time to time prescribed (*h*), and must be left at, or sent by post to *the Patent Office in the prescribed manner* [such place and in such manner as may be prescribed] (*i*).

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

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

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

[(6.) Where an applicant for the registration of a trade mark otherwise than under an International Convention is out of

the United Kingdom at the time of making the application, he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.]

The amendments in this section were made by § 8 of the Act of 1888.

(*a*) The Comptroller General of Patents, Designs, and Trade Marks:—§ 117.

(*b*) "Person" includes a body corporate, § 117, Rule 41. There is no limitation to British subjects, and the practice hitherto has been to grant registration to aliens. See, however, *In re Riviere & Co.*, 26 Ch. D. 48. By § 103 a certain priority is given to foreign applicants who have applied for registration in their own countries.

(*c*) By "claiming to be the proprietor" nothing more is meant than "claiming to be the first to adopt," whether there has been any user or not. The doubt expressed in *In re Anderson*, 54 L. J. Ch. 1084, *Edwards* v. *Dennis*, 30 Ch. D. 454, and *In re Lyndon*, 32 Ch. D. 109, is now removed: *In re Hudson*, 32 Ch. D. 311. Since by § 77 a trade mark cannot be protected until either it has been registered or registration has been refused, it hardly seems that there can be any effective proprietorship until registration has been granted, or, in the case of an old mark—*i.e.*, a mark used before August 13th, 1875—refused.

(*d*) As to what is a trade mark, see § 64, *infra*, and Ch. 2.

(*e*) As to the mode of registration, see Rules 32-35. By Rule 33, if an applicant dies before registration, the trade mark may be registered for the successor to the goodwill of his business.

(*f*) For the mode of making application, see Rules 7-16. By § 81 (3) applications for registration of Hallamshire cutlery marks must be made to the Cutlers' Company.

(*g*) Form F in the second Schedule to the Rules is substituted for Form F in the Schedule to the Act. See Rules 4, 5.

(*h*) "Prescribed," *i.e.*, by the Rules. See § 117.

(*i*) See Rule 16.

(*k*) Four in classes 23-35; three in other classes. See Rule 13 and Form G.

(*l*) The application may be for any goods in a class: see Form F. But it should be only for the particular goods for which the applicant has used or is about to use the mark: *Edwards* v. *Dennis*, 30 Ch. D. 454. For the classification of goods, see Rule 6 and the Third Schedule to the Rules.

(*m*) The comptroller's discretion to allow the registration of a trade mark is limited by §§ 69, 72, 73 (see per Cotton, L. J., in *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278, and per Pearson, J., in *In re Price's Patent Candle Co.*, 27 Ch. D. 681). And, further, "the question whether the comptroller shall, in the exercise of the discretion which the Act gives to him, register a trade mark, is a very different question from any of the questions upon a trade mark that can be raised. He is quite within his duty, and he is quite entitled, if he thinks that—either because there are words in it, the exclusive use of which would be calculated to deceive, or otherwise—there is a sufficient reason, to say, 'No; I do not think it is proper to register this trade mark" (per Kay, J., in *In re Dunn*, 41 Ch. D. 489, and see *In re Marks & Tellefsen*, 79 L. T. (Journal) 247; *In re Speer*, 55 L. T. N. S. 880). It is, however, to be observed that in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 497, Lord Blackburn, referring to § 5 of the Act of 1875, by which it was provided that the Court "may" direct registration of a trade mark to which a claimant is entitled, said, "I

cannot construe this section as meaning anything else than that, where the Court of Chancery is satisfied that the applicant is a person who is for the time being entitled to the exclusive use of a trade mark in accordance with law, and that the trade mark is one within the definition in the Act, the Court is, *ex debito justitiæ*, to rectify the register, just as it would, before the Act of 1875, have been bound *ex debito justitiæ*, on similar proof, to prevent any one infringing the trade mark shown to be his property." And his lordship went on to say that, though the burden of proof lay upon the person making the application, yet if he did produce such proof as would, in the opinion of the Court, entitle him to an injunction, he did not think that the Court had any discretion to consider whether the registration would be inconvenient. If the comptroller has an absolute discretion to reject any mark he thinks fit, the result may be, in the case of an old mark, to destroy a very valuable property without redress. In any event the comptroller is forbidden to refuse registration without giving the applicant an opportunity of being heard : § 94.

(*n*) Before refusing to register a mark, the comptroller is to give the applicant ten days' notice of a time when he may be heard personally or by his agent. § 94 and Rules 17-19.

(*o*) See Rules 20-26 and Form H.

(*p*) As to limited registration, see note (*e*) to § 72 *infrà*.

(*q*) The Court is the High Court of Justice in England : § 117. The Court has no jurisdiction to deal with an application which the comptroller has refused, except upon an appeal to the Board of Trade and a reference of the matter by the Board to the Court : *In re Normal Co., Ld.*, 35 Ch. D. 231. But the Board should refer the matter to the Court : *Ib.* On the matter coming before the Court all objections can be taken, whether originally raised by the comptroller or not : *In re Sanitas Co., Ld.*, 58 L. T. N. S. 164. When the comptroller refuses an application, and the matter is taken to the Court, the usual rule is to make the applicant pay the comptroller's costs, whether successful or unsuccessful : *In re Van Duzer*, 34 Ch. D. 623. See Rule 44 as to entering orders of the Court on the register.

Limit of time for proceeding with application.

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

(*a*) This provision was first made by the edition of March 1883, of the Rules under the old Acts. The amendments in this section were made by § 9 of the Act of 1888. By the combined operation of this section and § 113 all applications not completed within twelve months by the applicant's default lapse, whether they were pending at the date of this Act or have been made subsequently : *In re Hayward & Co.*, 54 L. J. Ch. 1003. And this is so, though the default was occasioned by the neglect of the applicant's agent, and not of the applicant himself : *Jackson & Co.* v. *Napper*,

35 Ch. D. 162. But a trade mark registered in 1885, in pursuance of an application made in 1879, was allowed to remain on the register, subject to certain disclaimers, and to the entry of a note on the register making the five years for the purposes of § 76 run from 1885 and not from 1879: *In re Hayward & Co.*, 54 L. J. Ch. 1003. An application which has been abandoned may afterwards be renewed, at all events where the applicants are not personally in default: *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *In re Bancroft & Co.*, 5 P. R. 209. In *In re United Vineyards Proprietors Co.*, Stirling, J., Nov. 8th, 1889, an application made in 1876 had lapsed in consequence of the applicants having failed to comply with a request from the registrar for the payment of the final fee, the letter containing such request having miscarried. The applicants supposed that the mark had been registered, and took no further step. In 1882 a somewhat similar new mark was registered for the same goods by another firm. In 1889 the mistake was discovered by the original applicants, and they at once made a fresh application. The matter was referred to the Court, and it was held that, the mark having been used long before 1875, the registration should proceed, notwithstanding that the firm registered in 1882 refused to consent, while not appearing to actively oppose.

Conditions of registration of trade mark.

64.—(1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars (a):*

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

or

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

c.) *A distinctive (d) device, mark, brand, heading (e), label (f), ticket, or fancy word or words not in common use (g).*

(2.) *There may be added to any one or more of these particulars any letters, words or figures, or combination of letters, words or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.*

[64.—(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

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

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

(c.) A distinctive device, mark, brand, heading, label, or ticket; or

(d.) An invented word or invented words (*h*); or

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

(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them (*k*); but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3.) Provided as follows:

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act (*l*).]

The amendments in this section were made by § 10 of the Act of 1888.

(*a*) This section is enlarged from § 10 of the Act of 1875. The essential particular is that which causes a mark which, without it, would not be a registrable trade mark, to be a registrable trade mark; it is that by virtue of which registration is granted to a mark; and when the validity of an alleged trade mark is being considered by the Court, "the first duty cast upon the Court is to ascertain whether some one or more than one of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with one or more than one essential particular or particulars which distinguish it:" Per Earl Cairns, C., in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479. This being so, it is provided by § 92 that, though non-essential particulars of registered trade marks may be altered with the leave of the Court, essential particulars may not be. Where, therefore, two trade marks had been registered, one of which contained the name of the firm in ordinary type, and the other contained it printed in the form of a signature, Jessel, M. R., allowed a firm who had acquired the trade mark by assignment to substitute their own name for the name printed in ordinary type, but refused to allow any alteration of the signature in the second mark: *In re Dewhurst*, M. R., June 11th, 1880. See also *In re Murphy & Co.*, W. N. 1890, p. 84. A trade mark which does not contain any essential particular, and is therefore not registrable, does not become a good trade mark by remaining five years on the register: *In re Palmer* (1), 21 Ch. D. 47; (3) 24 Ch. D. 504; *In re Ralph*, 25 Ch. D. 194; *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Edwards* v. *Dennis*, 30 Ch. D. 454; *Wood* v. *Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659. So in Victoria: *Lewis* v. *Klapproth*, 11 Vict. L. R. (E.) 214: *Wolfe* v. *Alsop* (2), 12 Vict. L. R. (E.) 421; *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 162. The defini-

tion section in the Canada statute is wider, so that cases on this section must be applied with caution in Canada: *Smith* v. *Fair*, 14 Ont. Rep. 729.

(*b*) See *ante*, p. 26. The name of an individual in ordinary type is not made distinctive by having the descriptive name of the goods added: *In re Gianaclis*, 53 L. J. Ch. 782; *In re Hannay*, 7 P. R. 46.

(*c*) See *ante*, p. 36; and *In re Dewhurst*, M. R., June 11th, 1880. Registration of a signature, together with a descriptive word, gives no exclusive right in the descriptive word: *Watt* v. *O'Hanlon*, 4 P. R. 1.

(*d*) See *ante*, p. 37. The word "distinctive" applies to all the varieties of marks mentioned in this subsection. Per Cotton, L. J., in *Waterman* v. *Ayres*, 39 Ch. D. 29; and per Chitty, J., in *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274. The distinctiveness which is required cannot consist solely in colour: *In re Hanson*, 37 Ch. D. 112.

(*e*) A word used alone is not a heading: per Earl of Selborne, C., in *In re Leonard & Ellis*, 26 Ch. D. 288-95.

(*f*) The label itself must be distinctive, so that a label with the name of the proprietors in ordinary type and words descriptive of the goods is not a distinctive label: *In re Price's Patent Candle Co.*, 27 Ch. D. 681; nor can words which are descriptive or common to the trade be such a label: *Great Tower St. Tea Co.* v. *Smith*, 6 P. R. 165. A label was held to be distinctive in *In re Bryant & May, Ld.*, 4 Times L. R. 675; and see *Bryant & May* v. *Heyde*, 7 N. S. W. Rep. (E.) 72. The registration of a distinctive label does not give an exclusive right to descriptive words appearing on it: *In re Hudson*, 32 Ch. D. 311; *In re Atkins Filter & Engineering Co., Ld.*, 3 P. R. 164; *Symington & Co.* v. *Footman, Pretty, & Co.*, 56 L. T. N. S. 696; *Watt* v. *O'Hanlon*, 4 P. R. 1; nor to words common to the trade registered in connection with it: *British Tea & Trading Association, Ld.* v. *Cooke*, V. C. B., June 8th, 1886. And where applicants applied for registration of a label containing descriptive words, and contended that their registration would give them a right to the descriptive words, the opinion of the Court of Appeal negativing the claim was stated in the order of the Court allowing the registration to proceed: *In re Hudson*, 32 Ch. D. 311.

(*g*) See *ante*, p. 44. Fancy words were not registrable under the old Act: *Ex parte Stephens*, 3 Ch. D. 659; and see *Rose* v. *Evans*, 48 L. J. Ch. 618. A fancy word cannot be made out of that which is not one by prefixing the word "the": *In re Stapley & Smith*, 29 Ch. D. 877. An old mark is not considered to be in common use unless it has been used by more than three firms, but the leave of the Court is necessary for the second or third registration of the same, or substantially the same, old mark. See note (*e*) to § 72 and § 74.

(*h*) See *ante*, p. 47.

(*i*) See *ante*, p. 48.

(*k*) "Figures" mean numerals. See *Ex parte Stephens*, 3 Ch. D. 659. When it is wished to register the same essential (or "material," by which the same thing appears to be meant) particular, with a number of varying additions, the proper course is to register the marks as a series, under § 66, *q.v.* See also note (*e*) to § 72 *infra*. Inasmuch as the parts of a combination mark which are not within the definition of "essential particulars" are not entitled to registration or protection when standing alone, it seems that there cannot well be infringement of a combination mark unless the essential particular is taken. See *In re Hudson*, 32 Ch. D. 311; *In re Atkins Filter & Engineering Co., Ld.*, 3 P. R. 164; *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274; *Watt* v. *O'Hanlon*, 4 P. R. 1. In *In re Horsburgh*, 53 L. J. Ch. 237, where a registered trade mark consisted of a distinctive device and a descriptive word, it was held that substantially the same descriptive word might be registered by another

firm with a different device, from which it follows that the use of the second trade mark would be no infringement of the first.

There will not be registered as new marks or prominent parts of new marks—(See Instructions, par. 30, *infrà*):—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of the Queen, or of any member of the Royal Family.

Representations of the Royal Crown.

The National Arms or Flags of Great Britain. (See *Ex parte Davids & Co.*, 16 U. S. Pat. Gaz. 94, as to the American practice.)

Prize or exhibition Medals were also formerly excluded, but are now admitted. (As to these, see *Batty* v. *Hill*, 1 H. & M. 264; *Taylor* v. *Gillies*, 59 N. Y. 331; *In re Bush & Co.*, 10 U. S. Pat. Gaz. 164; *In re Brook*, 26 W. R. 791; *In re Farina* (2), 27 W. R. 456.)

Old marks.

(*l*) See *ante*, 48. The wording of this subsection is wider than that of the corresponding provision in § 10 of the Act of 1875. *E.g.*, a single letter may now be registered as an old mark, though it was formerly excluded from registration: *In re Mitchell* (1), 7 Ch. D. 36. An old mark must be registered as a whole, and in the exact form in which it has been actually used. Thus, in *In re Royal Baking Powder Co.*, W. N., 1880, p. 49, the applicants were not allowed to register the word "Royal," or the words "Royal Baking Powder," apart from the rest of the label with which they had been used. So in *In re Simpson, Davies & Sons*, M. R., January 12th, 1881, the registration of a trade mark consisting of a cross would have been held to be wrongful, by reason of the points of the cross registered being differently shaped from the points of the cross used, had it not been proved that there had been user in both forms. So in *Russell & Sons, Limited* v. *Smith*, M. R., June 18th, 1880, it was held that registration was wrongful because the user had been of a rough outline of a crown, and the registration was of an elaborate crown, with all the shading filled in. And see cases at p. 49. On the other hand, in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479, the House of Lords directed registration of the essential particular, omitting the immaterial additions. Now, by §§ 64, 74, the entire mark would be registered, with a disclaimer of the additions. Where blanks are left in the marks as registered, there is nothing to prevent the proprietor from filling them up in actual use: *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.); *Melachrino* v. *Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co.* v. *R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

The words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery," will not be registered under the Acts. See Instructions, par. 29, *infrà*. Nor will pictorial representations of goods to which the marks are to be applied, or names of persons in the possessive case in combination with the names of goods. See p. 462, *infrà*. As to ornamental or coloured groundwork, see Instructions, par. 28.

Connection of trade mark with goods.

65. A trade mark must be registered for particular goods or classes of goods (*a*).

(*a*) This comes from § 2 of the Trade Marks Registration Act, 1875. The appropriation of a trade mark to particular goods or classes of goods was not new. See *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *Somerville* v. *Schembri*, 12 App. Cas. 453. See Rule 6 and Schedule 3 to the Rules with respect to the classification of goods for the purposes of the Act, also per Pearson, J., in *In re Lyndon*, 32 Ch. D. 109, and per North, J., in *Hart* v. *Colley*, 44 Ch. D. 193. The Third

Schedule divides the various descriptions of goods into fifty classes. By the Rules under the Act of 1875 it was provided that where a trade mark was registered, a similar trade mark should not be registered in the name of another proprietor for any goods in the same class without the leave of the Court; but this requirement of the leave of the Court is now limited to cases in which the second application is in respect of the same goods or description of goods (see § 72). Under the old Act, registration for part of a class was granted to old marks: in *Ex parte Barrows*, W. N. 1877, p. 119; L. J. N. of C. 1877, p. 110; *In re Lysaght*, Dig. 623; *In re Rabone*, Dig. 643; *In re Ashton & Sons*, V.-C. H., February 26th, 1881; and to new marks in *In re Jelley Son, & Jones*, 51 L. J. Ch. 639; *In re Braby & Co.*, 21 Ch. D. 223; and *In re Clark & Co.*, 27 Sol. J. 396 (though in this case the mark was common for other goods in the class); and refused to a new mark in *In re Hargreaves*, 11 Ch. D. 669. And see *In re De Otaduy*, W. N. 1885, p. 177; *In re Metcalf*, 31 Ch. D. 454. Registration ought to be applied for only in respect of goods for which the mark is used or intended to be used: *Edwards* v. *Dennis*, 30 Ch. D. 454. In cases of Sheffield marks within § 81 (2) the Cutlers' Co. are to register old marks for all the metal goods in § 81, though they may have been used for some only of such goods: per North, J., in *In re Lambert*, 61 L. T. N. S. 138. If a mark is used for other goods than those in respect of which it is registered, even though in the same class, such user may be restrained if a similar mark has been used and registered by another firm in respect of those other goods: *Upper Assam Tea Co.* v. *Herbert & Co.*, C. A. July 3rd, 1889. In America, registration of the same mark in the same class may be granted to different persons if the goods are different: *Sorg* v. *Welsh*, 16 U. S. Pat. Gaz. 910. It has been held under the United States Statute of 1870 (now replaced by that of 1881) that registration in respect of too wide a class of goods is bad altogether: *Smith* v. *Reynolds* (2), 10 Bl. C. C. 100; S. C. (3), 13 *ib.* 458.

Registration of a series of marks.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately (*a*).

(*a*) This section is entirely new, but a mode of registration bearing a resemblance to that for which provision is here made was suggested by the Court of Appeal as the right one in *In re Barrows*, 5 Ch. D. 353, and was occasionally adopted. See note (*e*) to § 72, *infrà*, and cases there cited. In some cases, however, this form of registration was not considered satisfactory by the applicant, usually because, the different combinations not being individually registered, the registered proprietor was unable to get such a certificate of registration as would enable him to obtain registration in foreign countries. In *In re Fox & Co.*, V.-C. H., May 7th, 1881, Hall, V.-C., allowed a person who had registered a device together with a word (which, under the Act of 1875, could not be an essential particular in a new trade mark) to obtain a separate registration of the same device with

a different word, so that the same one essential particular was separately registered twice over, with additions which, for the purposes of the Act, were immaterial. After this decision, separate registration was generally granted by the registrar to marks which would more properly have been registered in a series, or, as it was more generally called, by representation. The concluding words of this section render separate registration unnecessary, but there is nothing to prevent it.

The only rules specially relating to applications for registration of a series of trade marks are Rule 14 (by which a representation of each trade mark included in the series is to be placed on the application form and on each of the half-sheets containing the additional representations required by Rule 13), and Rule 30, relating to the mode of advertisement.

Trade marks may be registered in any colour.

67. A trade mark may be registered in any colour [or colours], and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour [or colours] (*a*).

The amendments in this section were made by § 11 of the Act of 1888.

(*a*) In the old Acts and Rules no mention was made of colour, on account of the difficulty of properly advertising marks applied for in colour. See per Jessel, M. R., in *In re Robinson*, 29 W. R. 31. A trade mark registered in black and white consisted of the device registered, whatever might be the colour in which it was used, and it was therefore regarded as entitled to protection in whatever colour it might be used, and against rival marks in whatever colour: *Nuthall* v. *Vining*, C. A., Jan. 21st, 1880. There it was said that, in cases of alleged infringement, the true test of comparison was to compare the designs of the two trade marks in the same size and free from colour, and that similarities in respect of colour would only be regarded in order either to prove fraud, or to turn the scale when the question of infringement, leaving colour out of sight, was very difficult to decide. In *Hanson* v. *British Tea and Trading Association, Limited*, V. C. B., April 9th, 1884, C. A., June 19th, 1884, a label had been used, which, as registered under the Act of 1875, was divided into three parallel stripes of equal width, of which the outer ones were shaded and the middle one was left white, and which had the words "'Red, white, and blue' label" printed across it, and the name of the plaintiffs at the foot, and which, in actual use, was coloured with the French tricolour; and though it was registered without colour, an injunction was granted to restrain the use of a label similarly coloured and containing the same words. But where a fresh application was made to register the same label for other goods under this Act, registration was refused by the comptroller, and his refusal was upheld by the Court, on the ground that the distinctiveness required in a mark tendered for registration could not consist solely in colour: *In re Hanson*, 37 Ch. D. 112. When the question was whether a trade mark sent in for registration was too similar to one already registered for registration to be permitted, and the trade mark already on the register was in practice used in colour, the question was taken into consideration whether the subsequent trade mark, if similarly coloured, would be likely to cause deception: *In re Worthington*, 14 Ch. D. 8. In *In re Jeffrey & Co.*, Stirling, J., May 18th, 1888, the applicants for registration were allowed to bind themselves by a note on the register not to use the trade mark in black colour, nor in so dark a hue as to resemble black; and in *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888, the register was rectified by consent by adding a note that the registered proprietor was only to use his mark in blue and white.

In Canada the same effect as that provided by this section is given to registration in colour: *Smith* v. *Fair*, 14 Ont. Rep. 729; and in the United States also a trade mark cannot consist in colour alone: *Ex parte Landreth*, 31 U. S. Pat. Gaz. 1441; *Fleischmann* v. *Starkey*, 25 Fed. Rep. 127.

In some exceptional cases, under the Act of 1875, trade marks were found to be incapable of advertisement or registration in black and white, the only peculiarity being the combination of colours, *e.g.*, where coloured threads were twisted in the wick of a candle, or combined in the selvage of a piece of stuff. In such cases the marks were registered by deposit, actual specimens of the marked article being sent in to the registrar and deposited by him at the Patent Museum. For instance, there were so deposited specimens of certain marks for worsted stuffs in Class 34, numbered 5844 to 5850, and consisting of selvages containing distinctive coloured threads. See "Trade Marks Journal," Vol. II., No. 51, p.88. The use of colour being very frequently of importance in the cotton trade, it was decided that all marks for goods in the cotton classes (23-5) should be registered by deposit. When a trade mark was thus registered by deposit, the actual thing deposited, colour included, constituted the trade mark, so that in questions of infringement the point was whether the device, plus colour, was imitated in the offending mark with sufficient exactness to deceive. And the same rule was applied in registration cases, colour being taken into consideration in estimating the degree of resemblance. Thus, in *In re Robinson*, 29 W. R. 31, a device of a silver rupee being already registered, another applicant sought to obtain registration of a device of a gold mohur, and this was granted, on the ground that all that was registered was a silver coin, notwithstanding that if the second mark were to be coloured silver, deception would be probable. In such cases it was held that the proper manner of regarding the colour was a question for the trade, and that if, in the opinion of the trade, deception might arise, the Court would act on that opinion: *Mitchell* v. *Henry*, 15 Ch. D. 181. See also *In re Christiansen*, 3 P. R. 54, as to the opinion of the trade. Besides the cases above referred to, see *In re Orr-Ewing*, 8 Ch. D. 798, 4 App. Cas. 479; *In re Brook*, 26 W. R. 791; and *In re Jones Bros. & Co.* V.-C. H., July 10th, 1880.

The present section appears to have the effect of giving trade marks registered by deposit at the Patent Office Library, or registered in pursuance of an application accompanied by coloured representations, the same advantages as registration in black and white, so that for the future the colour of a trade mark registered in colour will not, except in very exceptional cases, such as that of the coloured selvage, be a part of the mark, but after one trade mark is so registered, another will not be entitled to be used or registered, if it would be likely to be mistaken for the first, on the supposition that the first mark was used in any different colour from that in which it was registered.

See Rules 13 and 27 as to the deposit of specimens of trade marks.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller (*a*), [unless the comptroller refuse to entertain the application] (*b*). Advertisement of application.

The amendments in this section were made by § 12 of the Act of 1888.

(*a*) "The object of the advertisement is to give to persons who might be claimants of the trade mark proposed to be registered the opportunity of coming forward and objecting:" per Hall, V.-C., *In re Meikle*, 24 W. R. 1067. Consequently, as was there held, when a refusal of the comptroller

to register a trade mark is overruled, the only order that can be made is an order for him to proceed with the application, so that the usual course of advertisement, &c., may be followed. This course was adopted by Hall, V.-C., in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479, and subsequent cases. It is not, however, incumbent on persons to see the advertisement, so that if a common mark has been registered, in consequence of the firms interested in opposing it having failed to see the advertisement of the application, they are able to obtain the removal of the mark from the register, with costs, on application within a reasonable time after the registration was brought to their knowledge: *In re Hyde & Co.*, 7 Ch. D. 724. See *In re Palmer* (3), 24 Ch. D. 504; *In re Kuhn & Co.*, 53 L. J. Ch. 288; *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Wood* v. *Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659.

As to the mode of advertisement, see Rules 27-30.

(*b*) This exception was no doubt inserted in consequence of the case of *Ex parte Saxlehner*, Q. B. D., July 7th, 1887, in which the comptroller refused to advertise applications by Saxlehner for the registration of certain trade marks, on the ground that similar marks were already registered in the name of the Apollinaris Co., so that registration could not be granted and advertisement was useless; but on application by Saxlehner the Q. B. Div. granted a rule to show cause why a mandamus to advertise should not issue. The matter does not appear to have been further contested, and the marks were advertised in the "Trade Marks Journal" for July 27th, 1887..

Opposition to registration.

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

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

(3.) If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court (d).

[(3.) If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who

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

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

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

(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom.]

(*a*) This section comes from the old rules. The amendments were made by § 13 of the Act of 1888.

There is no limitation of the right of opposing to persons who can themselves claim registration: *In re Riviere & Co.*, 26 Ch. D. 48; nor is there any limitation of the right of opposing on the ground of similarity to proprietors of trade marks registered for the same goods, or even for goods in the same class, as the goods for which the applicant is seeking to register. But an opposition on this ground would, of course, not succeed unless the two marks would come into collision in some way when being used. Thus, in *In re Simpson, Davies & Sons*, M. R., Jan. 12th, 1881, the application was for registration in class 22 for railway waggons, and the successful opposition was by a firm registered in class 4 for coal, whose trade mark was used by placing it on the waggons in which the coal was conveyed and sold. And in *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278, a mark applied for in respect of wines was not allowed to be registered on account of its similarity to a mark already registered for spirits. But in *In re Dunn*, 41 Ch. D. 439, the opposition failed because a mark used for baking-powder could not be mistaken for a mark used for powder for an effervescing drink. The opposition may be by a person with whom the applicant has covenanted not to use the mark. See the Victorian case of *Ex parte Grist & Bowring*, 11 Vict. L. R. 630.

If what is desired is, not to have the registration altogether refused, but to have it limited by the addition of a note stating, *e.g.*, that the mark is only to be used in trade with a particular country, and the applicant is willing to consent to such limitation, it is not necessary to go through the process of entering a notice of opposition, but an order directing that the mark, if registered, is to be registered with the addition of a note to the desired effect, may be obtained by the applicant on an *ex parte* application: *In re Keep Brothers*, 26 Ch. D. 187.

(*b*) See pp. 470, 492 for notice of opposition. The practice in opposition cases is prescribed by Rule 31. The notice of opposition may be amended under rule 54, even after the counter-statement has been put in: *R.* v. *Comptroller*, Q. B. D., May 3rd, 1890.

(*c*) pp. 482, 496, *infra*.

(*d*) This being the time at which the case stood for the determination of the Court, it was held that the costs of the previous proceedings in the office could not be given to a successful opponent: *In re Brandreth*, 9 Ch. D. 618; *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278. Where a claim had been wrongfully set up to use a certain trade mark, the claimants were ordered to pay the costs of cross adjourned summonses, as well as of an action which had been brought to enforce the right, even though they had not actually used the mark in question: *Davis* v. *Tylor*, M. R., April 24th, 1879. In *In re Hudson*, 32 Ch. D. 311, no costs of an opposed application were given to successful applicants, on the ground that they had caused the litigation by the manner in which they had put forward their case. By the rules under the Act of 1883 the proceedings subsequent to the case standing for the determination of the Court were to take the form of an application by the applicant to the Court by summons for leave to register. Now the proceedings are assimilated to those in the case of an unopposed application for registration, and the rights of the parties are decided by the comptroller, with an appeal to the Board of Trade, who may refer the case to the Court. Under the old Acts and Rules the opponent was required to take out a summons for directions, which almost always resulted in the applicant being directed to apply for leave to register. See *In re Simpson, Davies & Sons*, 15 Ch. D. 525; also *In re Johnston*, 43 L. T. N. S. 672. See rule 46 as to notifying the order of the Court to the comptroller.

(*e*) It seems that if, for any reason, an opponent is not heard, his course is to apply for a mandamus: see per Bowen, L. J., in *In re Lambert*, 61 L. T. N. S. 138.

(*f*) See Rules 20-26, and compare § 62. On an opposed application coming before the Court, the Court has full jurisdiction to decide as to the validity of the mark, notwithstanding that the comptroller has originally, under § 62, passed it for registration: *In re Arbenz*, 35 Ch. D. 248. And where an application is opposed by a competent person, all questions as to the validity of the mark are open to the consideration of the Court. It remains to be decided what costs the Court now has power to award; but it would appear that the Court can give the costs of the appeal, but not of the proceedings before the comptroller. See note (*d*) *supra*.

Assignment and transmission of trade mark.

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

(*a*) This section comes from § 2 of the Act of 1875. As to assignment and transmission, see Rules 30-40 and 61, and Form K in the Second Schedule to the Rules. See, too, Ch. 3, *supra*.

Assignments and transmissions are to be entered in the register: see §§ 78, 87, *infra*. By § 4 of the Act of 1875, it was enacted that every proprietor registered in respect of a trade mark subsequently to the first registered proprietor should, as respected 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. This enactment is not now repeated, the same result being effected by generalising the language of § 76. Compare the American case of *Walton* v. *Crowley*, 3 Bl. C. C. 440; R. Cox, 166.

(*b*) As to the connection between trade marks and the goodwill of the business, see *Cooper* v. *Hood*, 26 Beav. 293; *Churton* v. *Douglas*, Johns. 174; *Shipwright* v. *Clements*, 19 W. R. 599, and *Cotton* v. *Gillard*, 44 L. J. Ch. 90; and the American cases of *Sohier* v. *Johnson*, 111 Mass. 238;

Witthaus v. *Braun*, 44 Md. 303; *Taylor* v. *Bemis*, 4 Biss. 406; *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54, and S. C. (2), 51 How. Pr. 455; *Morgan* v. *Rogers*, 19 Fed. Rep. 596; *McVeagh* v. *Valencia Cigar Factory*, 32 U. S. Pat. Gaz. 1124; *Oakes* v. *Tonsmierre*, 4 Woods 547; *Smith* v. *Fair*, 14 Ont. Rep. 729. Where a trade mark has been placed on the register, but no business exists in which it is used, the mark cannot be assigned, since there is no goodwill to be assigned with it. *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98. See *In re Farina* (4), 44 L. T. N. S. 99. In *In re Wellcome*, 32 Ch. D. 213, the English agents of an American firm had registered in their own names two trade marks used by the latter, and subsequently assigned them to them; and it was held by Chitty, J., that the assignment, being an assignment to the persons entitled to the goodwill of the business for the purposes of which the trade marks had been registered, it was an assignment of the trade marks in connection with the goodwill, within this section, notwithstanding that the persons originally registered had no interest in the goodwill. As to goodwill, see ch. 9, *ante*.

(*c*) "An assignee has no exclusive right to a trade mark unless the assignment is of a business co-extensive with the trade mark as registered" (per Fry, L. J., in *Edwards* v. *Dennis*, 30 Ch. D. 454). And an assignment of a trade mark with a goodwill consequently gives the assignee no right in the trade mark in connection with any goods other than those to which the goodwill extends: *Ib.*

(*d*) It would appear that, since a trade mark is to determine when the goodwill of the business in connection with which it has been used determines, the registration should also be determined upon that event happening. So long as the registration continues, there is, under § 75, public use of the mark, which might be thought to imply the existence of a goodwill. It will, however, be noticed that sub-section 1 of § 90 only gives power to expunge an entry *made* without sufficient cause, so that it would appear that an entry made at a time when a goodwill was in existence is not within the wording of the sub-section. However this may be, registration of a trade mark is, by § 76, only evidence of the proprietor's right, *subject to the provisions of the Act*. Rule 34 of the old Trade Mark Rules (re-numbered 33 in the edition of March 1883) gave power to the Court, on the application of any person aggrieved, to 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 was not engaged in any business concerned in the goods within the same class as the goods with respect to which the trade mark was registered; and under this rule a trade mark was removed from the register in *In re Ralph*, 25 Ch. D. 194.

A patentee is carrying on business, and has, therefore, an existing goodwill, as long as he receives royalties from licensees, though he does not himself manufacture: *In re Ralph*, *ubi suprà*. This rule is not re-enacted, but there is no reason to suppose that this omission is due to an intention to allow a trade mark to be protected after the goodwill has determined, and after, by this section, the mark has itself determined.

Conflicting claims to registration.

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court (*a*).

(*a*) This section comes from § 5 of the Act of 1875. Rules 42-45 direct that the mode of submission to the Court shall be by special case.

This was also provided by the Rules under the old Acts, and *Allsopp* v. *Walker*, Dig. 545, was heard on special case, and in *Ex parte Grimshaw*, W. N. 1877, p. 24, Hall, V.-C., refused to order otherwise. It was, however, found to be so difficult in practice to settle the statement of facts that in all cases of rival claim the practice was adopted of applying to the Court by way of motion or summons, asking at the same time for the leave of the Court to have the matter decided in that way, and it is believed that after the first year or two from the passing of the Act of 1875 there is no instance of a special case to be found. *Allsopp* v. *Walker* was a case in which the registration of a trade mark was objected to on the ground of its similarity to another trade mark, but the cases which this section and the rules under it appear to be really intended to govern are cases in which not similar, nor even identical, trade marks are claimed, but in which *the same* trade mark is claimed, *e.g.*, where a partnership has been dissolved and a question has arisen between the former co-partners as to the way in which the trade marks of the partnership have been transmitted.

Restrictions on registration.

72.—(1.) Except where the Court has decided (*a*) that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register (*b*) in respect of the same goods or description of goods (*c*) a trade mark identical with one already on the register with respect to such goods or description of goods.

(2.) [Except as aforesaid] (*d*) the comptroller shall not register (*b*) with respect to the same goods or description of goods (*c*) a trade mark *so nearly resembling* [having such resemblance to] a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive (*e*).

The amendments in this section were made by § 14 of the Act of 1888.

(*a*) This section comes from § 6 of the Act of 1875, by which the "special leave" of the Court was required for such subsequent registration. Of this leave of the Court, Jessel, M.R., said in *In re Jelley, Son & Jones*, 51 L. J. Ch. 639, that it "is not a capricious leave. It merely means that the second man must show his title." The same principle will still govern the decisions of the Court, which will be obtained on motion or adjourned summons. It is for the Court to judge as to the similarity, so that registration may be granted notwithstanding the adverse decision of the Manchester Committee of Experts (see notes to cotton rules, *infra*), or refused, notwithstanding the favourable decision of a foreign Court (*In re Farina* (2), 27 W. R. 456). "The Court" being the High Court of Justice, an order of the House of Lords should be made an order of the High Court of Justice. See *In re Orr-Ewing* (2), 28 W. R. 412.

(*b*) The comptroller's discretion to allow registration is limited by this section: *In re Price's Patent Candle Co.*, 27 Ch. D. 681; *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278.

(*c*) The prohibition of § 6 of the old Act was of registration "in respect of the same goods or *classes* of goods." The alteration in the language confines the prohibition to cases in which the goods are substantially the same, so that it no longer applies to cases of different goods which happen to be grouped together in the same class. Even under the old Act registration was sometimes granted to similar marks for different goods included in the same class, when no clashing could take place. See note (*a*) to § 65, and note (*a*) to § 69.

(*d*) Before the introduction of these words by the Act of 1888 the pro-

hibition was absolute ; but it was held that the Court had a certain discretion where the case was not precisely covered by this section : *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278.

(*e*) The meaning of the words "calculated to deceive" was considered in *In re Lyndon*, 32 Ch. D. 109, in which Fry, L. J., said that "the words 'calculated to deceive' import at first sight a design to deceive ; but I think it plain, from the rest of the section and the decisions of the Courts, that a mark is within the section 'calculated to deceive' when that mark, fairly used, is so like a mark on the register, also fairly used, as that the one is likely to be mistaken for the other." And Bowen, L. J., said "a trade mark is calculated, by its resemblance to another already on the register, to deceive, if in the course of its legitimate use in the trade it is likely to do so." In *In re Farina* (1), 26 W. R. 261, Hall, V.-C., appears to have thought that a mark ought only to be refused registration as being 'calculated to deceive' if it bore such a resemblance to the earlier mark that an injunction would be granted to restrain the use of it ; but in *In re Marks & Tellefsen*, 79 L. T. (Journal) 247, Pearson, J., considered that the question in such cases was, not whether an injunction would necessarily be granted to restrain the use of the mark applied for, but whether it so nearly resembled the earlier mark as to be likely in the future to give rise to litigation ; and in *In re Speer*, 55 L. T. N. S. 880, Kay, J., took the same view, and went on to explain that the comptroller would be right in refusing to register a mark which was so composed as to be likely to cause the goods to which it was applied to be known by the same name in the market as the goods to which the older mark was applied. And see also per Kay, J., in *In re Dunn*, 41 Ch. D. 439, and per Stirling, J., in *In re Baschiera & Co.*, 33 Sol. J. 469. If the essential and permanent particulars of the two marks are too similar, it is immaterial that there are differences in the non-essential and changeable elements : *In re Murphy & Co.*, W. N., 1890, p. 84. It has been held in Victoria that when A and B have for years used marks bearing a certain resemblance to one another, A cannot afterwards register a mark still more similar to B's mark : *In re Rowley & Pyne*, 9 Vict. L. R. (L.) 307. "Calculated to deceive."

The restriction imposed on the registration of similar trade marks does not extend to similar marks of the same owner, but when one person applies for the registration of an essential particular, or combination of essential particulars, together with varying additions, the proper course is to register the marks as a series under § 66, *ante*. The old Acts contained no provision corresponding to those of § 66, but the same course was considered to be the right one, viz., either to register the essential particular, omitting the additions, but stating that there were to be such, or else to register the essential particular with one form of addition, but stating that that might be varied. See *In re Barrows*, 5 Ch. D. 353 ; *In re Brook*, 26 W. R. 791 ; *In re William Dixon & Co.*, M. R., April 4th, 1879 ; *Davis* v. *Tylor*, M. R., April 24th, 1879 ; *In re Clippens Oil Co.*, M. R., March 11th, 1881 ; *In re Steedman*, L. J. N. of C. 1883, p. 83 ; though occasionally separate registration was granted to marks which differed only in non-essential respects, as in *In re Fox & Co.*, V. C. H., May 7th, 1881. See the observations of Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238, as to registration with a note of disclaimer. Also *infra*. Registration as a series.

When the second of two trade marks which it is thought may conflict is claimed by a different person from the registered proprietor of the first one, it makes a considerable difference whether the second mark is an old one or a new one ; for it is the duty of a manufacturer, when adopting a new mark, to take especial care to select a distinctive one, and the Court will be far more strict in deciding whether this has been done, than it will be in deciding as to similarities between old marks. So that old marks bearing a certain similarity to each other may sometimes be allowed to be Old marks favoured

registered, though if the mark last applied for were a new one, registration would be refused to it: *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975; *In re Lambert*, 61 L. T. N. S. 138; and see per Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 499.

The "Three Mark Rule."

When the Act of 1875 came into operation it was soon discovered that trade marks which were for practical purposes indistinguishable had in various instances been used by two or more firms, generally in different parts of the country, for the same or substantially the same goods, and the injustice of giving an exclusive right to the first of these firms was felt to be so great that what is known as the "Three Mark Rule" was promulgated by the Commissioners of Patents. The first public announcement of the new rule was made by Jessel, M. R., in *In re Walkden Aerated Waters Co.*, 54 L. J. Ch. 394; when he stated that the Lord Chancellor was of opinion that the number of times that a device or emblem might be registered as a trade mark for articles of the same class ought, for the sake of distinctiveness, in no case to exceed three. That was a case in which the application was for the registration of a mark similar in its main features to two others already on the register. The mark was a new one, and the application was only allowed upon condition of the consent of both the previously registered proprietors being produced. On account of the mark in that case having been a new one, an idea arose that the rule was only applicable to new marks, but in *In re Hyde & Co.*, 54 L. J. Ch. 395; the Master of the Rolls took another opportunity of referring to the rule, and stated that the Lord Chancellor had personally come to the decision that not more than three registrations of the same, or practically the same, mark should be allowed, and that this was also his own decision; and, in fact, that of the Commissioners of Patents, having been communicated to the Attorney and Solicitor General. This decision was intended to cover old marks, and not merely new ones. A mark used in substance by more than three firms could not be registered, but must be treated as open. The rule therefore is that where a mark has been used by more than three firms it is common to the trade and incapable of registration; that where a mark has been used by two firms or three firms before the 13th of August, 1875 (the date of the passing of the Act of 1875), it is the old mark of each firm, and each firm is entitled to registration, almost as of right, on proof of the facts; but that where a mark has been registered by one firm or two firms, another firm will not be allowed to register substantially the same mark for the same goods as a new mark, except by the consent of the previously registered proprietors. See *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Brook*, 26 W. R. 791; *In re Powell*, Dig. 589; *Ex parte Sales, Pollard & Co.*, Dig. 620; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Benbow* v. *Low* (4), 44 L. T. N. S. 875; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398; and *In re Vergaras*, V.-C. H. June 3rd, 1881, in which last case the same mark was allowed to be registered by three separate firms as a new mark, all consenting. In *In re Walkden & Co.*, 54 L. J. Ch. 394, the mark was allowed to be registered as a new mark with the consent of two other firms who had registered similar marks as their old marks. An old mark may be registered under the Three Marks Rule, notwithstanding that another similar mark has been on the register for upwards of five years: *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *In re Bancroft & Co.*, 5 P. R. 209. And to entitle a mark to such registration it is not necessary to show user on the identical goods for which it is sought to register; it is sufficient to show actual user before August, 1875, on substantially identical goods—*e.g.* hatchets and axes, gimlets and augers, coopers' drawing-knives and carpenters' drawing-knives: *Jackson & Co.* v. *Napper*, 35 Ch. D. 162. In *In re United Vineyards Proprietors Co.*,

Stirling, J., Nov. 8th, 1889, the Company applied in 1876 for the registration of a device of a salamander with the words "The Salamander" as their old mark for brandy, used upwards of twenty years before 1876; but the application lapsed in consequence of the applicants having never received a letter from the registrar requesting the final fee to be forwarded. The applicants supposed the mark to have been registered. In 1882 another firm obtained the registration of a different device of a salamander as their new mark for fermented liquors and spirits. In 1889 the original applicants became aware of the non-registration, and at once made a fresh application for registration of their original mark as their old mark for brandy, used since 1850. The firm registered in 1882 refused to consent to the application, but did not appear to oppose it; and it was held that the registration should proceed, the mark being an old one. Where a new mark had been registered and much used, and another similar mark which had not been much used, was proved to be an old mark and was allowed to be registered, the new mark was not removed from the register, but was allowed to remain there side by side with the old one: *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398. But where the word "Emollio" had been used for several years prior to 1870, but had been abandoned from that year till 1881, when the user was recommenced in a different form, and there had been considerable use of the word "Emolline" by another firm since 1876. "Emollio" was not allowed to be registered: *In re Grossmith*, 60 L. T. N. S. 612. In *In re Sone & Fleming Manufacturing Co.*, 30 Ch. D. 505 the applicants had used the mark in England and America since 1872, and had registered it in America in 1881. On their applying for registration in 1885 registration was refused by the comptroller on account of a somewhat similar mark having been registered by another firm in 1877, but that firm not appearing to oppose, though served with notice of the application, and the mark being an old one, registration was granted. So in *In re Bancroft & Co.*, 5 P. R. 209. To bring a mark within the rule and entitle it to registration, notwithstanding a previous similar registration for the same goods, foreign user is insufficient, and there must have been user within the United Kingdom: *In re Münch*, 50 L. T. N. S. 12; with which compare *In re Riviere & Co.*, 26 Ch. D. 48: *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 (per Fry, L. J.): and *Berliner Brauerei Gesellschaft Tiroli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70. And the mere passage of marked goods through England, without any sale or exposure for sale, is not user of the mark in England: *Jackson & Co.* v. *Napper*, 35 Ch. D. 162, and see *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.). The user within the United Kingdom must have been substantial, and not merely nominal and unknown to the other proprietor: *In re Hodson & Co.*, 26 Sol. J. 43. A mark will be held to have been in common use, and to be consequently incapable of registration in any name, if the substantial part of it was so, though the minor parts were sometimes varied, *e.g.* in *In re Wragg*, 29 Ch. D. 551, the device of a syphon, hand and glass was held to be common to the mineral waters trade. though in the six cases relied on the three elements appeared together in three only, the syphon and hand in one, and the syphon and glass in two. From the same case it appears that the cases of user, which make the mark common, need not all have been on the goods, as in three out of the six cases the user was only on invoices and circulars, and not on the bottles.

Registration with a note.

In some cases the similarity between marks has been got over by registering for different goods, though in the same class (see note (*a*) to § 65, *ante*); or restricting the manner of user in respect of colour: *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *In re Jeffrey & Co.*, Stirling, J., May 18th, 1888, or otherwise; (*In re Whitley*, 42 L. T. N. S. 627; *In re Sykes*, 43 L. T. N. S. 626; *In re Farina* (3), Dig. 654), (see *In re De Otaduy*, W. N. 1885, p. 177); or the locality within which the mark is to

be used (*In re Rabone*, Dig. 643; *In re Keep Brothers*, 26 Ch. D. 187; *In re Mitchell & Co.*, 28 Ch. D. 666; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888. But where registration is granted with a limitation, the nature and extent of the limitation should appear on the face of the register, so as to be ascertainable by persons searching the register: *In re Mitchell & Co.*, 28 Ch. D. 666. See *In re De Otaduy*, W. N. 1885, p. 177. And in the same spirit, the improper grant of an exclusive right in common elements has been avoided by the use of disclaimers (*In re Leonardt*, Dig. 610; *In re Mitchell* (2) Dig. 611; *In re Hubbuch*, M. R., June 20th, 1879; *Ex parte Sales, Pollard & Co.*, Dig. 620; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Hoyle & Sons, Ld.* (2), Chitty, J., Nov. 30th, 1883); *In re Davies*, Chitty, J., March 9th, 1885; and see § 74: and permission to use a mark has been reserved to certain persons, on registration against all others being granted (*Ex parte Hemming & Son*, M. R. April 27th, 1881).

Marks compared as used.

In considering whether there is in fact such similarity between two marks as to exclude the second from registration, it is very important to compare them in the actual mode of user—*e.g.*, as branded on metal goods (*In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975; *Nuthall* v. *Vining*, C. A. Jan. 21st, 1880; and compare *Davis* v. *Reid*, 17 Grant Up. Can. Ch. 69). And if there are blanks in the new mark, as tendered for registration or registered, regard will be had to the manner in which these are filled up in practice: *In re Christiansen*, 3 P. R. 54, and the manner of arrangement of parts common to the trade will also be taken into consideration: *ib.* and see *In re Parrow*, 6 Times L. R. 313. And it has been held that, if one trade mark has been registered without colour, but is in practice used in a particular colour, and another trade mark is offered for registration which is distinguishable without colour, but might by the addition of colour be made to resemble the first mark, registration will be refused (*In re Worthington*, 14 Ch. D. 8). And see *In re Bieyel*, 57 L. T. N. S. 247. Although a trade mark must now be distinctive, irrespective of colour; (*In re Hanson*, 37 Ch. D. 112), it may now be registered in colour (§ 67), an advantage which was previously reserved for cotton marks and other marks of a special character requiring registration by deposit. In such a case it was formerly held that the colour was part of the mark, so that a gold coin might be registered for goods for which a silver coin was already registered, though if both were in gold, or both in silver, there would be a similarity (*In re Robinson*, 29 W. R. 31), but having regard to the provisions of § 67, it hardly seems that this decision could now be repeated. In *In re Lyndon*, 32 Ch. D. 109, it was held by the Court of Appeal that a mark tendered for registration must be compared with a mark already registered, not as actually used, but as registered, and on the footing that the applicant's mark will be fairly used; and "it is established now that when two marks are being compared together for the purpose of seeing to what extent one resembles the other with reference to the question of registering or not, the Court must presume a fair user of the mark; and at the same time it is established that the Court must look, in deciding such a question as this, to the mode in which the mark would be stamped or affixed, the character of the goods upon which it is affixed, and generally to all the circumstances of the case with respect to the placing on of the mark and the user of it. But, though the circumstances are to be looked at, it is a cardinal proposition that the Court must presume a fair user": Per Chitty, J., in *In re Haines, Batchelor & Co.*, 5 P. R. 669. In the same way Cotton, L. J., said in *In re Lambert*, 6 P. R. 351: "In considering whether the mark is calculated to deceive, we must consider what would be the ordinary use, without fraud, of the mark, and not go into the question of what might be done by a fraudulent user. If that were done—if there were a fraudulent user—then the Court would interfere, not because the man had not got the trade mark, but because he was using that trade mark

fraudulently, so as to pass off his goods for those of another. That matter of fraud is not to be considered in dealing with the question whether the mark is so like another as to be calculated to deceive. In dealing with that question you must assume that it is fair and right." And see *In re Farrow* 6 Times L. R. 319. It has been held in Victoria (*Ex parte Kennedy*, 9 Vict. L. R. (L.) 335), and the same would appear to hold good in this country, that the marks ought to be compared taken apart, and not as seen side by side, and that the question is whether it is or is not probable that an incautious person would be deceived.

Cotton marks.

In the case of cotton marks which were brought before the Manchester Committee of Experts, due weight should be given to their opinion as to the distinctiveness of the marks (*Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479), but they seem to have given somewhat too wide an interpretation to the expression "substantial similarity," in their instructions. See *In re Brook*, 26 W. R. 791. The cotton rules being now repealed, a B. list mark may be registered without an application to the Court, if the comptroller considers that a mistake has been made.

Cases of refusal.

For instances of cases in which registration has been refused on the ground of similarity, reference may be made to *Allsopp* v. *Walker*, Dig. 545, in which the first mark was a man's hand held upwards, and the second was a female hand pointed horizontally; *In re Jelley, Son, & Jones* 51 L. J. Ch. 639, in which the first mark was a pointer at a point, with the word "Staunch," and the second was a pointer feeding out of a porridge pot; *In re Rosing*, 54 L. J. Ch. 975, in which the first mark was a plain horn with a looped cord, and the second was a sprig of two roses with a twisted horn; *Barrows* v. *Pelsall Coal and Iron Co.*, Dig. 530, in which the marks were a crown with "B. B. H." in Roman letters, and a crown with "B. B. S." in italics; *In re Worthington & Co.*, 14 Ch. D. 8, a plain triangle, and a triangle containing a church with an inscription; *In re Barker & Son*, 53 L. T. N. S. 23, where each label consisted of a sporting scene; *In re Marks & Tellefsen*, 79 L. T. (Journal) 247, in which the general arrangement of the two marks was very similar; *In re Speer*, 53 L. T. N. S. 880, a dog, tower and harp, in each case; *In re Sanitas Co., Ld.*, 58 L. T. N. S. 166, where the application was for the word "Sanitas," which was included in two previous marks; *In re Grossmith*, 60 L. T. N. S. 612, where "Emollio" was thought too similar to "Emolline;" *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278, where each mark contained prominently a device of a golden fleece; *In re Baschiera & Co.*, 33 Sol. J. 439, a lion and a winged lion; *In re Murphy & Co.*, W. N. 1890, p. 84, a lion rampant with a crown and a lion rampant with a sheaf; *In re Goodall*, 42 Ch. D. 566, a similar arrangement of common words; and see *In re Farina* (2), 27 W. R. 456; *In re Hargreaves*, 11 Ch. D. 669; *In re Meyerstein & Co.*, 43 Ch. D. 604, and other cases; also *Ex parte Kennedy*, 9 Vict. L. R. (L.) 335, in Victoria.

Cases of non-refusal.

For instances of cases in which registration has not been refused on the ground of similarity see *In re Farina* (1), 26 W. R. 261, where a label had been registered with a small seal in one corner, and application was made for the registration of the same seal alone; *In re Lyndon*, 32 Ch. D. 109, a man's head surmounting the word "way," and a helmeted female head surmounting the word "Athena;" *In re Haines, Batchelor & Co.*, 5 P. R. 669, a shaded device of a pointer at a point, facing to the left, and surmounting the word "Staunch," and an outline device of a pig, facing to the left, and surmounting the initials "H. B. & Co.;" *In re Burgoyne*, 61 L. T. N. S. 39, "Emu" and "Oomoo;" in *In re Dunn*, 41 Ch. D. 439, the opposition was disallowed on the ground that the goods were different. See also *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479, and the other cotton cases mentioned in the notes to the cotton rules. Except in the cases of cotton marks the opposition has usually been successful, and registration has either been refused altogether or only granted subject to limitations.

American cases.

Under the similar section in the United States Act, registration was refused where the first mark was the figure of a star and the second was the word "star" (*In re The American Lubricating Oil Co.*, 9 U. S. Pat. Gaz. 687); where the first mark was the name Haxall, and the principal part of the second consisted of the same name and a Maltese cross (*In re Coggin, Kidder & Co.*, 11 U. S. Pat. Gaz. 1100); where the marks were the word "Swan" and the words "Black Swan" (*Ex parte Caire*, 15 U. S. Pat. Gaz. 248); so where a trade mark was tendered which consisted of three parts, each of which was already registered, one by the applicant and the others by other firms (*In re Bush & Co.*, 10 U. S. Pat. Gaz. 164), and where the new mark consisted of "A. S. California Family * Soap," and "California" and "*" were already on the register (*Ex parte Smith* (1), 16 U. S. Pat. Gaz. 679); and see *Ex parte Weisert Bros.*, 16 U. S. Pat. Gaz. 680. In *In re Cornicall* (1), 12 U. S. Pat. Gaz. 138, registration was granted to a star and crescent, a star being on the register; and see *In re Imbs*, 10 U. S. Pat. Gaz. 463.

The comptroller is entitled to his costs of opposing an application on the ground of similarity to a registered mark; at all events, unless the marks are very clearly distinct. See *In re Patent Plumbago Crucible Co.*, M. R. Aug. 1st, 1879.

See Rule 46 as to notifying the order of the Court to the comptroller.

Where the Registrar had refused to register on the ground of similarity to a registered mark, and the marks did not appear to be similar, but the owner of the registered mark had not been served with the notice of motion of the person applying for the registration of the second mark, Chitty, J., directed the registered owner to be served, and on that being done, and no objection being made, ordered the registration to proceed: *In re Milne & Co.*, Chitty, J., July 6th, 1883. And where the comptroller objects to register a mark on the ground of similarity to a registered mark, the usual practice now is to require notice of the application to be given to the proprietor of the registered mark: *In re Sone & Fleming Manufacturing Co.*, 30 Ch. D. 505; *In re Bancroft & Co.*, 5 P. R. 209; *In re Baschiera & Co.*, 33 Sol. J. 469.

Further restriction on registration.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the *exclusive* use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice (*a*), or any scandalous design.

(*a*) This section is taken from § 6 of the Act of 1875, and was amended by § 15 of the Act of 1888. The wording of the original enactment was "would not be deemed entitled," and the present wording, "would be deemed disentitled," seems less open to misinterpretation. That the original enactment only referred to deceptiveness inherent in the mark itself, and not to liability to be mistaken for another mark, was held by Jessel, M. R., in *In re Horsburgh*, 53 L. J. Ch. 237. Kay, J., however (*In re Grossmith*, 60 L. T. N. S. 612; *In re Dunn*, 41 Ch. D. 439), and Stirling, J. (*In re Swift Specific Co.*, 6 P. R. 352) appear to have thought that words were within this section which bore a resemblance to words included in an earlier mark. And Cotton, L. J., took this view in *In re Dunn*, 41 Ch. D. 439. But in that case Lindley, L. J., expressly concurred in the view taken by Jessel, M. R., and Fry, L. J., did not dissent from it. And in *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278, the observations of Cotton, L. J., incline rather in the same direction. In so great a division of judicial opinion it cannot yet be said with certainty which view of the section is correct. It is, however, submitted that §§ 72 and 73 simply have reference to the course which the comptroller is to take of his own motion with respect to marks tendered for registration, and that § 72

requires him not to register marks calculated to deceive by similarity to other marks, and that § 73 requires him not to register marks calculated to deceive by reason of some inherent defect. Section 69, which is the section by which provision is made for opposition, not by the comptroller, but by any private objector, contains no limitation of the grounds upon which objection may be raised, and it is conceived that the Act imposes no restriction upon such objections, but leaves it open to the objector to set up any legal or equitable ground for rejecting the application. If this is correct, then the cases which fall within this section are cases in which a trade mark contains a false statement of origin: *In re Horsburgh*, 53 L. J. Ch. 237; or in which the trade mark untruly states that the proprietors are the "sole makers:" *In re Hayward & Sons*, 54 L. J. Ch. 1003; or in which the mark is habitually used as part of a deceptive whole: *Wood* v. *Lambert*, 32 Ch. D. 247.

Words which are descriptive or deceptive.

Where it is sought to register as a trade mark a word or words which are or may be appropriate to the article to which the trade mark is to be applied, the applicant is in the dilemma that the alleged trade mark is either descriptive or deceptive; if the word or words are properly applicable to the article and may be truly used with respect to it, they are descriptive and are not within § 64; if they may be read as stating something with respect to the article which is untrue, they are deceptive within the present section; so that *quâcunque viâ* the application must fail. Thus in *In re Saunion & Co.*, Dig. 625, where the mark was "Anglo-Portugo Oysters," either the oysters were of Anglo-Portuguese origin, in which case any one had a right to say that they were so, or they were not of such origin, in which case no one had a right to say so; and this was adopted by Lopes, L. J., in *In re Van Duzer*, 34 Ch. D. 623. There are numerous similar cases under the U. S. Acts. Thus, *In re American Sardine Co.*, 3 U. S. Pat. Gaz. 495 ("American Sardines"); *In re Dole Bros.*, 12 *ib.* 939 ("Egg Macaroni"); *In re Warbury & Co.*, 13 *ib.* 44 ("Cachemire Milano"); *Ex parte Marsching*, 15 *ib.* 294 ("French" paints); *Ex parte Knapp*, 16 *ib.* 318 ("London" Animal Foods); *Ginter* v. *Kinney Tobacco Co.*, 12 Fed. Rep. 782 ("Straight-cut" Cigarettes). Compare *In re Green*, 8 U. S. Pat. Gaz. 729 ("German Sirup"), where registration was allowed.

In the American case of *Ex parte Cigar Makers' Association*, 16 *ib.* 958, it was held that a mark could not be registered which was intended to be used by any member of an association on goods of any quality, nor one which was intended to be used for the furtherance of a scheme in restraint of trade. And in *Schneider* v. *Williams*, 44 N. J. Eq. 391, the Court refused to protect such a mark at the instance of a member of such an association. (But see *Strasser* v. *Moondis*, 108 N. Y. 611; *People* v. *Fisher*, 57 N. Y. Sup. Ct. 552; *Allen* v. *Macarthy*, 37 Minn. 347; *Blocte* v. *Simon*, 19 Abb. N. C. 88.) And in *Ex parte Bloch & Co.*, 40 U. S. Pat. Gaz. 443, registration was refused in America to a mark which contained the words "Knights of Labour," the applicants having no connection with the society of that name.

As to what will be deemed to disentitle to protection in a court of justice, see further Ch. 7, *ante*.

Saving fo power to provide for entry on register of common marks as additions to trade marks.

74.—(1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark (*a*).

(a.) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive (*b*) device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade (*c*) in the goods with respect to which the application is made ;

(b.) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive (*b*) word or combination of words, though the same is common to the trade (*c*) in the goods with respect to which the application is made ;

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim* (*d*) *in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*

[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

Provided that a person need not, under this section, disclaim his own name or the foreign equivalent thereof, or his place of business ; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.]

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words or figures, which was, or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods (*e*).

The amendments in this section were made by § 16 of the Act of 1888.

(*a*) This section was new in 1883, and is not very clearly expressed, but what is intended appears to be that when a trade mark sent in for registration contains, together with an essential particular, a feature which is in common use in the trade, that common feature must be disclaimed, so that the rest of the trade may not be deprived of their right to use it. The additions to which this section relates are apparently not quite the same as the additions to an essential particular referred to in § 64 (2), but such as would be capable of distinguishing the goods, were it not that in point of fact they have been used by several different firms. Thus, if a device of an animal were registered in combination with the words "First quality," for iron, the case would be within § 64 ; but if the same device were to be registered in combination with a crown, the case would be within the present section, the crown being *primâ facie* distinctive, but in point of fact common to the

trade. Long user does not entitle members of a trade to register a particular device as part of their trade marks when the user was fraudulent in its inception and is still calculated to deceive: *In re Heaton*, 27 Ch. D. 570.

(*b*) The word "distinctive" is applicable to all the matters here mentioned: per Chitty, J., in *Burland & Co.*, v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274, and see, per Cotton, L. J., in *Waterman* v. *Ayres*, 39 Ch. D. 29. There is at first sight a contradiction in terms here, as a mark common to the trade cannot, of course, be distinctive; but what is intended appears to be that any mark which is *primâ facie* distinctive, but which is really common to the trade, must be disclaimed when registered as part of a combination. The epithet "distinctive" would thus be here applied to every mark which is not inherently incapable of appropriation by an individual. This view was approved by Chitty, J., in *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274. From the dicta in the Court of Appeal in *In re Hudson*, 32 Ch. D. 311, and *In re Atkins Filter & Engineering Co., Ld.*, 3 P. R. 164 it would appear that their attention had not been directed to this word.

(*c*) The words "common to the trade" have been construed to mean "open to the trade:" *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820, and *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274; and this seems to be what is meant. In *Thompson* v. *Montgomery*, 41 Ch. D. 35. Lindley, L. J., said that "nothing can be common to the trade which is used only by one person in the trade;" but in § 64, where it was intended to exclude from registration fancy words "in common use," that expression was employed, and the difference of language seems to show that the phrase here means that which is of common right, whether in common use or not. When it is alleged adversely to an applicant for registration that the whole or a part of his trade mark is common to the trade, the onus is upon the person alleging that this is so to prove it, not upon the applicant for registration to prove the contrary: *In re Leonard & Ellis*, 26 Ch. D. 288. And the entries in the registry office books of applications for registration do not prove that a mark is in common use, as they only prove that the applications entered have been made, not that they have all been properly made, or upon true allegations, or that the marks applied for have in fact been used: *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434. A mark is not made common to a particular trade by the fact that persons engaged in different trades have used it on goods of a different character: *Somerville* v. *Schembri*, 12 App. Cas. 453; nor by the fact that goods marked with it have passed through England from one foreign country to another, without any offering for sale in England: *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.). And see *Jackson & Co.* v. *Napper*, 35 Ch. D. 162. In a number of cases since the Registration Acts marks have been found to be common to different trades; thus, a number of words and devices to the iron trade: *In re Barrows*, 5 Ch. D. 353; *In re Davies*, Chitty, J., March 9th, 1885; the words "Bank of England," to the sealing-wax trade; *In re Hyde & Co.*, 7 Ch. D. 724; the word "Selected," and other words and devices, to the steel-pen trade: *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Kuhn & Co.*, 53 L. J. Ch. 238; the letters "S. P." to the snuff trade: *Ex parte Sales, Pollard & Co.*, Dig. 620; the Eton arms to the hat trade: *Lucke* v. *Webster*, M. R., April 4th, 1879; the words "Braided Fixed Stars," to the match trade: *In re Palmer* (3), 24 Ch. D. 504; the words "La Minerva, Habana," "La Pureza," and "Gold Leaf," to the cigar and tobacco trade: *In re Lloyd & Sons*, 27 Ch. D. 646; *Newman* v. *Pinto*, 57 L. T. N. S. 31; *Partlo* v. *Todd*, 12 Out. Rep. 171; a device of a syphon, hand and glass to the mineral-water trade: *In re Wragg*, 29 Ch. D. 551; the words "Extra," "Extra G." "Coker," to the canvas trade: *In re Hayward & Sons*, 54 L. J. Ch. 1003; the words "Mandarin Tea" to the tea trade: *British Tea & Trading Association, Ld.* v. *Cooke*

Common marks.

V. C. B., June 8th, 1886; the words "Old Innishowen" to the whisky trade: *Watt* v. *O'Hanlon*, 4 P. R. 1; the words "Parchment" and "Bank" to the paper trade: *In re Goodall*, 42 Ch. D. 566; various animals, devices, and colours to the cotton trade: *Orr-Ewing & Co.* v. *Johnston & Co.*, 7 App. Cas. 219; *Wallace & Co.* v. *King & Co.*, Bombay High Ct., April 30th, 1879; *In re Hoyle & Sons, Ld.* (2), Chitty, J., Nov. 30th, 1883; and see *Orr-Ewing & Co.* v. *Registrar of Trade Marks*, 4 App. Cas. 479; and *In re Brook*, 26 W. R. 791.

Disclaimers under the Act of 1875.

(*d*) The practice of entering disclaimers in the register appears to have originated with the cases of *In re Leonardt*, Dig. 610, and *In re Mitchell* (2), Dig. 611. In those cases the consent of the owner of the mark was required, but in *In re Kuhn & Co*, 53 L. J. Ch. 238, an order for a disclaimer was made notwithstanding that the owner did not formally consent, and in other cases the registration was subjected to limitations entered on the register. See cases cited in note (*e*) to § 72 *suprà*. The practice has been carried so far that in *In re Hoyle & Sons, Ld.* (2), Chitty, J. Nov. 30th, 1883, a trade mark, consisting of a pheasant sitting on a gate, was registered with a disclaimer of the bird, leaving only the gate. See the order of the House of Lords in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479, and see also the statement by Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238.

In *In re Hudson*, 32 Ch. D. 311, the Court of Appeal appears to have thought that a disclaimer could not be compulsorily enforced under the Act of 1875; but there does not seem to have been much argument on the point, and the case was decided on the ground that the words of which it was sought to compel a disclaimer were descriptive, and could not in any event be claimed as a result of the registration of the label. The words not being *primâ facie* distinctive, the question as to disclaimer could not really arise. The same was the case in *In re Atkins Filter & Engineering Co., Ld.*, 3 P. R. 164. In *In re Hayward & Sons*, 54 L. J. Ch. 1003, Kay, J., held that the Court had power under the Act of 1875 to order a compulsory disclaimer, and he accordingly ordered a disclaimer to be entered of the words "Extra G," which were common to the trade.

Disclaimers under the Acts of 1883-8.

The provision in the present Acts being that the common particular must be disclaimed *in the application*, the question has been raised whether such a disclaimer can be made at a later date, and North, J., in *In re Goodall*, 42 Ch. D. 566, decided that this could not be done, and that an application from which a necessary disclaimer had been omitted was simply null and void. In *In re Swift Specific Co.*, 6 P. R. 352, Stirling, J., refrained from deciding whether an application defective in this respect was invalid, but directed a disclaimer to be entered on the register. Subsequent disclaimers have also been directed under these Acts by Kay, J.: *In re Hayward & Co.*, 54 L. J. Ch. 1003 ("Extra," "Coker"); by Kekewich, J.: *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820 ("Herbalin"); and by Chitty, J.: *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274 ("Washerine"). So that the greater weight of authority appears to be in favour of thus correcting an originally defective or wrongful application or registration. It has also been held by Kekewich, J., that the fact that a common word has been registered as part of a trade mark, without a disclaimer, does not necessarily disentitle the owner of the mark to his costs in an action against a person who has adopted the same trade mark: *Newman* v. *Pinto*, 57 L. T. N. S. 31. Where a distinctive device has been registered, together with words which are in fact common to the trade, but without any disclaimer, no right is acquired in the common word, even after the lapse of five years from registration: *British Tea & Trading Association, Ld.* v. *Cooke*, V. C. B., June 8th, 1886 ("Mandarin Tea").

(*e*) The intention of this sub-section is to introduce here the "Three

Mark Rule," as to which see note (*e*) to § 72, *supra*. That rule is that registration of the same or substantially the same mark may be granted to not more than three persons, who can prove real user before August 13th, 1875, but that proof of user by more than three persons before that date debars all persons from registering. For there to have been "public user" by more than three persons, it would seem that the user by each must have been substantial (*In re Hodson & Co.*, 26 Sol. J. 43), and such as came or ought to have come to the knowledge of each of the others. But the marks used need not have been absolutely identical, nor in all cases on the actual goods: *In re Wragg*, 29 Ch. D. 551. It will be noticed that this subsection only relates to old marks. In the case of new marks a second registration of the same device would not be granted under § 72, except by the consent of the previously registered proprietor, and a disclaimer might even then be required as a condition of his consent. User is not proved by the books of applications for registration, as the allegations therein contained are not proved: *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434.

Effect of Registration.

Registration equivalent to public use.

75. Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark (*a*).

[Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration (*b*).]

(*a*) The original § 75, for which the present section was substituted by § 17 of the Act of 1888, came from § 2 of the Act of 1875, but the provision in that Act was made subject to the existence of a connection with goodwill. Now there is to be deemed to be public use of a trade mark as long as it is registered, whether there is or is not any goodwill, which points to the propriety of the removal of a trade mark from the register as soon as the goodwill has determined. It is, however, doubtful whether there is power under § 90 to obtain this. And see the last words of § 76, and note (*d*) to § 70. But registration does not entitle to an injunction in respect of goods for which the mark has not been used, though it has been registered for them, at all events unless the mark has been exactly copied: *Edwards* v. *Dennis*, 30 Ch. D. 454. In the United States also registration is equivalent to public use. See *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis., 1871, 248. Apart from the legislation on the subject, public use of a trade mark gives a property in it. See per Lord Blackburn, in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 496. It has been decided that to constitute public use it is not sufficient for the marked goods to be advertised; they must be actually in the market. But so long as that is the case, length of user is not necessary. See *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *In re Simpson, Davies & Sons*, M. R. Jan. 12th, 1881.

(*b*) The last part of this clause, as now altered, comes from rule 32 of the Rules of 1883, and originally from the old Rules. The principle that

registration dated from the receipt of the application prevailed throughout. Now a slight alteration is made by substituting the date of the application for the date of the receipt of it.

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be primâ-facie evidence (*a*) of his right to the exclusive use (*b*) of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence (*a*) of his right to the exclusive use of the trade mark, subject to the provisions of this Act (*c*).

Effect of registration.

(*a*) This section comes from § 3 of the Act of 1875. Until the end of five years from registration the only effect of it is, as was said in the Court of Appeal in *Nuthall* v. *Vining*, C. A. Jan. 21st, 1880, to qualify the registered proprietor for suing infringers,—in other words, registration is "simply a condition precedent to suing." per Chitty, J., in *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398; and it seems that when an action is brought to restrain an alleged infringement of a trade mark which has been registered for less than five years, the defendant may rebut the *primâ-facie* evidence of the plaintiffs' right afforded by his registration, without moving to rectify the register by expunging the mark. See *In re Palmer* (1), 21 Ch. D. 47; *Lever* v. *Goodwin*, 36 Ch. D. 1; *Weaver* v. *Sanitary Engineering & Ventilation Co.*, L. J. N. of C., 1887, p. 144; *Weaver* v. *Stiff & Sons*, *ib.* After the expiration of five years from registration, the title of the registered proprietor is, for the purposes of an action for infringement, an absolute right, and cannot be disputed except upon an application under § 90 to rectify the register: *Edwards* v. *Dennis*, 30 Ch. D. 454; *Apollinaris Co., Ld.* v. *Herrfeldt*, 4 P. R. 478. Compare *Evans* v. *Smith*, 3 Times L. R. 390, and *Bodega Co., Ld.* v. *Owens*, 23 L. R. (Ir.) 371, where this principle does not appear to have had full effect given to it. This applies also to cases of colourable imitation, as well as to cases of direct copying: *Rodgers & Sons, Ld.* v. *Rottgen*, 5 Times L. R. 678. The lapse of five years from registration is, however, no bar to proceedings brought for the purpose of rectifying the register. The view originally entertained as to the effect of this section, and the corresponding section of the Act of 1875 upon applications to rectify, appears to have been that during the first five years from registration the mark remained liable to removal from the register, *e.g.*, on application by the true proprietor of it, when it had been wrongfully registered in the name of another person, as in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98; *In re Australian Wine Co., Ld.*, 61 L. T. N. S. 427; but that after the expiration of five years from registration the title of the registered proprietor was secure against individual rival claimants, but as "the Act only says that after five years the person who has registered a trade mark shall be entitled to the trade mark, but does not say that the mark as registered shall be deemed to be a trade mark"—(see per Jessel, M. R., in *In re Palmer* (1), 21 Ch. D. 47; and compare the Victorian cases of *Lewis* v. *Klapproth*, 11 V. L. R. (E.) 214; *Wolfe* v. *Alsop* (2), 12 V. L. R. (E.) 421; *Wolfe* v. *Lang & Co.*, 13 V. L. R. 752)—the trade mark remained liable to removal for inherent defects in it—*e.g.*, that it contained no one of the essential particulars specified by § 64. Thus in *In re Palmer* (1), 21 Ch. D. 47, and (3) 24 *ib.*, 504, the words "Braided fixed stars," registered for matches, were expunged, on the ground that at the date of the registration and ever since they had been merely descriptive of matches prepared in a particular way. So where the word "Valvoline" had been

registered, though it had been used as a descriptive term : *In re Leonard & Ellis*, 26 Ch. D. 288. And see *In re Ralph*, 25 Ch. D. 194 ; *In re Lloyd & Sons*, 27 Ch. D. 646 ; *In re Wragg*, 29 Ch. D. 551 ; *Wood* v. *Lambert*, 32 Ch. D. 247 ; *In re Spencer*, 54 L. T. N. S. 659. Since the case of *Edwards* v. *Dennis*, 30 Ch. D. 454, however, it has been generally recognised that § 90 (§ 5 of the Act of 1875) overrides the provisions of this section (§ 3 of the Act of 1875), and that even after the lapse of five years the registration of a mark which is for any reason wrongful may be rectified. In that case Cotton, L. J., said that " the third section (of the Act of 1875) is intended to afford assistance to a person who is bringing an action against another person for passing off his goods as the goods of the person who brings the action. In such a case, if the plaintiff shows that he has been on the register for five years, that dispenses with the necessity of his adducing evidence of exclusive use of his trade mark. But the third section is no bar to an application under the fifth section for rectification of the register, and in the case of such an application the Court is bound to consider whether the trade mark is properly on the register ; for, although it may have been on for five years, if it ought not to have been on at all, then it can be taken off." And in this the other Lords Justices concurred. Where words common to the trade—*e.g.* " Mandarin Tea "—have been registered in combination with a distinctive device, or in connection with a distinctive label, for upwards of five years, no exclusive right is thereby acquired in the words : *British Tea and Trading Association, Ld.* v. *Cooke*, V. C. B. June 8th, 1886. In *Lamplough* v. *Beedzler*, C. A., Nov. 12th, 1880, it was held that the registered words " Pyretic Saline " were purely descriptive. See *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57, and *Wheeler* v. *Johnston*, 3 L. R. Ir. 284. In *In re Hayward & Co.*, 54 L. J. Ch. 1003, a note was entered on the register that in the case of a mark registered in 1885 the five years were to run from that date, and not from the date of the application, which was in 1879.

In the United States, registration only affords *primâ-facie* evidence of ownership (Act of 1881, § 7), and amounts to nothing more than a mere record of a claim : *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183 ; and it has been there held that registration of descriptive words confers no right in them : *Van Beil* v. *Prescott*, 82 N. Y. 630 ; and that the use of a registered mark may be restrained : *Glen Cove Manufacturing Co.* v. *Ludeman*, 23 Bl. C. C. 46 ; *Schumacher & Ettlinger* v. *Schwenke* (2), 36 U. S. Pat. Gaz. 457. In Canada it has been repeatedly held that registration can be invalidated by proof that the registered proprietor was not the first to use the mark : *McCall* v. *Theal*, 28 Grant Up. Can. Ch. 48 ; *Partlo* v. *Todd*, 12 Ont. Rep. 171 ; *Watson* v. *Westlake*, 12 Ont. Rep. 449. But it has also been held that for this to be so, the user by others must have been before the registered proprietor used the mark, not merely before he registered it : *Smith* v. *Fair*, 14 Ont. Rep. 729. Under the Canadian Statute it has been held that registration gives no right of action for anything done before registration : *Morse* v. *Martin*, Quebec Super. Ct., Feb. 28th, 1882 ; but neither the Quebec Court of Queen's Bench (3 Dorion 353) nor the Canada Supreme Court (Cassel's Dig. 509) decided the point. In New South Wales the right to registration depends, not on priority of application, but on priority of user : *Harris* v. *Ogg*, 5 N. S. W. Rep. (E.) 114 ; and although registration has been held to be from the outset conclusive proof of the right of the registered proprietor : *Walker* v. *Cargill*, 5 N. S. W. Rep. (E.) 243, the use of a registered mark has been restrained by injunction : *Harris* v. *Ogg*, 5 N. S. W. Rep. (E.) 114 ; *Bryant & May* v. *Heyde*, 7 N. S. W. Rep. (E.) 72.

(*b*) The right to the exclusive use of a trade mark, first asserted in *Gout* v. *Aleploglu*, 5 Leg. Obs. 495, and *Millington* v. *Fox*, 3 My. & Cr. 338, and

after much discussion affirmed by the chancery judges (see Ch. 6, *ante*)' is now given by statute upon registration.

(*c*) See § 70 as to the connection with goodwill.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused (*a*). The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused (*b*).

Necessity for applying for registration.

(*a*) This part of this section comes from § 1 of the Act of 1876. By § 1 of the Act of 1875, failure to obtain registration was fatal to the owner of a trade mark, whether old or new. The effect of the alteration introduced by the Act of 1876 was clearly explained by Lord Blackburn in the House of Lords in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 498, in which he said: "This alters the Act of 1875 in two respects; it renders registration a condition precedent to a proceeding to recover damages, as well as to a proceeding to prevent infringement, and it provides that if the proprietor of a trade mark in use before the passing of the principal Act has been refused registration, he may, notwithstanding such refusal, institute proceedings, either for prevention of, or damages for, the infringement of such trade mark, and need not wait till he has got the register rectified." And again he said: "It seems to me that the effect of the Act of 1876 is, that if one who says he is the proprietor of a trade mark wishes to institute proceedings against some one who, as he says, is infringing it, he must first try to have his trade mark registered. If the registration is refused for any reason, he may apply (under § 5 of the Act of 1875) to have the register rectified, and then the Court will have to determine as the principal question whether the reason of the refusal was sufficient. But he may also seek for more speedy redress. He may obtain a certificate of the refusal, and then institute proceedings to prevent the infringement, and then the Court will have to determine whether he was the proprietor of the trade mark." See, also, Malins, V.-C., in *In re Barrows*, 5 Ch. D. 353-59, and *Twentsche Stoom Bleekery Goor* v. *Ellinger & Co.*, 26 W. R. 70. The present section differs from § 1 of the Act of 1876, in that by that section the alternative of registering or procuring a certificate of refusal was given to an owner of any old mark, whether the old mark was or was not capable of being registered, so that an owner of such a mark might safely be content with a certificate of refusal, however obviously wrong the refusal might be. In the present section it will be seen that this alternative is no longer given to owners of old marks capable of being registered. Such marks must now be registered or left unprotected. New marks which are incapable of being registered under § 64 need not apparently be either registered or refused registration. If the owner of a trade mark for which registration or refusal to register is required is unable, when suing an infringer, to produce a certificate of registration or of refusal to register, his remedy is barred: *Goodfellow* v. *Prince*, 35 Ch. D. 9; even though he has made application for registration, and has only failed to obtain it because of delay in the

office: *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819. In *Jay* v. *Ladler*, 40 Ch. D. 649, a trade mark which had been registered for some only of the goods in a class was protected in respect of other goods in the same class for which it had not been registered; but it seems very questionable whether full effect was given to the provisions of § 65 and of the Act generally. In *Hart & Colley*, 44 Ch. D. 193, North, J., decided the contrary, and this decision appears more in accordance with the spirit of the Act. It has been held that where a mark has been properly registered under the Act, persons to whom it has been assigned with the goodwill are not precluded under this section from suing on it before transfer of the registration into their names: *Ihlee* v. *Henshaw*, 31 Ch. D. 323; and the same has been decided in Canada: *Carey* v. *Goss*, 11 Ont. Rep. 619.

It appears that there is nothing in this section to preclude, in the absence of registration, the granting of an injunction where the get-up of goods has been imitated: *Lever* v. *Goodwin*, 36 Ch. D. 1 (with which compare the Canadian case of *Smith* v. *Fair*, 14 Ont. Rep. 729); nor where special words have been imitated, apart from trade mark: *Sanitas Co., Ld.* v. *Condy*, 4 P. R. 530; nor where a distinctive name or mark has been imitated, under which the plaintiff's goods have become known in the market: *In re Sanitas Co., Ld.*, 58 L. T. N. S. 166; *Rodgers & Sons, Ld.* v. *Rottgen*, 5 Times L. R. 678; nor where the registered trade mark is usually placed with other matters on a label or wrapper: *Great Tower St. Tea Co.* v. *Langford & Co.*, 5 P. R. 66; *Ascough* v. *Johnson & Co.*, 3 Times L. R. 735; nor where spaces left blank in the trade mark as registered are in practice filled in: *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.); *Mclachrino & Co.* v. *Mclachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Mclachrino & Co.* v. *R. Mclachrino & Co.*, Chitty, J., May 27th, 1888.

Under the Canadian statute it has been held that registration only qualifies for suing in respect of acts done after registration, and not in respect of earlier acts: *Morse* v. *Martin*, Quebec Super. Ct., Feb. 28th, 1882. But the point was not decided either by the Quebec Court of Q. B. (3 Dorion 353) or by the Supreme Court of Canada (Cassel's Dig. 509; and in *Smith* v. *Fair*, 14 Ont. Rep. 729, it was held that the account granted in cases of infringement should not be limited to the period of registration, at all events where fraud was proved. In the last-mentioned case it was also held that a plaintiff who has failed in an action for infringement by reason of non-registration is not debarred by that fact from bringing a fresh action after he has effected registration. In California an exclusive right to the use of a name or trade mark cannot now be acquired without registration as provided by the State Code: *Whittier* v. *Dietz*, 66 Cal. 78.

By § 1 of the Act of 1875, as amended by § 1 of the Act of 1876, the disability for suing without registration was to begin from July 1st, 1877. The time thus allowed for registration was extended, in the case of marks used in respect of any goods in classes 23 to 35 ("textiles") by § 1 of the Act of 1877, and Orders in Council of Dec. 12th, 1877, and June 29th, 1878, to Dec. 31st, 1878, and in the case of marks used in respect of cotton piece goods, by further Orders in Council of Nov. 27th, 1878, and May 17th, 1879, to July 31st, 1879. Since the date last mentioned a certificate of registration or of refusal to register has been a *sine quâ non* in all cases within the Acts.

(*b*) See § 96, rule 60, and forms L. and T1. See, also, per Chitty, J., in *In re Normal Co., Ld.*, 35 Ch. D. 231.

[77 A. In an action for infringement of a registered trade mark (*a*) the Court or a judge may certify that the right to the exclusive use of the trade mark came in question; and if the Court or a judge so certifies, then in any subsequent action

Certificate as to exclusive use and costs thereon.

for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.]

This new section was introduced by § 18 of the Act of 1888.

(*a*) This new provision for the benefit of trade mark owners does not seem likely to be of much use to them, inasmuch as it only provides for a certificate being given where the right to a trade mark has come in question in an action for infringement; whereas the right to a trade mark is almost invariably contested on a motion to rectify, and the result of the action follows the result of the motion. Kay, J., has held that this provision does not apply to such a case: *B. Edgington, Ld.* v. *John Edgington & Co.*, 6 P. R. 513, and this appears to be so.

Register of Trade Marks.

Register of trade marks

78. There shall be kept at the Patent Office a book called the Register of Trade Marks (*a*), wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

(*a*) The register of trade marks was previously kept under the authority of § 1 of the Act of 1875. As to entries in the register, see §§ 87, 91, and 92, and Rules 32-34, and 46-48, *infrà*.

Removal of trade mark after fourteen years unless fee paid.

79.—(1.) At a time not being less than two months nor more than three months before the expiration of fourteen years (*a*) from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee (*b*); and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register (*c*), and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee (*d*), the comptroller may without removing

such trade mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee (*e*).

(5.) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless, for the purpose of any application (*f*) for registration during *the five years* [one year] *next* after the date of such removal, be deemed to be a trade mark which is already registered, [unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark].

(*a*) This section comes from the old Rules. The amendments were made by § 19 of the Act of 1888.

(*b*) *I.e.* £1. See First Schedule. Also Form X.

(*c*) The removal and its cause are to be recorded, under Rule 47.

(*d*) *I.e.* 10*s*. See First Schedule. Also Form Y.

(*e*) *I.e.* £1. See First Schedule. Also Form Z.

(*f*) *The effect of this is that* (under § 72) the comptroller cannot, for one year after a mark has been removed from the register, place another similar mark on the register for similar goods, except under the circumstances stated in the words added to the subsection.

Fees.

Fees for registration, &c.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade (*a*); and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

(*a*) Under § 7 of the Act of 1875, these fees were fixed by the Lord Chancellor, with the assent of the Treasury. For the list of fees now fixed by the Board of Trade, see the First Schedule to the Rules. Also Rule 3.

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield

marks) assigned or registered by the master, wardens, searchers, and assistants of that Company (*a*), the following provisions shall have effect :

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register) :

(2.) *The Cutlers' Company shall enter* (*b*) *in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act*, 1875, *belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act*, 1875 (*c*).

[(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine, in respect of metal goods, either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said registers (*d*).]

(3.) An application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*, [on metal goods] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company (*e*).

'4.) Every application so made (*f*) to the Cutlers' Company

shall be notified to the comptroller in the prescribed manner (*g*), and unless the comptroller within the prescribed time (*h*) gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner (*i*):

(5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6.) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day:

(7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark, shall apply in the case of applications and registration in the Sheffield register (k); and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this subsection shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register (l)*:

[(7.) The provisions of this Act, and of any general rules made under this Act, with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly, with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the comptroller, the Patent Office, and the Register of Trade Marks respectively; and notice of every entry, cancellation, or correction made in

the Sheffield Register shall be given to the comptroller by the Cutlers' Company: provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register.]

(8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on *cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without cutting edge,* [on metal goods] he shall in the prescribed manner (*m*) notify the application and proceedings thereon to the Cutlers' Company (*n*):

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned:

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks:

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks (*o*):

(12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal (*p*) to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court:

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register (*q*).

[(14.) For the purposes of this section, the expression "metal goods" means all metals whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield Register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.]

The amendments in this section were made by § 20 of the Act of 1888.

(*a*) As to the Cutlers' Company, the old Sheffield corporate marks, and the system which prevailed with respect to Sheffield marks under the Trade Marks Registration Act, 1875, see Appendix G., *infrà*. The specified goods now form a much wider class than formerly. The present section provides for the closing of the old Cutlers' register and the immediate establishment of a new one, which will be an exact duplicate of the general register, so far as it relates to marks used for the specified goods within the specified limits.

(*b*) Under this subsection the Cutlers' Co. are performing a mere ministerial act in registering marks which come within this subsection, whether the marks are registered on the Company's own motion or on the application of a party claiming to be the proprietor of the marks, and there is no appeal from their action under subsection (12), nor any *locus standi* for an opposition to an application to them to register a mark under this subsection, and they are directed to register marks within the subsection for all the goods mentioned in the subsection, though they may have been used for some only of those goods. And they are authorised to register, under this subsection, marks which have been assigned by the proprietor on the Sheffield register to another, but which have not been surrendered by him to the Company and reassigned by them to the assignee: *In re Lambert*, 5 P. R. 542; 6 *ib.* 344.

(*c*) By § 9 (6) of the Act of 1875, Sheffield corporate marks were allowed to be registered in the trade marks register in the same manner and upon the same terms and conditions in and upon which they might have been registered if they were not corporate marks. Under this provision it was held that where a corporate mark had been assigned by its proprietor, but had not been surrendered to the Company and reassigned by them to the assignee, he must perfect his title with the Company before he could obtain registration under the Act: *In re Rabone*, Dig. 643. There was, however, no requirement for corporate marks to be registered.

(*d*) See form of application at end of second Schedule to Rules.

(*e*) This subsection relates to new marks not within subsection (2), and it appears that applications to register such marks may be opposed by other persons in the trade: *In re Lambert*, 5 P. R. 542 (per North, J.), and that if the Cutlers' Company refuse to hear such opposition the opponent's proper remedy is by mandamus: *ib.*, 6 P. R. 344 (per Bowen, L. J.). Applications under this subsection are to be made in duplicate, accompanied by the prescribed fees and representations: Rule 56.

(*f*) This and the two next subsections relate to new marks: *In re Lambert*, 5 P. R. 542.

(*g*) By sending to the comptroller one copy of the application and two representations of the mark for each class, within seven days after receipt of the application: Rule 57.

(*h*) One month from the receipt by the comptroller of the notice from the Company: Rule 58 (1).

(*i*) The Company is to require the applicant to send the comptroller a wood block or electrotype, and the comptroller is to advertise the application as in other cases: Rule 58 (2).

(*k*) It appears that this first part of this subsection relates to new marks only: *In re Lambert*, 5 P. R. 542.

(*l*) This latter part of this subsection relates to all Sheffield marks, new or old: *In re Lambert*, 5 P. R. 542. See Rule 59, by which the proceedings at Sheffield are assimilated to those in London.

(*m*) By sending a copy of the official paper, with a note distinguishing the application: Rule 58 (3).

(*n*) In *In re Rosing*, 54 L. J. Ch. 975, the Company opposed the registration of a trade mark on the ground of similarity to a corporate mark, but, the objection failing in the Court of first instance, were ordered to pay the costs of the motion. On appeal, however, the objection taken by the Company was supported.

(*o*) Compare Rule 41.

(*p*) This subsection applies to all cases in which the Cutlers' Company have arrived at a decision, but not to cases in which the Company have performed a mere ministerial act—*e.g.* by registering an old mark under subsection (2); in which case there is no appeal: *In re Lambert*, 5 P. R. 542. For Form of Notice of Appeal, see Form W.

(*q*) These provisions are, shortly, that a counterfeiter may be fined not exceeding £20 by a justice or justices of the peace, subject to an appeal to Quarter Sessions. See Appendix G., *infra*.

PART V.

GENERAL.

Patent Office and Proceedings thereat.

Patent Office.

82.—(1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office:

(2.) Until a new Patent Office is provided, the offices of the Commissioners of Patents of inventions and for the registration of designs and trade marks existing at the commencement of this Act (*a*) shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the comptroller general of patents, designs, and trade marks (*b*), who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

(*a*) This is in Southampton Buildings, Chancery Lane, W.C.
(*b*) Under the Trade Marks Registration Acts the registrar was at the head of the Registry Office.

Officers and clerks.

83.—(1.) The Board of Trade (*a*) may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

(*a*) The authority given by this section to the Board of Trade was formerly possessed by the Lord Chancellor, under § 7 of the Act of 1875.

Seal of Patent Office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive (*a*).

(*a*) This section, so far as it relates to trade marks, comes from the old Rules. Under this section an order to rectify the register by adding to the registration of a trade mark a note stating that the user was restricted by an agreement of which the date only was given, was varied so that the terms of the agreement should appear on the face of the register: *In re Mitchell & Co.*, 28 Ch. D. 666; and in another case a similar agreement was allowed to be stated in the register so far as it restricted the goods on which a registered trade mark was to be used, but not so far as it regulated the manner of user or the way in which orders were to be executed: *In re De Otaduy*, W. N. 1885, p. 177.

Refusal to grant patent &c., in certain cases.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality (*a*).

(*a*) This is a new section, and, so far as it relates to trade marks, does not seem to carry much farther the provisions of § 6 of the Act of 1875, now re-enacted in § 73, *suprà*, prohibiting the registration of a scandalous design as a trade mark.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his

satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be (*a*). The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design, or trade mark, as the case may be, shall, subject to [the provisions of this Act and to] any rights appearing from such register to be vested in any other person, have power absolutely to assign (*b*), grant licences (*c*) as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

The amendment in this section was made by § 21 of the Act of 1888.

(*a*) As to the mode of obtaining registration as a subsequent proprietor, see Rules 36-40 and Form K. Though § 4 of the Act of 1875 is not re-enacted, it seems that a subsequent proprietor will still, as regards his title to the trade mark, be in the same position as if his title were a continuation of the title of the first registered proprietor. In *In re Bryant & May, Ld.*, 4 Times L. R. 675, a question was raised as to a title by assignment, and it was held that an agreement to assign the goodwill and trade marks was sufficient.

(*b*) A trade mark can be assigned only in connection with the goodwill of the business. See § 70, *supra*. Also *In re Wellcome*, 32 Ch. D. 213.

(*c*) The power of granting licences must not be exercised so as to deceive the public, *e.g.* so as to authorise the use of the mark on inferior goods. See ch. 7. The power of granting licences at all seems, in the case of trade marks, rather to conflict with § 70; the intention of which appears to be that only the person entitled to the goodwill shall have the right of using the trade mark.

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to [the provisions of this Act and to] such regulations as may be prescribed (*a*); and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (*b*).

The amendment in this section was made by § 22 of the Act of 1888.

(*a*) This section is taken from the old Rules. See Rule 52 for the present regulations. The fee for inspection is 1*s.* for every quarter of an hour.

(*b*) See First Schedule.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers and

other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.

90.—(1.) The Court may on the application of any person aggrieved (*a*) by the omission without sufficient cause of the name of any person [or of any other particulars] (*b*) from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making (*c*), expunging (*d*), or varying (*e*) the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit (*f*).

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller (*g*).

This section comes from § 5 of the Act of 1875, but is in rather different terms. The amendment was made by § 23 of the Act of 1888.

"Person aggrieved."

(*a*) The first question on an appli ation to rectify the register under this section is whether the applicant is or is not a "person aggrieved." This question usually has to be considered with reference to cases in which it is alleged that a mark which is on the register ought not to be there; and it has been said that in such cases "any person interested in the same trade as the registered proprietor" is a person aggrieved (*Rose* v. *Evans*, 48 L. J. Ch. 618); and that "the course of decision before the Act of 1883 was passed was that any person interested in the same trade might, without showing any special damage, be treated as a 'person aggrieved' by any improper or inaccurate registration" (*In re Hayward & Sons*, 54 L. J. Ch. 1003). That there must be some legal damage was laid down by Lord Selborne, C., in *In re Riviere*, 26 Ch. D. 48, where he pointed out that what was necessary to constitute a "person aggrieved" was that the thing complained of should be one of the grievances mentioned in the section, and that it should tend to his injury, to inflict upon him some damage, in a legal sense. Similarly, on the further hearing of the same case (59 L. T. N. S. 289), it was said by Fry, L. J., that "'any person aggrieved' means 'every person who will in reasonable probability suffer any injury or loss—using those words in a legal and not in a sentimental sense—from the other persons claiming to use it;" and per Lindley, L. J. (S. C.), that the person must be aggrieved "in the sense of sustaining legal damage, either immediate or prospective." The commonest case is where the proprietor of a registered trade mark brings an action for infringement of it, and the defendant applies to have it removed from the register, on the ground that it never ought to have been placed there. In such cases it has been repeatedly held that the person sued is entitled to apply as a "person aggrieved:" *In re Ralph*, 25 Ch. D. 194; *In re Leonard & Ellis*, 26 Ch. D. 288; *Lloyd & Sons* v. *Bottomley*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551;

Edwards v. *Dennis*, 30 Ch. D. 454; *Wood* v. *Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659; *In re Lever*, Chitty, J., Dec. 3rd, 1886; *In re Tongood*, 56 L. T. N. S. 394; *In re Ainslie*, 4 P. R. 212; *In re Perry, Davis & Son*, 58 L. T. N. S. 695. In *In re Gianaclis*, 58 L. J. Ch. 782, this was held to be so, though no relief was claimed in the action as for infringement of trade mark, seeing that the registration was set out in detail in the statement of claim, thus showing that it was intended to make some use of it. And in *Thompson* v. *Montgomery*, 41 Ch. D. 35, words registered as a trade mark were removed from the register on the application of a person who was restrained by the same judgment from using them, and Lindley, L. J., said that "it is the duty of the Court, where its attention is called to an improper entry upon the register to rectify upon an application being made." Somewhat similarly it was held in *In re Ainslie*, 4 P. R. 212, that the fact that the applicants for rectification had contracted with the proprietors of the registered words "Ben Ledi," to sell no whiskey but theirs under that name, did not prevent them from applying as persons aggrieved. In *In re Vignier*, 61 L. T. N. S. 495, the applicants were aggrieved, they having registered and used the word "Monopole" for champagne, and the respondents having registered the similar word "Monobrut." But where the alleged grievance consists in registering a mark which is not too similar to an earlier mark, there is no grievance: *In re Lambert*, 61 L. T. N. S. 133. In *In re Batt & Co.*, 6 P. R. 493, the applicants had used the word "Brymbo" on iron and steel, and the respondents had registered the words "The Brymbo Special" for the whole of class 5, having used it only for tin-plates; and although the respondents offered to limit their registration to tin-plates, it was held that the applicants, being aggrieved by the registration as it stood, and the mark being bad in itself, it must come off altogether. There is no ground for thinking that only a person who is himself entitled to registration can be a person aggrieved: *In re Riviere*, 26 Ch. D. 48, and it is not impossible for a person who only carries on a foreign trade to be aggrieved by a wrongful registration. *Ib.* If a registered proprietor becomes insolvent while proceedings to rectify his registration are pending, his representative in bankruptcy may be added as a respondent to the application for rectification: *In re Rowe*, 48 L. T. N. S. 388.

(*b*) These words, now inserted, remove the possibility of any question whether the Court is enabled under this section to direct any other entry than that of a name to be made. It has been decided that the Court has power to direct the correction of any entry which has been improperly made in the register, whether of a name or of a mark: *In re Arbenz*, 35 Ch. D. 248.

Rectification by registration.

(*c*) It seems that the Court has no jurisdiction to rectify the register under this section, unless some entry has been made in it; and it cannot rectify the register by directing a mark to be registered after it has been refused registration by the comptroller, except upon an appeal from the comptroller to the Board of Trade, referred by the Board to the Court, under § 62: *In re Normal Co., Ld.*, 35 Ch. D. 281. An application to register, which is opposed by another trader, is not an application to rectify under this section, but is governed by § 69: *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278. The jurisdiction to rectify by making an entry is, therefore, confined to small matters of detail.

Rectification by removal.

(*d*) On an application to remove a mark from the register, the question whether it was entitled to registration must be decided as at the date when registration was effected: *Wood* v. *Lambert*, 32 Ch. D. 247. The burden of proof is upon the applicant for removal, but he may prove his case by the statements in or omissions from the evidence tendered on behalf of the registered proprietor: *In re Leonard & Ellis*, 26 Ch. D. 288. Consequently if the mark is

one which was inherently capable of being used as a trade mark, and the application for removal is based on an allegation that it was not used as a trade mark, but as a descriptive term, the burden of proving that it was not used as a trade mark is on the applicant. See per Cotton, L. J., *ib.* And where a word was registered in 1878 as an old mark, and an application was made in 1889 to remove it from the register on the ground that it had not been used as a trade mark before 1875, and the original proprietor and his family were dead, and his successors in business failed to prove user of the word *per se* as a trade mark on the goods before 1875, though they proved user in various other ways before that date, Kay, J., while refusing to receive in evidence the statutory declaration made by the original proprietor on applying for registration, held that the applicants for removal after so great a lapse of time had not discharged the burden which rested on them, and that the mark could not be directed to be removed from the register: *B. Edgington, Ld.* v. *J. Edgington & Co.*, 6 P. R. 513.

Where it is sought to remove a trade mark from the register on the ground of its too great similarity to an earlier mark, it is necessary, when comparing the two marks, to take into consideration (1) the manner in which blanks left in the earlier mark as registered are filled in in practice; (2) the manner in which the parts common to the trade are arranged; (3) the opinion of the trade as to the probability of deception: *In re Christiansen*, 3 P. R. 54, in which Lopes, L. J., said, as to the second point, "In dealing with matters which are common to the trade, I think we must look at the combination of those different matters common to the trade, their collocation and arrangement, and if we find things that are common to the trade all inserted in a similar position, in a similar form, and in similar arrangements, so as to make the whole so similar as to be calculated to deceive, I think that is enough." As to the third point, see *Mitchell* v. *Henry*, 15 Ch. D. 181. It is, however, necessary, when making such a comparison, to deal with the two marks on the footing that both will be fairly used: *In re Lambert*, 61 L. T. N. S. 138, per Cotton, L. J.; and see notes to § 72.

The cases in which marks have been removed from the register are numerous, and the grounds of removal may be classified as follows:—

(i.) Name not printed in a distinctive manner (§ 64 (1) (*a*)); *In re Gianaclis*, 58 L. J. Ch. 782 ("Gianaclis Cigarettes"); *In re Hannay*, 7 P. R. 46 ("Hannay's Electroid Anti-fouling Composition").

(ii.) Device not distinctive, being in common use in the trade (§ 64 (1) (*c*)): *In re Wragg*, 29 Ch. D. 551 (Syphon, hand and glass).

(iii.) Words not distinctive or fancy words, being in common use in the trade (§ 64 (1) (*c*), § 64 (3)); *In re Hyde & Co.*, 7 Ch. D. 724 ("Bank of England" Sealing-wax); *In re Lloyd & Sons*, 27 Ch. D. 646 ("La Minerva Habana" cigars); *Great Tower St. Tea Co.* v. *Smith*, 6 P. R. 165 ("Tower Tea").

(iv.) Words not distinctive or fancy words, being descriptive (§ 64 (1) (*c*), § 64 (3)): *In re Palmer* (3), 24 Ch. D. 504 ("Braided Fixed Stars" cigar-lights); *In re Harden Star, &c., Co., Ld.*, 55 L. J. Ch. 596 ("Hand Gronado Fire Extinguisher"); *In re Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey); *In re Lever*, Chitty, J., Dec. 3rd, 1886, following *Lever* v. *Goodwin*, 36 Ch. D. 1 ("The Self Washer" soap); *In re Vaughan-Jones*, North, J., June 21st, 1884 ("Glenlivet" whiskey); *In re Towgood Bros.*, 56 L. T. N. S. 394 ("The Jubilee" note-paper); *In re Ainslie*, 4 P. R. 212 ("Ben-Ledi" whiskey); *In re Laing*, L. J. N. of C. 1887, p. 102 ("Glengowrie Blend of fine old Highland Whiskey"); *In re Arbenz*, 35 Ch. D. 248 ("Gem" air-guns); *In re Waterman*, 39 Ch. D. 29.

("Roversi" game); *In re Perry Davis & Son*, 58 L. T. N. S. 695 ("Pain-Killer" medicine); *In re Davis & Co.*, 59 L. T. N. S. 854 ("Boköl" beer); *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820 ("Horbalin" medicine); *Great Tower St. Tea Co.* v. *Smith*, 6 P. R. 165 ("Tower Tea"); *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274 ("Washerine" soap); *In re Vignier*, 61 L. T. N. S. 495 ("Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" metal goods); *In re Hannay*, 7 P. R. 46 ("Electroid" Anti-fouling Composition).

(v.) Words registered as old mark, but not used as a trade mark *per se* on the goods before 1875 (§ 64 (3)): *In re Palmer* (3), 24 Ch. D. 504 ("Braided Fixed Stars" cigar-lights); *In re Spencer*, 54 L.T.N.S. 659 ("Diamond Cast Steel"); *In re Hayward & Sons*, 54 L. J. Ch. 1003 ("Hayward's Coker Canvas"); *In re Perry Davis & Son*, 58 L. T. N. S. 695 ("Pain-Killer Medicine"); *In re Eno*, 41 Ch. D. 439 ("Fruit Salt" medicine); *Thompson* v. *Montgomery*, 41 Ch. D. 35 ("Stone Ale").

(vi.) Words registered as old mark, but used descriptively and not as a trade mark (§ 64 (3)); *In re Leonard & Ellis*, 26 Ch. D. 288 ("Valvoline" oil); *In re Harrison, McGregor & Co.*, 42 Ch. D. 691 ("Albion" tools).

(vii.) A mark registered for goods for which it was not used or intended to be used: *Edwards* v. *Dennis*, 30 Ch. D. 454 ("Neptune" brand metal goods).

(viii.) Registered proprietor carrying on no business (Rules of 1876, now repealed): *In re Ralph*, 25 Ch. D. 194 ("Homewasher" machine).

(ix.) Marks registered, though too similar to earlier marks (§§ 69, 72): *In re Barker & Son*, 53 L. T. N. S. 23 (a sporting scene in each case); *In re Christiansen*, 3 P. R. 54 (match-box labels); *In re Hayward & Sons*, 54 L. J. Ch. 1003 ("Hayward's Coker Canvas"); *In re Metcalf*, 31 Ch. D. 454 ("Milkmaid" brand and "Dairymaid" brand condensed milk); *In re Biegel*, 57 L. T. N. S. 247 (three-triangle devices for beer); *In re Vignier*, 61 L. T. N. S. 495 ("Monopole" and "Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("Brymbo" and "The Brymbo Special" metal goods).

(x.) Marks inherently deceptive (§ 73): *In re Hayward & Sons*, 54 L.J. Ch. 1003 ("Sole Makers Extra Coker" canvas); *Wood* v. *Lambert*, 32 Ch. D. 247 ("Eton" cigarettes, made in London, but used with addressee in St. Petersburg and Constantinople).

(xi.) Mark registered by servant of owner: *Ex parte Laurence Brothers*, 44 L. T. N. S. 98 (mark for printers' rollers).

In some of the above cases the marks were not absolutely expunged, but some lesser step was taken. Where a trade mark has been wrongly registered, it may be expunged *instanter*, without waiting for the trial of an action to meet which the application is made: *In re Gianaclis*, 58 L. J. Ch. 782. Five years' registration is no bar to the removal of the mark: *Edwards* v. *Dennis*, 30 Ch. D. 454. And see cases in note to § 76.

Applications for rectification were refused on various grounds in the following cases: *In re Riviere*, 53 L. T. N. S. 237; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398; *In re Chorlton & Dugdale*, 53 L. T. N. S. 337; *In re James*, 33 Ch. D. 392; *In re Talbot*, 3 P. R. 276; *In re Lambert*, 61 L. T. N. S. 138; *In re B. Edgington, Ld.*, 6 P. R. 513.

In *In re Palmer* (2), 22 Ch. D. 88, when the Court of Appeal had decided that the fact of five years' registration was not a legal bar to an application to expunge a mark, they refused to stay the hearing of the case with the evidence till after the determination by the House of Lords of an

appeal from their decision on the point of law. It seems that an appeal from a decision upon an application for the removal of a trade mark from the register will not be treated as an interlocutory appeal, but that the case must be heard by three judges: *In re Riviere & Co.*, 26 Ch. D. 48, *In re Leonard & Ellis*, *ib.* 288.

For Australian cases of removal from the register, see *In re Rowley & Pyne*, 9 V. L. R. (L.) 307, in which R. & P. had used a device of a horse and groom for twenty years, and D. and his predecessor in business had used a device of a horse alone for twelve years, and then R. & P. adopted and registered a device of a horse alone, and it was removed from the Victorian register on D.'s application; and *Harris* v. *Ogg*, 5 N. S. W. Rep. (E.) 114, in which a mark which had been registered by a person who had not used it was removed from the New South Wales register on the application of a person who had long done so.

(e) The register has been rectified by varying an entry in the following ways:— Rectification by varying.

(i.) By restricting the goods for which the mark is registered: *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Metcalf*, 31 Ch. D. 454.

(ii.) By striking some part of the mark out of it: *In re Stock*, 52 L. T. N. S. 123 (word "Strathmore" struck out of a whiskey mark); *In re Vaughan-Jones*, North, J., June 21st, 1884 (word "Glenlivet" struck out of a whiskey mark); *In re Biegel*, 57 L. T. N. S. 247 (three-triangle device struck out of a beer mark); and see *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274.

(iii.) By causing a partial disclaimer to be entered on the register, as in *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Hubbuck*, M. R., June 20th, 1879; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *Humphries & Co.* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820; *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274, and other cases. See notes to §§ 72 and 74.

(iv.) By directing an alteration in the name of the registered proprietor. It is, however, very questionable whether this can be done, and when registration has been effected in accordance with the application, but the application was wrong in some respect, it seems that the Court will amend the register by expunging the entry, but not by varying it so as to make the registration stand in another name. Thus Hall, V. C., said, in *In re Ward, Sturt & Sharp*, 50 L. J. Ch. 347, "I cannot rectify the register where no error has been committed. The term 'rectification' is only applicable to cases in which there has been some mistake or error in the registration. In other cases the applicant must follow the course laid down for cases of assignment or transmission." So in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98, the Master of the Rolls expunged the entry, and left the rightful owners of the mark to make a fresh application in their own names. So in *In re Farina* (4), 44 L. T. N. S. 99, he directed administration to be taken out to the estate of the deceased registered proprietor, and the administrator, when appointed, to assign to the rightful proprietor. In *In re Rust & Co.*, 44 L. T. N. S. 98, however, the same learned judge allowed a mark to be transferred from the name of an individual member of a firm, stated to be trading under the name of the firm, into the names of all the partners trading under the name of the firm. It appears to have been thought by Jessel, M. R., in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98, that it might not be impossible for the Court to

transfer a registration from one name into another, if the registered proprietor has registered another's trade mark in his own name when he was actually employed by the true owner to register it for him, and was so the agent and trustee for the other. In that case there was no agency, and no such order was made; but in *In re Australian Wine Co., Ld.*, 61 L. T. N. S. 427, where the sole consignee in England of the wine from certain Australian vineyards had registered the name of the vineyards as his own trade mark, but intending it to be for the benefit of the owner of the vineyards, an order transferring the mark into the name of the owner of the vineyards was made. In *In re Riviere*, 53 L. T. N. S. 237, however, the Court of Appeal seem to have been decidedly of opinion that such an order could not be made, and Cotton, L. J., said: "In my opinion, whatever might be the result of the application to strike the name of the French firm off the register, the other application ought not to be granted. Without saying that it is impossible to grant such an application as this in any case where one person is improperly on the register, and another person who is entitled to the trade mark wishes to be put on, yet, as a rule (and I do not know a case where there would be an exception), when any one applies in the first instance to be publicly registered as the proprietor of a trade mark, the requirements of the Act and Rules as to issuing advertisements and otherwise ought to be complied with. For there may be cases—and I can imagine them—where, although the person applying to strike a name off the register may be entitled to say, as against the person on the register, that he is improperly registered as owner of the trade mark, yet there may be persons, not present at the litigation, who have a right, as against the applicant, to rectify the register, and to say that such applicant is not himself entitled to be there so as to prevent such third person from using the mark. I have thought it right to express my opinion on that part of the case at once." And Lindley, L. J., added: "If the applicants had succeeded in making out a case to remove the name of Riviere & Co., I do not think they would have been entitled to have themselves registered in respect of this mark. I think Mr. Stirling's observation is conclusive—that they could not have registered anew in respect of the old mark without advertising and taking the other steps required by the Act and Rules. I say that on behalf of the public." The same view was taken independently by Kay, J., in *Ex parte Kingsford & Son*, 61 L. T. N. S. 426. The most expedient course to adopt in such cases, where the parties are friendly, is indicated by the case of *In re Wellcome*, 32 Ch. D. 213, where an agent had registered his foreign principal's mark in his own name, but for the benefit of the principal, and subsequently assigned the trade mark to the principal, and it was held that the assignment was an assignment in connection with the goodwill, within § 70, and ought to be registered. A very special order was made in *In re Avril*, Stirling J., April 20th, 1888, in which persons to whom the registered proprietor of a trade mark had assigned her business and goodwill, with the right to use the trade mark, all for a limited period of six-and-a-quarter years, at the end of which period those rights were to revert to her, procured themselves to be registered as the proprietors of the trade mark in succession to their assignor; but, on her making complaint, they applied to the Court to restore the register to its previous condition, and it was accordingly ordered that the register should be rectified by removing their

names as subsequent proprietors of the mark and re-entering the name of the original proprietor. In *In re Patent Plumbago Crucible Co.* (2), Stirling, J., March 21st, 1890, two trade marks were registered in 1879 as the property of the Patent Plumbago Crucible Co., an unregistered company. In 1882 the Company assumed the name of "The Morgan Crucible Co.," and in 1890 the marks were allowed to be transferred into the name of "The Morgan Crucible Co., formerly trading as the Patent Plumbago Crucible Co. In America a partner who registered in his own name a trade mark of the firm was ordered to assign to his partner an equal interest in it: *Taylor* v. *Bothin*, 5 Sawy. 584.

(*f*) It has been held that opposed applications for the registration of trade marks are not within this section, and that the Court has no jurisdiction to give a successful opponent his costs of the proceedings in the Registry Office: *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278; following *In re Brandreth*, 9 Ch. D. 618. As to the costs of applications to remove marks, see Chap. 7, *sub fine*. Where the comptroller is served with notice of the application, as he now must be (Rule 49), and appears, his costs are ordered to be paid by the unsuccessful party.

(*g*) See Rule 46 and Form N in the 2nd Schedule. The order is to be carried into effect by the comptroller (Rule 46), and to be made public if he thinks fit (Rule 50).

Power for comptroller to correct clerical errors.

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

(a.) Correct any clerical error (*c*) in or in connection with an application for a patent, or for registration of a design or trade mark; or

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

(c.) Cancel the entry or part of the entry of a trade mark on the register (*d*): Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark (*e*).

[(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.]

The amendment in this section was made by § 24 of the Act of 1888.

(*a*) In addition to the powers given by this section, the comptroller has authority, under Rule 48, to alter in the register the address of the proprietor of a trade mark (see Form M), and, under Rule 54, to allow amendments of documents.

(*b*) By the First Schedule the fee for altering address, or allowing correction of a clerical error, or cancelling the whole or part of an entry, or permitting amendment, is 5*s*.

(*c*) For form of request, see Form Q.

(*d*) This comes from the old Rules. For form of application for cancellation, see Form O. In *In re Lysaght*, Dig. 623, a registration for all the

goods in Class 5 was, on application by the proprietor, corrected by limitation to galvanised sheet iron only. In *Ex parte Sales, Pollard & Co.*, Dig. 620, the registered proprietors of a trade mark for snuff, consisting of the letters "S. P.," the initials of their firm, discovered that that mark had been for many years in common use in the snuff trade, though used originally by themselves, and procured the cancellation of the registration.

(*e*) See Rule 61, and for Form of Declaration see Form P.

Alteration of registered mark.

92.—(1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter (*a*) such mark in any particular, not being an essential particular (*b*) within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant (*c*); and the comptroller shall be entitled to be heard on the application.

(3.) If the Court grants leave, the comptroller shall, on proof thereof (*d*) and on payment of the prescribed fee (*e*), cause the register to be altered in conformity with the order of leave.

(*a*) This section is taken from the old Rules.

Alteration of trade marks.

(*b*) For what is an "essential particular," see § 64. *supra*. In *Ex parte Walker & Co.*, Dig. 624, a trade mark consisting of the letter "W.," a crown, and the word "Netherton" was allowed to be altered by substituting "Dudley" for "Netherton." In *Ex parte Lazenby*, V.-C. M., Feb. 26th, 1880, a trade mark was allowed to be altered by varying the address and changing the type in which it was printed. In *In re Dewhurst*, M. R., June 11th, 1880, a trade mark which had been assigned was not allowed to be altered by substituting the name of the assignee for that of the assignor, that being printed in the form of a signature, so as to constitute an essential particular; but in a similar trade mark, which had the name of the assignor printed in ordinary type, the substitution was allowed to be made. See also *In re Murphy & Co.*, W. N. 1890, p. 84. In *In re Board*, M. R., March 25th, 1881, persons who were registered as proprietors of a trade mark which contained a former name of their firm in ordinary type, were allowed to remove the name from the mark, leaving the space a blank, with permission, when using the mark, to insert in that space the name of the firm for the time being. In *In re Moeller & Schreiber*, Kay, J., March 7th, 1888, the letters "M. & S." were allowed to be substituted for the letters "D. G. F. H." In *In re Bloxwich Iron & Steel Co., Ld.*, Chitty, J., Nov. 24th, 1887, the word "Bloxwich" was allowed to be substituted for the words "Birchills Hall." In *In re British Tea and Trading Association, Ld.*, North, J., Oct. 26th, 1886, the registered trade mark consisted of three sides of a wrapper for packets of tea, of which those on the right and left consisted of arrangements of Chinese words, and that in the centre of the head of a mandarin, with the words "The British Tea Association" above it, and below it the words "Imperial Mandarin Tea, imported direct from the Imperial district in China," and leave was given to alter it by substituting for the words "imported direct from the Imperial district in China" (which had never been used by the applicants themselves, and not by their predecessors in business since 1877) the words, "This label is protected by registration as a trade mark." In *In re Ermen & Roby*, 56 L. J. Ch. 177, leave was given to alter a registered trade mark on which were words in Russian, by changing a capital E from the English into the Russian character and

inserting the word "of." In *In re Reiss Brothers*, 5 P. R. 291, the registered mark consisted of a combination mark for cotton piece goods, which comprised various words and devices, including their name and address, "Reiss Brothers, Manchester," and the words "Grass Bleach—Best Quality." "Grass Bleach" was the name of a description of bleaching which had gone out of use, and leave was given to alter the word "Grass" to "Reiss," notwithstanding that another combination mark, registered for similar goods, bore the name "Reiss & Co., Batavia," the remainder of the latter's mark being quite dissimilar from the applicant's mark. In *In re Guinness, Son & Co., Ld.*, 5 P. R. 316, the firm of Arthur Guinness, Son & Co. had registered an oval label bearing, with other words and a device of an Irish harp, the printed signature, "Arth. Guinness, Son & Co.," and the goodwill and trade marks of the firm having been subsequently assigned to a limited company called "Arthur Guinness, Son & Co., Ld.," leave was given to alter the registered trade mark by adding the word "Limited" in ordinary type beneath the signature. In *In re Ind, Coope & Co., Ld.*, Stirling, J., June 22nd, 1888, and *In re Allsopp & Sons, Ld.*, Chitty, J., July 6th, 1888, the word "Limited" was similarly allowed to be added on the trade marks after the name of the firm; and in *In re Bryant & May, Ld.*, 4 Times L. R. 675, Stirling, J., said that such leave would be given as a matter of course. In *In re Jones & Co.*, Chitty, J., July 20th, 1883, on the other hand, the word "Limited" was allowed to be expunged. The addition of non-essential matters does not deprive a mark of the benefit of the period of user before the addition: *In re Bryant & May, Ld.*, 4 Times L. R. 675.

(*c*) Notice must be given to the comptroller fourteen days before the application. See Rule 51.

(*d*) As to mode of notifying the order to the comptroller, see Rule 46 and Form N.

(*e*) *I.e.*, 10*s*. See First Schedule. Representations of the mark as altered are also to be supplied. See Rule 51.

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Exercise of discretionary power by comptroller.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent (*a*).

(*a*) See Rules 17-19 as to the exercise by the comptroller of his discretionary powers.

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers (*a*) for directions in the matter.

(*a*) The Attorney-General or Solicitor-General for England. See § 117.

Certificate of comptroller to be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ-facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone (*a*).

(*a*) This section is somewhat modified from § 8 of the Act of 1875, by which the certificate of the registrar was made evidence. Now the certificate is to be *primâ facie* evidence only.

By § 77, *suprà*, the comptroller is authorised to grant a certificate of refusal to register an old mark (see Forms L and T), and by Rule 60 he *may* give a certificate, when required so to do, for the purpose of any legal proceeding or other special purpose, and on so doing *shall* specify on the face of it the purpose for which it is granted. (See Forms R, S, and T 1.)

See Instructions *infrà*, paragraphs 35-37, in which it is stated that the comptroller's certificate in relation to a trade mark is of four kinds, viz :—

(i.) For use in legal proceedings.
(ii.) For use in applying for registration in foreign countries.
(iii.) Of any application made and of proceedings thereon.
(iv.) A certificate of refusal of a mark in use before the 13th August, 1875, and not registrable.

Applications and notices by post.

97.—(1.) Any application, notice or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post (*a*).

(*a*) See Rule 16.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office, shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none,

any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted (*a*).

(*a*) This section, so far as it relates to trade marks, comes from the old Rules.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

101.—(1.) The Board of Trade may from time to time make such general rules (*a*) and do such things as they think expedient, subject to the provisions of this Act—

(a.) For regulating the practice of registration under this Act:

(b.) For classifying goods for the purposes of designs and trade marks (*b*):

(c.) For making or requiring duplicates of specifications, amendments, drawings, and other documents:

(d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments, and other documents:

(e.) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(f.) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications

to patentees and to public authorities, bodies, and institutions at home and abroad:

(g.) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid (*c*).

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

(*a*) The power of making rules was formerly, by § 7 of the Act of 1875, vested in the Lord Chancellor. For the rules which have been made by the Board of Trade, *see infrà*.

(*b*) See classification in Third Schedule to Rules.

(*c*) See Forms in Second Schedule to Rules. A new Form F is thereby substituted for Form F appended to the Act.

Annual reports of comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries and allowances, and other money received and paid under this Act.

Proceedings of Board of Trade.

[102 A.—(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or

to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.]

This section was introduced by § 25 of the Act of 1888.

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks.

103.—(1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants (*a*); and such patent or registration shall have the same date as the *date of the protection obtained* [date of the application] in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months (*b*), from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly

applied for in the country of origin may be registered under this Act (*c*):

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state (*d*).

(*a*) This section is new. The amendment in it was made by § 6 of the Act of 1885. In the case of trade marks used by aliens, the existence of a convention between the state to which the alien belongs and the British Government is not a necessary condition precedent to his registration here. The Act does not say that to obtain priority the application for registration in a foreign state with which there is a convention must have been made by a subject of that state. That is apparently the intention of the section; but there is nothing to say that the same priority is to be refused to a subject of a different state, with which there may possibly be no convention, or even to a British subject, who has applied in a country with which there is a convention. On the other hand, in the proviso in subs. (3) the term "country of origin" is employed. Again, in subs. (3) the words are "has been *duly* applied for," whereas in subs. (1) there is nothing about "duly," and for all that appears the application may be one which could not possibly succeed in the foreign country. The object of this section is to enable effect to be given to the International Convention of 1883. See Appendix C. The exceptional rights of foreigners in respect of the registration of trade marks in the United Kingdom depend exclusively upon the terms of this Act, and the Court cannot have reference to the terms of the International Convention, 1883: *In re Californian Fig Syrup Co.*, 40 Ch. D. 620. Similarly, in the United States, the Courts cannot give effect to the convention without legislation. See opinion of the Attorney-General of the United States in 47 U. S. Pat. Gaz. 397.

(*b*) The application within four months is imperative, and if application is made after that time all special rights under this section are gone. And this is so though the foreign registration was effected before this section was made applicable to the particular foreign country: *In re Californian Fig Syrup Co.*, 40 Ch. D. 620. If a subject or citizen of a foreign state which is a party to the convention has registered in England a mark which is of doubtful validity according to English law, and is desirous of obtaining for it the benefits of this section (particularly subs. (3)), it seems that his proper course is to obtain its removal from the English register, and then to make an application for protection in his own country. Upon this being done, he will be in a position to apply again (within the four months) for registration in England under this section: see, per Kay, J., in *In re Vignier*, 61 L. T. N. S. 495.

(*c*) This subsection appears to qualify for registration in England any trade mark duly applied for in a country which has acceded to the convention, if the prescribed conditions are complied with, even though it is not within § 64: *In re Californian Fig Syrup Co.*, 40 Ch. D. 620. The proviso in this subsection gives no independent right of registration, but must be r ad with subs. (1), which requires application within four months: *Ib.*

(*d*) For list of Orders in Council, see Appendix C.

Provision for Colonies and India.

104.—(1.) Where it is made to appear to Her Majesty that the legislature of any British possession (*a*) has made satisfactory

provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession (*b*).

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

(*a*) See the definition of "British possession" in § 117, *infrà*.
(*b*) For list of Orders in Council, see Appendix C.

Offences.

Penalty on falsely representing articles to be patented.

105.—(1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same (*a*), or describes any design or trade mark (*b*) applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction (*c*) to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article (*d*).

(*a*) This section, so far as it relates to an untrue representation as to the existence of a patent, is in substance a re-enactment of § 7 of 5 & 6 Will. IV. c. 83. In that case, however, the penalty of £50 was imposed, recoverable in an action, and a fraudulent intention was of the essence of the offence. See *Myers* v. *Baker*, 3 H. & N. 802. This section appears to follow that in not imposing a penalty where there has been a patent, though it may have expired. Under the U. S. Revised Statutes a penalty is imposed for a misrepresentation as to the existence of a patent, but there is no offence if there has been a patent and the date of the patent is given. See *Wilson* v. *Singer Manufacturing Co.*, 16 U. S. Pat. Gaz. 1091. But it is an offence to represent that an article is patented, after application has been made for a patent and provisional protection has been obtained, but before the actual grant: *R.* v. *Wallis*, 3 P. R. 1; *R.* v. *Crampton*, 3 P. R. 367.

See § 3 (1) (e) of the Merchandise Marks Act, 1887.

(*b*) Hitherto no penalty has been recoverable for untruly representing that a trade mark is registered. An offence is committed if a trade mark is represented to be registered before it actually is so, even though application for registration has been made and advertised: *R.* v. *Morris*, Great Marlborough Street Police Court, Dec. 16th, 1886.

(*c*) As to "summary conviction" in Ireland, see § 117.

(*d*) See Ch. 7, *ante*.

Penalty on unauthorised assumption of Royal Arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal Arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid (*a*), shall be liable on summary conviction (*b*) to a fine not exceeding twenty pounds (*c*).

(*a*) This section is new. For an offence against it to be committed it is not sufficient to prove that a person is using the Royal Arms without authority, or that what he is doing is calculated to lead to the belief that the user of the arms is authorised; but it must be proved that that user is calculated to lead to the belief that the trader is *carrying on his business* by Royal or Governmental authority.

(*b*) As to "summary conviction" in Ireland, see § 117.

(*c*) The following notice has been published in the *London Gazette*:—

"FRIDAY, FEB. 22ND, 1884.

"BOARD OF GREEN CLOTH, BUCKINGHAM PALACE, FEB. 19TH.

"Notice is hereby given that by section 106 of the Patents, Designs, and Trade Marks Act, 1883 (46 & 47 Victoria, cap. 57), a penalty of £20 is incurred by any persons who, without proper authority, assume the Royal Arms with a view to lead other persons to believe that they are employed under any department of Her Majesty's Household.

"SYDNEY, Lord Steward."

It will be observed that the above notice treats fraudulent intention as of the essence of the offence; but this does not appear to be in accordance with the provisions of the section.

See § 20 of Merchandise Marks Act, 1887, as to false representations with reference to holding a Royal warrant.

Scotland, Ireland, &c.

Saving for courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

For the purposes of this section "Court of Appeal" shall mean any court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109.—(1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having

interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110.—All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

General saving for jurisdiction of courts.

111.—(1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts;

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Jurisdiction of Lancashire Palatine Court

[112 A.—The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied

for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster, in pursuance of this section, shall be subject to the like appeal as decisions of that Court in other cases.]

This section was introduced by § 26 of the Act of 1888.

Repeal; Transitional Provisions; Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending (*a*), or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

(*a*) Applications under the Act of 1875 had to be decided under that Act: *In re Hudson*, 32 Ch. D. 311. But § 63 applied to applications pending at the date of the passing of this Act, and not completed within twelve months by the applicants' default: *In re Hayward & Co.*, 54 L. J. Ch. 1003.

Former registers to be deemed continued.

114.—(1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2.) The registers of designs and of trade marks (*a*) kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

(*a*) The register of trade marks was previously to this Act kept under the authority of the Trade Marks Registration Act, 1875 (38 & 39 Vict. c. 91, by § 1 of which it was established), and the amending Acts (39 & 40

Vict. c. 33, and 40 & 41 Vict. c. 37). Those Acts placed the register under the superintendence of the then Commissioners of Patents, now abolished. See *In re Meikle*, 24 W. R. 1067; *In re Burrows*, 5 Ch. D. 353-61; *In re Rotherham*, 11 Ch. D. 250; 14 *ib.* 585.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act (*a*).

(*a*) Rule 63 repeals all the old Rules.

Saving for prerogative.

116. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England (*a*):

"Law Officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks:

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man; and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

(a) See § 112 A, *supra*.

SCHEDULES.

THE FIRST SCHEDULE.

Forms of Application, &c. (a).

(a) The only Form relating to trade marks is Form F., for which an amended Form F. is substituted by the Trade Marks Rules, *q.v. infra*.

THE SECOND SCHEDULE.

Fees on Instruments for obtaining Patents and Renewal.

THE THIRD SCHEDULE.

Enactments Repealed.

* * * * * *

38 & 39 Vict. c. 91.	[1875].—The Trade Marks Registration Act, 1875.
39 & 40 Vict. c. 33.	[1876].—The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37.	[1877].—The Trade Marks Registration Extension Act, 1877.

THE PATENTS, DESIGNS, AND TRADE MARKS (AMENDMENT) ACT, 1885.

48 & 49 VICT. c. 63.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[14*th August*, 1885.]

Construction and short title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the Principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

2-5. [These sections relate exclusively to Patents].

Amendment of § 103 of 46 & 47 Vict. c. 57.

6. In subs. 1 of § 103 of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

THE PATENTS ACT, 1886.

49 & 50 VICT. c. 37.

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, *so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.*

[25*th June*, 1886.]

WHEREAS (preamble).

Be it therefore enacted * * * * as follows:

Short title and construction.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

[This Act relates exclusively to Patents and Designs.]

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

51 & 52 Vict. c. 50.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[24*th December*, 1888.]

46 & 47 Vict. c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act:

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. [This section establishes a register of patent agents.]

2-5. [These sections relate to Patents].

6, 7. [These sections relate to Designs].

Amendments of 46 & 47 Vict. c. 57, § 62, as to application for registration.

8.—(1.) In subs. 2 of § 62 of the principal Act for the words "the patent office in the prescribed manner" shall be substituted the words "such place and in such manner as may be prescribed."

(2.) To the same section of the principal Act the following subsection shall be added:

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

§ 63, as to limit of time for proceeding with application.

9. In § 63 of the principal Act for the words "the application shall be deemed to be abandoned" shall be substituted the words "the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant; and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and, if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned."

§ 64, as to fancy words.

10.—(1.) For § 64 of the principal Act the following section shall be substituted, namely:

"64.—(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

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

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

(c.) A distinctive device, mark, brand, heading, label, or ticket; or

(d.) An invented word or invented words; or

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

"(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them; but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"(3.) Provided as follows:

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act."

§ 67, as to colours of trade marks.

11. In § 67 of the principal Act the words "or colours" shall be added after the word "colour" in each place where that word occurs.

§ 68, as to advertisement of applications.

12. In § 68 of the principal Act after the word "comptroller" shall be added the words "unless the comptroller refuse to entertain the application."

§ 69, as to opposition to registration.

13.—(1.) In subs. 1 of § 69 of the principal Act for the words "two months" shall be substituted the words "one month or such further time, not exceeding three months, as the comptroller may allow."

(2.) In the same subsection the word "first" shall be omitted.

(3.) In subs. 2 of the same section for the words "two months" shall be substituted the words "one month."

(4.) For subs. 3 and 4 of the same section the following subsections shall be substituted, namely:

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

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

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

"(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom."

§ 72, as to restrictions on registration.

14. In subs. 2 of § 72 of the principal Act the following words shall be added at the beginning of the subsection, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

§ 73, as to restriction on registration.

15. In § 73 of the principal Act the word "exclusive" shall be omitted.

§ 74, as to additions to trade marks.

16. For subs. 2 of § 74 of the principal Act the following subsection shall be substituted, namely:

"(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"Provided that a person need not under this section

disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof."

§ 75, as to effect of registration.

17. For § 75 of the principal Act the following section shall be substituted, namely:

"Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been the date of the registration."

Certificate as to exclusive use and costs thereon.

18. After § 77 of the principal Act the following section shall be added and numbered 77A, namely:

"In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

§ 79, as to removal of trade mark from the register.

19.—(1.) In subs. 5 of § 79 of the principal Act for the words "five years" shall be substituted the words "one year."

(2.) To the same subsection the following words shall be added; namely, "unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

§ 81, as to Sheffield marks.

20.—(1.) For subs. 2 of § 81 of the principal Act the following subsection shall be substituted:

"(2.) The Cutlers' Company shall enter in the Sheffield Register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying

38 & 39 Vict. c. 91.

on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield Register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

(2.) In subs. 3 and 8 of the same section for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For subs. 7 of the same section the following subsection shall be substituted:

"(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register."

(4.) To the same section the following subsections shall be added, namely:

"(14.) For the purposes of this section the expression 'metal goods' means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield Register a certificate under the hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the comptroller."

21. In § 87 of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to." § 87, as to entry of assignments, &c.

22. In § 88 of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to." § 88, as to inspection.

23. In § 90 of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars." § 90, as to rectification register.

24. To § 91 of the principal Act the following subsection shall be added, namely: § 91, as to correction of errors.

"(*d.*) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered."

25. After § 102 of the principal Act the following section shall be added and numbered 102A, namely: Proceedings of Board of Trade.

"(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified."

26. After § 112 of the principal Act the following section shall be added and numbered 112A, namely: Jurisdiction of Lancashire Palatine Court.

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression 'the court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in

pursuance of this section shall be subject to the like appeal as decisions of that court in other cases."

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act (*a*).

(*a*) In *In re Burgoyne*, 61 L. T. N. S. 39, Chitty, J., said that when an application was made before the commencement of this Act a right had been acquired to have the mark registered under the Act of 1883, subject to opposition and the like. But in *In re Baschiera*, 33 Sol. J. 469, the same learned judge said that the point must still be considered open.

Commencement of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

TRADE MARKS RULES, 1890.*

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

Preliminary.

1. These Rules may be cited as the Trade Marks Rules, 1890, and shall come into operation from and immediately after the 31st day of December, 1889.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Acts (*a*) shall have the meanings thereby assigned to them respectively. Interpretation.

(*a*) See § 117.

Fees.

3. The fees to be paid in pursuance of the said Acts, so far as they relate to trade marks, shall be the fees specified in the first schedule hereto (*a*). Fees.

(*a*) See § 80. The fees are to be paid by stamps. See Instructions, par. 2, *infrà*.

Forms.

4. The Form F in the first schedule to the Patents, Designs, and Trade Marks Act, 1883, shall be altered or amended by the substitution therefor of the Form F in the second schedule to these Rules (*a*). Forms

(*a*) For this Schedule see Appendix B *infrà*. See Instructions, par. 8, *infra*, for list of stamped forms.

* Under the Trade Marks Registration Acts three successive sets of Rules were made, one in 1875, one in 1876 (which was considerably altered from time to time), and the last in March 1883. All these were repealed by the Rules of Dec. 1883, made under the Act of that year, to which later additions were made from time to time, especially in 1889. All these are now repealed (see Rule 63, *infrà*). The repealed Rules as to cotton marks are printed in Appendix D, in order to enable the position of such marks to be understood.

5. (1) An application for registration of a trade mark shall be made in the Form F in the second schedule to these Rules; (2) the remaining forms in such schedule may be used in all cases to which they are applicable.

CLASSIFICATION OF GOODS.

Classification of goods.

6. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the third schedule hereto.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the comptroller (*a*).

(*a*) See § 65. A guide to the classification can be obtained on application at the office. See Instructions, par. 19, *infrà*.

APPLICATION FOR REGISTRATION.

Application by firm.

7. An application (*a*) for registration of a trade mark, if made by any firm or partnership, may be signed (*b*) by some one or more members of such firm or partnership, as the case may be.

If the application be made by a body corporate it may be signed (*c*) by the secretary or other principal officer of such body corporate.

(*a*) See § 62. For mode of making application, see also Instructions, para. 8-19, *infrà*. A separate form is required for each class—par. 10. As to disclaimer of common or open marks, see § 74, and Instructions, par. 18.

(*b*) A member signing an application should add after his signature, "A member of the firm." See Instructions, par. 11.

(*c*) The officer signing should add after his signature and designation, "For the Company." See Instructions, par. 11.

Address of application.

8. Where a trade mark for registration of which application is made is in classes 23, 24 or 25 of the third schedule to these Rules, the applicant shall address and send his application to the Manchester Trade Marks Branch, 48, Royal Exchange, Manchester (*a*). Other applications (except applications which under § 81 of the said Acts should be made to the Cutlers' Company (*b*), shall be addressed and sent to the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

(*a*) See Instructions, par. 34.

(*b*) See Rules 56-59, and Instructions, par. 33.

Agency.

9. An application for registration and all other communications between the applicant and the comptroller may be

made by or through an agent duly authorised to the satisfaction of the comptroller (*a*).

(*a*) An agent signing should add after his signature the word "Agent." See Instructions, par. 12.

10. On receipt of the application the comptroller shall furnish the applicant with an acknowledgment thereof. Acknowledgment of application.

11. Where application is made to register a trade mark which was used (*a*) by the applicant or his predecessors in business before the 13th of August, 1875 (*b*), the application shall contain a statement (*c*) of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application. Contents of form of application.

(*a*) *I.e.*, in respect of the same goods for which the application is being made. Registration must be applied for as for a new mark when the mark has been used on different goods. See *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*b*) This is the date of the passing of the Act of 1875, and at this point the line is drawn between old and new marks, various indulgences being allowed to the former and not to the latter. See notes to §§ 64 and 72.

(*c*) Prior to 1883 a statutory declaration was required, since then a mere statement has been sufficient.

12. Subject to any other directions that may be given by the comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the comptroller or to the Cutlers' Company (*a*), shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half. Size, &c., of documents.

(*a*) See § 81; also Rules 56-59, and Instructions, par. 33.

13. Subject to any other directions that may be given by the comptroller, three representations (*a*) of each trade mark, except in the case of marks applied for in classes 23 to 35 inclusive (*b*), must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap (*c*). Representations of trade mark.

In the case of marks applied for in classes 23 to 35 inclusive, the applicant shall supply four representations (*d*) of each mark for each class.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the comptroller may think most convenient.

The comptroller may, if dissatisfied with the representation of a trade mark, require a fresh representation, either before he proceeds with the application or before he registers the trade mark.

The comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit (*e*).

(*a*) See § 62 (3), and Instructions, pars. 15, 16.
(*b*) These are the textile classes.
(*c*) See Instructions, par. 16.
(*d*) One of them will be exhibited at the Manchester Office.
(*e*) As to deposit, see note to § 67. All cotton marks are deposited, but other marks have been deposited in exceptional cases only. See *In re Robinson*, 29 W. R., 31; *Mitchell* v. *Henry*, 15 Ch. D. 181; *In re Jones Bros. & Co.*, V.-C. H., July 10th, 1880.

Representations of a series of trade marks.

14. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in § 66 of the said Acts, a representation of each trade mark of the series shall be made or affixed upon the form of application and also upon each of the separate half-sheets of paper aforesaid (*a*).

(*a*) See Instructions, par. 17.

Translation of foreign characters.

15. Wherever a mark consists of or includes words printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent (*a*).

(*a*) See Instructions, par. 14, and *In re Rotherham*, 11 Ch. D. 250; 14 *ib.* 585.

Mode of sending notices, &c.

16. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post (*a*).

In proving such service or sending, it shall be sufficient to

prove that the letter was properly addressed and put into the post.

(a) See § 97, and Instructions, pars. 1, 8, and 33. Communications relating to different applications should be made in separate letters. See Instructions, par. 8.

Exercise of Discretionary Powers.

Hearing by comptroller.

17. Before exercising any discretionary power (a) given to the comptroller by the said Acts adversely to the applicant for registration of a trade mark, the comptroller shall (if so required by the applicant within one month from the date of the comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

(a) See § 94.

Notice of wish to be heard before comptroller.

18. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the comptroller whether or not he intends to be heard upon the matter.

Notification of decision.

19. The decision of the comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Appeal to the Board of Trade.

Notice of appeal.

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

(a) See §§ 62 and 69.

Grounds of appeal to be stated.

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

(a See Forms H (p. 469, *infrà*) and 4 (p. 499, *infrà*).

Transmission of notice.

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

Directions by Board.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

Hearing of appeal.

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

No appeal unless notice duly given.

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

Evidence on appeal.

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

ADVERTISEMENT OF APPLICATION.

Advertisement of application.

27. Every application shall be advertised (*a*) by the comptroller in the official paper, during such times, and in such manner as the comptroller may direct, unless he refuse to entertain the application.

If no representation of the trade mark be inserted in the official paper in connection with the advertisement of an application, the comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition (*b*).

(*a*) As to advertisement, see § 68, and Instructions, pars. 20-27. "The object of the advertisement is to give to persons who might be claimants of the trade mark proposed to be registered the opportunity of coming forward and objecting," said Hall, V.-C., in *In re Meikle*, 24 W. R. 1067, and advertisement is therefore indispensable, *ib.* It is not, however, incumbent on persons to see the advertisement, and if a common mark has been registered, after advertisement, and without opposition, it may be removed from the register on application by persons aggrieved: *In re Hyde & Co.*, 7 Ch. D. 724; and marks improperly registered may be removed from the register even after they have been there for five years: *In re Palmer* (3), 24 Ch. D. 504; *In re Leonard & Ellis*, 26 Ch. D. 288, and other cases. See Notes to § 90.

(*b*) See Rule 13, *supra*.

Definition of official paper.

28. The official paper (*a*) for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

(*a*) The official paper is "The Trade Marks Journal" published at short intervals. It contains illustrations of all the trade marks for which application is made, or a reference to the places where they may be seen, as well as the

name, address, and calling of each applicant, the description of the goods, and the length of user as an old mark, if any, thus affording all persons interested in the use of trade marks authentic information as to the nature of the marks applied for in their respective trades. The journal may be obtained from the Patent Office, Sale Branch, 38, Cursitor Street, Chancery Lane. Copies of the journal are open to inspection at the Patent Office Library, Southampton Buildings, Chancery Lane. Upwards of 600 numbers of the journal have now been published. As to prices, see Instructions, par. 5.

Means of advertising trade mark to be supplied to official paper.

29. For the purposes of such advertisements the applicant may be required to furnish a wood-block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the comptroller, or with such other information or means of advertising the trade mark as may be required by the comptroller; and the comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement (*a*).

(*a*) See Instructions, pars. 20-27.

Advertisement of series.

30. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in § 66 of the said Acts, the applicant may be required to furnish a wood-block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series (*a*); and the comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

(*a*) See Instructions, par. 22.

Opposition to Registration.

Notice of opposition.

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

(*a*) As to oppositions, see § 69 and Instructions, par. 32. The notice of opposition may be amended under rule 54, even after the counter statement has been put in: *R.* v. *Comptroller*, Q. B. D., May 3rd, 1890. Under the old Acts and Rules the practice was to require the opponent to take proceedings for the purpose of bringing the matter before the Court. The opponent thereupon took out a summons for directions as to the course to be followed, upon which it was usual for the applicant to be directed to apply for registration by way of motion or summons. In *In re Salamon*, Dig. 569, Jessel, M. R., said that the best mode of trying the case was by special case, when it was a simple question of law; by summons, when it was a question as to directions for carrying out the Act; by motion,

when it was a question as to disputed facts. In *In re Simpson, Davies & Sons*, 15 Ch. D. 525, he said he usually directed a summons, but had in one or two cases directed a motion. In *Ex parte King of Saxony*, Dig. 598, Hall, V.-C., directed a motion. Latterly a summons was almost invariably directed. See also *In re Johnston*, 43 L. T. N. S. 672, as to the course of procedure where there was an action pending. Under the old Rules, and while the first step had to be taken by the opponent, who had to give notice thereof to the office, two cases occurred in which trade marks were registered, though the registration was opposed, in consequence of no notice having been given to the office by the opponents of their having brought the matter before the Court. In one of these cases, *In re The Patent Nut and Bolt Screw Co.*, Chitty, J., March 9th, 1883, with a view to remedying the slip, a consent order was taken to rescind the registration, without prejudice to the applicant's summons for leave to register, the object being to restore matters to their *status quo ante* the registration. The opposition was subsequently withdrawn, but the registrar now objected to register, on the ground that the application had been finally disposed of, and that a new application was necessary. It was, however, held that the proper course was to discharge the former order for the removal of the mark from the register, and to direct the registrar to restore the register to its condition previous to such removal. In the other case, *In re Esbensen*, Pearson, J., Jan. 25th, 1883, the opponent moved to cancel the registration, with a view to the prosecution of the opposition as if there had been no registration; but it was held that the proper course was for the opponent to move to rectify the register in the ordinary way. See also *In re Paton*, Dig. 601. Under the Act of 1883 a summons for leave to register was taken out by the applicant, but the case will now only go to the Court on a reference from the Board of Trade.

Opposition on the ground of trade mark already on the register.

(2.) Where the ground, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the register of such trade mark already on the register.

Opponent's evidence.

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

(*a*) *I.c.*, within two months after the time allowed, under § 69 (1) of the Act of 1883, as amended by § 13 (1) of the Act of 1888, for putting in the notice of opposition.

Applicant's evidence.

(4.) * Within one month from the delivery of the opponent's copies of his statutory declarations the applicant shall leave at

* The counter-statement required by the Acts must also be delivered by the applicant within one month from the date of the receipt of the opponent's notice of opposition.

the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof, and within seven days from such delivery the opponent shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply.

Evidence in reply.

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

Closing of evidence.

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

Applications for leave to adduce further evidence.

(7.) On the completion of the evidence the comptroller shall, upon application by either party, upon Form E in the second schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Appointment of time for hearing.

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

Disallowance of opposition in certain cases.

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

Decision to be notified to parties.

Register of Trade Marks.

32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee (*a*), enter the name, address, and description of the applicant in the Register of Trade Marks as the registered proprietor of the trade mark in respect of the particular goods or classes of goods described in his application.

Time of registration of trade marks.

(*a*) See Form I and Schedule 1.

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

33. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the comptroller.

Entries to be made in register.

34. Upon registering any trade mark the comptrollor shall enter in the register the date on which the application for registration was received by the comptroller, and such other particulars (*a*) as he may think necessary.

(*a*) As to entering "other particulars," see *In re Keep Bros.*, 26 Ch. D. 187, and *In re De Oladuy*, L. J. N. of C. 1885, p. 155.

Notice of registration.

35. The comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper.

Request by subsequent proprietor.

36. Where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, a request for the entry of his name in the register as proprietor of the trade mark shall be addressed to the comptroller, and left at the Patent Office, Trade Marks Branch (*a*).

(*a*) See Form K and Instructions, par. 33.

Signature of request.

37. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively duly authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner (*a*).

(*a*) See Rules 7, 9, *suprà*.

Contents of request.

38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted, in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered (*a*).

(*a*) See § 70 and cases in note (*e*) to § 90.

39. Every such request shall be accompanied by a statutory declaration (*a*) to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request. Declaration to accompany request.

(*a*) See Form K.

40. The claimant shall furnish to the comptroller such other proof of title and of the existence and ownership of such good-will as aforesaid as he may require for his satisfaction. Further proof of title if required.

41. A body corporate may be registered as proprietor by its corporate name. Body corporate.

42. The term "applicant" in Rules 17, 18 and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark (*a*). Definition of applicant.

(*a*) See § 71.

43. Whether all such persons so claiming require to be heard before the comptroller or not, he may, before exercising the discretion vested in him by § 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the comptroller may require. Comptroller may require statement from rival claimants.

44. Where each of several persons claims to be registered as proprietor of the same trade mark, and the comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the comptroller, or if the comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case (*a*); 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. Submission to Court of conflicting claims.

(*a*) See note to § 71.

45. Where the special case is to be submitted by the parties it may be agreed to by them, or if they differ, may be settled by the comptroller on payment of the prescribed fees (*a*). Settlement of special case.

(*a*) See Form T.

46. Where an order has been made by the Court in either of the following cases, viz.: Order of Court.

(a.) allowing an appeal under § 62 of the said Acts;

(b.) disallowing an opposition to registration under § 69; or,

(c.) under the provisions of §§ 72, 90, or 92 of the said Acts, the person in whose favour such order has been made, or such one of them, if more than one, as the comptroller may direct, shall forthwith leave at the Patent Office, Trade Marks Branch, an office copy of such order (*a*). The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

(*a*) See Form N.

Removal of mark from register.

47. Where a trade mark has been removed from the register for non-payment of the prescribed fee or otherwise, under the provisions of § 79 of the said Acts, the comptroller shall cause to be entered in the register a record of such removal and the cause thereof.

Alteration of address in register.

48. If the registered proprietor of a trade mark send to the comptroller, together with the prescribed fee, notice of an alteration in his address, the comptroller shall alter the register accordingly (*a*).

(*a*) See Form M.

Notice to comptroller of applications to rectify register.

49. Four clear days' notice of every application to the Court under § 90 of the said Acts, for rectification of the register, shall be given to the comptroller (*a*).

(*a*) This is a new rule. Hitherto no such notice has been necessary.

Publication of rectification or variation of register.

50. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the register, the comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register.

Notice to comptroller of order of Court for alteration of trade mark under § 92 of Acts.

51. Whenever the registered proprietor of any trade mark intends to apply for the leave of the Court to add to or to alter such trade mark, under § 92 of the said Acts, the notice to be given to the comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the comptroller such a number of representations of the trade mark as altered as he may deem sufficient.

Inspection of Register.

Hours of inspection.

52. The Register of Trade Marks shall be open to the inspection of the public (*a*), on payment of the prescribed fee, on every weekday, between the hours of ten and four, except on the days and at the times following :

(a.) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

(b.) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(c.) Times when the register is required for any purpose of official use.

(c) See § 88.

Power to Dispense with Evidence.

Dispensing with evidence.

53. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the Patent Office, and it is shown to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Amendments.

Amendment of documents.

54. Any document or drawing or other representation of a trade mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which in the opinion of the comptroller may be obviated without detriment to the interests of any person may be corrected, if the comptroller think fit, and on such terms as he may direct (*a*).

(*a*) Under this rule leave may be given to amend a notice of opposition, even after the counter statement has been put in: *R.* v. *Comptroller*, Q. B. D. May 3rd, 1890. As to the comptroller's power to correct clerical errors, see 91. See also Form Q.

Enlargement of Time.

Comptroller may enlarge time.

55. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the comptroller (*a*), if he think fit, and upon such notice to other parties and proceedings thereon, and upon such terms as he may direct.

(*a*) See, however, the limitations imposed by § 69 (1), *supra*.

CUTLERS' COMPANY.

Sheffield applications in duplicate.

56. All applications to the Cutlers' Company (*a*) for registration of a trade mark, under § 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

(*a*) See § 81, and Instructions, par. 33, also Form W.

Notice to comptroller.

57. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Time within which comptroller may object to application made at Sheffield.

58.—(1.) The time within which the comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said company shall be one month from the date of the receipt by the comptroller of the notice from the said company of the making of the application.

Advertisement of application made at Sheffield.

(2.) If no such objection is made by the comptroller, the Cutlers' Company shall require the applicant to send the comptroller a wood-block or electrotype as the comptroller may direct, and the comptroller shall, if satisfied with such wood-block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

Manner of notifying to Cutlers' Company application received by Comptroller.

(3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in subs. 8 of § 81 of the said Acts shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

Similarity of proceedings at London and at Sheffield.

59. The provisions of these Rules as to forms, representations, the proceedings in opposition to registration, registration, and all subsequent proceedings, shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

CERTIFICATES.

Certificate by comptroller.

60. The comptroller, when required to give a certificate as to an entry, matter, or thing which he is authorised by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, but every certificate of registration shall have specified on the face thereof, whether the same is to be used in legal proceedings, or for the purpose of obtaining

registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country (*a*).

(*a*) See § 96, and Instructions, para. 35-37.

DECLARATIONS.

Manner in which, and persons before whom, declaration is to be taken.

61. The statutory declarations (*a*) required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:

(a.) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(b.) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(c.) If made out of Her Majesty's dominions, before a British minister, or person exercising the functions of a British minister or a consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a judge or magistrate.

(*a*) As to declarations by infants and other persons under disability, see § 99.

Notice of seal of officer taking declaration to prove itself.

62. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

REPEAL.

Previous rules repealed.

63. All general rules as to the registration of trade marks heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of December, 1889, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application pending at the said date.

M. E. HICKS-BEACH,
President of the Board of Trade.

SCHEDULES.

FIRST SCHEDULE.

FEES.

	£	s.	d.
1. On application to register a trade mark for one or more articles included in one class . .	0	5	0
2. For registration of a trade mark for one or more articles included in one class . . .	1	0	0
3. For registering a series of trade marks, for every additional representation after the first in each class	0	5	0
4. On appeal from comptroller to Board of Trade— By appellant	1	0	0
5. On notice of opposition for each application opposed.—By opponent	1	0	0
6. On hearing by comptroller.—By applicant and by opponent respectively	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
8. For every additional mark assigned or transmitted at the same time	0	2	0
9. For continuance of mark at expiration of fourteen years	1	0	0
10. Additional fee where fee is paid within three months after expiration of fourteen years .	0	10	0
11. Additional fee for restoration of trade mark where removed for non-payment of fee. .	1	0	0
12. For altering address on the register, for every mark	0	5	0
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
14. For cancelling the entry or part of the entry of a trade mark upon the register, on the application of the owner of such trade mark .	0	5	0
15. On request to comptroller to correct a clerical error, or permit amendment of application under § 91	0	5	0

FEES—*continued.*

	£	s.	d.
16. For certificate of refusal to register a trade mark under § 77	1	0	0
17. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first	0	10	0
18. For certificate of registration to be used in legal proceedings	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
20. For certificate of comptroller under § 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country .	0	5	0
21. For copy of notification of registration . .	0	2	0
22. Settling a special case by comptroller . .	2	0	0
23. For inspecting register, for every quarter of an hour	0	1	0
24. For making a search amongst the classified representations of trade marks, for every quarter of an hour	0	1	0
25. For office copy of documents, for every 100 words (but never less than one shilling).	0	0	4
26. For certifying office copies, MS. or printed .	0	1	0
27. In cases where the wood-block or electrotype of the trade mark exceeds two inches in breadth or depth, or in breadth and depth—For every inch or part of an inch over two inches in breadth	0	2	0
For every inch or part of an inch over two inches in depth	0	2	0
28. Manchester Trade Marks Office .	Same as above		
29. Sheffield Marks	Same as above		
30. On appeal from Cutlers' Company, Sheffield, to comptroller	1	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

Approved,
FRANK MOWATT,
Assistant Secretary
for the Lords Commissioners of
Her Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

(See Appendix B, infrà.)

THIRD SCHEDULE.

General Note.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the comptroller may desire.

CLASSIFICATION OF GOODS.*

	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.
Class 2.	
Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.	Such as— Artificial manure. Cattle medicines. Deodorisers. Vermin destroyers.

* For further information as to the classification of goods, see Guide to the Classification, obtainable at the Patent Office on application.

Class 3.	
Chemical substances prepared for use in medicine and pharmacy.	Such as— Cod liver oil. Medicated articles, Patent medicines. Plasters. Rhubarb.
Class 4.	
Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.	Such as— Resins. Oils used in manufactures and not included in other classes. Dyes, other than mineral. Tanning substances. Fibrous substances (*e.g.*, cotton, hemp, flax, jute). Wool. Silk. Bristles. Hair. Feathers. Cork. Seeds. Coal. Coke. Bone. Sponge.
Class 5.	
Unwrought and partly wrought metals used in manufacture.	Such as— Iron and steel, pig or cast. Iron rough. ,, bar and rail, including rails for railways. ,, bolt and rod. ,, sheet, and boiler and armour plates. ,, hoop. Lead, pig. ,, rolled. ,, sheet. Wire. Copper. Zinc. Gold, in ingots.

Class 6.

Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.	Such as— Steam engines. Boilers. Pneumatic machines. Hydraulic machines. Locomotives. Sewing machines. Weighing machines. Machine tools. Mining machinery. Fire engines.

Class 7.

Agricultural and horticultural machinery, and parts of such machinery.	Such as— Ploughs. Drilling machines. Reaping machines. Thrashing machines. Churns. Cyder presses. Chaff cutters.

Class 8.

Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.	Such as— Mathematical instruments. Gauges. Logs. Spectacles. Educational appliances.

Class 9.

Musical instruments.

Class 10.

Horological instruments.

Class 11.

Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.	Such as— Bandages. Friction gloves. Lancets. Fleams. Enemas.

Class 12.

Cutlery and edge tools.	Such as— Knives. Forks. Scissors. Shears. Files. Saws.

Class 13.

Metal goods not included in other classes.	Such as— Anvils. Keys. Basins (metal). Needles. Hoes. Shovels. Corkscrews.

Class 14.

Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.	Such as— Plate. Clock cases and pencil cases of such metals. Sheffield and other plated goods. Gilt and ormolu work.

Class 15.

Glass.	Such as— Window and plate glass. Painted glass. Glass mosaic. Glass beads.

Class 16.

Porcelain and earthenware.	Such as— China. Stoneware. Terra cotta. Statuary porcelain. Tiles. Bricks.

Class 17.

Manufactures from mineral and other substances for building or decoration.	Such as— Cement. Plaster. Imitation marble. Asphalt.

Class 18.

Engineering, architectural, and building contrivances.	Such as— Diving apparatus. Warming apparatus. Ventilating apparatus. Filtering apparatus. Lighting contrivances. Drainage contrivances. Electric and pneumatic bells.

Class 19.

Arms, ammunition, and stores not included in Class 20.	Such as— Cannon. Small arms. Fowling pieces. Swords. Shot and other projectiles. Camp equipage. Equipments.

Class 20.

Explosive substances.	Such as— Gunpowder. Gun-cotton. Dynamite. Fog-signals. Percussion caps. Fireworks. Cartridges.

Class 21.

Naval architectural contrivances and naval equipments not included in Classes 19 and 20.	Such as— Boats. Anchors. Chain cables. Rigging.

Class 22.

Carriages.	Such as— Railway carriages. Waggons. Railway trucks. Bicycles. Bath chairs.

Class 23.

(*a*) Cotton yarn, and sewing cotton not on spools or reels. (*b*) Sewing cotton on spools or reels.	

Class 24.

Cotton piece goods of all kinds.	Such as— Cotton shirtings. Long cloth.

Class 25.

Cotton goods not included in Classes 23, 24, or 38.	Such as— Cotton lace. Cotton braids. Cotton tapes.

Class 26.

Linen and hemp yarn and thread.	

Class 27.

Linen and hemp piece goods.	

Class 28.

Linen and hemp goods not included in Classes 26, 27, and 50.	

Class 29.

Jute yarns and tissues, and other articles made of jute not included in Class 50.

Class 30.

Silk, spun, thrown, or sewing.

Class 31.

Silk piece goods.

Class 32.

Other silk goods not included in Classes 30 and 31.

Class 33.

Yarns of wool, worsted, or hair.

Class 34.

Cloths and stuffs of wool, worsted, or hair.

Class 35.

Woollen and worsted and hair goods not included in Classes 33 and 34.

Class 36.

Carpets, floor-cloth, and oil-cloth.	Such as— Drugget. Mats and matting. Rugs.

Class 37.

Leather, skins unwrought and wrought, and articles made of leather not included in other classes.	Such as— Saddlery. Harness. Whips. Portmanteaus Furs.

Class 38.	
Articles of clothing.	Such as— Hats of all kinds. Caps and bonnets. Hosiery. Gloves. Boots and shoes. Other ready-made clothing.
Class 39.	
Paper (except paper-hangings), stationery, and bookbinding.	Such as— Envelopes. Sealing wax. Pens (except gold pens). Ink. Playing cards. Blotting cases. Copying presses.
Class 40.	
Goods manufactured from india rubber and gutta percha not included in other classes.	
Class 41.	
Furniture and upholstery.	Such as— Paper-hangings. Papier mâché. Mirrors. Mattresses.
Class 42.	
Substances used as food, or as ingredients in food.	Such as— Cereals. Pulses. Olive oil. Hops. Malt. Dried fruits. Tea. Sago. Salt. Sugar. Preserved meats.

Class 42 (continued).	Confectionery. Oil cakes. Pickles. Vinegar. Beer clarifiers.
Class 43.	
Fermented liquors and spirits.	Such as— Beer. Cyder. Wine. Whiskey. Liqueurs.
Class 44.	
Mineral and aerated waters, natural and artificial, including ginger-beer.	
Class 45.	
Tobacco, whether manufactured or unmanufactured.	
Class 46.	
Seeds for agricultural and horticultural purposes.	
Class 47.	
Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches; and starch, blue, and other preparations for laundry purposes.	Such as— Washing powders. Benzine collas.
Class 48.	
Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).	

Class 49.

Games of all kinds and sporting articles not included in other classes.	Such as— Billiard tables. Roller skates. Fishing nets and lines. Toys.

Class 50.

Miscellaneous, including— (1.) Goods manufactured from ivory, bone, or wood, not included in other classes. (2.) Goods manufactured from straw or grass, not included in other classes. (3.) Goods manufactured from animal and vegetable substances, not included in other classes. (4.) Tobacco pipes. (5.) Umbrellas, walking-sticks, brushes and combs. (6.) Furniture cream, plate powder. (7.) Tarpaulins, tents, rick-cloths, rope, twine. (8.) Buttons of all kinds, other than of precious metal or imitations thereof. (9.) Packing and hose of all kinds. (10.) Goods not included in the foregoing classes.	Such as— Coopers' wares.

(Signed) M. E. HICKS-BEACH,
President of the Board of Trade.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE MARKS.

Preliminary.

1. All communications relating to Trade Marks, not being marks in Classes 23, 24, or 25, or Sheffield marks, should be addressed to the Comptroller, Patent Office, Trade Marks Branch (*a*). All applications should be in the English language.

They may be made by post, or left at the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C. (*See* also paragraphs 8 and 33.)

(*a*) As to the Manchester Office, see par. 34, *infra*.

2. The fees in relation to Trade Marks Registration cannot be received at the Patent Office. They should be paid in exchange for the *stamped forms* required, which may be obtained at the following places :—

(*a.*) The Inland Revenue Office, Royal Courts of Justice, London (Room No. 6).

(*b.*) The following Post Offices in London :—

The General Post Office, E.C.

District Post Office, Lombard Street, E.C.

„ 226, Commercial Road, E.

„ 9, Blackman Street, Borough, S.E.

„ Charing Cross, W.C.

„ 28, Eversholt Street, Camden Town, N.W.

Post Office, 12, Parliament Street, S.W., or

(c.) The Chief Post Office of the undermentioned cities and towns:—

IN ENGLAND AND WALES.

Accrington.
Altrincham.
Ashton-under-Lyne.
Barnsley.
Barrow-in-Furness.
Bath.
Bedford.
Beverley.
Birkenhead.
Birmingham.
Blackburn.
Bolton.
Bradford.
Brighton.
Bristol.
Bromsgrove.
Burnley.
Burslem.
Burton-on-Trent.
Bury.
Cambridge.
Cardiff.
Carlisle.
Chatham.
Chester.
Clitheroe.
Congleton.
Coventry.
Crewe.
Croydon.
Darlaston.
Derby.
Dewsbury.
Doncaster.
Dorchester.
Driffield.
Droitwich.
Dudley.
Durham.
Exeter.
Gateshead.
Goole.
Greenwich.
Guildford.
Halifax.
Hartlepool.
Huddersfield.
Hull.
Ipswich.
Keighley.
Kendal.
Kidderminster.
Knaresbro'.
Knutsford.
Lancaster.
Leamington.
Leeds.
Leicester.
Lichfield.
Lincoln.
Liverpool.
Macclesfield.
Manchester.
Middlesbrough.
Nantwich.
Newcastle.
Newport (Mon.).
Northallerton.
Northampton.
Nottingham.
Nuneaton.
Oldbury.
Oldham.
Patrington.
Plymouth.
Pontefract.
Portsmouth.
Prescot.
Preston.
Reading.
Redditch.
Richmond (Yorks).
Ripon.
Rochdale.
Rotherham.
Rugby.
Salford.
St. Helen's.
Scarborough.
Sedgley.
Sheffield.
Southampton.
Stafford.
Stalybridge.
Stockport.
Stoke-on-Trent.
Stourbridge.
Stourport.
Sunderland.
Swansea.
Tamworth.
Truro.
Tunstall.
Wakefield.
Walsall.
Warrington.
Wednesbury.
West Bromwich.
Whitby.
Widnes.
Wigan.
Wolverhampton.
Wolverton.
Woolwich.
York.

IN SCOTLAND.

Aberdeen.
Dumbarton.
Dundee.
Edinburgh.
Glasgow.
Greenock.
Inverness.
Lanark.
Leith.
Paisley.
Perth.
Renfrew.

IN IRELAND.

Belfast.
Cork.
Dublin.
Dundalk.
Galway.
Limerick.
Londonderry.
Waterford.
Wexford.

NOTE.—*Arrangements have also been made by which any of the forms required may be ordered at any Money Order Office in the United Kingdom not included in the above List.*

3. The following is a list of the stamped forms under the Patents, Designs, and Trade Marks Acts, 1883-8, which relate to Trade Marks, and which may be obtained at the places mentioned above:—

TRADE MARKS.

Letter.	Title of Form.	Fee.		
		£	s.	d.
E	Application for Hearing by Comptroller - - -	1	0	0
F	Application for Registration of Trade Mark - - -	0	5	0
G	Additional Representation Form - - - - -	No stamp.		
H	Appeal to Board of Trade from decision of Comptroller	1	0	0
I	Registration Fee - - - - - - - - -	1	0	0
J	Notice of Opposition to Application for Registration -	1	0	0
K	Request to enter Name of Subsequent Proprietor, with Declaration in support thereof - - - -	1	0	0
L	Request for Certificate of Refusal to Register a Trade Mark	1	0	0
M	Notice of Application for Alteration of Address - -	0	5	0
N	Notice of Order of Court for Alteration or Rectification of Register - - - - - - - - -	0	10	0
O	Application to Cancel Entry of Mark on Register - -	0	5	0
Q	Request for Correction of Clerical Error or for Amendment of Application under § 91 - - - -	0	5	0
R	Request for Certificate of Registration for use Abroad	0	5	0
S	Request for Certificate of Registration for use in Legal Proceedings - - - - - - - - -	1	0	0
T	Application for Settlement of a Special Case - -	2	0	0
T'	Request for General Certificate of Comptroller - -	0	5	0
V	Request for Copy of Official Notification - - -	0	2	0
W	Appeal from Cutlers' Company at Sheffield to Comptroller	1	0	0
X	Fee for Continuance of Trade Mark at expiration of fourteen years - - - - - - - -	1	0	0
Y	Additional Fee where fee is paid within three months after expiration of fourteen years - - - -	0	10	0
Z	Additional Fee for Restoration of Trade Mark where removed *for non-payment of fee* - - - -	1	0	0

Of the above forms, those bearing the letters F, G, I, X, Y, and Z, are kept in stock at the various offices named in paragraph 2. Any of the others when required must be bespoken.

Sale of Official Publications.

4. The Patents, Designs, and Trade Marks Acts, 1883-8, and the Trade Marks Rules, 1890, should be carefully studied. Copies of the Acts and of the Rules can be purchased at the Sale Branch of the Patent Office, 38, Cursitor Street, Chancery Lane, London, E.C. The price of the Acts and Rules together is 2*s.* 6*d.*, postage, 2*d.*; of the Acts alone, 2*s.*, postage, 1½*d.*; and of the Rules alone, 6*d.*, postage 1*d.* Sums exceeding 1*s.* should be remitted by Postal Order or Post Office Order.

5. Copies of the "Trade Marks Journal" may also be obtained from the Sale Branch of the Patent Office, 38, Cursitor Street, Chancery Lane, London, E.C.

The price of the "Trade Marks Journal" is:—
Nos. 1 to 509 (Years 1876 to 1887) - 1*s. per number.*
Nos. 510 to 561 (Year 1888) - - - 1*s.* 6*d.* ,,
No. 562 and following Nos. from 1 January, 1889, 6*d.* ,,

Definition of a Trade Mark.

6. The definition of a trade mark is given in the 64th section of the Acts, as follows:—

"(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

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

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

(*c.*) A distinctive device, mark, brand, heading, label, or ticket; or

(*d.*) An invented word or invented words; or

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

(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3.) Provided as follows:—

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade mark under this part of this Act."

SEARCHES.

7. A person wishing to adopt a trade mark should, before engraving a block and circulating impressions of the mark among his customers, make a search or a formal application at the Trade Marks Branch of the Patent Office with the view of ascertaining whether his proposed mark is already registered, or whether, from its being calculated to deceive by a resemblance to other marks already on record, it would be refused registration under the 72nd section of the Acts.

The fee for making a search amongst the classified representations of trade marks is 1*s.* for each quarter of an hour. The fee for a formal application is 5*s.* (*See* paragraphs 9 and 3 of these Instructions as to the mode of making a formal application.)

The comptroller does not undertake to make searches amongst the trade marks recorded at his office, *except in connexion with formal applications for registration.*

APPLICATIONS FOR REGISTRATION.

8. Applications sent by post should be addressed—

The Comptroller,
The Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London, W.C.

In the case of marks claimed in Classes 23, 24, or 25, applications should be addressed—

The Comptroller,
Manchester Trade Marks Branch,
48, Royal Exchange,
Manchester.

Agents and other persons who may be interested in more than one application are particularly requested to make communications relating to different applications in *separate* letters.

9. An application for the registration of a trade mark consists of:—

(*a.*) An application form (Form F) bearing an impressed stamp of 5*s.* (*see* paragraph 3).

(The applicant should, before filling up the form, carefully read the marginal notes.)

(*b.*) Certain additional representations of the trade mark, mounted on forms (Form G) (*see* paragraphs 3 and 15).

10. A *separate* application Form is required for *each* class in

cases where the same trade mark is claimed in more than one class of goods.

11. If the mark be the property of a firm, the Form F should be signed by a member of the firm, who should add, after his signature, "A member of the firm;" if of a company, by the secretary or other principal officer, who should add, after his signature and designation, "For the Company."

12. Applications may be made by agents in the names of and on behalf of the owners of trade marks. The agent must be *duly authorised by the owner* or *owners*; the *necessary authority* should be signed by the owner or owners.

Applications made by agents should have, after the name of the agent, the description "Agent."

13. When an applicant for the registration of a trade mark, otherwise than under an international convention, is out of the United Kingdom at the time of making the application, he must give the comptroller an address for service in the United Kingdom.

14. When the mark consists of or includes words printed in other than Roman characters, there should be given upon the forms a translation of such words, signed by the applicant or his agent.

In the case of marks claimed in Classes 23, 24, or 25, the applicant should state by what name the particular mark claimed would be referred to in the invoices of his house.

Additional Representations of Mark.

15. Each of the additional representations should be placed in the centre of a separate Form G.

In the case of a trade mark which is not claimed in Classes 23 to 35, *two* additional representations are required for *each* class claimed.

In the case of a trade mark claimed in any one or more of the Classes 23 to 25, *four* additional representations should be sent for *each* of such classes. In the case of a trade mark claimed in any one or more of the Classes 26 to 35, *three* additional representations should be sent for each of such classes.

The representations of the mark on the Forms G must agree *in every respect* with each other, and with that on the Form F.

16. Representations of a mark of a large size may be folded. In that case they must, however, be backed with linen and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners.

Series of Trade Marks.

17. By § 66 of the Acts, the comptroller is empowered to register under one registration a series of trade marks which, whilst they resemble each other in the material particulars, differ from each other in respect of the statements of the goods for which they are used, of the statements of numbers, of the statements of price, of the statements of quality, or of the statements of names of places. When an application is made for such a series, a representation of *each* of the marks included in the series must be affixed to the Form F, and also to each of the Forms G.

Common or Open Marks.

18. In the case of a trade mark used before the 13th August, 1875, common or open marks of any kind may be registered in connection with it; but in the case of a trade mark not so used, common or open marks consisting of *a word or combination of words only* can be registered as a part of the mark.

In each case, the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the foot of the application form, such note to be signed by the applicant or his agent.

See § 74 of the Acts, subs. 3, for definition of common marks.

Classification of Goods.

19. A guide to the classification of goods under the Trade Marks Rules can be obtained on application at the Patent Office, Trade Marks Branch, and should be asked for if the applicant feels any difficulty in determining to which of the classes set out in the third schedule to the Rules the goods for which he uses his mark belong.

Advertisement in the "Trade Marks Journal."

20. A trade mark cannot in any case be entered upon the Register until one month after its advertisement in the official paper.

21. A wood-block or electrotype must be furnished for each mark in each class claimed, except in the case of Class 23 (*a*) (Cotton Yarn and Sewing Cotton, not on spools or reels), and Classes 24 and 25, for which no blocks or electrotypes are required.

A wood-block or electrotype will be required for an application in Class 23 whenever it is in respect of, or covers, sewing cotton on spools or reels.

No block or electrotype should be forwarded until a formal demand for it is sent by the comptroller.

22. In the case of a series of trade marks differing only in respect of the particulars mentioned in § 66 of the Acts, a wood-block or electrotype must be furnished for each mark in the series, for each class claimed.

23. The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

24. The largest space available for the insertion of any single block or electrotype is five and a half inches broad by seven and a half inches deep.

When a block or electrotype *exceeds two inches in depth or breadth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch in depth or breadth beyond the two inches.

25. The number given by the comptroller should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure its identification.

26. All blocks or electrotypes should be sent to the Patent Office, Trade Marks Branch, together with the paper marked "Form 2," and with the representation of the mark sent for the guidance of the applicant in preparing the block or electrotype.

27. The blocks or electrotypes supplied for the advertisement of trade marks cannot in any case be returned to applicants.

Restrictions on Registration.

28. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork be included within the mark by some border or lines.

29. The words "Registered," "Registered Design," "Copy-

right," "Entered at Stationers' Hall," "To counterfeit this is Forgery," will not be registered under the Acts, and should not, therefore, appear upon the representations of trade marks forming part of an application (*a*).

(*a*) The following official notice appeared in "Trade Marks Journal" No. 570 (February 27th, 1889), p. 220, and is still in force :—

OFFICIAL NOTICE—TRADE MARKS.

After the 31st March, 1889, marks of the nature indicated below will not be accepted for registration as trade marks under the Patents, Designs, and Trade Marks Acts, 1883-8 :

(1.) Pictorial representations of goods to which the marks are to be applied.

(2.) Names of persons in the possessive case in combination with the names of goods.

30. The following will not be registered as trade marks, or as prominent parts of trade marks, unless the marks have been used before 13th August, 1875 :—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of Her Majesty the Queen, or of any member of the Royal Family.

Representations of the Royal Crown.

The National Arms or Flags of Great Britain.

31. When there appears on the face of a trade mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of *those goods only*.

OPPOSITIONS.

32. Notice of opposition to the registration of a trade mark (Form J) must be filed within one month (or such further time, not exceeding three months, as the comptroller may allow) from the date of advertisement of the mark in the "Trade Marks Journal."

The applicant's counter-statement must be filed within one month from the date of receipt of the opponent's notice of opposition.

The opponent's evidence, in support of the opposition, must be filed within two months after the expiration of such month or extended time.

The applicant's evidence must be filed within one month from the delivery of the opponent's evidence.

The opponent's evidence in reply must be filed within seven days from the delivery of the applicant's evidence.

On the completion of the evidence, either party may apply (upon Form E) for the case to be heard by the comptroller.

Form of Counter-statement.

The following is a form of counter-statement :—

[For this form see Appendix B., p. 482, *infrà*.]

Cutlers' Company.

33. By § 81 of the Acts, application for the registration of trade marks used on metal goods shall, if made by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company. (*See* Rules 56 to 59.)

Applications made to the Cutlers' Company in pursuance of § 81 of the Acts should be made on Form F, the address in the left-hand corner to be, "To the Cutlers' Company, Sheffield," instead of "To the Comptroller," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on foolscap paper. (*See* Rule 56.)

Applications sent by post should be addressed—

The Law Clerk to the Cutlers' Company,
The Cutlers' Hall,
Sheffield.

Manchester Office.

34. For the convenience of merchants and manufacturers engaged in the cotton trade, and for the purpose of facilitating the recording of trade marks used in respect of cotton goods, an office is open at 48, Royal Exchange, Manchester, where searches can be made, on payment of 1*s*. for each quarter of an hour, for marks in classes of textiles from Class 23 to Class 35.

Certificates.

35. The comptroller's certificate in relation to a trade mark is of four kinds, viz. :—

(i.) For use in legal proceedings.
(ii.) For use in applying for registration in foreign countries.

(iii.) Of any application made and of proceedings thereon.
(iv.) A certificate of refusal of a mark in use before 13th August, 1875, and not registrable.

36. A person desirous of obtaining any of the above certificates should forward Form S, Form R, Form T[1], or Form L (*see* paragraph 3), as the case may be, to the comptroller, giving the comptroller's official number of the mark, and stating whether the certificate is required for use in legal proceedings, or for use in applying for the registration of the mark in a foreign country, or for what other purpose.

37. In every case where a certificate is required in respect of a cotton mark, or in respect of any trade mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the comptroller.

Registration of Subsequent Proprietors of Registered Trade Marks.

38. The request and declaration to be made by a subsequent proprietor on application for the registration in his name of a registered trade mark must be made on Form K (*see* paragraph 3).

H. Reader Lack,
Comptroller.

January 1890.

N.B.—The Rules and Instructions under the Trade Marks Registration Acts, 1875-7, were frequently added to and altered, and it will be advisable for intending applicants under the Patents Acts, 1883-8, to take care to proceed in accordance with the Rules and Instructions for the time being in force.

APPENDIX B.

FORMS AND PRECEDENTS.

PART I.

FORMS PRESCRIBED BY THE SECOND SCHEDULE TO THE RULES.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

E.

Form of Application for Hearing by the Comptroller.

In Cases of Opposition, &c.

Sir,

(a) Here insert full address.

I, of (a)

hereby apply to be heard in reference to

and request that I may receive due notice of the day fixed for the hearing.

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings, London*

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

F.

Application for Registration of Trade Mark.

TRADE MARKS.

One representation to be fixed within this square, and two others to be sent on separate half-sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

You are hereby requested to register the accompaning trade mark in Class , in respect of (*a*) ,

in the name of (*b*) ,

who claims to be the proprietor thereof (*c*).

The essential particulars of the trade mark are the following (*d*)

and disclaim any right to the exclusive use of the added matter.

(*a*) Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

(*b*) Here insert legibly the full name, address and description of the individual firm or company. Add trading style (if any).

(*c*) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

(*d*) See subs. (2) and (3) of § 64 of the Acts.

(*e*) To be signed by the applicant or by an agent duly authorised.

(Signed) (*e*)

Dated the day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings, London.*

[Or where the application is for a mark in classes 23, 24 or 25],

To the Comptroller,
Manchester Trade Marks Branch,
48, *Royal Exchange, Manchester.*

Note.—If the trade mark has been in use in respect of the goods since before August 13th, 1875, state length of such user.

PATENTS, DESIGNS, AND TRADE MARKS ACTS 1883—1888.

G.

Additional Representation of Trade Mark to accompany Application for Registration.

One representation of the trade mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the application form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto.

Two of these Additional Representations of the trade mark must accompany *each* form of application.

In the case of a trade mark claimed in one of the Classes 23 to 35, Three of these Additional Representations of the mark must accompany the form of application.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

H.

Form of Appeal from the Comptroller to the Board of Trade.

I, (*a*)
of (*a*)
hereby give notice of my intention to appeal to the Board of Trade from (*b*)
of the Comptroller of the day of 18 ,
whereby he (*c*)

(*a*) Here insert full name and address of appellant.

(*b*) Here insert "the decision" or "that part of the decision" as the case may be.

(*c*) Here insert the decision complained of.

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

(Signed)

Dated day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings, London.*
and to
[*Name of Respondent to Appeal.*]

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

I.

Fee for Registration of a Trade Mark.

Sir,

In reply to your request I hereby transmit the prescribed fee for the registration of the Trade Mark No.
in Class

I am,
Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

J.

NOTICE OF OPPOSITION TO APPLICATION FOR REGISTRATION.

[*To be accompanied by an unstamped duplicate.*]

In the matter of an application, No. by of

(a) Here state full name and full address.

I, (*a*) hereby give notice of my intention to oppose the registration of the trade mark advertised under the above number for Class in the "Trade Marks Journal" of the day of 18 , No. , page .

The grounds of opposition are as follows (*):—

(Signed)

Dated the day of 18

Address for service:—

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

(*) See p. 492, *infrà*, for forms of grounds of opposition.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF TRADE MARK UPON THE REGISTER, WITH DECLARATION IN SUPPORT THEREOF.

(a) *Or* We. Here insert name, full address, and description.

I, (*a*)

(b) My *or* our. (c) *Or* names.

hereby request that you will enter (*b*) name (*c*) in the register of trade marks as proprietor of the trade mark No. in Class .

(d) I am, *or* We are.

(*d*) entitled to the said trade mark and to the goodwill of the business concerned in the goods with respect to which the said trade mark is registered.

(e) Here state whether trade mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof as *e.g.*, "by deed dated the day of 18 , made between So-and-so of the one part."

(*e*)

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said trade mark as above claimed.

(f) This paragraph is not required when the declaration is made out of the United Kingdom.

(*f*) And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(g) To be signed here by the person making the declaration.

(*g*)

Declared at

this day of 18 .

Before me,

(*h*)

(h) Signature and title of the authority before whom the declaration is made.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

L.

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A TRADE MARK IN USE BEFORE 13TH AUGUST, 1875.

In the matter of an application for registration of an old trade mark, No.
in Class

SIR,

I,
of
the applicant in the above matter, hereby request you to furnish me with your certificate of refusal to register the said trade mark.

(a) Signature of applicant.

(a)

Dated this day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

M.

NOTICE OF APPLICATION FOR ALTERATION OF ADDRESS ON REGISTER OF TRADE MARKS.

In the matter of the trade mark, No. , registered in Class .

SIR,

Notice is hereby given that I
of
the registered proprietor of the trade mark numbered as above, desire that my address on the Register of Trade Marks be altered to

Dated this day of 18 .

(a) Signature of proprietor.

(a)

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

N.

TRADE MARKS.

NOTICE OF ORDER OF COURT FOR ALTERATION OR RECTIFICATION OF REGISTER OF TRADE MARKS.

In the matter of the trade mark No. , registered in Class in the name of

SIR,

Notice is hereby given that by an order of the Court made on the day of 18 , it was directed that the entry on the Register of Trade Marks in respect of the trade mark numbered as above should be rectified in the manner therein specified.

An office copy of the order of the court is enclosed herewith.

Dated this day of 18 .

(a)

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

(a) To be signed by the person interested or his agent.

PATENTS, DESIGNS, AND TRADE MARKS ACTS. 1883—1888.

O.

TRADE MARKS.

FORM OF APPLICATION BY PROPRIETOR OF REGISTERED TRADE MARK TO CANCEL ENTRY ON REGISTER.

Trade mark No. Class advertised in "Trade Marks Journal," No. page .
Name of registered proprietor or firm

Place of business
I, the undersigned
of

[*or* I, the undersigned,
a member of the firm of
of
on behalf of my said firm]
apply that the entry upon the Register of the Trade Marks in Class of the trade mark No. may be cancelled.

The day of 18 .

(Signed)

This is the statement marked "O" referred to in the declaration of
made before me the of 18 .

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

P.

Form of Declaration in Support of Application for Cancellation of Trade Mark by Owner.

I, of

; [*or*

I, a member of the firm of

of

]

do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows:—

(1) The application signed by me, and dated the day of 18 and marked with the letter "O," and shown to me at the time of making this declaration, is true.

(2) I am the person whose name appears on the Register of Trade Marks as the proprietor of the trade mark referred to in the said application marked with the letter "O."

[*or* My said firm is the firm whose name appears on the Register of Trade Marks as the proprietor of the trade mark referred to in the said application marked with the letter "O."]

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(Signed)

Declared at

this day of

18 .

Before me,

If the declaration be made before a commissioner to administer oaths it will require to be stamped with a 2*s.* 6*d.* impressed Inland Revenue stamp.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

Q.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR PERMISSION TO AMEND APPLICATION UNDER § 91.

SIR,

I hereby request that

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

R.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK FOR USE IN OBTAINING REGISTRATION ABROAD.

In the matter of the trade mark
No. , registered in
Class in the name of

SIR,

I,
of
the registered proprietor of the above trade mark, hereby request you to furnish me with your certificate of registration for use in obtaining registration of the same in (*a*)

(*a*) Here state name of country in which registration is to be sought.

(*b*)

(*b*) Signature.

Dated this day of 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

S.

TRADE MARKS.

Request for Certificate of Registration of Trade Mark to be Used in Legal Proceedings.

In the matter of the trade mark
No. , registered in
Class in the name of

Sir,

I,
of
the registered proprietor of the above trade mark, hereby request you to furnish me with your certificate of registration to be used in legal proceedings

(a) Signature. (*a*)

Dated this day of 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

T.

TRADE MARKS.

Application for Settlement of a Special Case on Application to Register a Trade Mark.

In the matter of the application of and
of the application of

Sir,

Notice is hereby given that I, ,
of ,
and I, ,
of ,
are unable to agree upon the facts on which the opinion of the Court is to be taken, and that we request you to fix a day on which we may attend before you and obtain your finding on the matters of fact to be submitted to the Court as settled.

Dated this day of 18 .

(a) To be signed by both parties. (*a*)

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

T[1].

TRADE MARKS.

REQUEST FOR GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).

In the matter of the trade mark No.
in Class

SIR,

I,

of

hereby request you to furnish me with your certificate that (*a*)

(*a*) Here set out the particulars which the comptroller is requested to certify.

(*b*)

Dated this day of 18 .

(*b*) Signature.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

U.

TRADE MARKS.

GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).*

Patent Office, Trade Marks Branch,
London,
18 .

I,
Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

* In practice this form is usually employed as shown at p. 490, *infra*.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

V.

TRADE MARKS.

REQUEST FOR COPY OF OFFICIAL NOTIFICATION OF REGISTRATION OF TRADE MARK.

In the matter of the trade mark No. , registered in Class .

SIR,

I , of , the registered proprietor of the trade mark above named hereby request that you will furnish me with a copy of the official notification of the registration of the same.

(a) Signature. (a)

Dated this day of , 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

W.

TRADE MARKS.

FORM OF APPEAL FROM CUTLERS' COMPANY AT SHEFFIELD TO COMPTROLLER.

[*To be accompanied by an unstamped duplicate.*]

SIR,

I hereby give notice of appeal against the decision of the Cutlers' Company of Sheffield in regard to my application for registration of a trade mark No. , in Class , for ,

(a) The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

(b) Signature.

and I beg to submit my case (a) for your decision accordingly.

(b)

Dated this day of , 18 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS 1883—1888.

X.

TRADE MARKS.

CONTINUANCE OF MARK AT EXPIRATION OF 14 YEARS FROM THE DATE OF REGISTRATION.

SIR,

In pursuance of the notice received from you, I hereby transmit the prescribed fee of £1 for continuance on the Trade Marks Register of the trade mark No. , in Class .

Dated the day of 18 .

(a) Signature of proprietor.

(a)

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Y.

TRADE MARKS.

ADDITIONAL FEE OF 10/- TO ACCOMPANY "CONTINUANCE FEE" (FORM X), WITHIN 3 MONTHS AFTER EXPIRATION OF 14 YEARS.

SIR,

In pursuance of the notices issued by you, and of the provisions of § 79 (3), of the above Acts, I hereby transmit the additional fee of 10/- (along with Form X) for the continuance on the Trade Marks Register of the trade mark No. , in Class .

Dated the day of

(a) Signature proprietor.

(a)

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Z.

TRADE MARK.

RESTORATION OF TRADE MARK WHERE REMOVED FOR NON-PAYMENT OF FEE.

(To accompany Form X.)

SIR,

In pursuance of the notices issued by you, and of the provisions of § 79 (4), of the above Acts, I hereby transmit the additional fee of £1 (along with Form X) for restoration to the Trade Marks Register of the trade mark No. , in Class .

Dated the day of 18

(a) Signature of proprietor.

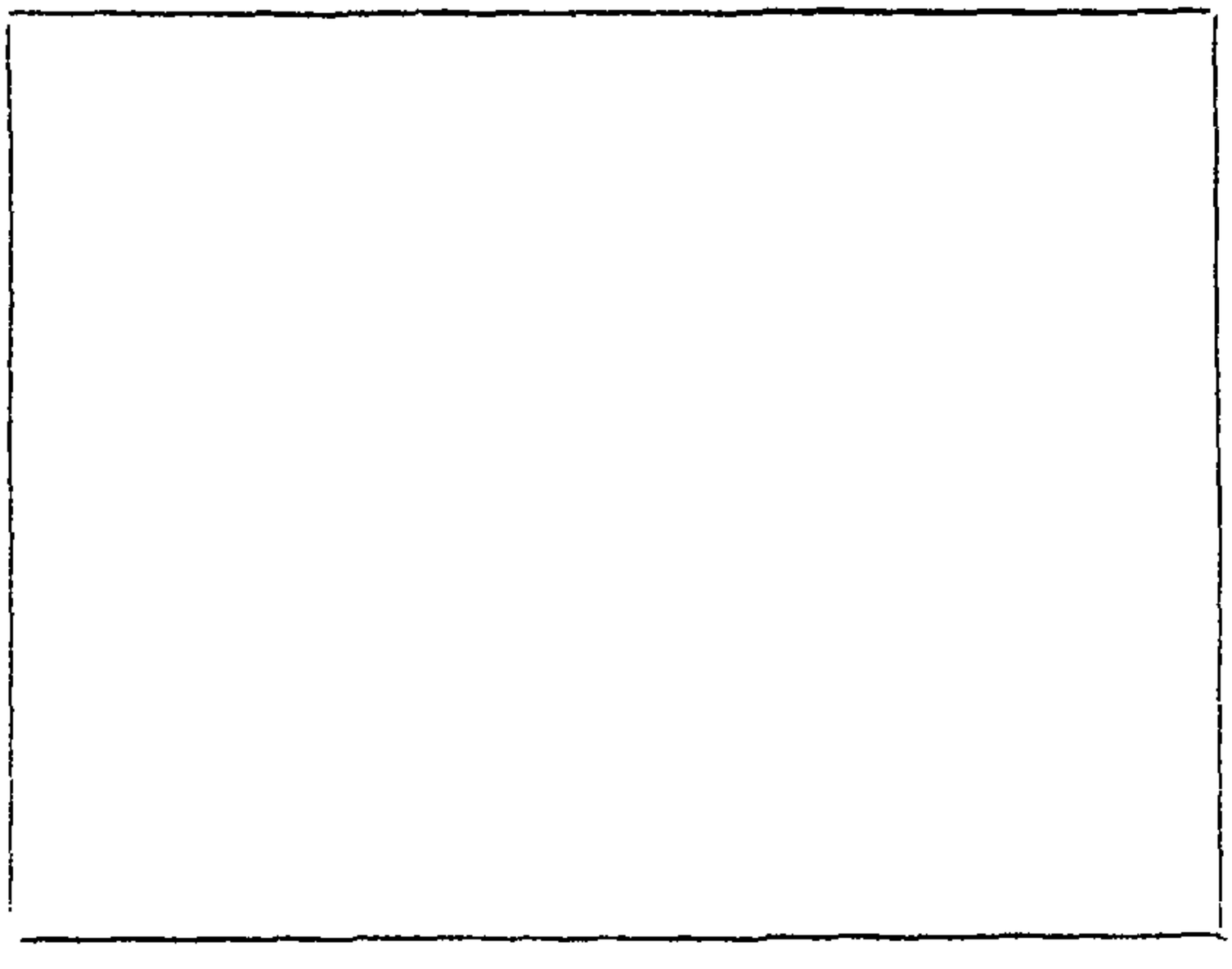
(a)

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

CORPORATE TRADE MARK.

Application for Registration of Old Corporate Trade Mark.



You are hereby requested to register the accompanying old Corporate Trade Mark in Class , in respect of

in the name of

who claims to be the proprietor thereof.

(Signed)

Dated the day of 18 .

To the Cutlers' Company,
Cutlers' Hall, Sheffield.

FORM SUGGESTED BY THE COMPTROLLER.

[*See Instructions, par.* 32.]

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a.

FORM OF COUNTER-STATEMENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

TRADE MARKS.

In the matter of an application No. , and of the opposition thereto No. .

In reply to the notice of opposition in this matter by of , I give notice by way of counter-statement that I rely for my application on the following grounds (*a*):—

(To be dated and signed by the applicant or his solicitor.)

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

(*a*) See page 496, *infrà*, for forms of grounds of counter-statement.

FORMS IN USE IN THE PATENT OFFICE, TRADE MARKS BRANCH (SELECTED).

b.

FORM OF RECEIPT OF AN APPLICATION.

Patent Office: Trade Marks Branch,
London.

Received this day of , 18 , an application for the registration of trade mark in the name of

Comptroller.

c.

FORM OF AUTHORISATION OF AGENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

FORM OF AUTHORISATION.

SIR,

I beg to inform you that I have appointed (*a*) of to act as my agent for the registration of (*b*)

I am,
Sir,
Your obedient servant,

(*c*)

To the Comptroller,
The Patent Office,
25, *Southampton Buildings.*
London, W.C.

(*a*) Here insert name and address of agent.
(*b*) If the authority is to be limited to one application, insert "of the Trade Mark" or as the case may be "sent herewith."
(*c*) To be signed by the proprietor.

d.

FORM OF ADVERTISEMENT.

FORM FOR "TRADE MARKS JOURNAL."

18 .

Class of Goods.	Number.	Description of Goods.	Name, address, and calling of applicant.	Date of application received.	If mark used prior to 13th August, 1875, how long used.

N.B.—This Paper is to be sent with the block or electrotype and the representation, *prepaid*, to

The Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London, W.C.

c.

Form of Notification of Registration.

PATENT OFFICE, TRADE MARKS BRANCH.

London, , 18 .

Notification of Registration.

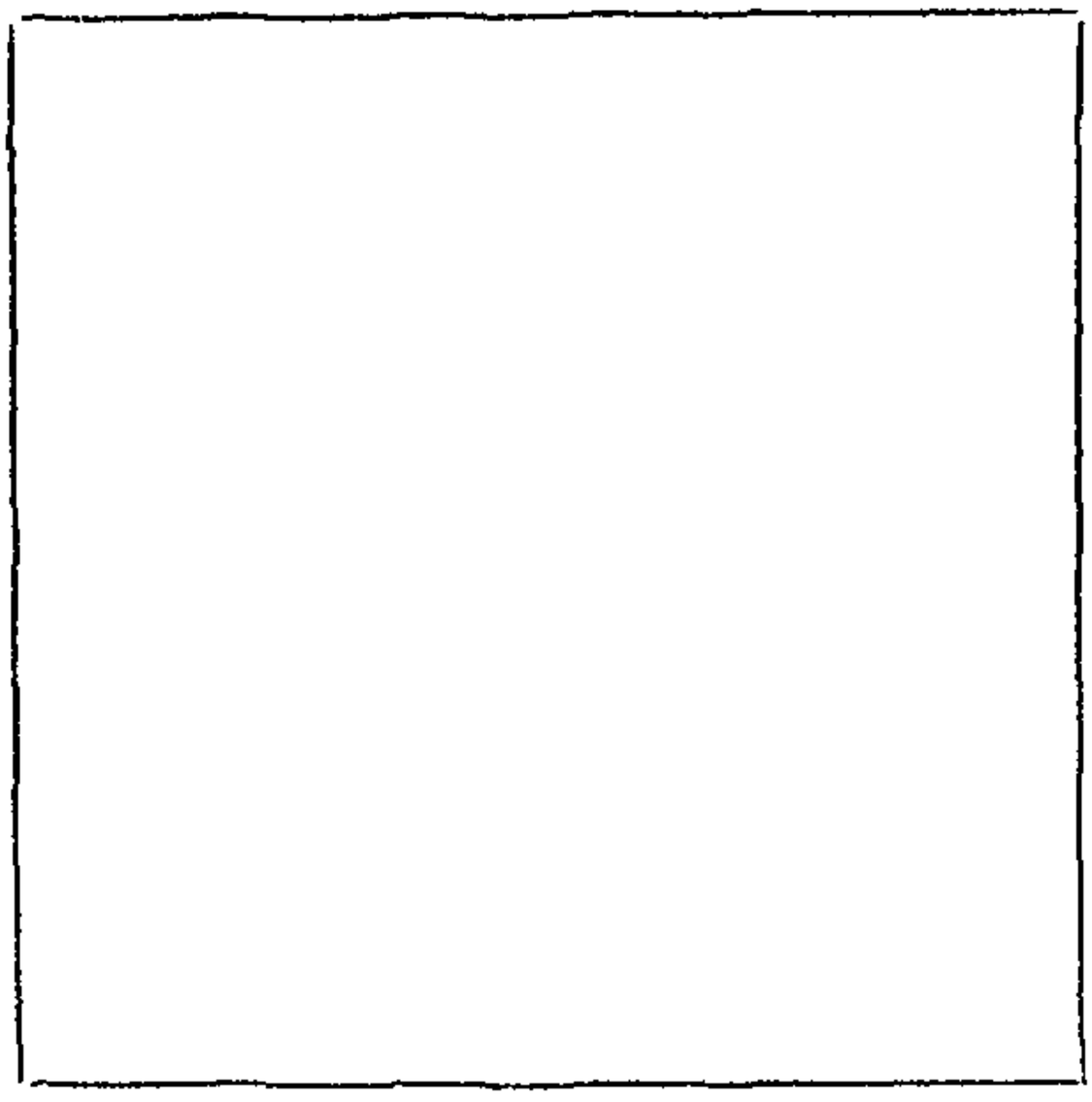
Sir,

I beg to inform you, pursuant to Rule 35 of the Trade Marks Rules, that the trade mark No. , advertised in tho "Trade Marks Journal," No. , has been registered in your name for the following goods in Class , viz. :—

The registration dates from the day of , 18 .

I am,
Your obedient servant,
H. Reader Lack.
Comptroller-General.

REPRESENTATION OF TRADE MARK AS ADVERTISED.



f.

FORM OF NOTIFICATION OF REGISTRATION OF SUBSEQUENT PROPRIETOR.

PATENT OFFICE: TRADE MARKS BRANCH,

London 18 .

SIR,

I have to inform you that, in pursuance of your application received at this office on the , 18 , your ha been entered on the register as proprietor of the trade mark

I am,
Your obedient servant,
H. READER LACK.
Comptroller.

---

g.

FIRST NOTICE UNDER § 79.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Notice before removal of Trade Mark from the Register, under § 79.

SIR,

I, HENRY READER LACK, Comptroller-General of Patents, Designs, and Trade Marks, hereby give you notice that, in conformity with the provisions of § 79 of the above Acts (printed at back hereof), your trade mark No. , registered in Class , will be removed from the Trade Marks Register unless the prescribed fee of £1 (payable by Form X) be received at this office *before* the day of 18 .

A stamped Form X, for payment of the fee, may be obtained as directed at the back of this Notice.

Dated this day of 18 .

To

Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London, W.C.

k.

Second Notice under § 79.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Second Notice.

Notice before removal of Trade Mark from the Register, under § 79.

Sir,

I, Henry Reader Lack, Comptroller-General of Patents Designs, and Trade Marks, hereby give you notice that, in conformity with the provisions of § 79 of the above Acts (printed at back hereof), your trade mark No. , registered in Class , will be removed from the Trade Marks Register unless the prescribed fee of £1 (payable by Form X) be received at this office *before* the day of 18 .

If the above fee be not paid *before* the date above named, the trade mark will, after the end of three months from such date, be removed from the Trade Marks Register, unless an *additional* fee of 10*s.* (payable by Form Y) be remitted.

Stamped forms for payment of renewal fees may be obtained as directed at the back of this notice.

Dated this day of , 18 .

To

i.

Form of Certificate of Registration of Original Proprietor for Use in Legal Proceedings, or in Applying for Registration in Foreign Countries.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Certificate of Registration.

In the matter of legal proceedings
No. [*or*, in the matter of an application to register the trade mark No. of *A. B.*, in *France*.]

I, Henry Reader Lack, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that *A. B.* of , is entered on the Register of Trade Marks as proprietor of the trade mark No. in Class in respect of , for the registration of which mark application was made on the day of 18 .

The user claimed for the said trade mark is [*one year before the 13th day of August, 1875*] (*a*).

A representation of the said trade mark is shown hereunder [*or*, is annexed hereto].

(*a*) No mention is made of user, unless this was prior to the 13th August, 1875.

REPRESENTATION OF TRADE MARK.

Witness my hand and seal this day of 18 .

Comptroller-General.

Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

k.

Form of Certificate of Registration of Subsequent Proprietor for Use in Legal Proceedings, or in applying for Registration in Foreign Countries.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Certificate of Registration.

No. In the matter of legal proceedings [*or*, in the matter of an application to register the trade mark No. of *A. B. & Co.*, in *France*].

I, Henry Reader Lack, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that under date the day of 18 , *A. B. & Co.* of , are entered on the Register of Trade Marks as proprietors of the trade mark No. in Class in respect of , in succession to *A. B.* of , in whose name the said trade mark was registered in the same class, and in respect of the same goods under date the day of 18 .

The user claimed for the said trade mark is [*one year before the 13th day of August*, 1875] (*a*).

A representation of the said trade mark is shown hereunder [*or*, is annexed hereto].

(*a*) No mention is made of user, unless this was prior to the 13th August, 1875.

REPRESENTATION OF TRADE MARK.

Witness my hand and seal this day of 18 .

Comptroller-General.

Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

I.

FORM OF GENERAL CERTIFICATE.

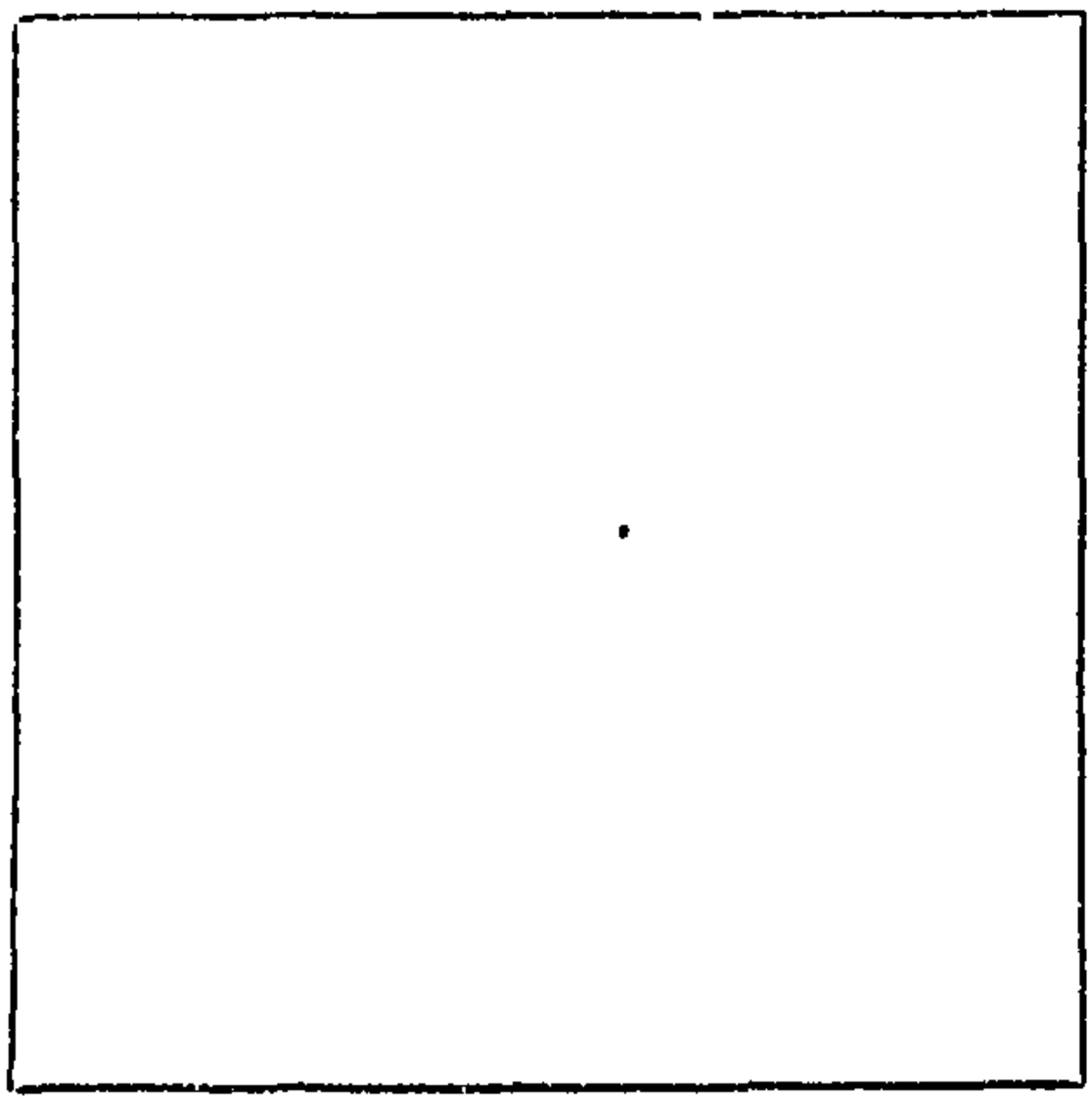
PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

General Certificate.

In the matter of
No.

I, HENRY READER LACK, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that

REPRESENTATION OF TRADE MARK.



Witness my hand and seal this day of 18 .

Comptroller-General.

Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

m.

Form of Certificate of Refusal to Register.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Certificate under § 77.

No.

I, Henry Reader Lack, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that on the day of 18 , of

applied to register the mark, of which a representation is below, in Class in respect of

stating that the same had been in use as a trade mark before the 13th day of August, 1875; and I also certify that it is a mark incapable of being registered under "The Patents, Designs, and Trade Marks Acts, 1883—1888."

REPRESENTATION OF TRADE MARK.

Witness my hand and seal this day of 18 .

Comptroller-General.

Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

PART II.

FORMS FOR USE IN REGISTRATION PROCEEDINGS.

1. Grounds of Opposition (*a*).

(i.) The alleged trade mark to which the above-mentioned application relates is not a registrable trade mark within § 64 of the Patents, Designs, and Trade Marks Acts, 1883-8.

(ii.) The alleged [as in (i.) to—relates] does not consist of or contain any essential particular as defined by § 64 of the Patents, Designs, and Trade Marks Acts, 1883-8, or any special and distinctive word, or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the 13th August, 1875.

(iii.) It is not the fact, as alleged by the applicant in his application, that he has used the trade mark No. for years. The said trade mark has in fact been used exclusively for years past by the opponent, who is now applying to register the same. If there has been any user by the applicant, the same has been clandestine and unknown to the opponent.

(iv.) It is not the fact as alleged [as in (iii.) to—years]. The applicant has never used the said alleged trade mark otherwise than as a mere descriptive term, and he is not now entitled to register it as his old trade mark.

(v.) The goods in respect of which the above-mentioned applicant is seeking to register the alleged trade mark No. are not goods comprised in Class of the classes under the Patents, Designs, and Trade Marks Acts, 1883-8.

(vi.) The alleged [as in (i.) to—relates] is a mere word in ordinary use in the English language descriptive of quality, and the applicant is not entitled to acquire an exclusive right therein by registration.

(*a*) See Form J, p. 470, *supra*, for the formal parts of the notice of opposition. These forms are intended to be varied and combined as may be necessary, or they may suggest others more suitable to particular cases.

(vii.) The alleged [as in (i.) to—relates] is not distinctive of the above-named applicant's goods, but is merely descriptive of the character and quality of the goods to which it is applied.

(viii.) The alleged [as in (i.) to—relates] is not a mark distinctive of the above-named applicant's goods, but has for many years past been in common use in the trade, and is generally understood by the trade and the public to denote a particular quality [*or* pattern] of goods [and was for that reason placed by the Manchester Committee of Experts in their second class or B. list], and no person is entitled to acquire an exclusive right therein by registration.

(ix.) The alleged [as in (i.) to—relates] consists of a name which has throughout the continuance of an expired patent been applied by the applicant as patentee, and by the trade and the public, to articles manufactured in accordance with the said patent. Upon the expiration of the said patent the trade became entitled to manufacture in accordance with the said patent, and to describe articles so manufactured by the name which was generally understood to be descriptive of them, and the applicant is not now entitled to exclude the trade from the use of the said name.

(x.) The alleged [as in (i.) to—relates] is identical with the opponent's trade mark No. registered with respect to the same goods or description of goods as those for which the applicant is now applying to register the same. If the applicant is allowed to register or use the said alleged trade mark, the trade and the public will be deceived and the opponent injured.

(xi.) The alleged [as in (i.) to—relates] has such a resemblance to the opponent's [as in (x.) to—register the same] as to be calculated to deceive. An action is now pending in the Chancery Division of the High Court of Justice in which the opponent is seeking to restrain the applicant from using the said alleged trade mark.

(xii.) The alleged [as in (i.) to—relates] has such a resemblance to the opponent's Sheffield mark No. , registered in the Sheffield register with respect to the same goods or description of goods as those for which the applicant is now applying to register the said alleged trade mark, as to be calculated to deceive.

(xiii.) The trade mark [as in (i.) to—relates] is the trade mark of the opponent, and has been used by him in his business for years last past, and an application by the opponent for the registration of the same is now pending. The applicant is a discharged servant of the opponent, in fraud of whose rights the present application is made.

(xiv.) The trade mark [as in (i.) to—relates] was months since adopted by the opponent and used upon his [describe the goods], and the applicant was employed by the opponent to obtain the registration of the same on his behalf, and he is not now entitled to obtain the registration of the same in his own name.

(xv.) The trade mark [as in (i.) to—relates] has for many years past been the exclusive property in [France] of the opponent, and it has for the same period been exclusively used in the United Kingdom upon goods of the opponent imported into this country. [The opponent has not hitherto registered the said trade mark in the United Kingdom from ignorance of the requirements of British law, but he is now about to apply for the registration of the same.]

(xvi.) The alleged [as in (i.) to—relates] contains several material misstatements with respect to the nature and composition of the article to which it is applied by the applicant, and the said alleged trade mark is therefore calculated to deceive, and ought not to be registered.

(xvii.) The alleged [as in (i.) to—relates] contains a statement contrary to the fact, that the goods to which it is applied by the applicant are patented, and the said alleged trade mark ought not therefore to be registered.

(xviii.) By articles of partnership, dated , under which the opponent and the applicant carried on business until recently in partnership, it was agreed that on the dissolution of the partnership the goodwill of the partnership business and the trade marks used therein (of which the trade mark [as in (i.) to—relates] was one) should belong solely to the opponent. The said partnership is now dissolved, and the applicant is not entitled to use or register the said trade mark.

(xix.) By articles [as in (xviii.) to—dissolution of the partnership] neither of the partners should in any business

carried on by him use the name or trade marks used by the said partnership. The trade mark [as in (i.) to—relates] is one of the trade marks which were used by the said partnership, and since the dissolution of the said partnership the applicant is not entitled to use or register the said trade mark.

(xx.) The word which forms part of the alleged [as in (i.) to—relates] is a word in common use in the trade, and the applicant is therefore not entitled to acquire any exclusive right in the said word by registration, or to obtain registration of the said alleged trade mark, except and unless he first disclaims any right to the exclusive use of the said word.

(xxi.) The device of a ["lion"] is in common use in the trade, and the applicant is therefore not entitled to obtain registration of the words ["Lion Brand"] as part of his alleged trade mark No. , except and unless he first disclaims any right to the exclusive use of the said words.

(xxii.) Goods of my manufacture [*or*, merchandise] of the same description as the goods for which the applicant is now applying to register his alleged trade mark, are constantly ordered and sold as ["Lion"] goods, and if the applicant is allowed to obtain registration of the device of a [lion] as [*or* as part of] his trade mark, it will cause his goods to be passed off as and for my goods.

(xxiii.) The alleged [as in (i.) to—relates] has such a resemblance to the opponent's registered trade mark No. as to be calculated to deceive. The class of goods for the whole of which the above-mentioned applicant is now applying to register the said trade mark includes the goods in respect of which the opponent's said trade mark is registered, and the applicant is therefore not entitled to obtain registration of the said alleged trade mark except and unless the goods in respect of which registration is granted to him are so limited and defined as not to include the goods or description of goods for which the opponent's said trade mark is registered as aforesaid.

2. GROUNDS OF COUNTER-STATEMENT (*a*).

(i.) The trade mark to which the above-mentioned application relates has been exclusively used for years last past by the applicant, and is a good, valid, and registrable trade mark.

(ii.) The trade mark [as in (i.) to—relates] consists of [*or* contains] an essential particular as defined by § 64 of the Patents, Designs, and Trade Marks Acts, 1883-8, viz., [a distinctive device, mark, or label], and is therefore registrable as a new trade mark.

(iii.) The trade mark [as in (i.) to—relates] consists of a special and distinctive word used by the applicant as a trade mark before the 13th day of August, 1875, and is therefore a good and valid trade mark and is registrable as an old mark.

(iv.) I have publicly used the trade mark [as in (i.) to—relates] in the United Kingdom for years, as alleged in my above-mentioned application. Such user has not been clandestine, but has been generally known to the trade in ; and if it has not been known to the opponent, that must have been either because he was not engaged in such trade, or else because he conducted his business negligently.

(v.) The goods in respect of which I am applying to register my above-mentioned trade mark No. are goods comprised in Class of the classes under the Patents, Designs, and Trade Marks Acts, 1883-8, [as appears from the Guide to the Classification issued at the Patent Office].

(vi.) My above-mentioned trade mark is not a mere word in ordinary use in the English language descriptive of quality, but is a special and distinctive word by which my goods are generally recognised by the trade and the public, and I am entitled to register the same.

(vii.) My above-mentioned trade mark is not merely descriptive of the character and quality of the goods to which it is applied, but it was first adopted and has since been exclusively used by myself for the purpose of distinguishing goods of my manufacture [*or* merchandise], and it is generally recognised as being distinctive of such goods.

(viii.) It is not the fact that my above-mentioned trade mark has for many years past, or at all, been in common use

(*a*) See Form *a*, p. 482, *supra*, for the formal parts of the counter-statement.

in the trade. In instances I have obtained injunctions to restrain infringements thereof, and if there has been any user by persons not so restrained it has been without my knowledge, or I should have taken proceedings against them.

(ix.) It is not the fact that my above-mentioned trade mark is generally understood by the trade or the public to denote a particular quality of goods; on the contrary, it is generally understood to denote goods of my manufacture [*or* merchandise], and the trade and the public would be deceived and I should be injured if any other manufacturer were to use it.

(x.) My above-mentioned trade mark was placed by the Manchester Committee of Experts in their 2nd class, or B. list, in consequence of a misapprehension as to the principles by which their action was to be governed, and the said mark was wrongfully so placed, and ought to be admitted to registration.

(xi.) It is not the fact that I, or the trade, or the public, have used or understood my above-mentioned trade mark as describing articles made in accordance with my expired patent. On the contrary, I adopted it before the grant to me of the said patent, and it has always been used and understood as distinguishing goods of my make, and not goods of any particular pattern.

(xii.) My above-mentioned trade mark is not identical with the opponent's registered mark [*or* Sheffield mark], nor has it such resemblance to the same as to be calculated to deceive.

(xiii.) The goods with respect to which the opponent's trade mark [*or* Sheffield mark] is registered are not the same goods nor goods of the same description as the goods with respect to which I am applying for registration of my above-mentioned trade mark.

(xiv.) The opponent's trade mark No. is not a good or valid trade mark, but was registered by mistake and wrongfully, and I am now applying for the rectification of the register by the removal therefrom of the said mark.

(xv.) Whether the trade mark which I am now applying to register is or is not the property of the opponent in a foreign country, as to which I have no knowledge, the said trade mark has not up to the present time been known in the United Kingdom in connection with [describe the goods], but the same is a new mark adopted for the first time by myself months since.

(xvi.) The statements contained in my above-mentioned trade mark are true, and my said trade mark is not calculated to deceive. If any of such statements are exaggerated, such exaggerations are trifling and immaterial and not calculated to deceive.

(xvii.) The mention of a patent contained in my above-mentioned trade mark is not such as to lead to the belief that the patent there mentioned is an existing patent, and my said trade mark is not calculated to deceive.

(xviii.) The articles of partnership mentioned in the notice of opposition provided that the goodwill and trade marks of the partnership business should belong to the opponent only in the event of the partnership being dissolved by effluxion of time. The said partnership was dissolved at an earlier date by common consent, and the provisions of the said articles were varied in such manner that the goodwill and trade marks devolved upon the opponent and myself equally.

(xix.) The trade mark to which my above-mentioned application relates was used by me in my business concurrently with the opponent before the 13th day of August, 1875, and is an old trade mark, and was not used by any other person in the same trade, and I am therefore entitled to registration notwithstanding the opponent's registration.

(xx.) The opponent uses his trade mark No. only by stamping it on his goods. I only use mine by placing it on the wrappers in which the goods are placed; and the concurrent use of the two trade marks in such different ways is not calculated to deceive. I have used my trade mark for years, and am willing to undertake to use it in the future only as I have hitherto used it.

(xxi.) The opponent uses his trade mark No. only on goods exported by him to [the Colonies and the United States]. I only use mine in [the United Kingdom]; and the concurrent user of the two trade marks in such different parts of the world cannot deceive. I am willing [as in (xx.)].

(xxii.) The word , which forms part of my above-mentioned trade mark No. , and also of the opponent's registered mark No. , is a mere word of description, and is not an essential particular of the opponent's said registered mark, nor has he any exclusive rights therein by reason of his registration.

3. Form of Statutory Declaration in Support of Application or Opposition.

Patents, Designs, and Trade Marks Acts, 1883-8.

Trade Marks.

In the matter of an application by , for the registration of a trade mark No. ,
and
In the matter of the opposition thereto, No. , by .

I of , a member of the firm of , the above-named applicants [*or* opponents], do hereby solemnly and sincerely declare as follows:—

1.

2.

3.

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

Signed

Declared at
this day of
before me, (*a*).

---

4. Form of Case on Appeal to the Board of Trade.

[Heading as in Form 3, but omitting the reference to the opposition, if the appeal is from the comptroller's spontaneous refusal.]

Case on Appeal to the Board of Trade (*b*).

1. [Set out the material facts of the case in numbered
2. paragraphs.
3.
4.

The appellants submit that, under the circumstances hereinbefore stated, the decision of the comptroller should be reversed, and the appellants' trade mark No. above

(*a*) See Rule 61. (*b*) To accompany Form H.

mentioned should be admitted to registration [*or* as the case may be] on the following grounds:—

1. Because, &c.
2. Because, &c.

[The matters with which this appeal is concerned are of great importance to the appellants, and the appellants are desirous that the same may be referred to the decision of the Court, under § 62 [*or* 69] of the above-mentioned Acts.]

Signed

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5. SPECIAL CASE.

In the High Court of Justice, 18 . B. No. .
Chancery Division.
Mr. Justice .

Between [*A.B.*], Plaintiff,
and
[*C.D.*], Defendant.

Special case stated for the opinion of the High Court of Justice, pursuant to the Patents, Designs, and Trade Marks Acts, 1883-8, and the Rules made thereunder.

1. [The facts necessary to enable the Court to determine
2. the rights of the parties must be stated concisely in
3. numbered paragraphs.]
4.

The questions submitted for the opinion of the Court are:

1. Whether the plaintiff *A.B.*, or the defendant *C.D.*, or either of them, is entitled to have his name entered in the register of trade marks kept under the authority of the above-mentioned Acts as the proprietor of the said trade mark, or whether both of them are so entitled.
2. By whom the costs of this special case should be paid.

E. F., Solicitor for Plaintiff.
G. H., Solicitor for Defendant.

Note.—This special case is filed by *E. F.* of , Solicitor for the above-named Plaintiff.

6. Summons for Leave to Register.

In the High Court of Justice,
Chancery Division.
Mr. Justice .

In the matter of an application by *A. B.* for the registration of a trade mark No. ,
and
In the matter of the opposition thereto, No. of *C. D.*,
and
In the matter of the Patents, Designs, and Trade Marks Acts, 1883-8.

Let all parties concerned attend at the chambers of Mr. Justice , at the Royal Courts of Justice, on , the day of , 18 at o'clock in the noon, upon the application of the above-named *A. B.*, that the Comptroller-General of Patents, Designs, and Trade Marks may be directed to proceed with the above-mentioned application of the said *A. B.* [notwithstanding the above-mentioned opposition thereto of *C. D.*] *or* [notwithstanding the registration of *C. D.'s* trade mark No.], *or* [notwithstanding the registration of *C. D.'s* trade mark No. in the Sheffield register].

Dated the day of 18 .

(Seal)

This summons was taken out by *E. F*, of , Solicitor for the above-named *A. B.*

To the Comptroller-General of Patents, Designs, and Trade Marks, *or where there is an opposition*, To the above-named *C. D.*

The following note to be added to the original summons, and when the time is altered by indorsement the indorsement to be referred to as below.

Note.—If you do not attend either personally or by your solicitor at the time and place above mentioned [*or*, at the place above mentioned at the time mentioned in the indorsement hereon] such order will be made and proceedings taken as the judge may think just and expedient.

7. Notice of Motion for Leave to Register.

[Heading as in No. 6.]

Take notice that the Court will be moved before the Hon. Mr. Justice on the day of 18 , or so soon thereafter as counsel can be heard, by Mr. , of counsel on behalf of the above-named *A. B.*, that you [*or* that the Comptroller-General of Patents, Designs, and Trade Marks] may be directed to proceed [as in No. 6].

Dated the day of , 18 .

(Signed) *E. F.* of , Solicitor for the above-named *A. B.*

To the Comptroller-General of Patents, Designs, and Trade Marks, *or, if there is an opposition,*
To *Mr. C. D.*

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8. Notice of Motion for Leave to Add to, Alter, a Registered Trade Mark.

In the High Court of Justice,
Chancery Division.
Mr. Justice

In the matter of the registered trade mark No. of *A. B.*
and
In the matter of the Patents, Designs, and Trade Marks Acts 1883-8.

Take notice [as in No. 7 to—that] leave may be given to add to the above-mentioned trade mark in the register of trade marks [the words " ," *or*, as the case may be], *or*, that leave may be given to alter the registration of the above-mentioned trade mark in the following respects, that is to say by [diminishing the size of the words and altering the address from to , *or*, as the case may be].

[Dated and signed as in No. 7.]

To the Comptroller-General of Patents, Designs, and Trade Marks.

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9. Notice of Motion for the Rectification of the Register.

[Heading as in No. 8.]

Take notice [as in No. 7 to—behalf of] *C. D.* of , that the register of trade marks kept under the authority of

the above-mentioned Acts may be rectified [by removing therefrom the above-mentioned trade mark No.], *or* [by adding to the registration of the above-mentioned trade mark No. a note disclaiming any exclusive right in the above-named *A. B.* to the use of the word], *or* [by adding, &c., &c., a note stating that the above-named *A. B.* is only entitled to use the same in respect of goods intended for export to], *or* [by adding, &c., &c., entitled to use the same by placing it upon the wrappers in which the goods are sold, and not by placing it upon the goods themselves], *or* [by limiting the registration of the above-mentioned trade mark No. to (describe the goods), and not allowing it to remain in respect of all the goods in class], *or* that such further or other order may be made for the rectification of the said register as to the Court shall seem just.

[Dated and signed as in No. 7.]

To Mr. *A. B.* and the Comptroller-General of Patents, Designs, and Trade Marks.

PART III.

FORMS FOR USE IN ACTIONS FOR INFRINGEMENT (*a*).

1. Writ of Summons, with Indorsement.

In the High Court of Justice., 18 . B. No. .
Chancery Division.
Mr. Justice .

Between *A. B.*, Plaintiff,
and
C. D., Defendant.

Victoria, by the Grace of God, &c.

To *C. D.*, of , in the county of .

We command you that within eight days after the service of this writ on you, inclusive of the day of such service, you do cause an appearance to be entered for you in an action at the suit of *A. B.*; and take notice that in default of your so doing the plaintiff may proceed therein, and judgment may be given in your absence.

Witness, Hardinge Stanley Baron Halsbury, Lord High Chancellor of Great Britain, the day of , in the year of our Lord one thousand eight hundred and .

Memorandum to be subscribed on the writ.

N.B.—This writ is to be served within twelve calendar months from the date thereof, or, if renewed, within six calendar months from the date of the last renewal, including the day of such date, and not afterwards.

The defendant [*or* defendants] may appear hereto by entering an appearance [*or* appearances] either personally or by solicitor at the Central Office, Royal Courts of Justice, London.

(*a*) See Schedules to Rules of Supreme Court.

Indorsement to be made on the writ before issue thereof.

The plaintiff's claim is for an injunction to restrain the defendant from [*see forms of Injunction in Part IV. of this Appendix*], and for an account or damages;
or The plaintiff's claim is for damages for wrongfully using [*or* imitating] the plaintiff's trade mark, and for an injunction to restrain, &c.
This writ was issued by the said plaintiff, who resides at ;
or, This writ was issued by *E. F.* of , whose address for service is , solicitor for the said plaintiff, who resides at ;
or, This writ was issued by *G. H.* of , whose address for service is , agent for *E. F.* of , solicitor for the said plaintiff, who resides at [*mention the city, town, or parish, and also the name of the street and number of the house of the plaintiff's residence, if any.*]

Indorsement to be made on the writ after service thereof.

This writ was served by me at on the defendant on the day of , 18 .

Indorsed the day of 18 .
(Signed)
(Address)

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2. Notice of Motion for Injunction.

[Heading as in No. 1.]

Take notice that the Court will be moved before the Hon. Mr. Justice on the day of 18 , or so soon thereafter as counsel can be heard, by [Mr. of] counsel for the above-named plaintiff, that an injunction may be granted to restrain the defendant, &c., until judgment in this action or further order, from [*see Part IV. of this Appendix*] [and take also notice that special leave to serve you with this [short] notice for the day aforesaid [with the writ of summons] has been obtained from the said Mr. Justice].

Dated the day of 18 .

(Signed) *E. F.* of ,
Solicitor for the above-named Plaintiff.

To the Defendant *C. D.*

3. Statement of Claim.

[Heading as in No. 1, inserting above the title of the action—"Writ issued the day of , 18 ."

Statement of Claim (*a*).

1. The defendant has infringed the plaintiff's trade mark.
2. The trade mark is [*describe it*].

(*If the plaintiff is not the original proprietor the trade mark, show shortly how his title is derived.*)

3. The following are the acts complained of, viz.:—

(*Set them out.*)

The plaintiff claims an injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade mark, and in particular from [*see forms of Injunction in Part IV. of this Appendix*].

The plaintiff also claims an account or damages.

(Signed)

(Delivered)

(*a*) The above is the form appended to the Rules of Court, 1883, but it is thought that fuller particulars will usually be required. Forms 3 (i.), 3 (ii.), and 3 (iii.) are therefore suggested.

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3 (i.). [Heading as above.]

Statement of Claim.

1. The plaintiff is the registered proprietor of a trade mark [consisting of] (*a*), which was advertised in the "Trade Marks Journal" of the day of , 18 , and is registered for in Class [the date of such registration being the day of , 18] (*b*).

2. The defendant has infringed the plaintiff's said trade mark in manner following; that is to say [he has].

[3. The plaintiff has applied to the defendant to desist from his wrongful acts aforesaid, but he has refused (*or* neglected) so to do] (*c*).

4. The defendant has made considerable profits by selling goods not being the plaintiff's goods under the trade mark of which the plaintiff complains [*or* in manner aforesaid].

5. The plaintiff has sustained considerable damage from the defendant's wrongful acts aforesaid.

The plaintiff claims—

1. An injunction [as above].

2. An account of profits or damages and delivery up to him of all goods in the possession or power of the defendant having thereon the trade mark of which complaint is hereby made in order that such trade mark may be obliterated therefrom, and also delivery up to him for the purpose of destruction of all copies in the possession or power of the defendant of the said trade mark and of all blocks, dies, or other apparatus in the like possession or power adapted for the production of the said trade mark.

3. Costs.

(*a*) The trade mark need not be described unless the nature of the infringement renders it necessary.

(*b*) The date of registration may be omitted, if not more than five years before writ issued.

(*c*) Though previous application is not necessary, if it has been made, it should be mentioned.

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3 (ii.). [Heading as above.]

Statement o Claim.

1. [As in 3 (i.), omitting the description of the plaintiff's trade mark].

2. The said trade mark consists of [*or* contains] the device of a [lion], and the plaintiff's goods bearing such trade mark are extensively known in the [Indian] markets as ["Lion"] goods, and are frequently ordered and invoiced under that name.

3. No other goods of the same kind are or ever have been known in the [Indian] markets as ["Lion"] goods.

4. The defendant is using on goods intended for export to the [Indian] markets a trade mark [*or* label, *or* wrapper] on which he places the device of a [lion], and such user is calculated to deceive by inducing purchasers to buy the defendant's goods in the belief that they are buying those of the plaintiff.

5. [As in 3 (i.), par. 4].

6. [As in 3 (i.), par. 5].

The plaintiff claims [as in 3 (i.). For form of injunction, see that in *Orr-Ewing & Co. ohnston & Co.*, Part IV., No. 4, *infrà*].

3. (iii.). [Heading as above.]

Statement of Claim (*a*).

1. The plaintiff has for years last past and upwards offered for sale and sold [a preparation for the human hair] of his manufacture under the title of [Robinson's Hair Stimulant], and previously to the defendant commencing his wrongful acts hereinafter stated no other person except the plaintiff offered for sale or sold under that title any similar preparation.

2. The plaintiff offers for sale and sells and always has offered for sale and sold [his said preparation] in bottles of a peculiar and distinctive shape packed in cases which are also of a peculiar and distinctive shape; and previously to the defendant commencing his wrongful acts hereinafter stated no other person except the plaintiff used for the purposes of trade in any [preparation for the human hair] bottles or cases similar in shape to the plaintiff's bottles and cases.

3. The plaintiff has recently ascertained as the fact is that the defendant for the purpose of passing off his goods as and for the plaintiff's goods is offering for sale and selling [a preparation] not of the plaintiff's manufacture under the title of [Robinson's Hair Stimulant], and in bottles similar in shape to the plaintiff's bottles and packed in cases similar in shape to the plaintiff's cases, whereby divers persons have been induced to purchase the defendant's [preparation] as and for the goods of the plaintiff [*or* and such acts are calculated to induce, &c.].

4. The defendant has made considerable profits by selling his goods as and for the goods of the plaintiff.

5. [As in 3 (i.), par. 5.]

The plaintiff claims—

1. An injunction to restrain the defendant, his servants and agents, from passing or attempting to pass off the defendant's goods as or for the plaintiff's goods, and in particular from offering for sale or selling any [preparation for the human hair] not of the plaintiff's manufacture by means of the use of the title [Robinson's Hair Stimulant], and by means of the use of bottles similar in shape to the plaintiff's bottles, and by means of the use of cases similar in shape to the plaintiff's cases, or by any of such means [*or* as may be].
2. An account of profits or damages.
3. Costs.

(*a*) This is intended for a case in which no trade mark has been registered.

4. Defence.

[Heading as in No. 1.]

Defence (*a*).

The defendant says that :—

1. The trade mark is not the plaintiff's.
2. The alleged trade mark is not a trade mark.
3. The defendant *did not infringe.*

(Signed)
(Delivered)

(*a*) The above is the form appended to the Rules of Court, 1883, but a fuller form varying with the nature of the defence will generally be required.

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5. Reply.

[Heading as in No. 1.]

Reply.

The plaintiff as to the defence says that :—

1.
2.

(Signed)
(Delivered)

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6. Summons to Stay Proceedings by Consent, the Defendant submitting to an Injunction.

[Heading as in No. 1.]

Let all parties concerned attend at the chambers of Mr. Justice at the Royal Courts of Justice on the day of , 18 , at o'clock in the noon, on the hearing of an application on the part of the above-named defendant that the defendant submitting to a perpetual injunction restraining [*see forms of Injunction in Part IV. of this Appendix, infrà*] and submitting to pay the plaintiff £ in respect of [damages and] his taxed costs of this action, all further proceedings in this action may be stayed, or that such further or other order may be made as to the judge shall seem just.

Dated the day of , 18 .

This summons was taken out by *G. H.* of , Solicitor for the above-named Defendant.

To the above-named Plaintiff.

PART IV.

PRECEDENTS OF INJUNCTIONS, &c.

1. CROFT *v.* DAY, 7 Beav. 84—90.

Label on Blacking Bottles—Trade Cards—Injunction.

INJUNCTION to restrain the defendant, his servants, &c., "from selling, or exposing for sale, or procuring to be sold, any composition or blacking described as, or purporting to be, blacking manufactured by Day and Martin, in bottles having affixed thereto such labels as in the complainant's bill mentioned, or any other labels so contrived or expressed as, by colourable imitation or otherwise, to represent the composition or blacking sold by the defendant to be the same as the composition or blacking manufactured and sold by John Weston (the manager), for the benefit of the estate of Charles Day, the testator; and from using trade cards so contrived or expressed as to represent that any composition or blacking sold or proposed to be sold by the defendant is the same as the composition or blacking manufactured or sold by John Weston" (*a*).

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2. SEIXO *v.* PROVEZENDE, L. R. 1 Ch. 192—194.

Brand on Casks of Wine—Injunction.

Injunction to restrain the defendants, &c., "from affixing or causing to be affixed to any casks of wine shipped to their orders the brand or marks of a crown and the word *Seixo*, or any other combination of marks or words so contrived as, by colourable imitation or otherwise, to represent the marks or brands of the plaintiff, and from employing any marks or words which shall be so contrived as to represent, or induce the belief, that such wines are Crown Seixo, or the produce of the *Quinta do Seixo*, or otherwise using the word *Seixo* without clearly distinguishing the same from the wine produced by the *Quinta do Seixo*" (*b*).

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3. STEPHENS *v.* PEEL, 16 L. T. N. S. 145.

Labels on Bottles of Ink—Injunction.

Injunction restraining the defendant, &c., "from selling, or exposing, or advertising for sale, or procuring to be sold, any ink or writing fluid

(*a*) Lord Langdale, M. R. (*b*) Wood, V.-C.

in bottles bearing thereon such labels as after mentioned, and from using any labels, or stamps, or advertisements so contrived or expressed as by colourable imitation or otherwise to represent or lead to the belief that the ink sold by the defendant is the ink or writing fluid manufactured by the plaintiffs, and sold by them under the name of 'Stephens' Blue Black Writing Fluid'" (*a*).

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4. ORR-EWING & Co. *v.* JOHNSTON & Co., 7 App. Cas. 219—233.

"Two Elephant" Yarn—Injunction.

Injunction restraining the defendants, &c., "from affixing or causing to be affixed to any Turkey red yarn not dyed by the plaintiffs the ticket marked 'B,' and from using two elephants on any ticket used on Turkey red yarn, without clearly distinguishing such ticket from the plaintiffs' ticket mentioned in the pleadings, being the exhibit marked 'A' referred to in the depositions, or so as to represent or induce the belief that any of the said yarn was dyed by the plaintiffs" (*b*).

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5. READ BROTHERS *v.* RICHARDSON & Co., 45 L. T. N. S. 54—60.

"Dog's Head" Beer for Exportation—Undertaking—Injunction to the Hearing—Costs.

"The plaintiffs by their counsel undertaking to abide by any order this Court may make as to damages in case this Court shall hereafter be of opinion that the defendants have sustained any by reason of this order which the plaintiffs ought to pay, this Court doth order that the defendants, &c., be restrained from using the figure of a dog's head upon any labels, tickets, or wrappers, affixed or applied to bottles of beer or stout sold for exportation or exported by the defendants to any of the Australian Colonies or New Zealand, and from selling for exportation or exporting to any of the said colonies any bottles of beer or stout having affixed or applied thereto any such label, ticket, or wrapper, until judgment in this action or further order; and it is ordered that the plaintiffs' costs of this motion be their costs in the action" (*c*).

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6. BROADHURST *v.* BARLOW, L. J. N. of C., 1872, p. 183.

Stamps on Shirtings—Injunction.

Injunction restraining the defendants, &c., "from stamping, impressing, or affixing, or causing to be stamped, impressed, or affixed on or to

(*a*) Wood, V.-C. (*b*) House of Lords. (*c*) Court of Appeal.

any Spanish shirtings or pieces of white calico manufactured or sold by them, any mark consisting of words in the Turkish, Armenian, and Greek languages, meaning 'exactly 12 yards,' and placed between a figure or crest and the words 'Spanish Shirtings' enclosed in a scroll in the same manner as those are respectively placed in the plaintiff's trade mark, or in any manner only colourably differing therefrom" (*a*).

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7. WOTHERSPOON *v.* CURRIE, L. R. 5 H. L. 508—523.

"Glenfield Starch"—Injunction.

Injunction restraining the respondent, &c., "from using the word 'Glenfield' in or upon any labels affixed to packets of starch manufactured by or for him, and from in any other way representing the starch manufactured by or for him to be 'Glenfield Starch,' and from selling or causing the same to be sold as 'Glenfield Starch,' and from doing any act or thing to induce the belief that starch manufactured by or for him, the respondent, is 'Glenfield Starch,' or starch manufactured by the appellant" (*b*).

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8. FORD *v.* FOSTER, L. R. 7 Ch. 611—634.

"Eureka" Shirts—Injunction.

Injunction restraining the defendants, &c., "from applying th mark or title 'Eureka' to any shirts manufactured by them, or to any shirts sold by them, unless manufactured by the plaintiffs, and from selling any shirts already marked with the mark and title 'Eureka,' unless such mark or title has been applied with the sanction of the plaintiffs; and from issuing any boxes or packages on which the mark or title of 'Eureka' shall be applied to shirts not of the plaintiff's manufacture; and from affixing or using any label, or card, or other mark containin the word 'Eureka' to or upon any shirts not of the plaintiffs' manufacture" (*c*).

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9. APOLLINARIS CO. *v.* NORRISH, 33 L. T. N. S. 242.

"Apollinaris Water"—Injunction.

Injunction restraining the defendants, &c., "from selling, &c., any mineral or other waters, not being the genuine Apollinaris Water, under the name of 'Apollinaris Water,' or 'London Apollinaris Water,' or

(*a*) Wickens, V.-C. (*b*) House of Lords. (*c*) James, L. J.

under any other name of which the word 'Apollinaris' so forms part as to be calculated to deceive the public" (*a*).

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10. CARUNCHO *v.* STEPHENSON, 25 SOL. J. 929.

"La Intimidad" Cigars—Injunction.

Injunction restraining the defendant, &c., "from selling or causing or allowing to be sold, and from in any manner representing, or causing or procuring to be represented, any cigars manufactured, sold, or dealt in by the defendant as 'La Intimidad' cigars, or as cigars manufactured, imported, or sold by the plaintiffs or either of them; and also from affixing, or procuring or causing or allowing to be affixed, to any boxes of cigars manufactured, or bought, or procured, or sold, or attempted to be sold by the defendant, or otherwise using, or employing, or permitting to be used or employed, any labels, wrappers, brands, or marks used by the plaintiffs or either of them, or so contrived or prepared as to represent or lead to the belief that the cigars manufactured or sold by the defendant are cigars manufactured or sold by the plaintiffs or either of them, and from using the words 'La Intimidad' on any cigars, or boxes or wrappers containing cigars, so as to induce the belief that such cigars are manufactured or imported by the plaintiffs or either of them, pending the trial of this action" (*b*).

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11. EDELSTEN *v.* EDELSTEN, 1 De G. J. & S. 185—189.

"Anchor Brand Wire"—Prayer of Bill—Injunction—Account—Delivery up.

Prayer of Bill: "that an account may be taken of the gains and profits made and obtained by the defendants by the sale of wire having tallies or labels attached thereto with the plaintiff's trade mark, or a trade mark in imitation of, or only colourably differing from that of the plaintiff, stamped or impressed thereon; and that the defendants may be ordered to pay to the plaintiff the amount of such gains and profits. That the defendants may be restrained by injunction from attaching to wire, not the manufacture of the plaintiff, any tally or label with the plaintiff's trade mark,

(*a*) Bacon, V.-C. And see also forms of injunctions in *Apollinaris Co.* v. *Edwards*, Seton, 4th ed. 237; *Millington* v. *Fox*, 3 My. & Cr. 338; and Pemberton, 4th ed. 490; *Edelsten* v. *Vick*, 11 Hare, 78; *Collins Co.* v. *Walker*, 7 W. R. 222, and Seton, 4th ed. 235; *Harrison* v. *Taylor*, 11 Jur. N. S. 408, and Pemberton, 4th ed. 490; *Braham* v. *Bustard*, 1 H. & M. 447; *McAndrew* v. *Bassett*, 4 De G. J. & S. 380, and Pemberton, 3rd ed. 239; *Mickle* v. *Emery*, Seton, 4th ed. 234; *Siegert* v. *Findlater*, 7 Ch. D. 801—814; *McLean* v. *Fleming*, 96 U. S. Rep. 245; 13 U. S. Pat. Gaz. 913, 914.

(*b*) Cave, J.

or any mark in imitation thereof, or only colourably differing therefrom, stamped or impressed thereon, and from otherwise using the plaintiff's trade mark, or any mark in imitation thereof, so as to denote or represent that the said wire is the 'Anchor Brand Wire,' or is the manufacture of the plaintiff; and from selling, or offering for sale, or procuring to be sold, any wire not being of the plaintiff's manufacture, having a tally or label attached thereto with the plaintiff's trade mark, or a mark in imitation thereof, or only colourably differing therefrom, stamped or impressed thereon, or otherwise in any manner having the said trade mark, or a mark in imitation thereof, or only colourably differing therefrom, attached thereto. That the defendants may deliver up to be cancelled all tallies, labels, and papers in their possession, or in the possession of their servants or agents, having the said trade mark so in colourable imitation of the plaintiff's as hereinbefore mentioned; and also all tallies, labels, and papers in their possession, or in the possession of their servants or agents, having the plaintiff's trade mark, or any mark in imitation thereof, or only colourably differing therefrom, stamped or impressed thereon, and also all dies for stamping or impressing the same; and that the defendants may pay all the costs of the suit" (*a*).

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12. GUINNESS *v.* ULLMER, 10 L. T. (Old Series), 127.

Engraving Blocks for Printing Forged Labels—Injunction.

Injunction restraining the defendant, &c., "from cutting, engraving, casting, or making, and from causing to be cut, engraved, cast, or made, and also from using or permitting to be used, and from selling or otherwise disposing of or parting with any blocks or plates adapted for printing labels or sheets of labels in imitation of the label furnished by Sparkes Moline to and used by the agents appointed by him for sale of the plaintiffs' stout, as in the plaintiffs' bill mentioned, or any of them, or differing only colourably therefrom. And also from selling or otherwise disposing of, and from delivering over or parting with any of such blocks or plates as are now in their possession, custody, or power, to any person other than the plaintiffs or such person as they shall appoint to receive the same" (*b*).

(*a*) Wood, V.-C., made a decree in the terms of the prayer of the bill. See 1 De G. J. & S. 196; Lord Westbury, C., affirmed the decree. As to the account, see also *Foster* v. *Megevand*, Pemberton, 4th ed. 492; and the full decree in *Ford* v. *Foster*, Seton, 4th ed. 236. As to order restraining exportation of goods with forged trade marks, see *Henderson* v. *Jorss*, Seton, 4th ed. 236. As to order restraining the bringing into the market of imported goods with forged trade marks, see *Upmann* v. *Elkan*, L. R. 12 Eq. 140; 7 Ch. 130; *Rivero* v. *Norris*, Seton, 4th ed. 236; *Del Valle* v. *Mayer*, *ib.*; *Hoet* v. *Pickering*, 6 Ch. D. 770-1; 8 *ib.* 372.

(*b*) Shadwell, V.-C. of Eng.

13. FARINA *v.* SILVERLOCK, 1 K. & J. 509.

Printing Forged Labels—Injunction.

Injunction restraining the defendant, &c., "from printing or selling, or exposing for sale, or procuring to be printed or sold, any labels similar to those in use by the plaintiff, as in the bill in this cause mentioned, or containing copies of the signature, or address, or flourish, seal, or stamp, or other marks invented and used by the plaintiff as therein mentioned, or any signature, address, flourish, seal, stamp, or other mark merely colourably differing therefrom, or any other papers or labels so printed or contrived as, by colourable imitation or otherwise, to represent or lead to the belief that Eau de Cologne prepared by other parties was Eau de Cologne prepared by the plaintiff" (*a*).

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14. LEVER *v.* GOODWIN, 4 P. R. 503.

Order—Action Dismissed as to Trade Mark—Injunction as to get-up of Goods—Account—Costs.

Order "that this action so far as the same claims protection in respect of the Trade Mark No. , stand dismissed out of court. Order that the defendants Goodwin Bros., their agents and servants, be restrained from selling, offering for sale, or disposing of any soap not being manufactured for or by the plaintiffs in the wrapper or of the form of any one of the three exhibits admitted in this action to have been issued by the defendants, and marked A, B, and C, or in any wrapper or in any form calculated or intended to pass off, or to enable others to pass off, such soap as or for the goods of the plaintiffs. Order that the following account be taken: that is to say, an account of the profits made by the defendants in selling or disposing of soap made by or for the defendants in any wrapper such as that contained in the exhibits marked A, B, and C, and in the form of those exhibits. Order that the defendants Goodwin Bros. do, within fourteen days after the date of the chief clerk's certificate to be made pursuant to this order, pay to the plaintiffs Lever & Co. the amount which upon taking such account shall be certified to be payable by the defendants to the plaintiffs. Order that it be referred to the taxing master to tax the costs of the plaintiffs of this action up to and including the trial, except so far as the same have been incurred by their claim for protection in respect of the trade mark aforesaid. Order that it be referred to the taxing master to tax the costs of the defendants of this action so far as the same have been incurred by the plaintiffs setting up the said claim for protection in respect of the said trade mark, and the costs of the plaintiffs when so

(*a*) Wood, V.-C.

taxed are to be set off against the said costs of the defendants when taxed, and the taxing master is to certify to whom, after such set-off, the balance is due. Order that the party from whom such balance shall be certified to be due do pay the amount thereof to the other party. And the question of the costs of this action incurred subsequent to the trial are reserved, and either of the parties are to be at liberty to apply as they may be advised" (*a*).

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15. CLEMENT *v.* MADDICK, 1 Giff. 98—101.

Name of Newspaper—Injunction.

Injunction restraining the defendants, &c., "from printing, publishing, or continuing to print or publish, any newspaper or other periodical paper with or under the name or style of 'The Penny Bell's Life and Sporting News,' or with or under any name or style of which the name, style, or words of 'Bell's Life' shall form a part, or in any way occur [therein]; and from using the said name, style, or title of 'Bell's Life' by way of name, style, or title to any newspaper or periodical without the licence or consent of the plaintiff" (*b*).

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16. INGRAM *v.* STIFF, 5 Jur. N. S. 947.

Name of Newspaper—Injuring Plaintiff's Paper—Injunction.

Injunction restraining the defendant, &c., "from printing, publishing, or selling any newspaper or other periodical under the name of 'The Daily London Journal,' or under any other name or style of which the words 'London Journal' form part, and from doing or committing any act or default which may tend to lessen or diminish the sale or circulation of the plaintiff's periodical, called 'The London Journal'" (*c*).

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17. WALTER *v.* HEAD, 25 Sol. J. 757.

Name of Newspaper—Injunction.

Injunction restraining the defendant, &c., "from printing or publishing any newspaper or other publication in the form of a newspaper with or under the name or title of 'The Times,' and from doing any other act

(*a*) Chitty, J., affirmed by C. A.
(*b*) Stuart, V.-C. And see *Edmonds v. Benbow*, Seton, 3rd ed. 905; *Corns v. Griffiths*, Pemberton, 4th ed. 489; *Mack v. Petter*, 41 L. J. Ch. 782.
(*c*) Wood, V.-C.

in invasion or infringement of the plaintiff's right or interest in the name or title of 'The Times'" (*a*).

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18. PROWETT *v.* MORTIMER, 2 Jur. N. S. 414.

Name of Newspaper—Soliciting Customers—Injunction.

Injunction restraining the defendant, &c., "from printing, or publishing, or exposing for sale, or procuring to be printed or sold, the newspaper publication called 'The True Britannia,' or any other newspaper or publication, as a continuation of the plaintiff's newspaper 'The Britannia,' in the bill mentioned, and from soliciting custom in the name of the plaintiff's trade and business as for 'The Britannia' newspaper" (*b*).

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19. HOGG *v.* KIRBY, 8 Ves. 215—226.

Publication of a Magazine as a Continuation of Plaintiff's Magazine—Injunction.

Injunction restraining the defendant, &c., "from publishing or exposing for sale any copy or copies of the defendant's said work, and from printing, publishing, or exposing for sale, any other work or publication as or being a continuation of the plaintiff's work, or of the defendant's work which has been so published as such continuation as aforesaid; and from printing all or any part or parts of the plaintiff's said work;" and Ordered "that the injunction shall be continued as to any letters, &c., admitted by the Answer to have been received from correspondents by the defendant, while publishing for the plaintiff" (*c*).

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20. AINSWORTH *v.* BENTLEY, 14 W. R. 630.

Publication of Magazine in Breach of Contract—Order—Injunction.

Ordered, "That the defendant, &c., be restrained from carrying on, &c., the said 'Temple Bar Magazine,' but the order to be without prejudice to the publication of the said magazine until the hearing of the cause, so as the name of Bentley do not appear either in the title-page, or in any other part of the said publication, or in any advertisement of the said publication, and this order to be without prejudice to the right (if any) of the plaintiff to damages or profits in respect of any publication of the work" (*d*).

(*a*) Court of Appeal. (*b*) Stuart, V.-C. (*c*) Lord Eldon, C. (*d*) Wood, V.-C.

21. PRINCE ALBERT *v.* STRANGE, 2 De G. & Sm. 652—717.

Etchings Improperly Obtained and Published—Catalogues Improperly Published—Decree—Delivery up—Injunction.

Decree, by which—"Declared that the plaintiff is entitled to have delivered to him the impressions (by the Answer of defendant J. admitted to be in his possession) of such of the several etchings in the pleadings mentioned as in the catalogue and in the pleadings are stated to have been etched by the plaintiff; that is to say (description by reference to Nos. in the catalogue); Ordered, that J. shall, within four days after the service of the decree, deliver up the impressions above specified on oath, and leave them with the Clerk of Records and Writs at the Record Office. Ordered, that the defendant S. shall, within four days after the service of the decree, deliver to the Clerk of Records and Writs, at the said Office, the twenty-five copies of the catalogue, being the same as are mentioned in the decree in the other suit of even date. Similar directions as to six copies of the catalogue admitted by J. to be in his possession. Ordered, that the Clerk of Records and Writs shall destroy those copies of the catalogue, giving notice to the solicitors of the several parties of the time and place at which he intends to do so. Injunction restraining the defendants, &c., from making or permitting to be made any engraving or copy of such etchings, or any of them, and from publishing the same; and from parting with or disposing of them or any of them, except in obedience to the decree; and from selling or in any manner publishing the catalogue, or any work being or purporting to be a catalogue of the etchings made by the plaintiff. Provision made for costs. Liberty to apply reserved" (*a*).

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22. CHAPPELL *v.* SHEARD, 2 K. & J. 117—122.

Name and Title-page of Song—Injunction.

Injunction restraining the defendants, &c., "from printing, publishing, selling, exposing for sale, or otherwise disposing of the song 'Minnie Dale,' or any copy or copies thereof, or any other publication containing a colourable imitation of the name, title, or title-page of the plaintiff's said song" (*b*).

(*a*) Knight-Bruce, V.-C.

(*b*) Wood, V.-C. And see *Emperor of Austria* v. *Day* (V.-C. Stuart, 2 Giff. 628-31; Court of Appeal, 3 De G. F. & J. 217-19), for injunction against printing spurious Hungarian notes, and order for delivery up of plates used in such printing.

23. Morison *v.* Moat, 9 Hare, 241—267.

Name of Patent Medicine—Secret Recipe—Injunction.

Injunction restraining the defendant, &c., "from selling, or causing or procuring to be sold, under the title or designation of 'Morison's Universal Medicine,' or 'Morison's Vegetable Universal Medicine,' any medicine made or manufactured by the defendant, or by or under his order or direction;" and restraining the defendant, &c., "from making or compounding any medicines according to the secret in, &c., and from in any manner using the secret of compounding the said medicines, or any part thereof" (*a*).

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24. Estcourt *v.* Estcourt Hop Essence Co., 31 L. T. N. S. 567.

Hop Essence—Secret Recipe—Trade Name—Representation of Succession in Business—Manufacturing Contrary to Agreement—Injunction.

Injunction restraining the defendants C. Estcourt and the Estcourt Hop Essence Co., &c., "from manufacturing, or selling, or advertising for sale, an article called 'Hop Essence,' or any other substance identical with or only colourably differing from the 'Hop Supplement' manufactured and sold by the plaintiffs, and from using or disclosing to any persons the secret of compounding the said 'Hop Supplement'; and also restraining the defendant company from trading under the name of 'The Estcourt Hop Essence Co., Limited,' and from using any designation, either of the vendors or of the substance offered for sale, calculated to lead purchasers into the belief that such substance is the 'Hop Supplement' manufactured by the plaintiffs, or equivalent or substantially equivalent thereto, or that they, such defendants, or any of them, are the successors in business of the plaintiffs' firm, or the original firm who manufactured and sold the said article; and also restraining the defendant C. Estcourt from carrying on or being connected with the business of manufacturing or selling any substance intended to be used as a substitute for hops in brewing" (*b*).

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25. Franks *v.* Weaver, 8 L. T. (Old Series), 510.

Fraudulently using Another's Testimonials—Injunction.

Injunction restraining the defendant, &c., "from making, vending, or offering for sale, or in any manner disposing of any preparation, mixture, compound, or nostrum, having around, or upon, or in

(*a*) Turner, V.-C. And see *Ansell* v. *Gaubert*, Seton, 4th ed. 235; *Weston* v. *Hemmons*, 2 Vict. L. R. Eq. 121.

(*b*) Malins, V.-C. The injunction was afterwards rescinded, but on grounds independent of the form of it. L. R. 10 Ch. 276.

connection with the same, or the bottles or other vessels containing the same, any cover, wrapper, envelope, label, bill, circular, notice advertisement, or other formula, in the terms or to the purport or effect of the cover, wrapper, envelope, label, bill, circular, notice, advertisement, or other formula, in the plaintiff's bill stated to have been used by the said defendant, or any other cover, &c., containing any testimonial in favour of the plaintiff's medicine or medical preparation in the said bill described as 'Franks' Specific Solution of Copaiba,' or in which any statement or representation is made or contained indicating, or implying, or tending to induce the public or purchasers to suppose that such preparation, mixture, compound, or nostrum is the same as 'Franks' Specific Solution of Copaiba,' or referred to in connection with any preparation, mixture, compound, or nostrum, made, vended, or disposed of by the said defendant, or in which any use is made of the character and reputation of the plaintiff, or his said specific solution of copaiba, and from publishing or circulating, or causing to be published or circulated, or in any manner using such cover, &c., as aforesaid" (*a*).

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26. KNOTT *v.* MORGAN, 2 Keen, 213—219.

Imitating a Rival Line of Omnibuses—Injunction.

Injunction restraining the defendant, &c., "from running, or in any manner using, or causing to be used, for the conveyance of passengers, his omnibus in the bill mentioned, or any other omnibus, having painted, stamped, printed, or written thereon the words or names 'London Conveyance' or 'Original Conveyance Company,' or any other names, words, or devices painted, stamped, printed, or written thereon, in such manner as to form or to be a colourable imitation of the names, words, and devices painted, stamped, printed, or written on the omnibuses of the plaintiff" (*b*).

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27. GLENNY *v.* SMITH, 2 Dr. & Sm. 476.

Trade Name—Injunction.

Injunction restraining the defendant, &c., "from continuing to use, or from exhibiting or using the words 'Thresher and Glenny,' or the name of the plaintiffs' said firm in any form in or about his said shop in such a way as to deceive the public, or to lead to the belief that his shop is a shop of the plaintiffs, or that the business carried on there

(*a*) Lord Langdale, M. R.

(*b*) Lord Langdale, M. R. The M. R. altered the form so as not to restrain all use of the words "London Conveyance Company"

is carried on by the plaintiffs, or is in any way connected with the business of the plaintiffs" (*a*).

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28. M. MELACHRINO & Co. *v.* R. MELACHRINO & Co., May 27th, 1888.

Name of Firm—"Original"—Injunction.

Injunction restraining the defendants, &c., "from carrying on business as dealers in cigarettes under the name of 'R. Melachrino & Co,' or under any other name containing the name 'Melachrino' so arranged or contrived as to represent or lead to the belief that the business so carried on is the business carried on by the plaintiffs, or is in any way connected with the business of the plaintiffs, and from using the name 'Melachrino' in any other manner calculated to represent or lead to such belief; and from selling or offering or exposing for sale, or procuring to be sold, any cigarettes not of the manufacture or merchandise of the plaintiffs, with statements that such cigarettes are 'Original Melachrino Cigarettes,' and from in any other manner selling or passing off their cigarettes as or for 'Original Melachrino Cigarettes,' or cigarettes of the manufacture or merchandise of the plaintiffs" (*b*).

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29. HENDRIKS *v.* MONTAGU, 17 Ch. D. 638-3-947.

Name of Company—Registration—User—Advertisement, &c.—Injunction.

Injunction restraining the defendants "from applying to the Registrar of Joint Stock Companies in England for registration under the Companies Acts of any company to be incorporated under the name of 'The Universe Life Assurance Association,' or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as 'The Universal Life Assurance Society'; from issuing or publishing advertisements, circulars, or prospectuses representing that a company is to be incorporated pursuant to the Companies Act, 1862, under the name of 'The Universe Life Assurance Association, Limited,' or any such other name as aforesaid; and from carrying on or commencing any business under the name of 'The Universe Life Assurance Association, Limited,' or any such other name as aforesaid" (*c*).

(*a*) Kindersley, V.-C. And see *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Hookham* v. *Pottage*, L. R. 8 Ch. 92; *James* v. *James*, Seton, 4th ed. 237; *Montague* v. *Moore*, *ib.* 238; *Cave* v. *Myers*, *ib.* 238; *Fullwood* v. *Fullwood*, 38 L. T. N. S. 381.

(*b*) Chitty, J.

(*c*) Court of Appeal.

30. Lee *v.* Haley, L. R. 5 Ch. 155.

Name of Company—Injunction against User within a certain Locality.

Injunction restraining the defendant, &c., "from continuing to use, and from exhibiting or using the words 'The Pall Mall Guinea Coal Company,' in Pall Mall, or any other name or style so framed as to be a colourable imitation of the name or style in which the plaintiffs' branch business mentioned in the bill is carried on, or so as to deceive the public, or to lead to the belief that the business carried on by the defendant is the same as the business carried on by the plaintiffs under the name or style of 'The Guinea Coal Company,' or is in any way connected therewith" (*a*).

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31. Wheeler *v.* Johnston, 3 L. R. Ir. 284.

Name of Mineral Springs—Injunction.

Injunction restraining the defendant, &c., "from using the words 'Cromac Springs' in connection with his trade or business as a manufacturer or seller of mineral waters, so as to represent that his said waters are so manufactured or sold by the plaintiffs at their works in the bill mentioned, called 'The Cromac Springs,' and from using the words 'Cromac Springs' as the name of the defendant's place of business so as to represent as aforesaid" (*b*).

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32. Braham *v.* Beachim, 7 Ch. D. 848—857.

Name of Collieries—Injunction until certain events.

Injunction restraining the defendants, "unless and until they shall acquire a colliery or coal mine within the parish of Radstock, from trading under or using the name or style of 'The Radstock Colliery Proprietors,' or any other name or style signifying that the defendants, or either of them, are proprietors of any colliery or collieries at Radstock"; and restraining the defendants, "unless and until they shall become authorised to sell or supply any coals raised or gotten from any colliery or coal mine within the parish of Radstock, from using any style or name signifying or implying that the defendants are selling or supplying, or are authorised to sell or supply, any coal raised or gotten from any colliery or coal mine within the parish of Radstock" (*c*).

(*a*) Malins, V.-C. (*b*) Chatterton, V.-C. of I. (*c*) Fry, J.

33. Scott *v.* Scott, 16 L. T. N. S. 143.

False Representation of Continuation of Business—Injunction.

Injunction restraining the defendants, &c., "from allowing or permitting the brass plate affixed by the defendants to the door of the premises in Regent Street to remain affixed, with any inscription thereon representing or holding out to the customers of the late partnership of 'R. & W. Scott,' or to any other persons whatsoever, that they are carrying on business in continuation of, or in succession to, the business carried on by the late firm of 'R. & W. Scott'" (*a*).

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34. Burrows *v.* Foster, 1 N. R. 156.

False Representation of Continuation of Business—Soliciting former Customers—Injunction.

Injunction restraining the defendant, &c., "from issuing or sending, and from causing or procuring to be issued or sent, to any person or persons any further copies or copy of the circular or letter bearing date the , in the plaintiffs' bill mentioned, or any other circular or letter signifying or importing that the business carried on by him the said defendant is, and from in any manner representing such business to be a continuation of the business formerly carried on by the firms of Foster, Lacy & Co., and Bashall, Lacy & Co., in the plaintiffs' bill mentioned, or by either of such firms, and from in any manner soliciting or inviting any person or persons who, at the date of the indenture of the , in the plaintiffs' bill mentioned, was or were a customer or correspondent, customers or correspondents, of the firms of Foster, Lacy & Co., and Bashall, Lacy & Co., or of either of such firms, and from causing or procuring any such person or persons to be solicited or invited to become or be a customer or correspondent or customers or correspondents of, or to employ him the said defendant in the business carried on by him, or to cease from employing or not to employ the said plaintiffs in the business formerly carried on by the said firms of Foster, Lacy & Co., and Bashall, Lacy & Co., or either of them" (*b*).

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35. Massam *v.* Thorley's Cattle Food Co., 14 Ch. D. 748—762.

False Representation of Continuation of Business—Trade Name—Labels—Advertisements—Circulars—Injunction.

Injunction restraining the defendants, &c., "from selling, shipping, or exporting, or causing or procuring or allowing to be sold, shipped, or

(*a*) Wood, V.-C. And see *Hoffman v. Duncan*, Seton, 4th ed. 256; *Witt* v. *Corcoran*, *ib.* 257; *Graveley* v. *Winchester*, *ib.* 257; *England* v. *Curling*, 8 Beav. 129

(*b*) Turner, L. J.

exported, and from in any manner representing, or causing or procuring to be represented, any goods manufactured by the defendant company as the manufacture or goods of the late Joseph Thorley, or of the plaintiffs, his trustees and successors in business; and also from in any manner representing, or causing or procuring to be represented, or doing anything which shall lead to the belief that the defendant company have been or are carrying on the business of the late Joseph Thorley; and also from affixing, or permitting or causing to be affixed to any goods or articles manufactured, or bought, or procured, or sold, or shipped, or exported by the defendant company, or otherwise using or employing, or permitting to be used or employed, any labels, wrappers, or marks used by the late Joseph Thorley and the plaintiffs, his trustees and successors in business, or so contrived and prepared as to represent or lead to the belief that the goods or articles manufactured, or sold, or shipped, or exported by the defendant company, are the goods or manufacture of the late Joseph Thorley or of the plaintiffs; and also from employing, using, or circulating, or causing to be employed, used, or circulated, any circulars, pamphlets, notices, or advertisements of the late Joseph Thorley or of the plaintiffs, or which shall in any manner represent or lead to the belief that the defendant company have been or are carrying on the business of the late Joseph Thorley, or that they are his successors in business" (*a*).

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36. LABOUCHERE *v.* DAWSON, L. R. 13 Eq. 322—327.

Soliciting former Customers, after Sale of Business—Injunction.

Injunction restraining the defendant, &c., "from applying to any person who was a customer of the firm of B. Dawson & Co. prior to the , privately by letter, personally, or by a traveller, asking such customer to continue to deal with the defendant, or not to deal with the plaintiffs, the Kirkstall Brewery Co., Limited" (*b*).

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37. WHEELER & WILSON MANUFACTURING CO. *v.* SHAKESPEAR, 39 L. J. Ch. 36—38—41.

False Representation of Agency—Injunction.

Injunction restraining the defendant, &c., "from, in manner aforesaid, or in any other manner, calling, or describing, or representing, his said shop or place of business, No. 32, Union Street, Birmingham, or

(*a*) James, L. J.

(*b*) Lord Romilly, M. R. After *Pearson v. Pearson*, 27 Ch. D. 145, this form is only applicable where there is a breach of an actual stipulation. See also *Leggott v. Barrett*, 15 Ch. D. 306; and *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191. As to opening letters containing orders intended for another firm, see *Scheile v. Brakell*, 11 W. R. 796; and Seton, 4th ed. 253; *Witt v. Corcoran*, Seton, 4th ed. 257; *England v. Curling*, 8 Beav. 129.

any other shop, warehouse, or place, not belonging to the plaintiffs, as 'The Original Wheeler & Wilson Sewing Machine Depôt,' or 'Wheeler & Wilson Sewing Machine Depôt, established in 1860,' or as a place of business of the plaintiffs, or of 'Wheeler & Wilson,' manufacturers of sewing machines; and from in manner aforesaid, or in any other manner, calling, or describing, or representing, himself or his said firm of T. Shakespear & Co., as the agent or agents for the American 'Wheeler & Wilson' sewing machines, in the same manner in which he has been since 1860, or as the agent of the 'Wheeler & Wilson' sewing machines; and from in any other manner representing himself as the agent of the plaintiffs, and from permitting the names 'Wheeler & Wilson' to remain over the door of his shop or business premises, at 32, Union Street, Birmingham, or on the brass plate under the window, or on the brass plate on the door jamb, or on any other part of his said shop or place of business, or on any placard in his said shop, or on the door, or in the window thereof; and from causing the names 'Wheeler & Wilson' to be inserted in any railway time-table, or directory, or other book or publication, under the head of, or described as sewing machine manufacturers, as residing or carrying on business at No. 32, Union Street, Birmingham, or as in any other manner connected with that or any other shop or place of business of the said defendant, and from doing any other act, matter, or thing representing, or whereby the trade or the public may be led to believe that the defendant has any connection whatever in business with the plaintiffs" (*a*).

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38. James *v.* James, 41 L. J. Ch. 358.

Fraudulent Disuse of Christian Name—Claim to be the "Only Genuine" —Injunction.

Injunction restraining the defendant, &c., "from using the name of 'Robert James' singly, instead of 'Robert Joseph James,' or 'R. J. James'; also from stating or inserting in his advertisement or circular any words or expressions asserting or suggesting that the ointment manufactured and sold by the plaintiffs is spurious and not genuine" (*b*).

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39. Liebig's Extract of Meat Co. *v.* Anderson, 55 L. T. N. S. 209.

Claim to be the only Genuine—Injunction.

Injunction restraining the defendant, &c., "from using the wrappers or making the advertisements complained of containing the words 'This is the only genuine' with reference to the Liebig's Extract of Meat sold or offered for sale by the defendant, and from using any other wrapper or making any other advertisement with reference to such extract sold or

(*a*) James, V.-C. (*b*) Lord Romilly, M.R.

offered for sale by the defendant, representing that such extract as the defendant's brand of such extract is the only genuine" (*a*).

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40. THORLEY'S CATTLE FOOD CO. *v.* MASSAM, 14 Ch. D. 763—781.

Trade Libel—Representation that the Plaintiffs' Goods are Spurious—Injunction.

Injunction restraining the defendants, &c., "from advertising, or representing, or suggesting in their advertisements or circulars that they are alone possessed of the secret for compounding the condiment known as 'Thorley's Food for Cattle,' and from representing, or suggesting, or doing anything calculated to represent or suggest, that the cattle food manufactured and sold by the plaintiffs is spurious or not genuine" (*b*).

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41. THOMAS *v.* WILLIAMS, 14 Ch. D. 864—875.

Trade Libel—Representation that the Plaintiff's Goods are Spurious—Injunction.

Injunction restraining the defendants, &c., "from issuing or permitting the issue of the circular dated the , and from in any manner representing or suggesting that the goods now made or sold by the plaintiff are imitations of the goods made or sold by J. Thomas & Sons, or Edmund Holyoake" (*c*).

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42. ROUTH *v.* WEBSTER, 10 Beav. 561—563.

Unauthorised and Injurious Use of a Person's Name—Injunction.

Injunction restraining the defendants, &c., "from printing, publishing, or circulating, any prospectus or other document of, or relating to, a certain company called 'The Economic Conveyance Company,' mentioned and referred to in the plaintiff's bill in this cause, with the plaintiff's name thereto, and from in any manner using the name of the plaintiff so as to identify him as a party interested in, or associated with, the said company" (*d*).

(*a*) Chitty, J.
(*b*) Malins, V.-C., affirmed by C. A.
(*c*) Fry, J.
(*d*) Lord Langdale, M. R.

APPENDIX C.

INTERNATIONAL ARRANGEMENTS.

(*See Patents, &c., Acts*, 1883-8, § 103, *suprà*.)

I.

International Convention for the Protection of Industrial Property.

Signed at Paris, March 20th, 1883.

[*Ratifications exchanged at Paris, June 6th*, 1884.]

(*Official Translation.*)

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a convention to that effect, and have named as their plenipotentiaries, that is to say:—

(*Here follow the appointments of the plenipotentiaries.*)

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles:—

ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a union for the protection of industrial property.

ARTICLE II.

The subjects or citizens of each of the contracting states shall, in all the other states of the union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each state.

ARTICLE III.

Subjects or citizens of states not forming part of the union, who are domiciled or have industrial or commercial establishments in the territory of any of the states of the union, shall be assimilated to the subjects or citizens of the contracting states.

ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the contracting states, shall enjoy, as regards registration in the other states, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other states of the union before expiry of these periods shall not be invalidated through any acts accomplished in the interval: either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

ARTICLE V.

(Relates only to Patents.)

Article VI.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the union (*a*).

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

Article VII.

The nature of the goods on which the trade mark is to be used can, in no case, be an obstacle to the registration of the trade mark.

Article VIII.

A trade name shall be protected in all the countries of the union, without necessity of registration, whether it form part or not of a trade mark.

Article IX.

All goods illegally bearing a trade mark or trade name may be seized on importation into those states of the union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

Article X.

The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

(*a*) No effect can be given to this or any other article of the convention by the Courts of the United Kingdom, except so far as it is embodied in § 103 of the Patents Act, 1883: *In re Californian Fig Syrup Co.*, 40 Ch. D. 620. And similarly in the United States legislation is necessary to enable effect to be given to it. See opinion of the Attorney-General of the United States, 47 U. S. Pat. Gaz. 397.

ARTICLE XI.

The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognised international exhibitions.

ARTICLE XII.

Each of the high contracting parties agrees to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

ARTICLE XIII.

An international office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the contracting states, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the states of the union.

ARTICLE XIV.

The present convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the union.

To this end conferences shall be successively held in one of the contracting states by delegates of the said states. The next meeting shall take place in 1885 at Rome.

ARTICLE XV.

It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present convention.

ARTICLE XVI.

States which have not taken part in the present convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation,

and by the latter to all the others. It shall imply complete accession to all the clauses and admission to all the advantages stipulated by the present convention.

Article XVII.

The execution of the reciprocal engagements contained in the present convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

Article XVIII.

The present convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing state, the convention remaining in operation as regards the other contracting parties.

Article XIX.

The present convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective plenipotentiaries have signed the same, and have affixed thereto their seals.

Dated at Paris the 20th March, 1883.

(*Signed by the Plenipotentiaries.*)

II.

Final Protocol.

(*Official Translation.*)

On proceeding to the signature of the convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed as follows:

1. The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. (Relates only to Patents.)

3. The last paragraph of Article II. does not affect the legislation of each of the contracting states as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any state of the union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that state; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other articles of the convention, the internal legislation of each state remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organisation of the special department for industrial property mentioned in Article XII. shall comprise, so far as possible, the publication in each state of a periodical official paper.

6. (After providing for the common expenses of the international office, continues:—)

The Swiss Government will superintend the expenses of the international office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The international office will centralise information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement which will be distributed to all the administrations. It will interest itself in all matters of common utility to the union, and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language dealing with questions regarding the object of the union.

The numbers of this papor, as well as all the documents published by the international office, will be circulated among the administrations of the states of the union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said administrations, or by societies or private persons, will be paid for separately.

The international office shall at all times hold itself at the

service of members of the union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The administration of the country in which the next conference is to be held will make preparation for the transactions of that conference, with the assistance of the international office.

The director of the international office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the union.

The official language of the international office will be French.

7. The present final protocol, which shall be ratified together with the convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said convention.

In witness whereof the undersigned plenipotentiaries have drawn up the present protocol.

(*Signed by the Plenipotentiaries.*)

III.

Accession of Her Majesty's Government to the Convention.

The undersigned, ambassador extraordinary and plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that convention to States not parties to the original convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said international convention for the protection of industrial property, and to the said protocol, which are to be considered as inserted word for word in the present declaration, and formally engages, as far as regards the President of the French Republic and the other high contracting parties, to co-operate on her part in the execution of the stipulations contained in the convention and protocol aforesaid.

The undersigned makes this declaration on the part of Her Britannic Majesty, with the express understanding that power

is reserved to Her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's Government.

In witness whereof the undersigned, duly authorised, has signed the present declaration of accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March, 1884.

(L.S.) (Signed) LYONS.

IV.

DECLARATION OF ACCEPTANCE OF ACCESSION.

(*Official Translation.*)

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the protection of industrial property, concluded at Paris, March 20th, 1883, together with a protocol dated the same day, by the declaration of accession delivered by Her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic; the text of which declaration is word for word as follows:—

(*Here is inserted the text of No. III. in English.*)

The President of the French Republic has authorised the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other high contracting parties to assist in the accomplishment of the obligations stipulated in the convention and the protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the undersigned, duly authorised, has drawn up the present Declaration of Acceptance and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.) (Signed) JULES FERRY.

V.

ORDER IN COUNCIL.

(*The Patents Act*, 1883.)

At the Court at Windsor, the 26th of June, 1884. Present, the Queen's Most Excellent Majesty in Council.

Whereas by the provisions of the Patents, Designs, and Trade Marks Act, 1883, it is, amongst other things, provided:—

That if Her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such State shall, subject to the conditions further provided and set forth in the said Act, be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under the said Act in priority to other applicants, and such patent or registration shall have the same date as the date of the protection obtained in such foreign State:

And whereas it has pleased Her Majesty to make an arrangement of the nature contemplated by the said Act by and in virtue of a declaration signed and sealed by Her Majesty's Ambassador at Paris on the 17th of March, 1884, duly conveying the accession of Great Britain to the International Convention and Protocol for the Protection of Industrial Property, signed by representatives of certain powers on the 20th of March, 1883, and duly ratified on the 6th of June, 1884, power being reserved to Her Majesty to hereafter accede to the provisions of the said convention and protocol on behalf of the Isle of Man, the Channel Islands, and any of Her Majesty's possessions, which declaration of accession was duly accepted by the French Government on behalf of the signatory powers by and in virtue of a declaration dated the 2nd of April, 1884:

Now, therefore, Her Majesty, by and with the advice and consent of her Privy Council, and by virtue of the authority committed to her by the said Act, doth declare, and it is hereby declared, that the provisions of the said Act hereinbefore specified shall apply to the following countries, viz.:—Belgium, Brazil, France, Guatemala, Italy, Netherlands, Portugal, Salvador, Servia, Spain, Switzerland, Ecuador,* and Tunis.*

And it is hereby further ordered and declared that this order shall take effect from the 7th of July, 1884.

C. L. PEEL.

* These States had acceded to the Convention and Protocol.

VI.

SUBSEQUENT ORDERS IN COUNCIL.

Orders in Council making § 103 *applicable.*

	DATE OF ORDER.	TO TAKE EFFECT FROM	"LONDON GAZETTE."
Santo Domingo	Jan. 27th, 1885.	Jan. 27th, 1885	1885, p. 418.
Sweden & Norway	July 9th, 1885.	July 1st, 1885	1885, p. 3173.
Paraguay & Uruguay	Sept. 24th, 1886.	Sept. 24th, 1886	1886, p. 4725.
United States of America	July 12th, 1887	July 12th, 1887	1887, p. 3827.
Netherlands East Indies	Nov. 17th, 1888	March 17th, 1889	1888, p. 6412.
Mexico	May 28th, 1889	Sept. 28th, 1889	1889, p. 2954.

Orders in Council making § 103 *cease to be applicable.*

Ecuador	April 16th, 1886	Dec. 26th, 1886	1886, p. 1894.
Salvador	Sept. 24th, 1886	Aug. 17th, 1887	1886, p. 4726.
Santo Domingo	May 28th, 1889	May 28th, 1889	1889, p. 3035.

Orders in Council making § 104 *applicable.*

Queensland	Sept. 17th, 1885.	Sept. 17th, 1885	1885, p. 4429.
New Zealand	Feb. 8th, 1890	June 8th, 1890	1890, p. 727.

APPENDIX D.

THE TRADE MARKS REGISTRATION ACTS, 1875-7, WITH THE ORDERS IN COUNCIL THEREUNDER, AND THE COTTON MARKS RULES.

All Repealed.

THE TRADE MARKS REGISTRATION ACT, 1875.

38 & 39 VICT. c. 91 (*a*).

An Act to establish a Register of Trade Marks.

[13*th August*, 1875.]

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Registration of trade marks.

1. *A register of trade marks as defined by this Act, and of the proprietors thereof, shall be established under the superintendence of the Commissioners of Patents, and from and after the first day of July one thousand eight hundred and seventy-six a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by this Act until and unless such trade mark is registered in pursuance of this Act.*

Characteristics of registered trade mark.

2. *A trade mark must be registered as belonging to particular goods, or classes of goods; and when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in such particular goods or classes of goods, and shall be determinable with such goodwill; but subject as aforesaid, registration of a trade mark shall be deemed to be equivalent to public use of such mark.*

Title of first proprietor of trade mark.

3. *The registration of a person as first proprietor of a trade mark shall be prima-facie evidence of his right to the exclusive use of such trade mark, and shall, after the expiration of five*

(*a*) It is frequently necessary to refer to these Acts, though repealed, and they are consequently printed here, for facility of reference.

years from the date of such registration, be conclusive evidence of his right to the exclusive use of such trade mark, subject to the provisions of this Act as to its connection with the goodwill of a business.

Title of proprietor claiming by transmitted proprietorship.

4. *Every proprietor registered in respect to a trade mark subsequently to the first registered proprietor shall, as respects his title to that trade mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor.*

Rectification of register.

5. *If the name of any person who is not for the time being entitled to the exclusive use of a trade mark in accordance with this Act, or otherwise in accordance with law, is entered on the register of trade marks as a proprietor of such trade mark, or if the registrar refuses to enter on the register as proprietor of a trade mark the name of any person who is for the time being entitled to the exclusive use of such trade mark in accordance with this Act, or otherwise in accordance with law, or if any mark is registered as a trade mark which is not authorised to be so registered under this Act, any person aggrieved may apply in the prescribed manner for an order of the Court that the register may be rectified; and the Court may either refuse such application, or it may, if satisfied of the justice of the case, make an order for the rectification of the register, and may award damages to the party aggrieved.*

Where each of several persons claims to be registered as proprietor of the same trade mark, the registrar may refuse to comply with the claims of any of such persons until their rights have been determined by the Court, and the registrar may himself submit or require the claimants to submit in the prescribed manner their rights to the Court.

The Court may, in any proceeding under this section, decide any question as to whether a mark is or is not such a trade mark as is authorised to be registered under this Act, also any question relating to the right of any person who is party to such proceeding to have his name entered on the register of trade marks, or to have the name of some other person removed from such register, also any other question that it may be necessary or expedient to decide for the rectification of the register.

The Court may direct an issue to be tried for the decision of any question of fact which may require to be decided for the purposes of this section.

Whenever any order has been made rectifying the register the Court shall by its order direct that due notice of such rectification be given to the registrar.

Restrictions on registry of trade marks.

6. *The registrar shall not, without the special leave of the Court, to be given in the prescribed manner, register in respect of the same goods or classes of goods a trade mark identical with*

one which is already registered with respect to such goods or classes of goods, and the registrar shall not register with respect to the same goods or classes of goods a trade mark so nearly resembling a trade mark already on the register with respect to such goods or classes of goods as to be calculated to deceive.

It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would not, by reason of their being calculated to deceive or otherwise, be deemed entitled to protection in a court of equity; or any scandalous designs.

Establishment of registry and general rules.

7. *Subject as aforesaid, a register office shall be established from and after such time (not being later than the first day of January one thousand eight hundred and seventy-six), in such manner, and with such officers, and at such salaries, to be paid out of moneys provided by Parliament, as the Lord Chancellor may, with the consent of the Treasury, direct; and the Lord Chancellor may, from time to time, with the assent of the Treasury as to fees, make, and when made, alter, annul, or vary, such general rules as to the registry of trade marks, and as to notices to be given by advertisement before the registration of trade marks, and as to the classification of goods for the purposes of this Act, and as to the registration of first and subsequent proprietors of trade marks, and as to the fees to be charged for registration, and also for the continuance of a trade mark on the register or otherwise, and as to the removal from the register of any trade mark, as to notices, and as to the persons entitled to inspect the register, and as to any proceedings to be taken to obtain the judgment or leave of the Court in any matter in which the judgment or leave of the Court is required to be obtained under this Act, and generally for the purpose of carrying into effect this Act, as he may deem expedient.*

Any rules made in pursuance of this section shall be laid before both Houses of Parliament if Parliament be then sitting, or if not then sitting, then within ten days from the then next assembling of Parliament, and shall be of the same validity as if they had been enacted by Parliament; provided that if either House of Parliament resolve, within one month after such rules have been laid before such House, that any of such rules ought not to continue in force, any rule in respect of which such resolution has been passed shall, after the date of such resolution, cease to be of any force, without prejudice, nevertheless, to the making of any other rule in its place, or to anything done in pursuance of any such rules before the date of such resolution.

Certificate of registrar to be evidence.

8. *The certificate of the registrar as to any entry, matter, or thing which he is authorised by this Act, or any general rules*

made thereunder, to make or do, shall be evidence of such entry having been made, and of the contents thereof, and of such matters and things having been done or left undone.

Provision as to Cutlers Company and Sheffield corporate marks.

9. *With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the County of York (in this Act called "the Cutlers Company"), and the marks or devices (in this Act called "Sheffield corporate marks") assigned or to be assigned by the master, wardens, searchers, and assistants of that company, be it enacted as follows:*

(1.) *Within the prescribed time and in the prescribed manner the Cutlers Company shall at their own expense deliver to the registrar under this Act copies of all Sheffield corporate marks in force at the time of such delivery:*

(2.) *When any person, after the passing of this Act, applies to the said master, wardens, searchers, and assistants to assign to him any mark or device, notice of such application, with a copy of such mark or device, shall, within the prescribed time and in the prescribed manner, be delivered to the registrar under this Act; and such mark or device shall not be assigned until after the expiration of the prescribed period from the giving of such notice. In like manner, when any person applies for the registration under this Act of a trade mark as belonging to any goods or class of goods specified in § 2 of the Cutlers Company's Act of* 1860, *notice of such application, with a copy of such trade mark, shall, within the prescribed time and in the prescribed manner, be delivered to the Cutlers Company; and such trade mark shall not be registered until after the expiration of the prescribed period from the giving of the last-mentioned notice:*

(3.) *Upon the assigning of any such mark or device, or the registration of any such trade mark as aforesaid, notice of the assignment or registration shall, within the prescribed time and in the prescribed manner, be given to the registrar under this Act, or to the Cutlers Company, as the case may be:*

(4.) *The registrar under this Act, without the special leave of the Court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with respect to which a Sheffield corporate mark shall have been assigned and actually used, and of which mark a copy or description or notice of the assigning thereof shall have been delivered or given to the registrar as aforesaid, register a trade*

mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive:

(5.) *The master, wardens, searchers, and assistants of the Cutlers Company shall not assign to any person a mark or device identical with any trade mark registered under this Act, and notice of the registration whereof shall have been given to the Cutlers Company as aforesaid, or so nearly resembling the same as to be calculated to deceive:*

(6.) *Any person to whom a Sheffield corporate mark legally belongs shall be entitled to have the same mark registered also as a trade mark under this Act, in respect of any particular goods or classes of goods, in the same manner and upon the same terms and conditions in and upon which he might have registered the same if it were not a Sheffield corporate mark:*

(7.) *Nothing in this Act shall prejudice or affect the rights and privileges of the Cutlers Company, nor, save as is otherwise in this Act expressly provided, shall any of the provisions of this Act apply to or in the case of any Sheffield corporate mark.*

Definitions.

10. *For the purposes of this Act:*

A trade mark consists of one or more of the following essential particulars; that is to say:

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

A written signature or copy of a written signature of an individual or firm; or

A distinctive device, mark, heading, label, or ticket;

and there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures; also

Any special and distinctive word or words or combination of figures or letters used as a trade mark before the passing of this Act may be registered as such under this Act.

"Prescribed" means prescribed by general rules made in pursuance of this Act; and

"Court" means any of Her Majesty's superior courts of law or equity at Westminster, or any court to which the jurisdiction of such courts may be transferred, or any one or more of such courts which may be declared to be the court for the purposes of this Act by such general rules as aforesaid; but the provisions of this Act conferring a special jurisdiction on the court as above defined shall not, excepting so far as such jurisdiction extends, affect the

jurisdiction of any court in Scotland or Ireland in causes, actions, suits, or proceedings relating to trade marks; and if the register requires to be rectified in consequence of any proceedings in any such court in Scotland or Ireland, due notice of such requirements shall be given to the registrar, and he shall rectify the register accordingly.

Short title of Act.

11. *This Act may be cited for all purposes as the Trade Marks Registration Act*, 1875.

The Trade Marks Registration Amendment Act, 1876.

39 & 40 Vict. c. 33.

An Act for the Amendment of the Trade Marks Registration Act, 1875. [24*th 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 prevent the infringement of any trade mark as defined by the principal Act until and unless such trade mark is registered in pursuance of that Act:*

And whereas by reason of the number of trade marks, and especially by reason of the difficulties attending the registration of trade marks in relation to textile fabrics, it has been found impossible to complete the registration of existing trade marks within the time specified by the said section; and it is therefore expedient to prolong the time for the completion of such registration as aforesaid, and otherwise to amend the principal Act:

Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Amendment of § 1 of the principal Act.

1. *There shall be repealed so much of* § 1 *of the principal Act as provides that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by that Act until and unless such trade mark is registered in pursuance of that Act; and in place thereof be it enacted that—*

From and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the

infringement of any trade mark as defined by the principal Act, until and unless such trade mark is registered in pursuance of that Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused as hereinafter is mentioned.

Saving of marks and devices not capable of being registered under Act.

2. *When an application by any person to register as a trade mark a device, mark, name, word, combination of words, or other matter or thing proposed for registration as a trade mark, which has been in use as a trade mark before the passing of the recited Act, has been refused, it shall be the duty of the registrar, on request, and on payment of the prescribed fee, to give to the applicant a certificate of such refusal, and a certificate so granted shall be conclusive evidence of such refusal.*

Short title.

3. *This Act may be cited for all purposes as the Trade Marks Registration Amendment Act*, 1876.

THE TRADE MARKS REGISTRATION EXTENSION ACT, 1877.

40 & 41 VICT. c. 37.

An Act for extending the Time for the Registration of Trade Marks, in so far as relates to Trade Marks used in Textile Industries. [6th *August*, 1877.]

39 & 40 Vict. c. 33.

Whereas by § 1 *of the Trade Marks Registration Amendment Act*, 1876, *it is provided that from and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade mark as defined by the Trade Marks Registration Act*, 1875 (*referred to in such Amendment Act and in this Act as the principal Act*), *until and unless such trade mark is registered in pursuance of the principal Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused, as is in the said Act thereafter mentioned:*

38 & 39 Vict. c. 91.

And whereas by reason of the difficulties attending the registration of trade marks used in the textile industries it has been found impossible to complete the registration of such trade marks within the time specified by the said section, and it is therefore expedient to prolong such time as aforesaid:

Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and

temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Extension of time for registration of trade marks used in textile industries.

1. *In so far as relates to the registration of trade marks used in the textile industries, but not further or otherwise,* § 1 *of the Trade Marks Registration Amendment Act,* 1876, *shall be construed as if for the words "from and after the first day of July one thousand eight hundred and seventy-seven" there were substituted the words "from and after the first day of January one thousand eight hundred and seventy-eight, or such further time as Her Majesty may by Order in Council determine."*

Definition of "trade marks used in the textile industries."

2. *The expression in this Act "Trade marks used in the textile industries" means the trade marks relating to goods comprised in Classes* 23 *to* 35, *both inclusive, of the First Schedule to the Rules under the Trade Marks Registration Acts,* 1875-6, *dated September* 1876.

Short title of Act.

3. *This Act may be cited for all purposes as the Trade Marks Registration Extension Act,* 1877; *and this Act and the Trade Marks Registration Amendment Act,* 1876, *and the Trade Marks Registration Act,* 1875, *may be cited together as the Trade Marks Registration Acts,* 1875-7.

ORDERS IN COUNCIL

EXTENDING THE TIME FOR REGISTRATION.

Dec. 12th, 1877	extension till	June 30th, 1878 (*a*).
June 29th, 1878	„	„ Dec. 31st, 1878 (*a*).
Nov. 27th, 1878	„	„ May 31st, 1879 (*b*).
May 17th, 1879	„	„ July 31st, 1879 (*b*.)

(*a*) These orders related only to trade marks used in the textile industries.

(*b*) These orders related only to trade marks used for cotton piece goods.

RULES OF AUGUST, 1876, WITH RESPECT TO COTTON MARKS.*

Cotton Goods.

Establishment of office for exhibition of

57. *For the purpose of facilitating the granting of trade marks in respect of cotton goods in Classes* 23, 24 *and* 25, *there*

* These rules, though repealed, are given here in order that the position of cotton marks dealt with by the late Manchester Committee of Experts may be comprehended. Where it is not otherwise stated, the rules were included in the set of Rules issued in August, 1876. Various additions were made from time to time, and in March 1883, after the Committee of Experts had completed their labours, an entirely new set was substituted (see p. 549, *infrà*). Those rules were, in their turn, repealed, and the rules now in force place cotton marks on the same footing as other trade marks, and this would seem to be the case even with B list marks.

shall be established by the Commissioners of Patents (*a*), *and subject to their control, an office at Manchester* (*b*) *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 in these Rules included under the expression "cotton marks"* (*c*).

cotton trade marks at Manchester.

(*a*) Previous to the coming into operation of the Patents Act, 1883, on January 1st, 1884, the registration of trade marks was under the control of the Commissioners of Patents, now no longer in existence.

(*b*) This was opened and is still maintained at No. 48, Royal Exchange, Manchester. See Instructions, par. 34.

(*c*) All cotton marks are treated as exceptional, and advertised and registered by deposit. See *In re Robinson*, 29 W. R. 31.

58 (*a*). *Every person who at the date of the passing of the Act 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.*

Representations of cotton marks to be sent by owners resident in the United Kingdom on or before Jan. 1, 1877; by owners resident abroad on or before March 1, 1877.

(*a*) This Rule was made on Dec. 1st, 1876, in substitution for the previous Rule 58, by which representations of old cotton marks were to be sent in at Manchester on or before Dec. 1st, 1876.

58a (*a*). *Every person who at the date of the passing of the Trade Marks Registration Act*, 1875, *used any "combination stamp" (b) for ctt on piece goods, shall on or before the first day of February, one thousand eight hundred and seventy-nine, send to the Manchester Branch of the Trade Marks Registry Office four representations of such "combination stamp," in such form and with such a description as may be from time to time required by the Commissioners of Patents.*

Extended time for sending representations of combination stamps for cotton piece goods.

(*a*) This rule was made on Dec. 28th, 1878.

(*b*) Combination stamps are combinations of several different trade marks which dealers in cotton goods habitually use on such goods, treating the combination as equivalent to a single trade mark. See *Robinson* v. *Finlay*, 9 Ch. D. 487, for an example of such a combination.

59. *A committee* (*a*) *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 a 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,*

Committee of experts to be appointed, and to divide cotton marks 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 (*b*).

(*a*) A list of the Committee of Experts appointed under this Rule will be found in the Instructions issued during the existence of the committee.

(*b*) The committee were instructed by the Commissioners of Patents in a letter, dated April 4th, 1877, to act on the following principles in dividing the cotton marks into two classes, viz. : (i) To decide only from the evidence before them whether, in their opinion, a mark belonged to the first or second class of cotton marks ; (ii) in case of further information being required, the keeper of the Manchester office was authorised to obtain such information for the use of the committee ; (iii) in case of a difference of opinion among the committee as to the nature of marks applied for, their decision should be given according to the opinion of the majority, the chairman presiding at each meeting having a casting vote ; (iv) single letters were not trade marks within the meaning of the Act ; (v) in all cases where more than three persons applied for registration of the same mark for the same description of goods, such mark must be considered as a trade mark not within the meaning of the Act, and must consequently be placed in the second class. By supplementary directions, the committee were instructed that Rule (v) extended to marks so similar, or so nearly resembling each other, as to be substantially the same marks, or calculated to deceive, and was not to be confined to identical marks. And they were also instructed that, in dealing with individual cases, they should bring to bear upon them the knowledge which the members of the committee might have of the state of things in the trade, and to decide with reference to that knowledge, and not merely upon such evidence as might be formally brought before them in the individual cases. Also that borders of marks should not be treated as parts of the marks. See *In re Brook*, 26 W. R. 791.

Acting on the principles thus laid down, the committee divided the marks submitted to them into two classes, known as the A list and the B list, of which the former contained registrable, and the latter non-registrable, cotton marks.

By Rule 62, *infrà*, the marks placed in the B list were not to be registered except in pursuance of an order of the Court, and in *In re Orr-Ewing & Co.*, 8 Ch. D. 794, the question was raised how far the decision of the committee was a binding decision. Hall, V.-C., decided that the marks there in question, which had been placed in the B list, were good and valid trade marks, and that they ought to be registered ; but the Court of Appeal reversed his decision, holding that the decision of the committee should not be interfered with except under special circumstances, James, L. J., saying that the Court should not interfere, unless satisfied that the committee had proceeded upon some wrong principle or in some improper manner. When, however, the case was brought before the House of Lords (4 App. Cas. 479), the decision of Hall, V.-C., was restored, with the modification that only the essential particulars of the marks were admitted to registration, and the Lord Chancellor (Lord Cairns) said that "the Rules appear to provide a rough but useful way of separating, by means of the technical knowledge and judgment of the committee, the cotton trade marks into two classes. The first class is to consist of those marks which the committee is of opinion are trade marks within the Act ; and proprietors in this class are to have the benefit, arising from this opinion, of being able at once to apply to be registered in respect of those marks. But in doing this they must satisfy

the registrar that they are the proprietors, and comply with the conditions of registration as any other applicants would do. With regard to the second class, there is no decision pronounced against them, but the proprietors cannot apply for registration as a matter of course. They must come to the court, and it must be for the Court to say whether the registrar shall proceed on their application to register, or not. In deciding this the Court will have before it the circumstance that the opinion of the committee was adverse to the claim of a trade mark; but this would be an opinion only, and not a decision arrived at after hearing both sides, or rendered in any judicial proceeding:" *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 483. and see per Lords O'Hagan and Blackburn. See also, *Orr-Ewing & Co.* v. *Johnston & Co*, 13 Ch. D. 434; 7 App. Cas. 219; and the cases noted under Rule 62, *infrà*.

The function of the committee was solely to decide on the question of registrability or non-registrability, and where they had assumed to decide a question of title, it was held by Jessel, M. R., that the registrar must proceed with the application, leaving it to the owners of other marks to oppose the registration: *Ex parte Ede Bros. & Co.*, 28 W. R. 436.

Committee to form list of marks sent in to Manchester office.

60. *The said committee shall form a list of the cotton marks sent to the Manchester office in each of the aforesaid classes* (*a*), *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.*

The third representation of each of the marks in the second class in such list shall be retained for reference in the Manchester office.

(*a*) *I.e.*, the A list and the B list.

Marks may be added to list.

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.*

Any person claiming to be the proprietor of a cotton mark in class 1 may apply to be registered.

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* (*a*), *but it shall not be lawful for the registrar to register* (*b*) *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* (*c*).

(*a*) After being passed by the committee, the marks in the A list had to be advertised, so that an opportunity for opposition might be afforded. In *In re Robinson*, 29 W. R. 31, an A list cotton mark was opposed, but without success.

(*b*) But he might grant a certificate of refusal to register, thus preserving any previous rights.

(*c*) For an order of the Court to be obtained for the registration of a B list mark, such a case had to be made out as, in the opinion of the Court, was sufficient to outweigh the opinion of the Committee of Experts: per Lord Blackburn in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 501. It is, however, believed that an application to the Court by an owner

of a B list mark has never been unsuccessful. Such applications were granted in *Ex parte Ede Bros. & Co.*, 28 W. R. 436; *In re Dugdale*, 49 L. J. Ch. 303; *In re J. Hoyle & Sons, Limited* (1), V.-C. H., May 8th, 1880; S. C. (2) Chitty J., Nov. 30th, 1883; *In re Dickinson, Ackroyd & Co.*, V.-C. H., July 8th, 1880; *In re Jones Bros. & Co.*, V.-C. H., July 10th, 1880; *In re Ward, Sturt & Sharp*, 50 L. J. Ch. 347; *In re Sykes*, 43 L. T. N. S. 626; *In re T. Ashton & Sons*, V.-C. H., Feb. 26th, 1881; *In re Framjee, Sands & Co.*, V.-C. B., Nov. 30th, 1883. In *In re Brook*, 26 W. R. 791, which was decided against the applicants on the authority of the decision of the Court of Appeal in *In re Orr-Ewing*, 8 Ch. D. 794, an arrangement satisfactory to the applicants was afterwards arrived at.

"The Court" being the Chancery Division (now the High Court of Justice), the order of the House of Lords was made an order of the Chancery Division in *In re Orr-Ewing* (2), 28 W. R. 412. The comptroller will now register a B list mark in a proper case, without requiring the applicant to go to the Court.

Advertisement of cotton marks.

62a (*a*). *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.*

(*a*) This and the following Rule were made on Feb. 26th, 1877, in substitution, so far as related to cotton marks, for Rules 13, 15 and 17 of the General Rules of August, 1876, as to advertisement.

Time of registration of cotton marks.

62b (*a*). *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.*

(*a*) See note to previous Rule.

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.*

Applications for registration of new

63a (*a*). *The Rules numbered* 57 *to* 63 *as aforesaid do not apply to such trade marks in respect of cotton goods in Classes* 23, 24 *and* 25 *as are not cotton marks which were in use at the date of the passing of the Trade Marks Registration Act*, 1875; *and applications for the registration of trade marks in respect of*

goods in Classes 23, 24 *or* 25, *and which marks were not cotton marks in use at the date of the passing of the Trade Marks Registration Act*, 1875, *shall be made in manner and subject to the conditions in and subject to which applications for trade marks other than cotton marks may be made in conformity with the Rules in that behalf for the time being in force.*

trade marks for cotton goods (classes 23, 24, and 25) to be made in the same manner as for all other classes of goods.

Provided that where application is made for the registration as a trade mark in respect of any goods in Classes 23, 24 *or* 25 *of any mark being a cotton mark contained in the second class of the list mentioned in Rule* 59 *aforesaid, such registration shall not take place except in pursuance of an order of the Court.*

(a) This Rule was made on Oct. 21st, 1879.

RULES OF MARCH, 1883, WITH RESPECT TO COTTON MARKS.*

57. [*This Rule is identical with Rule* 57, *suprà.*]

Establishment of office for exhibition of cotton trade marks at Manchester.

58 (*a*). *The Commissioners of Patents may from time to time add to the first and second class lists of cotton marks formed by the late Manchester Committee of Experts any cotton marks as they may think just, and such addition shall be deemed to be part of the original lists.*

Marks may be added to the first and second class lists of cotton marks.

(a) This is taken from the old Rule 61.

59 (*a*). *Any proprietor of a cotton mark in the first class 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 aforesaid, except in pursuance of an order of the Court.*

Any person claiming to be the proprietor of a cotton mark in first class may apply to be registered.

(a) This is taken from the old Rule 62.

Advertisement of cotton marks.

60. [*This Rule is identical with Rule* 62a, *suprà.*]

Time of registration of cotton marks.

61. [*This Rule is identical with Rule* 62b, *suprà.*]

* See note, p. 544, *suprà.*

APPENDIX E.

THE MERCHANDISE MARKS ACT, 1887, AND THE STATUTES, REGULATIONS AND ORDERS CONNECTED THEREWITH.

The Merchandise Marks Act, 1887.
50 & 51 Vict. c. 28.

An Act to consolidate and amend the Law relating to Fraudulent Marks on Merchandise. [23*rd August*, 1887.]

Be it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Short title.

1. This Act may be cited as the Merchandise Marks Act, 1887 (*a*).

(*a*) It was held that it was not against the policy of the law for proceedings taken under the Merchandise Marks Act, 1862, now replaced by this Act, to be compromised: *Fisher* v. *Apollinaris Co.*, L. R. 10 Ch. 297.

Offences as to trade marks and trade descriptions.

2.—(1.) Every person (*a*) who—

(a.) forges (*b*) any trade mark (*c*); or

(b.) falsely applies (*d*) to goods (*e*) any trade mark (*c*) or any mark so nearly resembling a trade mark as to be calculated to deceive; or

(c.) makes any die, block, machine, or other instrument (*f*) for the purpose of forging (*b*), or of being used for forging (*b*), a trade mark (*c*); or

(d.) applies any false trade description (*g*) to goods (*e*); or

(e.) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging (*b*) a trade mark (*c*); or

(f.) causes any of the things above in this section mentioned to be done,

shall, subject to the provisions of this Act, and unless he proves

that he acted without intent to defraud (*h*), be guilty of an offence against this Act.

(2.) Every person who sells, or exposes for, or has in his possession for sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark or mark so nearly resembling a trade mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

(a.) That having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(b.) That on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things (*i*); or

(c.) That otherwise he had acted innocently;

be guilty of an offence against this Act.

(3.) Every person guilty of an offence against this Act shall be liable—

(i.) on conviction on indictment (*k*), to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and

(ii.) on summary conviction (*k*) to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and

(iii.) in any case, to forfeit to Her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

(4.) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit.

(5.) If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions.

(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a court of

42 & 43 Vict. c. 49.

summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts: Provided that a person charged with an offence under this section before a court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly.

(*a*) Person includes any body of persons : see § 3 (1).
(*b*) Forgery of a trade mark is defined by § 4.
(*c*) Trade mark is defined by § 3 (1).
(*d*) Application and false application of a trade mark are defined by § 5; and see § 6.
(*e*) "Goods" is defined by § 3 (1).
(*f*) As to making dies and blocks, see § 6.
(*g*) Trade description and false trade description are defined by § 3 (1), and see also § 3 (2) and (3), also § 6. Compare § 18.
(*h*) In *Gridley* v. *Swinborne*, 5 Times L. R. 71, the Court appears to have entertained the view that the burden was on the prosecutor to prove a *mens rea* on the part of the defendant; but an intent to defraud a purchaser is not a necessary ingredient in the offence : *Wood* v. *Burgess*, 24 Q. B. D. 162, and in *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90, it was held, in proceedings taken by a trade society, that though the article supplied was of the quality contracted to be supplied, and had been accepted by the purchaser without objection, and no pecuniary loss or injury of any kind had been suffered by the purchaser, yet, inasmuch as the vendors were known as manufacturers only, and not as dealers, and they had placed their own name on the goods, without any notification that the goods had been obtained by them from elsewhere, they were not entitled to say that there was no intent to defraud.
(*i*) Under the present statute a person in possession of wrongfully marked goods for sale, &c., has to give information with respect to the persons from whom he obtained the goods, if he wishes to escape the penalties of the Act. By § 6 of the repealed Merchandise Marks Act, 1862, he was compellable to give the information under a special penalty.
(*k*) Whether a person charged with an offence under this Act is dealt with summarily or on indictment, the principles to be applied are the same : Per Lord Coleridge, C. J., in *Gridley* v. *Swinborne*, 5 Times L. R. 71.

Definitions. 46 & 47 Vict. c. 57.

3.—(1.) For the purposes of this Act—

The expression "trade mark" means a trade mark registered in the register of trade marks, kept under the Patents, Designs, and Trade Marks Act, 1883, and includes any trade mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of § 103 of the Patents, Designs, and Trade Marks Act, 1883, are, under Order in Council (*a*), for the time being applicable:

The expression "trade description" means any description, statement, or any other indication, direct or indirect (*b*).

(a.) as to the number, quantity, measure, gauge, or weight of any goods (*c*), or
(b.) as to the place or country in which any goods were made or produced (*d*), or

(c.) as to the mode of manufacturing or producing any goods, or

(d.) as to the material of which any goods are composed (*e*), or

(e.) as to any goods being the subject of an existing patent (*f*), privilege, or copyright,

and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act:

The expression "false trade description" means a trade description which is false in a material respect (*g*), as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect, and the fact that a trade description is a trade mark, or part of a trade mark, shall not prevent such trade description being a false trade description within the meaning of this Act:

The expression "goods" means anything which is the subject of trade, manufacture, or merchandise:

The expressions "person," "manufacturer, dealer, or trader," and "proprietor" include any body of persons corporate or unincorporate:

The expression "name" includes any abbreviation of a name.

(2.) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods of any such figures, words, or marks, or arrangement or combination thereof, whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.

(3.) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment the expression false name or initials means as applied to any goods, any name or initials of a person which—

(a.) are not a trade mark, or part of a trade mark, and

(b.) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of such name or initials (*h*), and

(c.) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods.

(*a*) See Table of Orders in Council in Appendix C.

(*b*) See § 18.

(*c*) See *Hooper* v. *Balfour*, W. N. 1890, p. 61.

(*d*) See *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90. Also § 7 as to watches.

(*e*) In *Gridley* v. *Swinborne*, 5 Times L. R. 71, it was held by the Q. B. D. that it was not a false trade description to apply the term "isinglass" to a material which, though not in the most strictly scientific sense isinglass, was yet very similar to it and was frequently called by that name.

(*f*) See § 105 of the Patents Act, 1883. The difference between that section and this appears to be that under that section no offence is committed if there has ever been a patent, while under this an offence is committed if there is not a patent still actually in existence. In *Gridley* v. *Swinborne*, 5 Times L. Rep. 71, an article had been sold for upwards of forty years as "Swinborne's Patent Refined Isinglass," there having originally been a patent granted in 1847; and it was held that to continue to use the word "Patent," as had so long been done, was not to apply to the article a false trade description. It was held that a person who himself wrongfully inserted or retained the word "Patent" in his trade mark could not avail himself of the Merchandise Marks Act, 1862: *Morgan* v. *McAdam*, 36 L. J. Ch. 228.

(*g*) There is nothing to show what is meant by "in a material respect," but it would appear that a trade description which is inaccurate is not false in a material respect unless the inaccuracy would have some effect on the mind of a purchaser. *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90, seems to show that a very stringent interpretation will be placed on the Act. In that case a firm of English gunpowder manufacturers, who usually sold gunpowder of their own make only, had entered into a contract with the Government for the supply of a quantity of powder, the contract containing no stipulation that the powder was to be of their own or of English manufacture. They were unable, in consequence of an accident, to supply the powder of their own make, and they consequently supplied German powder in barrels marked with their name, but without any statement where or by whom the powder was made; and it was held that although the quality was correctly stated, and the powder was as good as if it had been made by them, and the Government had accepted it without objection, yet, inasmuch as the expectation would be that a firm known only as manufacturers and not as dealers would supply only gunpowder of their own make, the use of their name, without a statement as to the foreign origin of the powder, was an application to the goods of a false trade description.

(*h*) See *Wood* v. *Burgess*, 24 Q. B. D. 162.

Forging trade mark.

4. A person shall be deemed to forge a trade mark who either—

(a.) without the assent of the proprietor of the trade mark

makes that trade mark or a mark so nearly resembling that trade mark as to be calculated to deceive; or

(b.) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise;

and any trade mark or mark so made or falsified is in this Act referred to as a forged trade mark.

Provided that in any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.

Applying marks and descriptions.

5.—(1.) A person shall be deemed to apply a trade mark or mark or trade description to goods who—

(a.) applies it to the goods themselves; or

(b.) applies it to any covering (*a*), label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture; or

(c.) places, encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade mark or trade description has been applied; or

(d.) uses a trade mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark or mark or trade description.

(2.) The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression "label" includes any band or ticket.

A trade mark, or mark, or trade description, shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label, reel, or other thing.

(3.) A person shall be deemed to falsely apply to goods a trade mark or mark, who without the assent of the proprietor of a trade mark applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive, but in any prosecution for falsely applying a trade mark or mark to goods the burden of proving the assent of the proprietor shall lie on the defendant.

(*a*) For definition of "covering," see subs. (2) of this section.

Exemption of certain persons employed in

6. Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade mark, or with falsely applying

ordinary course of business.

to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

(a.) That in the ordinary course of his business he is employed on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade marks, or, as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

(b.) That he took reasonable precautions against committing the offence charged; and

(c.) That he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(d.) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence.

Application of Act to watches.

7. Where a watch-case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *prima facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for or having in possession for sale, or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly, and for the purposes of this section the expression "watch" means all that portion of a watch which is not the watch-case.

Mark on watch-case.

8.—(1.) Every person who after the date fixed by Order in Council sends or brings a watch-case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch-case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the

mark placed by the office on a watch-case made in the United Kingdom), and in such a mode as may be from time to time directed by Order in Council (*a*).

(2.) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorised to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council (*a*).

(3.) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence.

(*a*) See Order in Council of Nov. 28th, 1887, p. 564, *infrd.*

Trade mark, how described in pleading.

9. In any indictment, pleading, proceeding, or document, in which any trade mark or forged trade mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade mark or forged trade mark to be a trade mark or forged trade mark.

Rules as to evidence.

10. In any prosecution for an offence against this Act,—

(1.) A defendant, and his wife or her husband, as the case may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness.

(2.) In the case of imported goods, evidence of the port of shipment shall be *prima-facie* evidence of the place or country in which the goods were made or produced.

Punishment of accessories.

11. Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act, which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any county or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed.

Search warrant.

12.—(1.) Where, upon information of an offence against this Act, a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods

or things by means of or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture under this Act.

(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

(3.) Any goods or things forfeited under this section, or under any other provision of this Act, may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct, and the Court may, out of any proceeds which may be realised by the disposition of such goods (all trade marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

Extension of 22 & 23 Vict. c. 17 to offences under this Act.

13. The Act of the session of the twenty-second and twenty-third years of the reign of Her present Majesty, chapter seventeen, intituled "An Act to prevent vexatious indictments for certain misdemeanours," shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in § 1 of that Act, but this section shall not apply to Scotland.

Costs of defence or prosecution.

14. On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively.

15. No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens. Limitation of prosecution.

16. Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act; be it therefore enacted as follows: Prohibition on importation.

(1.) All such goods (*a*), and also all goods of foreign manufacture bearing any name or trade mark being or purporting to be the name or trade mark of any manufacturer, dealer, or trader in the United Kingdom (*b*), unless such name or trade mark is accompanied by a definite indication (*c*) of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were specified in § 42 of the Customs Consolidation Act, 1876 (*d*). 39 & 40 Vict. c. 36.

(2.) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs may require the regulations (*e*) under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

(3.) The Commissioners of Customs may from time to time make, revoke and vary, regulations (*e*), either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.

(4.) Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom (*f*), that name, unless accompanied by the name of the country in which such place is situate (*g*), shall be treated for the purposes

of this section as if it were the name of a place in the United Kingdom.

(5.) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

(6.) The Commissioners of Customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion, or otherwise, shall act under the control of the Commissioners of Her Majesty's Treasury.

(7.) The regulations may provide for the informant reimbursing the Commissioners of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

(8.) All regulations under this section shall be published in the *London Gazette* and in the *Board of Trade Journal*.

(9.) This section shall have effect as if it were part of the Customs Consolidation Act, 1876, and shall accordingly apply to the Isle of Man as if it were part of the United Kingdom.

46 & 47 Vict. c. 55.

(10.) Section 2 of the Revenue Act, 1883, shall be repealed as from a day fixed by regulations under this section, not being later than the first day of January one thousand eight hundred and eighty-eight (*h*), without prejudice to anything done or suffered thereunder.

(*a*) The only goods which are prohibited by this section to be imported are, in addition to foreign goods bearing a real or spurious British name or trade mark, goods which, if sold, would be liable to forfeiture under this Act. The goods liable to forfeiture are the goods in relation to which an offence against the Act has been committed (§ 2 (3) (iii.)). Except, therefore, in the case of foreign goods with British marks, for goods to be seized it ought to be proved that an offence against the Act has been committed. But such an offence is not necessarily committed whenever the goods have on them a forged trade mark or a false trade description, and it would therefore appear that before goods bearing a forged trade mark or a false trade description are absolutely seized, it ought to be ascertained whether the owners can clear themselves of having committed an offence against the Act, under the provisions either of § 2 (1) or of § 2 (2), as may be applicable, since if they can do so, the goods are not seizable, even though they are improperly marked. See also § 12 (2) as to forfeiture.

(*b*) See 46 & 47 Vict. c. 55, § 2 (1) (*a*), also 39 & 40 Vict. c. 36, § 42, and 16 & 17 Vict. c. 107, § 44.

(*c*) See § 18.

(*d*) See p. 563. When goods have been wrongfully seized for an alleged

offence, the owner's remedy is to bring an action against the officer who seized the goods. Such actions are now controlled by 39 & 40 Vict. c. 36, §§ 268-74 and 40 Vict. c. 13, §§ 4, 5. By §§ 268-9 of the earlier Act one month's notice in writing is to be given before the action is commenced, and by § 270 the officer may tender amends within the month. By § 272 an action against an officer is to be commenced within one month (enlarged by 40 Vict. c. 13, § 4 to two months) after the day of seizure. After that time the only remedy appears to be to apply to the Commissioners of Customs or to the Treasury, under subs. (6) of this section. In *Jacobsohn v. Blake*, 7 Scott, N. R. 772, the defendants, who were custom-house officers, took possession of and detained goods imported by the plaintiff, believing them to be subject to forfeiture; but the goods were never actually seized, and ultimately it turned out that the goods were not liable to forfeiture, and they were delivered over to the plaintiff. The latter thereupon commenced an action for trespass; but it was held that, the goods never having been actually seized, but having been only detained for examination, the action would not lie.

(*e*) See these Regulations at p. 566.

(*f*) See 46 & 47 Vict. c. 55, § 2 (1) (*b*), also 39 & 40 Vict. c. 36, § 42, and 35 & 36 Vict. c. 20, § 4.

(*g*) See 46 & 47 Vict. c. 55, § 2 (3), also 39 & 40 Vict. c. 36, § 42, and 35 & 36 Vict. c. 20, § 4.

(*h*) This is the date fixed by the Regulations, p. 570, *infra*.

Implied warranty on sale of marked goods.

17. On the sale or in the contract for the sale of any goods to which a trade mark, or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade mark and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee.

Provisions of Act as to false description not to apply in certain cases.

18. Where, at the passing of this Act, a trade description is lawfully and generally applied to goods of a particular class or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods (*a*), the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

(*a*) See *Marshall* v. *Ross*, L. R. 8 Eq. 651, "patent thread." In *Gridley* v.

Swinborne, 5 Times L. R. 71, it was held that the defendant had a good defence under this section.

Savings.

19.—(1.) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

(2.) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act.

(3.) Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

False representation as to Royal Warrant.

20. Any person who falsely represents that any goods are made by a person holding a Royal Warrant, or for the service of Her Majesty, or any of the Royal Family, or any Government department, shall be liable, on summary conviction, to a penalty not exceeding twenty pounds (*a*).

(*a*) See § 106 of the Patents Act, 1883, as to unauthorised use of the Royal Arms.

Application of Act to Scotland.

21. In the application of this Act to Scotland the following modifications shall be made :—

The expression "Summary Jurisdiction Acts" means the Summary Procedure Act, 1864, and any Acts amending the same.

The expression "justice" means sheriff.

The expression "court of summary jurisdiction" means the Sheriff Court, and all jurisdiction necessary for the purpose of this Act is hereby conferred on sheriffs.

Application of Act to Ireland.

22. In the application of this Act to Ireland, the following modifications shall be made :—

The expression "Summary Jurisdiction Acts" means, so far as respects the police district of Dublin metropolis, the Acts regulating the powers and duties of justices of the peace of such district, and as regards the rest of Ireland means the Petty Sessions (Ireland) Act, 1851, and any Act amending the same.

14 & 15 Vict. c. 93.

The expression "court of summary jurisdiction" means justices acting under these Acts.

Repeal of 25 & 26 Vict. c. 88.

23. The Merchandise Marks Act, 1862, is hereby repealed, and any unrepealed enactment referring to any enactment so

repealed shall be construed to apply to the corresponding provision of this Act; provided that this repeal shall not affect—

(a.) any penalty, forfeiture, or punishment incurred in respect of any offence committed against any enactment hereby repealed; nor

(b.) the institution or continuance of any proceeding or other remedy under any enactment so repealed for the recovery of any penalty incurred, or for the punishment of any offence committed, before the commencement of this Act; nor

(c.) any right, privilege, liability, or obligation acquired, accrued, or incurred under any enactment hereby repealed.

Customs Acts.

The Customs Consolidation Act, 1876—39 & 40 *Vict. c.* 36.

Table of prohibitions and restrictions.

§ 42 (*a*). 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.

A Table of Prohibitions and Restrictions inwards.

Goods prohibited to be imported.

* * * * *

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 (*b*).

* * * * *

Foreign manufactures with British marks.

§ 153. If any articles of foreign manufacture, and any packages of such articles, bearing any names, brands, or marks being or purporting to be the names, brands, or marks of manufacturers resident in the United Kingdom, shall be imported into any of the British possessions abroad, the same shall be forfeited (*c*).

(*a*) This section was amended by 46 & 47 Vict. c. 55, now replaced by § 16 of the Merchandise Marks Act, 1887.

(*b*) This is re-enacted from 16 & 17 Vict. c. 107, § 44.

(*c*) This is re-enacted from 16 & 17 Vict. c. 107, § 161.

The Customs and Inland Revenue Act, 1879—42 & 43 *Vict. c.* 21.

PART I.—CUSTOMS.

Entry of British goods returned.

§ 6. * * Provided also, that if any British goods brought into the United Kingdom bear the name, brand, or mark of any British manufacturer, the same shall, either by bill of store, or by and with the consent in writing of the proprietor of such name, brand, or mark, or his legal representative, or on proof to the satisfaction of the Commissioners of Customs, by declaration of the importer, that such goods are of British manufacture, be admitted to entry as British (*a*).

(*a*) This is re-enacted from 30 & 31 Vict. c. 82, § 6, and 39 & 40 Vict. c. 36, § 63.

Order in Council under § 8 of the Merchandise Marks Act, 1887.

At the Court at Windsor, the 28th day of November, 1887.

Present,

The Queen's Most Excellent Majesty in Council.

Whereas by the Merchandise Marks Act, 1887, 50 & 51 Vict. c. 28, it is amongst other things, provided that—

(1.) Every person who, after the date fixed by Order in Council, sends or brings a watch-case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch-case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch-case made in the United Kingdom) and in such a mode as may be from time to time directed by Order in Council.

(2.) The declaration may be made before an officer of an assay office appointed in that behalf by the office (which officer is hereby authorised to administer such a declaration) or before a justice of the peace or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

(3.) Every person who makes a false declaration for the purposes of this section shall be liable on conviction on indictment to the penalties of perjury, and, on summary conviction, to a fine not exceeding twenty pounds for each offence.

Now, therefore, Her Majesty, by and with the advice of Her Privy Council, and in exercise of the powers vested in Her by the above-recited provisions of the said Act, is pleased to order and declare, and doth hereby order and declare, that where it appears by such declaration that such watch-cases have been made in some country or place out of the United Kingdom, then the following Authorities, that is to say:—

The Wardens and Commonalty of the Mystery of Goldsmiths of the City of London;
The Guardians of the Standard of Wrought Plate, Birmingham;
The Company of Goldsmiths of the City of Chester;
The Guardians of the Standard of Wrought Plate, Sheffield;
The Incorporation of Goldsmiths of the City of Edinburgh;
The Goldsmiths' Company of the City of Glasgow;
The Fraternity or Company of Goldsmiths of the City of Dublin;

shall respectively cause to be placed on such watch-cases the marks more particularly described and delineated in Schedule II. hereunto annexed, and no other mark or marks, and such marks are hereby authorised accordingly.

And it is hereby further ordered and declared that the declaration to be made shall be in the form set forth in Schedule I. hereunto annexed.

This order shall come into operation on the first day of January, one thousand eight hundred and eighty-eight.

C. L. PEEL.

SCHEDULE I.

Form of Declaration.

I (*a*) do hereby declare that the [watch-case] *or* [watch-cases] [brought] *or* [sent] by me this day to the Assay Office at in number and in a parcel marked [was] [were] made in

(*b*)

(*a*) Here insert name and address of declarant.
(*b*) Signature of declarant.

Declared at this day of 18 .

Before me (*c*)

Officer of the aforesaid Assay Office appointed in that behalf , *or*, Justice of the Peace for , *or*, Commissioner having power to administer oaths in the Supreme Court of Judicature in England.

[Supreme Court of Judicature in Ireland].

[Court of Session in Scotland].

(*c*) Signature and title of person before whom the declaration is made.

SCHEDULE II. (*a*).

On a foreign gold case :—

Within a shield of the form of a Cross, and of the size shown in Figure I. of the Appendix hereto, the word "Foreign," over which a hall mark particular to each office shown in Figure III. and the carat value of the gold, and under which the decimal equivalent of the carat value of the gold together with the variable annual date letter.

On a foreign silver case :—

Within a shield of the form of a regular octagon and of the size shown in Figure II. of the Appendix hereto, the word "Foreign," over which a hall mark particular to each office shown in Figure III. and under which the variable annual date letter.

The particular hall mark above referred to for each of the seven assay offices at which foreign cases may be stamped is shown in Figure V. of the Appendix hereto.

(*a*) See a table of the marks prescribed by this Schedule in Appendix G, *infrà*.

REGULATIONS MADE BY THE COMMISSIONERS OF CUSTOMS UNDER § 16 OF THE MERCHANDISE MARKS ACT, 1887.

WHEREAS by the Merchandise Marks Act, 1887 (hereinafter called "the Act"),

After various provisions against the sale, or exposure for sale, or possession for sale, trade or manufacture, of goods with forged trade marks or false descriptions, or trade marks falsely applied to them :

And after defining (amongst other things), the expression "trade mark" in manner therein set forth, with reference to "The Patents, Designs, and Trade Marks Act,

1883," and the law of indicated British Possessions and Foreign States:

And after defining the expression "trade description" as any description, statement or other indication, direct or indirect, as to number, quantity, measure, gauge, or weight, of goods, as to place or country in which any goods were made or produced, as to the mode of manufacturing or producing any goods, or as to the material of which any goods are composed, or as to any goods being the subject of any existing patent, privilege, or copyright:

And after defining the expressions "false trade description" and "goods," "apply," and "falsely apply";

It is provided by § 16 that,

(i.) All such goods as above mentioned, and

(ii.) All goods of foreign manufacture, bearing any name or trade mark, being or purporting to be, the name or trade mark of any manufacturer, dealer, or trader, in the United Kingdom, unless such name or mark be accompanied by definite indication of the country in which such goods were made or produced,

shall be prohibited to be imported, and, subject to the provisions of the said section, shall be included among goods prohibited to be imported, as if they were specified in § 42 of "The Customs Consolidation Act, 1876":

And whereas by § 18 of the Act, after authorising the continued use of trade descriptions lawfully and generally applied to goods of the particular class, or manufactured by a particular method, to indicate such class or method, it is provided that, where such trade description includes the name of a place or country calculated to mislead as to where the goods were actually made or produced, such goods not having been actually made or produced there, the said reciting section should not apply (and, consequently, goods so marked would be prohibited), unless there be added to the trade description, immediately before or after the name of the place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there:

And whereas it is also provided, by the said § 16, that the Commissioners of Customs (hereinafter called "the Commissioners"), may, from time to time, make, revoke

and vary regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited as hereinbefore mentioned, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such Regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of the said section, and the mode of verification of such evidence:

And it is further provided by the said last-mentioned section:—

That before detaining goods or taking proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners may require that such Regulations as aforesaid shall be complied with, and satisfy themselves as to the liability of the goods to forfeiture:

That such Regulations may apply to all goods, the importation of which is prohibited by the said section, or different Regulations may be made respecting different classes of such goods:

And also that the Regulations may provide for the informant reimbursing the Commissioners all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention:

And it is also provided, by the said section, that § 2 of the Revenue Act, 1883, shall be repealed from a day to be fixed by Regulations under the said reciting sections, such day not being later than the first day of January 1888, without prejudice to anything done or suffered thereunder:

And whereas § 2 of the Revenue Act, 1883, is the law under and by virtue of which goods of foreign manufacture infringing the proprietary rights of British subjects in Names, Addresses, and Trade Marks, or bearing or having upon them, under certain conditions, the name of a place in or a part of the United Kingdom, are, at the present time, detected and stopped by officers of customs acting on their own observation and responsibility, under directions laid down by the Commissioners, and without the requirement of previous information, security, or other conditions:

Now, therefore, the Commissioners under and by virtue of the hereinbefore recited power in that behalf, hereby make and require to be complied with the following Regulations, viz.:

1. Goods prohibited to be imported as hereinbefore recited, having applied to them forged trade marks, false trade descriptions, or marks, names, or descriptions otherwise illegal, which, upon examination, are detected by the officers of customs, are to be detained by them without the requirement of previous information.

2. In giving information with a view to detention an informant must fulfil the following conditions, viz. :—

(i.) He must give to the collector or superintendent, or the chief officer of customs of the port (or sub-port) of expected importation, notice in writing stating,
the number of packages expected, as far as he is able to state the same;
the description of the goods by marks or other particulars sufficient for their identification;
the name or other sufficient indication of the importing ship;
the manner in which the goods infringe the Act;
the expected day of the arrival of the ship.

(ii.) He must deposit with the collector or other officer as aforesaid a sum sufficient, in the opinion of that officer, to cover any additional expense which may be incurred in the examination required by reason of his notice.

3. If, upon arrival and examination of the goods, the officer of customs is satisfied that there is no ground for their detention, they will be delivered. If he is not so satisfied, he will decide either to detain the goods, as in a case of detention upon ordinary examination, or to require security from the informant, for reimbursing the Commissioners or their officers all expenses and damages incurred in respect of the detention made on his information, and of any proceedings consequent thereon.

4. The security thus required must be an immediate *ad valorem* deposit of ten pounds per cent. on the value of the goods, as fixed by the officer from the quantities of value shown by the entry; and, also, subsequently a bond to be completed within four days in double the value of the goods, with two approved sureties. The *ad valorem* deposit will be returned upon completion of the bond, and will not be required if, as an alternative where time permits, the informant prefers to give a like bond before examination, upon estimated value of the goods declared to by him under statutory declaration. If the security is not duly given as above required, there will be no further detention of the goods.

5. In the above Regulations the words "officer of customs" mean an officer acting under the general or special direction of the Commissioners, and the words "value of the goods" mean value irrespective of duty.

6. The "notice" and "bond" required as above shall be in the forms contained in the Schedule to these Regulations, or in such other forms as the Commissioners may from time to time order and direct.

7. The security taken under these Regulations will be given up at the times following, that is to say:—

Where given before examination, and if no detention, forthwith.

Where given on detention:—

If the forfeiture is completed, either by lapse of time or ultimate condemnation by the Court of Justice, then on such completion of forfeiture.

If the forfeiture is not completed, then

If the goods are released by the Commissioners, and no action or suit has been commenced against them, or any of their officers, in respect of the detention, then at the expiration of three months from the time of detention; or, if the goods are released for failure of proceedings taken for the forfeiture and condemnation thereof upon information under § 207 of "The Customs Consolidation Act, 1876," and no action or suit has been commenced against the Commissioners, or any of their officers, in respect of the detention, then at the expiration of three months from the trial of such information.

If within such periods as aforesaid any such action or suit as aforesaid has been commenced, then upon the ultimate conclusion of such action or suit, and the fulfilment of the purpose for which the security was given.

8. These Regulations apply to transhipment and transit goods as well as to goods landed to be warehoused, or for home consumption.

9. The 1st day of January 1888 is, by these "Regulations," fixed as the day from which § 2 of the "Revenue Act, 1883," shall be repealed, subject to the terms of the recited Act; and these Regulations will take effect from the date of such repeal.

CHARLES DU CANE
H. MURRAY
HORACE SEYMOUR
} Commissioners of H. M. Customs.

Custom House, London,
1st December, 1887.

SCHEDULE.

(Notice.)

THE MERCHANDISE MARKS ACT, 1887.

To the Collector, Superintendent,
or Chief Officer of Customs at
the *Port of

*Or Sub-Port.

I hereby give you notice that the undermentioned goods, that is to say, (*a*)

(*a*) Describe the goods, number of packages, marks used, and any other particulars necessary for their identification.

are about to be imported into your port on or about the day of next, in the (*b*)
from

(*b*) Describe the ship, and give name or indication.

That such goods are liable to detention and forfeiture being (*c*)

(*c*) State how the goods infringe the Act, and if the infringement is one as to a forged trade mark protected in a British Possession or Foreign State, state the Possession or State, or if the infringement is one as to place or country of origin, state the name of the place or country falsely used.

That
Mr. of
and Mr. of
are prepared to become my sureties in such bond as may be required upon detention of the goods.

And I request that the said goods may be detained and dealt with accordingly.

Dated this day of , 18 .

A. B.
(or Agent for)

NOTE.—Mr. refers to
his Bankers (or) Solicitors, and Mr.
to his Bankers (or) Solicitors as to his sufficiency for the penalty of the Bond.

(*Bond.*)

THE MERCHANDISE MARKS ACT, 1887.

KNOW ALL MEN BY THESE PRESENTS, THAT WE A.B.
and
are firmly bound unto Our Sovereign Lady Victoria, by the Grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, in the sum of Pounds to be paid to our said Lady the Queen, her heirs or successors. For which payment well and truly to be made we bind ourselves, jointly and severally, our heirs, executors, and administrators, firmly by these presents. Sealed with our Seals. Dated this day of , in the year of our Lord one thousand eight hundred and

WHEREAS the above named A.B.
has by a notice dated the day of
informed the Collector of Customs at that the undermentioned goods, that is to say,

were about to be imported into the port of
contrary to § 16 of the Merchandise Marks Act, 1887, and requested that the said goods should be detained and dealt with accordingly. And whereas the said goods duly arrived in the said Port on the day of last, and are now detained pursuant to the said notice. Now the condition of this obligation is such that if the said A.B.
his executors or administrators, shall well and effectually indemnify, save harmless, and keep indemnified, Her Majesty, her heirs and successors, and all her and their officers of Customs, and their executors or administrators, from and against all loss or damage, payment or payments, and all costs and expenses which Her said Majesty, her heirs or successors, and her and their officers of customs, their executors or administrators, shall or may sustain or incur by reason or on account of any detention of the said goods following upon the information contained in such notice and any proceedings consequent upon such detention, then this obligation shall be void, or otherwise shall be and remain in full force and virtue.

Signed, sealed, and delivered }

GENERAL ORDERS MADE BY THE COMMISSIONERS OF CUSTOMS FOR CARRYING INTO EFFECT THE MERCHANDISE MARKS ACT, 1887.

General Order $\frac{81}{1887}$.

CUSTOM HOUSE, LONDON,

20th October, 1887.

SIR,

Herewith you will receive the usual number of copies of the Merchandise Marks Act, 1887 (50 & 51 Vict. c. 28).

You are carefully to note the meanings given by the Act to the following expressions, viz.:—

"Goods," § 3.
"Applied," § 5; subs. 1 & 2.
"Falsely applied," § 5; subs. 3.

"Trade Mark"	§ 3.
"Trade Description"	
"False Trade Description"	
"Person"	
"Manufacturer"	
"Dealer" or "Trader"	
"Proprietor"	
"Name"	
"Name or initials"	

You will also especially note, as applying to imported goods, the provisions of § 10, subs. (2), and § 18 of the Act.

You will observe that by § 5 of the Act the word "applies" in connection with goods is extended to "applying" the name or mark to any "covering, label, reel, or other thing."

You will understand that, in future, as hitherto, this will not be held to extend to "coverings" or other such things, including boxes, bottles, or the like, imported alone and with the intention of using them as auxiliary means of carrying into the market goods really British or goods (such as wine) incapable of being mistaken as British goods, where the description applied to the coverings or such other things does not relate to *them*, but has reference to the goods which they are to cover to carry into the market.

There is, however, on this point one article to be specially noticed, viz. "Watch-cases;" and, as to this, your attention is called to § 7 of the Act, which lays down that, in the absence of a counter-description of the watch itself, the description on the watch *case* shall be always held to describe the watch.

Under § 16 of the Act, regulations have been prepared by the Board which are now under the consideration of the Lords of the Treasury.

As soon as these regulations are finally approved, a copy will be sent to you, together with instructions as to the manner in which you are to carry them into effect.

These regulations will come into force on a date to be fixed under them, but not later than the first day of January next.

It is highly desirable, therefore, that in the meanwhile you should make yourself familiar with the general scope of the Act, and especially with the provisions contained in § 16 as to the importation of goods coming within its powers, and with the points to which your attention is now more particularly directed.

I am,
Sir,
Your obedient Servant,
E. GOODWYN.

To the Collector.

General Order $\frac{99}{1887}$.

CUSTOM HOUSE, LONDON,
22nd December, 1887.

SIR,

1. As a sequel to G.O. $\frac{81}{1887}$ you will receive herewith a copy of the Regulations made by the Board under § 16 of the Merchandise Marks Act, 1887, published in the *London Gazette* of the 2nd of December, 1887, and in the *Board of Trade Journal* for the present month.

Twofold object of Regulations.

2. You will observe that the Regulations do two things:

(i.) They direct that goods prohibited by the Act which are detected by the officers upon examination (that is to say, upon ordinary examination for revenue purposes), are to be detained without previous information.

(ii.) They provide what is to be done in cases where prohibited importation, and the ground of such prohibition, are matters not of detection, in the ordinary way, but of information by an informant.

General points on which

3. You will require guidance as to what goods, in the opinion of the Board, the officers ought to detect as mentioned in

sub-paragraph (i.); and as to the action to be taken by officers, after information, as mentioned in sub-paragraph (ii).

guidance is necessary.

4. The Act extends so largely the area of prohibited goods, for the benefit not only of British subjects, but also of the subjects and citizens of foreign states, that as to a considerable proportion of goods liable to prohibition on importation, the officers cannot be expected to act without some guidance by information. It must not be, however, held or worked so as in any way to diminish the care at present taken by the officers in respect to "British Marks," involving names of British places, or indications of British manufacture, and to this extent, at least, the officers must continue to act without previous information.

As to the scope of the Act with reference to "British Marks."

5. You will observe that names or trade marks of British manufacturers, dealers, or traders on imported foreign goods (§ 16, sentence beginning "all goods of foreign manufacture") are to be only admissible if distinctly qualified, not merely, as heretofore, by words showing manufacture abroad, but by a definite indication of the country in which the goods were made or produced; and this same principle is contained, even more emphatically, in § 18 of the Act, as regards lawful and general "trade descriptions," which include the name of a place or country.

Reference to particular provisions as to place or country of origin.

6. The goods, therefore, which the Board distinctly expect the officers themselves to detect upon ordinary examination, and without previous information, will be as follows, viz.:—

Classification of goods specially indicated for detection without information.

Class (*a*). Goods of foreign manufacture, by whomsoever imported, having applied to them, either,

> A name or trade mark which is or purports to be the name or trade mark of a manufacturer, dealer, or trader in the United Kingdom; or a trade description which indicates particular class or method of manufacture, and includes the name of a place in, or a part of the United Kingdom, and is thereby calculated to mislead as to the place of the manufacture or production of goods which have not been manufactured or produced in the United Kingdom;
>
> unless such name, mark, or description is accompanied by a definite indication of the place or country in which the goods were made or produced, that is to say, an addition immediately before or after the said name, mark or description, in an equally conspicuous manner therewith, of the name of the place or country in which the goods were actually made or produced, with, in the case of a trade description including name of place, a statement that they were made or produced there.

Class (*b*). Goods of foreign manufacture, by whomsoever imported, having applied to them any description, figures, words, or marks, or arrangement or combination thereof, so as to constitute, by being or including, either expressly or by reference, the name of a place in or a part of the United Kingdom, or in any other way, a statement or other indication, direct or indirect, that the goods were made or produced in the United Kingdom.

7. On the above classification you will note this paragraph and the paragraphs to 10 inclusive.

As to the requirement of a definite indication of place or country of origin.

It will obviously not be in the power of the officers, nor are they expected, to decide whether goods falling within class (*a*) were actually made or produced in the country from which they come; but, in practice, it will be sufficient if the officers satisfy themselves that the name of *some* foreign country, or of some place in *a* foreign country, is applied to the goods in a manner equally indelible or irremovable, and as equally conspicuous, as the name or trade mark itself, and in close proximity to it.

As to the meaning of the word "purports."

8. The word "purports," also in (*a*), is to be understood as referring to any name or names reasonably suggesting a British manufacturer, dealer, or trader, without regard to the fact of whether the name is or is not known to the officer; or as referring to a trade mark not being merely matter of decoration or ornament, which reasonably suggests itself as British by containing English wording, or national devices or figures distinctly indicating British manufacture.

As to "trade description," including name of place calculated to mislead.

9. The words "a trade description which indicates a particular class or method of manufacture, and includes the name of a place in or a part of the United Kingdom, and is thereby calculated to mislead" mean such terms as Kidderminster Carpets, Windsor Soap, "Balbriggan" on Hosiery, or "Shetland" on Shawls, and the like, which, although they might be held to be merely phrases descriptive of method of manufacture, are yet calculated to mislead as to place of origin.

As to other, less definite, inscriptions indicating in any way make or production in the United Kingdom.

10. Class (*b*) refers to and includes such inscriptions as "present from such and such a place," and the like; or, even without a name, any phrases, words, language or devices, which state or indicate, directly or indirectly, make or production in the United Kingdom; and the words "by reference" mean that "Irish," for instance, is equivalent to "of Ireland." Any goods bearing such marks will be detained, and you will refer the matter to the Board.

Classification, generally, of goods prohibited by the Act.

11. Passing from the goods thus specially mentioned, those generally prohibited by the Act to be imported may be summarised as follows:—

(Head i.). Goods, whether of foreign manufacture or British goods brought back, having a false trade description as to name or initials, or a forged trade mark applied to them.

(Head ii.). Like goods having applied to them a false trade description as to the place or country in which they were made or produced; or as to number, quantity, measure, gauge or weight, mode of manufacture or production, or material of which composed; or as to the goods being the subjects of any existing patent, privilege, or copyright.

A false trade description is a description or indication, whether original or by addition, effacement or otherwise, and whether by figures, words, or marks, or any arrangement or combination thereof, directly or indirectly false in a material respect.

Scope of Head (i).

12. With regard to Head (i.). This is the protection of a manufacturer, dealer, or trader against the fraudulent or unfair use of his name or trade mark by any other person. It would not be possible for officers to enter into examination of all names and marks in respect to their use as between various importers. At the same time, a manufacturer, dealer, or trader who has reason to believe that his name or trade mark is one not unlikely to be imitated, so as to constitute a false trade description, or forged trade mark, is entitled to ask that, without the requirement of special information, such description or mark may, upon any importation, be stopped.

Registration for this purpose.

13. For this purpose the Board sanction the system of registration of names or marks in a way *similar* to that which has hitherto existed; and a manufacturer, dealer, or trader may register his name or mark at such port or ports as he desires. In respect of names or marks so registered, it will be the duty of the officers, at the particular port or ports, to prevent the delivery of goods to which such names or marks are applied, unless the delivery is authorised by the registered proprietor. Apart from names or marks as to which such registration exists, the officers are not expected to examine goods with reference to Head (i.).

Who may register, and on what terms.

14. Any manufacturer, dealer, or trader, whether British or foreign, may register his name or mark; but you may refuse registration to any name or mark which you consider to be of a character too indefinite or indistinct for officers to recognise, referring to the Board in any case of doubt. An applicant for registration must prove his proprietorship of the name or mark by declaration; and if, in order to avoid delay, he desires to do so, he may appoint an agent to give authority for delivery of

See paragraph 32.

his goods, and prove (also by declaration) the appointment of such agent.

Registration to be subject to provisions mentioned in paragraph 6.

15. You must understand, very distinctly, that the use by the British manufacturer, dealer, or trader of even his *own* name on foreign goods, and the use by *any* manufacturer, dealer, or trader, on like goods, of words, figures, or marks of any kind stating or indicating, directly or indirectly, make or production in the United Kingdom, are prohibited unless the qualifying conditions specified in paragraph 6 are complied with. You must, therefore, clearly explain to every person registering a name or mark which involves any such statement or indication, as will probably often be the case, that, while the name or mark will be guarded by such registration, it will not be rendered admissible unless duly qualified, as the law may require, in every case. The register at your port under the law now expiring will cease to be operative with the expiry of that law.

Notwithstanding classification in paragraph 6, any other infringement detected is to be followed by detention.

16. As regards Head (ii.); if (apart from the goods specially mentioned in paragraph 6, and notwithstanding that classification) the officers should in any case upon that ordinary examination for revenue purposes, detect anything constituting an infringement of any of the prohibitions of the Act as thus set forth, you will detain such goods and refer the matter to the Board.

Indication as to where such detection may happen.

17. Such detection by officers may happen, for instance, as to number, quantity, measure, gauge, or weight; while, on the other hand, as to mode or material of manufacture, as to any patent, privilege, or copyright,* or foreign trade marks, the officers, upon ordinary examination, may probably, in the absence of special knowledge, fail in detecting false descriptions or forged trade marks.

Directions as to question of place or country of origin.

18. False descriptions as to place of origin affecting the interests of "British Possessions" or "Foreign States" are matters which, unaided by information, officers will not generally be expected to trace; but wherever they observe goods conspicuously known as the usual product of a particular place or country, and marked with that name, shipped from a port in another country altogether—as, for instance, Wine marked "Xeres" or "Spanish" from Belgium, or Cigars marked "Havana" from Germany—such goods may, in the absence of proof of make or produce at the place or in the country named on them, be properly detained.

Action upon information—two stages of such action.

19. Some directions (beyond what is shown in the Regulations) are desirable as to your action upon "information;" and you will observe that there are two stages of procedure in this:

* As to copyright, this instruction in no way affects the practice under §§ 42 and 44 of "The Customs Consolidation Act, 1876."

viz., one up to and including the arrival and examination or identification of the goods; and the other after the examination or identification.

As to special examination of goods in such case.

20. With regard to the first stage—the two points for consideration are, whether any, and if so what, special examination of the goods should be made, and what deposit should be taken to cover the expense of such examination, if it is made.

On what it will depend.

21. The character and extent of examination will require careful discretion on your part, and will depend on the manner in which the goods are alleged in the notice to infringe the Act. An indication has been given you above as to what the Board consider that officers can detect and what they cannot, upon ordinary examination; and this will furnish you with a guide as to what they may be able to trace upon fuller examination after information.

Course where such examination would not be serviceable.

22. Wherever, in accordance with such indication, you are of opinion that the officers could not, even on fuller examination, discover whether the goods infringe the Act, you need not order a special examination, and consequently you will not require any deposit in respect of such examination, but you may at once order detention of the goods as if the officers had seen cause to detain them, and proceed to require security, in conformity with directions given in paragraph 29 of this Order.

Course where such examination would be serviceable.

23. Wherever, on the other hand, you are of opinion that a fuller examination than that ordinarily directed for revenue purposes may reasonably enable the officers to discover whether or not there is the infringement alleged—as, for instance, by careful weighing, measuring, counting, or gauging—you will direct that such an examination shall take place, examining as to free goods, for this purpose, not less than twice the usual number of packages, and in the case of goods imported in bulk, such as machinery and the like, treating each piece imported as a package.

Deposit to cover such examination.

24. Assuming examination to be ordered by you in accordance with the lines above indicated, you will take, as a deposit to cover the additional expense of this examination, such sum as you may think necessary, having regard to the nature of the goods, and to the number of packages which, according to the informant's knowledge, will have been stated in the notice.

Special rules in such examination in regard to place or country of origin as affecting

25. The case of false description as to place of origin affecting the interests of "British Possessions" or "Foreign States" is here again one for special mention. As above stated, it is one which, as a rule, officers cannot be expected to detect without information; but, for an officer examining upon information, the following rules may be laid down: viz., if it is ascertained that the name of place or country complained of is not applied

British Possessions or foreign states.

to the goods at all, or, if applied, is accompanied by a definite indication or addition, as contemplated by the Act, of make or production elsewhere, the officer may be satisfied that there is no ground existing to justify the notice received; but if the name complained of is found to be applied to the goods, and is the name of a country, or of a place in a country, not the country of a port or shipment, the officer may, in the absence of proof of make or produce at the place or in the country named on them, be satisfied that the alleged infringement clearly exists.

As to British Possessions and foreign states to which the provisions in relation to forged trade marks apply.

26. In the case of a notice alleging the application of a forged trade mark where the mark is one protected in a British Possession or foreign state, such a notice will only be good, and need only be accepted by you, if it relates to possessions or states included in the definition of trade marks.

Up to the present time the British Possessions and foreign states so included are:

British Possession ...	Queensland.
Foreign States in Europe	Belgium.
	France.
	Italy.
	The Netherlands.
	Norway.
	Portugal.
	Servia.
	Spain.
	Sweden.
	Switzerland.
In N. and S. America and the W. Indies	Brazil.
	Guatemala.
	Paraguay.
	San Domingo.
	The United States of America.
	Uruguay.
In Africa	Tunis.

Transhipment and transit.

27. As to transhipment and transit goods; where information and "notice" relate to these goods you will deal with them exactly as if they were goods for home use. Apart from information you will not, as regards the ordinary examination of such goods for revenue purposes, examine more packages than at present; but the Board, in addition to the existing rules as to transhipment and transit goods, direct that, as to all such goods, no marks of any kind or description shall be allowed to be applied to them in this country, and you will see that this is strictly carried out in your port.

Rules as to special

28. As to goods examined upon information generally, you

will be guided by the following rules. If upon examination the officer is satisfied that there is no ground existing to justify the notice received, he will pass the goods; if he is satisfied that the alleged infringement clearly exists, he will detain the goods as in a case of detention upon ordinary examination; but in cases where the officer is not so satisfied, and in cases where you may have considered that official examination cannot test the point, you will order the detention of the goods at the risk of the informant, and thus arrive at the second stage of the procedure upon information—viz., the taking of security. examination generally.

29. You will observe that (except in cases where the informant prefers to give a bond, and where time allows such a step to be taken before the goods arrive and are examined), there are two things to be done in taking security: first, to take an *ad valorem* money deposit to cover the possibility of the bond not being completed; and secondly, to see that the bond is completed, after which you will return the deposit. The amount of both the deposit and the bond will depend on the value of the goods. As to security where detention ordered.

30. The form of Notice given in the Schedule to the Regulations requires a statement of the names of persons proposed as sureties. As to the sufficiency of these you will make inquiries in the usual way, and have the bond completed as in other transactions. Inquiries as to sufficiency of sureties.

31. The security having once been taken, the goods will, without further special examination, remain in charge; and the Regulations contain definite provisions as to when, in the various contingencies that may arise, the security will be delivered up. As to goods after security taken, and as to delivery up of security.

32. A form is annexed of the declaration mentioned in paragraph 14; and also of a Bond, when it is preferred to give one before examination, as mentioned in paragraph 29. Supplies of these forms, and of those given in the Schedule to the Regulations, can be obtained in the usual way. Supply of forms.

33. A General Order as to Watch-cases and Watches will shortly be issued; and further directions will be given, from time to time, as decisions are arrived at, under paragraphs 9 and 10, and paragraphs 16, 17, and 18 of this Order.

I am,
Sir,
Your obedient Servant,
E. GOODWYN.

The Collector
at

MERCHANDISE MARKS ACT, 1887.

50 & 51 VICT. CH. 28.

Declaration on Registration under Paragraph 13 *of General Order* $\frac{99}{1887}$.

(*a*) Full name and address of declarant.

(*b*) "I" or "I and my partners, trading as Messrs. " or "such and such a Company, of which I am the representative official," or "so and so of such and such a place abroad, whom I represent in this country.

(*c*) "is" or "are."

(*d*) "the following name as a trade description," or "the following trade mark," or "the following name as a trade description and trade mark."

(*e*) "I" or "we."

(*f*) "I" or "we."

(*g*) This portion as to appointment of agent may be erased, where such appointment is not desired.

(*h*) "my" or "our."

Port of

I (*a*)

hereby declare that (*b*)

(*c*) the proprietor , of (*d*)

viz.

which (*e*) expect to be applied to goods imported, from time to time, at this Port; and that (*f*) have appointed Mr. (*g*) of to be (*h*) agent, to give authority for the delivery of such goods.

I make this solemn declaration conscientiously believing the same to be true, and by virtue of the Statutory Declarations Act, 1835.

Signed

Declared this day of . 18 .

At

Before me

A Commissioner to administer Oaths, &c

N.B.—Registration in pursuance of this Declaration is subject to the provisions of the Act which forbid the importation, by a registered proprietor, even of his own goods which bear, in name or mark, any statement or indication, direct or indirect, of make or produce in the United Kingdom, unless qualified as the Act requires.

Know all Men by these Presents that we are held and firmly bound unto our Sovereign Lady Victoria, by the Grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, in the sum of pounds to be paid to our said Lady the Queen, Her Heirs or Successors; for which payment well and truly to be made we bind ourselves jointly and severally, our heirs, executors and administrators, firmly by these Presents. Sealed with our seals. Dated this day of in the year of our Lord one thousand eight hundred and .

Whereas the above-named has by a notice dated the day of informed the Collector of Customs at that the undermentioned goods, that is to say,

are about to be imported into the port of contrary to § 16 of the Merchandise Marks Act, 1887, and has requested that the said goods shall be detained and dealt with accordingly. Now the condition of this obligation is such that if the said , his executors or administrators, shall well and effectually indemnify, save

harmless, and keep indemnified Her Majesty, Her Heirs and Successors, and all Her and Their Officers of Customs and their executors or administrators, from and against all loss or damage, payment or payments, and all costs and expenses which Her said Majesty, Her Heirs or Successors, and Her or Their Officers of Customs, their executors and administrators, shall or may sustain or incur by reason or on account of any detention or delay in the delivery of the said goods, following upon the information contained in such notice and any proceedings consequent upon such detention or delay, then this obligation shall be void, otherwise shall be and remain in full force and virtue.

Signed, sealed and delivered }

General Order $\frac{9}{1888}$.

CUSTOM HOUSE, LONDON.

18*th January*, 1888.

SIR,

In acordance with paragraph 33 of General Order $\frac{99}{1887}$, I now transmit to you the directions of the Board, to enable you to deal with watch-cases and watches, under the Merchandise Marks Act; the latter term, watches, meaning as provided by § 7 of the Act, "all that portion of a watch which is not the watch-case."

Your attention has already, by G.O. $\frac{81}{1887}$, been called to the position in which watch-cases, under this section, stand in relation to watches; and the consequent importance of the assay mark on watch-cases, which mark, by virtue of § 3 (1) of the Act, would be deemed a trade description as to place or country of origin.

You will note, in addition, that by § 8 (1) of the Act provision is made for preventing foreign-made watch-cases from obtaining the mark placed on a watch-case made in the United Kingdom: and it is enacted that a different mark shall be placed on foreign watch-cases of such pattern, and in such mode as directed by Order in Council.

An Order in Council to this effect, dated the 28th November

last (*a*), was published in *The London Gazette* of 9th December last; and a copy of this order, together with sheets 1 and 2 of Appendix to Schedule II. therein referred to, which contain diagrams of the required new marks, are sent to you herewith.

You will carefully study these sheets, and note how the marks apply variously to the different assay offices in the United Kingdom.

The directions to be observed by you in applying this new law will relate to—

(*a.*) Watch-cases with assay marks imported alone.
(*b.*) Like watch-cases imported with the watches, that is to say, watches of foreign manufacture in them.

(a.)—Watch-cases with Assay Marks imported alone.

If the cases are wholly unmarked, or are duly marked in accordance with the Order in Council, or with a foreign assay mark, and there is not, in addition, any wording on any part of the case proper, or on the dome, indicating make or produce in the United Kingdom, the goods may be delivered. If, on the other hand, there is any such wording, the goods must be detained and the matter referred to the Board.

If the cases are marked with a British Hall Mark as placed on watch-cases made in the United Kingdom, you will detain the goods unless they are entered as "British goods brought back," in which case they may be admitted under the usual regulations.

(b.)—Watch-cases imported with the Watches in them.

If the cases are wholly unmarked, or are marked either
In accordance with the Order in Council, or
With a foreign assay mark, or
With a British assay mark as placed on a watch-case made in the United Kingdom, and with an equally conspicuous statement either above or below the assay mark, that the watch is of foreign make;

And if there is no wording either as an addition on the case or dome, or upon the watch itself, whether on the dial or the plate, or any part of the works, indicating make or produce in the United Kingdom, then the goods may be delivered.

If, on the other hand, there is any such wording, the goods must be detained and the matter referred to the Board.

If the cases are marked with a British assay mark as placed on a watch-case made in the United Kingdom, and with no

(*a*) See p. 554, *supra*.

statement of foreign make on the cases, as required above, you will detain them as a seizure, unless there is upon the dial of each watch and also on the top "plate" (where the watch is of that construction) or on the bottom "plate" (where the watch is of that construction) visibly, between the "bridges," an indelible and definite indication of the place or country in which the watches were made. Such an indication will be considered definite, if it is, or contains only the name of the place or country of origin; if in addition, it contains the name of a place in, or a part of the United Kingdom, as, for instance, "Geneva and London," or if there is anywhere on the watch an indication by figures, words, or otherwise, that the watch might be the make or produce of the United Kingdom, then, in addition to the name of place or country of origin, there must be a distinct statement that the watches were there made.

I am, Sir,

Your obedient Servant,

E. GOODWYN.

The Collector

at

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eneral Order $\frac{14}{1888}$.

CUSTOM HOUSE, LONDON.

4th February, 1888.

SIR,

With reference to paragraph (*b*) of § 5 of the Merchandise Marks Act, 1887, I am desired to acquaint you that a name of a port or place of destination applied to mere packing-cases, in which goods are clearly not intended to be sold, or exposed for sale, either wholesale or retail, will not render the goods liable to detention; but, where a package containing goods is not of this description, the port or place of destination should be accompanied by a definite indication of the country of origin.

I am, Sir,

Your obedient Servant,

E. GOODWYN.

To the Collector.

General Order $\frac{26}{1888}$.

CUSTOM HOUSE, LONDON.

10*th March*, 1888.

SIR,

I am desired to acquaint you, for the information and guidance of yourself and of the officers under your survey, that, with reference to paragraph 6 (*b*) and to paragraph 10 of General Order $\frac{99}{1887}$, the Board are of opinion that inscriptions applied to goods by means of labels or tickets, or applied to boxes, cartons, parcels, or other ultimate packages containing goods, manifestly only for the purpose of distinguishing the goods for the convenience of dealers and shopkeepers, and not specially intended to attract the eye of the consumer, should not be practically treated as trade descriptions, whenever the inscription consists simply of the bare name of the goods or indication of number, quantity, size, and the like.

For instance,—

on Hosiery,

"Hose"

"White Cotton—size 10";

on Textile Fabrics,

"No.—Qual.—Colour—Dess.—Yards,"

or

"No.—Size—Quality—Shade";

on Goloshes,

"1 Doz. pairs—Men's 2nd Quality—No. 7."

Goods bearing labels, tickets, &c., of this character only are not to be detained, whatever may be the language in which the inscriptions are printed or written.

You are to cause these directions to be carried into effect accordingly.

It is to be understood that this order does not apply to wording on the goods themselves, nor to any wording which includes the name of a place or country, the name of any trader, manufacturer or dealer, or a trade mark.

I am further to acquaint you that the last clause of General Order $\frac{14}{1888}$ is not to be read as applying to the names of ports of unshipment, used for the mere purpose of indicating where the goods are to be unladen, as required frequently in bills of lading, whatever may be the description of package used.

The officers are to exercise their discretion in distinguishing whether those names are used solely for the purpose specified above.

I am, Sir,

Your obedient Servant,

R. T. PROWSE.

To the Collector.

General Order $\frac{33}{1888}$.

CUSTOM HOUSE, LONDON.

24th March, 1888.

SIR,

With reference to paragraph 33 of the General Order $\frac{99}{1887}$, I am desired to acquaint you that Swedish iron bearing the words "Lancashire Swedish," or the abbreviation thereof, "Lancash. Swedish," is to be admitted into this country without question so far as the provisions of the Merchandise Marks Act, 1887, are concerned.

This arrangement is sanctioned upon the understanding that the words of the Mark shall not be inverted, and that under no circumstances will Swedish iron marked "Lancashire" alone be admitted into this country.

I am, Sir,

Your obedient Servant,

R. T. PROWSE.

To the Collector.

General Order $\frac{44}{1888}$.

CUSTOM HOUSE, LONDON.

9th April, 1888.

SIR,

With reference to § 33 of the General Order $\frac{99}{1887}$, I am desired to acquaint you that packages used for the importation from any place of natural flowers, fresh fruit, vegetables and potatoes, and bearing upon them marks which the officers are satisfied are merely address marks, such as "Wm. Evans, Leeds," "Thos. Jones, London," are to be treated

as packing cases to which the provisions of the General Orders $\frac{14 \text{ and } 26}{1888}$ apply, and are not to be detained under the Merchandise Marks Act on account of such marks only.

Moreover, packages of the above description coming from the Channel Islands, Malta, Gozo, and Gibraltar, and bearing on them, in addition to address marks, any words in the English language describing the goods contained in the packages, are not to be detained on this account, provided such words do not constitute a trade mark, nor include the name of a place in the United Kingdom to which the General Orders quoted above do not apply.

I am, Sir,
Your obedient Servant,
R. T. PROWSE.

To the Collector.

General Order $\frac{7}{1889}$.

CUSTOM HOUSE, LONDON.
1st February, 1889.

MERCHANDISE MARKS ACT, 1887.

Certain Discretionary Powers given to Officers.

The importation sections of the Merchandise Marks Act, 1887, having now been in force for over twelve months, and its provisions having become familiar both to importers of goods and to the officers of customs, the Board have considered whether some discretionary power may not be given to the collectors, surveyors, or other superior officers in releasing goods which, although at first sight they appear to be liable to detention, yet on further explanation from the importer may properly be released, so far as the Merchandise Marks Act is concerned—such, for instance, as genuinely marked British returned goods, or private property in actual use.

The Board accordingly give to the collectors and surveyors at the Outports, and to the inspectors and surveyors in London, a discretionary power to deliver goods without a special order when they are satisfied that they come under any one of the following heads:—

(1.) Articles not dutiable, however marked, sent over to one individual as presents or for personal use, and not in any process of sale or purchase, on the officers satisfying themselves that the importer's statement in this respect is correct. (1.) Articles for private use.

(2.) Used articles either private property or sent for repairs.

(2.) Articles which are not new and which are manifestly private property, such as clothing or other personal effects, and old, used, and damaged articles sent to this country for repairs and imported by or consigned to the persons whose names are on the goods. Under this head, however, such goods as old lace, old china, or old violins, and similar articles sent by dealers for sale as antiquities, are not included; goods of this kind are strictly merchandise. Wherever age, apparent or real, adds to the value of the goods, they are not to be delivered under this paragraph, unless they are private property, not in any process of sale or purchase, but the directions of the Board must be obtained.

(3.) British samples returned.

(3.) Samples of *no value*, made by competing firms in the United Kingdom, and sent to manufacturers in this country for the purposes of trade, may be delivered on a statement being made in writing by the importer that the articles are samples of no value, and that they are imported for trade purposes, as samples, and not for sale or use, provided the officers are satisfied that they are of British manufacture.

(4.) Foreign samples.

(4.) Foreign samples *not* bearing the names or trade marks of manufacturers or dealers in the United Kingdom, but bearing trade descriptions which are misleading in language as to the country from which they come, may be also admitted upon being duly qualified, and on the officers being satisfied that they are imported for purposes of manufacture or comparison in this country. Foreign samples, however, bearing the names or trade marks of British manufacturers or dealers, or indirect indications of British manufacture, without qualification, sent for the purpose of soliciting orders for sale in this country, are to be placed under detention, and not delivered without the Board's sanction.

(5.) British returned goods.

(5.) British returned goods, not dutiable, or in respect to which no drawback can have been received, may be released under § 6 of the Act 42 & 43 Vict. c. 21, without a special order of the Board, so far as the marks are concerned, either by a Bill of Store, or by declaration of the importer that the goods are within his knowledge British returned, so long as the collector or surveyor sees no reason to doubt its truth.

Should, however, the goods be admitted to entry as British under the second alternative allowed by the section, viz.: "by and with the consent in writing of the proprietor of such name, brand, or mark, or his legal representative," such consent in each case must be accompanied by a statement from the persons whose names appear upon the goods that the articles have been manufactured by them in this country.

Should the officer who examines the goods have any doubt as to the truth of the statement, the matter is to be reported to the Board.

The officers will not call for Statutory Declarations made under the Statutory Declarations Act, 1835, without the Board's sanction in each case.

(6.) In London, goods which have been placed under detention on account of illegal marks, and in respect of which no applications have been made by the importers or no steps taken to carry out the conditions imposed by the Board on their release, within two months from the date of the Board's order for their detention, are to be removed to the Queen's Warehouse, without special directions in each case, should the officers see no circumstances which call for exceptional treatment.

(7.) The officers are to take care that, in all cases where the Board allow qualifying words to be added before the delivery of goods, such words are applied in characters clear, conspicuous, and as indelible as the marks requiring qualification, and in close proximity to those marks.

By Order,
E. GOODWYN.

To the Collector.

APPENDIX F.

STATUTORY ENACTMENTS WITH RESPECT TO MARKS ON GOODS, &c.

Weights and Measures.

41 & 42 *Vict. c.* 49. (*The Weights and Measures Act*, 1878.)

Part I.—Law of Weights and Measures.

Stamping and Verification of Weights and Measures.

Stamping of weights and measures with denomination.

§ 28. Every weight, except where the small size of the weight renders it impracticable, shall have the denomination of such weight stamped on the top or side thereof in legible figures and letters.

Every measure of capacity shall have the denomination thereof stamped on the outside of such measure in legible figures and letters.

A weight or measure not in conformity with this section shall not be stamped with such stamp of verification under this Act as is hereinafter mentioned.

Stamping of verification on measures and weights.

§ 29. Every measure and weight whatsoever used for trade shall be verified and stamped by an inspector with a stamp of verification under this Act.

Every person who uses or has in his possession for use for trade any measure or weight not stamped as required by this section, shall be liable to a fine not exceeding five pounds, or in the case of a second offence ten pounds, and shall be liable to forfeit the said measure or weight; and any contract, bargain, sale, or dealing made by such measure or weight shall be void.

Lead or pewter weights.

§ 30. A weight made of lead or pewter, or of any mixture thereof, shall not be stamped with a stamp of verification or used for trade, unless it be wholly and substantially cased with brass, copper, or iron, and legibly stamped or marked "cased:"

Provided that nothing in this section shall prevent the

insertion into a weight of such a plug of lead or pewter as is *bonâ fide* necessary for the purpose of adjusting it and of affixing thereon the stamp of verification.

A person guilty of any offence against or disobedience to the provisions of this section, shall be liable to a penalty not exceeding five pounds, or in case of a second offence ten pounds.

Stamping of verification on weights for coin.

§ 31. Every coin weight, not less in weight than the weight of the lightest coin for the time being current, shall be verified and stamped by the Board of Trade with a mark of verification under this Act, and otherwise shall not be deemed a just weight for determining the weight of gold and silver coin of the realm.

Every person who uses any weight declared by this section not to be a just weight shall be liable to a fine not exceeding fifty pounds.

Forgery, &c., of stamps on measures or weights.

§ 32. If any person forges or counterfeits any stamp used for the stamping under this Act of any measure or weight, or used before the commencement of this Act for the stamping of any measure or weight, under any enactment repealed by this Act, or wilfully increases or diminishes a weight so stamped, he shall be liable to a fine not exceeding fifty pounds.

Any person who knowingly uses, sells, utters, disposes of, or exposes for sale any measure or weight with such forged or counterfeit stamp thereon, or a weight so increased or diminished, shall be liable to a fine not exceeding ten pounds.

All measures and weights with any such forged or counterfeit stamp shall be forfeited.

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50 & 51 *Vict. c.* 58. (*The Coal Mines Regulation Act*, 1887.)

Application of 41 & 42 Vict. c. 49 to weights, &c., used in mines.

§ 15.—(1.) The Weights and Measures Act, 1878, shall apply to all weights, balances, scales, steelyards, and weighing machines used at any mine for determining the wages payable to any person employed in the mine according to the weight of the mineral gotten by him, in like manner as it applies to weights, balances, scales, steelyards, and weighing machines used for trade.

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52 & 53 *Vict. c.* 21. (*The Weights and Measures Act*, 1889.)

Verification of weighing instruments.

§ 1.—(1.) Every weighing instrument used for trade shall be verified and stamped by an inspector of weights and measures with a stamp of verification under this Act.

(2.) Every person who, after the expiration of twelve months from the commencement of this Act, uses or has in his possession for use, for trade any weighing instrument not stamped as

required by this Act, shall be liable to a fine not exceeding two pounds, or in the case of a second offence five pounds.

(4.) Section 32 of the principal Act (*a*) shall apply to weighing instruments in like manner as it applies to weights and measures.

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25 & 26 *Vict.* c. 76. (*The Weights and Measures (Ireland) Amendment Act*, 1862) (*b*).

PART III.

Prevention of Frauds.

Penalty on counterfeiting brand.

§ 14. If any person commit any of the following offences, he shall for each offence be liable to a penalty not exceeding five pounds;

(1.) If he, with intent to defraud, counterfeit or procure to be counterfeited any brand or stamp used by or under the authority of the owner or lessee of a market or fair, or of any person having by law the control of a market or fair, to denote the weight, measure, or quality of any article sold in the market or fair, or within the prescribed limits, during the holding of the market or fair, or of any cask, firkin, or other vessel, covering, or thing in which such article is sold, or the impression of any such brand or stamp:

(2.) Or, with the like intent, use or procure to be used any such counterfeit brand, or stamp, or impression:

(3.) Or, with the like intent, alter an impression of any such genuine brand or stamp:

(4.) Or, with the like intent, have in his possession anything having thereon an impression of any such counterfeit brand or stamp, or a fraudulently altered impression of any such genuine brand or stamp:

(5.) Or, with the like intent, transfer or apply any cask, firkin, or other vessel, covering, or thing, having thereon an impression of any such genuine brand or stamp, to any article other than that for denoting the weight, measure, or quality whereof such impression was made on such cask, firkin, or other vessel, covering, or thing, or in any other manner alter the *bonâ-fide* application of an impression of any such genuine brand or stamp:

(*a*) The principal Act is the Weights and Measures Act, 1878.
(*b*) This Act was repealed in part by 41 & 42 *Vict.* c. 49.

(6.) Or knowingly weigh or caused to be weighed, contrary to the provisions of this Act, or act or assist in committing or connive at any fraud respecting the weighing or the weight or measure of any such article as in Part II. of this Act is mentioned (*a*):

(7.) Or, with intent to defraud, alter any ticket specifying the weight of any such article:

(8.) Or, with intent to defraud, make or use, or be privy to the making or using of any such ticket, falsely stating the weight of any such article, or of any covering, cart, or load:

(9.) Or shall dispose of, sell, or cause to be sold any weight or measure having a false or counterfeit stamp, or a stamp purporting to resemble a genuine stamp.

Penalty for fraudulently increasing weight of butter in casks.

§ 15. If any person shall wilfully pack up or mix, or cause to be packed up or mixed, with or in any butter contained in any firkin or cask, any salt pickle, or other substance, with intent to increase the weight of such butter, and shall bring or send any butter so packed or mixed to any market for sale, he shall be liable to pay a fine not exceeding forty shillings, or be imprisoned for any period not exceeding one month, as the justice or justices shall determine.

Penalty for fraudulently increasing weight of fleeces.

§ 16. If any person shall wind or cause to be wound in any fleece any wool not being sufficiently rivered or washed, or wind or cause to be wound within any fleeces any deceitful locks, cots, skin, or lamb's wool, or any substance, matter, or thing, whereby the fleece may be rendered more weighty, to the deceit and loss of the buyer, such person shall be liable to a penalty of two shillings for every fleece so fraudulently made up.

THE EXHIBITION MEDALS ACT, 1863—26 & 27 Vict. c. 119.

Penalty on false representations. As to having obtained medals.

§ 1. If any trader commits any of the offences following; that is to say:

(1.) Falsely represents that he has obtained a medal or certificate from the Exhibition Commissioners (*b*) in respect of any article or process for which a medal or certificate has been awarded by the Commissioners:

(2.) Falsely represents (knowing such representation to be false) that any other trader has obtained a medal or certificate from the Exhibition Commissioners:

(3.) Falsely represents (knowing such representation to be false) that any article sold or exposed for sale has

(*a*) *I.e.*, every article sold by weight.
(*b*) Of 1851 or 1862. See § 3.

been made by, or by any process invented by, a person who has obtained in respect of such article or process a medal or certificate from the Exhibition Commissioners:

He shall incur the following penalties, that is to say:

(1.) For the first offence he shall forfeit to Her Majesty a sum not exceeding five pounds:

(2.) For any subsequent offence he shall forfeit to Her Majesty a sum not exceeding twenty pounds, or be imprisoned for a period not exceeding six months.

By § 2, in proceedings under this Act, it is not necessary to prove that any person has sustained damage by the false representations.

By § 5 no provision of this Act is to affect any right or civil remedy.

Registered Designs.

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

46 & 47 Vict. c. 57.

Marking registered designs.

§ 51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article (*a*).

(*a*) Under the old Copyright of Designs Acts it was held that the copyright was lost by the sale of pattern pieces of wall paper containing the whole of the registered design, unmarked (*Heywood* v. *Potter*, 1 E. & B. 439); by the sale in France of lace bearing the design, unmarked (*Sarazin* v. *Hamel*, 32 Beav. 151); by the sale of a small number of articles bearing the design, unmarked (*Pierce* v. *Worth*, 18 L. T. N.S. 710); by the sale of one such article unmarked (*Hunt* v. *Stevens*, W. N. 1878, p. 79). But it was held that the copyright was not lost by the sale of a book containing patterns of registered designs, the book being unmarked (*De la Branchardière* v. *Elvery*, 4 Ex. 380); nor by the sale of a butter-dish with a cover, the dish being marked but the cover not (*Fielding* v. *Hawley*, 48 L. T. N. S. 639). And it seems that if the design were applied, but obscured in the process of manufacture, the same would have been the result (*ib.*).

Under the present Act it has been held that where a manufacturer was instructed by his principal to place the right mark on the goods, but by mistake placed on them an old and incorrect mark, the proprietor's right

THE DESIGNS RULES, 1883.

Registration mark.

32. Before the delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in any of the classes 1 to 12 in the Third Schedule hereto, cause each such article to be marked with the abbreviation "RD." and the number appearing on the certificate of registration, and shall, if such article is included in the classes 13 or 14 in the Third Schedule hereto, cause each such article to be marked with the abbreviation "REGD."

Class 13 includes "Printed or woven designs on textile piece goods."

Class 14 includes "Printed or woven designs on handkerchiefs and shawls."

The first twelve classes include all other goods.

was saved by the proviso in the section, especially as each mark bore the abbreviation "R^{D}" (*Wittman* v. *Oppenheim*, 27 Ch. D. 260). Also that where a narrow trimming was sold in lengths round each of which was placed a paper band bearing the proper mark, the marking was sufficient (*Blank* v. *Footman*, 39 Ch. D. 678).

APPENDIX G.

STATUTORY ENACTMENTS WITH RESPECT TO MARKS ON SPECIAL CLASSES OF GOODS (*a*).

Cutlery.

59 *Geo. III. c.* 7 (1819). "An Act to regulate the Cutlery Trade in England."

§ 1. Manufacturers may mark with the figure of a hammer articles of cutlery made by them by means of the hammer.

§ 3. No person is to mark articles of cutlery not made by means of the hammer with the figure of a hammer, or to possess for the purpose of sale, or offer for sale such articles so marked, under penalty of forfeiture of the articles so marked, together with a fine of 5*l.* a dozen.

§ 4. No person is to mark articles of cutlery, or possess for the purpose of sale, or offer for sale articles marked with any words indicative of a quality other than the true one, under similar penalties.

§ 5. No person is to mark articles, or possess, &c., articles marked with the words "London" or "London made," unless such articles were made within the City of London, or twenty miles distance therefrom, under the penalty of forfeiture, together with a fine of 10*l.* a dozen.

§ 14. Articles of cutlery subject to forfeiture by virtue of the Act may be seized and destroyed, &c., by order of justices.

The remaining provisions refer chiefly to forms of procedure, recovery of penalties, &c.

The Cutlers' Company of Hallamshire.

21 *Jac. I. c.* 31 (1623).

§ 1 (*b*). The cutlers living in Hallamshire, or within six miles distance therefrom, are incorporated under the corporate name of "The Master, Wardens, Searchers, Assistants and Commonalty of the Company of Cutlers in Hallamshire in the county of York."

(*a*) The Acts abstracted in the text are in force at present.

(*b*) The remainder of this Act is repealed by 31 *Geo. III. c.* 58.

31 *Geo. III. c.* 58 (1791) (*a*).

§ 1. The company to consist of the trades hereinafter mentioned, and of none other.

§ 3 enumerates "the arts or trades of makers of knives, sickles, shears, scissors, razors, files and forks."

§ 7. Apprentices who have served for seven years are to have, at twenty-one years of age, their freedom of the company and a mark to be assigned them.

§ 17. Members of the company counterfeiting marks assigned to others are for every offence to pay a penalty not exceeding 20*l.* nor less than 4*l.*

§ 26. Penalties may be sued for by the company, or by the party aggrieved, in the Courts at Westminster.

§ 27. One or more justice or justices of the peace for the West Riding of the county of York, or for the county of Derby, shall, upon information of an offence for which a penalty is imposed, summon the parties and witnesses, and hear and determine the matter in a summary way, and give judgment with costs, and issue a warrant for levying the penalties by distress, and if the goods are insufficient, then shall commit the offender to the House of Correction for one month. Costs may be given to a person wrongly accused.

§ 28 contains a form of conviction.

§ 29. An appeal is given to the Court of Quarter Sessions at Sheffield, Rotherham, Barnsley, Wakefield, or Pontefract.

§ 31. The penalties which come to the company are to be distributed among the poor of the company.

The Act contains other provisions with respect to the constitution of the company, procedure, &c.

41 *Geo. III. c.* 97 (1801), (Local).

§ 2. A freeman of the company is empowered to give his mark by will to any person or persons, in the same manner as his other personalty, subject to the life estate therein which his widow is to have during her widowhood or any future coverture, and which she may sell, though on her death the provisions of the husband's will take effect.

§ 3. In default of a will, the mark is to pass in the same manner as its owner's other personalty, subject to the widow's life estate (*b*).

§ 5. Parish apprentices who shall prove to the satisfaction of a justice that they have regularly served a freeman for seven years shall be entitled to their freedom and a mark.

54 *Geo. III. c.* 119 (1814), (Local).

This Act repeals several of the provisions of the Act of 1791, in favour of free trade.

(*a*) Considerable portions of this Act have been repealed by the Acts which follow.

(*b*) And see § 6 of the Act of 1814.

§ 3. Any person carrying on any of the specified trades within the specified limits has a right to have a mark assigned to him by the company on application, which mark is not to be one that is the property of another, nor a surname (*a*); and for such mark he is to pay forty shillings, and if the mark be one previously assigned but surrendered, 3*l.* in addition, besides, in either case, any stamp duty imposed by Act of Parliament (*b*).

§ 4. No mark is to be assigned by the company if they have notice that it is in common use, or in the use of any person within the district (*c*).

§ 5. Members of the company, or any other persons carrying on any of the specified trades within the specified limits, who shall use a mark assigned by the company to another person, with intent to counterfeit, shall for every offence forfeit and pay a sum not exceeding 20*l.*, half of the fine to go to the injured person, the other half to the company. The fine is to be recovered and applied as under the Act of 1791.

§ 6. The provisions made by § 2 of the Act of 1801, for the devolution of marks on the deaths of their owners, are to apply to marks assigned under the present Act (*d*), but not more than one person of the family shall be entitled to use the mark at the same time.

23 *Vict. c. xliii.* (1860), (Local).

§ 1. The provisions of the previous Acts are extended to "the arts or trades of manufacturers of steel and makers of saws and edge-tools and other articles of steel, or of steel and iron combined, having a cutting edge."

§ 2. Any person exercising any of the trades formerly or now specified, within the specified limits, may and shall, on application to the company and payment of 20*l.* in addition to any other fees payable, become a freeman of the company and have a mark assigned to him.

§ 3. The former and present Acts may be cited as "The Cutlers' Company's Acts, 1623, 1791, 1801, 1814, 1860," respectively.

(*a*) The similar provision in § 24 of the Act of 1791 (repealed by the present Act), with respect to non-freemen, provided that, on a non-freeman having a mark assigned to him, he should become a freeman of the company. This is not repeated here.

(*b*) A mark assigned to a non-freeman is assignable by him. See *Bury* v. *Bedford*, 4 De G. J. & S. 352. But where a person to whom a Sheffield mark had been assigned had assigned it to another, and had not gone through the process of surrendering it to the company for re-assignment to his assignee, the latter was not recognised by the company as the proprietor of the mark, nor admitted to registration under the Trade Marks Registration Act, 1875, until he had perfected his title: *In re Rabone*, Dig. 643.

(*c*) By the Trade Marks Registration Act, 1875, § 9, no mark was to be assigned by the company which had been registered under the Trade Marks Registration Acts, notice of the registration having been given to the Cutlers' Company. And see the Patents, &c., Acts, 1883-8, § 81.

(*d*) Thus including non-freemen in possession of company's marks.

The rights of the Cutlers' Company were expressly reserved by the Merchandise Marks Act, 1862 (*a*), § 25, and also by the Trade Marks Registration Act, 1875, § 9.

See also the special provisions in regard to the Cutlers' Company contained in the Trade Marks Registration Act, 1875, § 9, and in 46-56 of the Rules under that Act, now repealed; the effect of which was that the registrar of trade marks was to be supplied with copies of all Sheffield corporate marks, and the Cutlers' Company with copies of all trade marks registered for goods or classes of goods within § 2 of the Cutlers' Company's Act, 1860; that notice of applications for assignment or registration of such marks, and of such assignment or registration, when complete, was to be given by the Cutlers' Company to the registrar and *vice versâ*; that marks identical with or similar to marks already assigned or registered, were not to be registered or assigned respectively (except, in the former case, with the special leave of the Court), and that Sheffield marks might be registered under the Trade Marks Registration Acts.

By § 81 of the Patents, &c., Act, 1883, and Rules 53-56 of the Trade Marks Rules, 1883, the Sheffield Cutlers' Register was reorganised. A new "Sheffield Register" was established, in which are to be entered all trade marks for Cutlery, edge-tools, raw steel, or goods made of steel, or of steel and iron combined, whether with or without a cutting edge, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and registered under the Act of 1875, or assigned by the Cutlers' Company and actually used before the commencement of the Act of 1883. All applications for marks for similar goods are, when made by persons trading within the specified limits, to be made to the company. Notice of such applications is to be given by the company to the comptroller, who may give notice of objection; and notice of applications by persons trading outside the specified limits for marks for similar goods is to be given by the comptroller to the company. Notice of registrations in the Sheffield Register is to be given to the comptroller, who is to enter the marks in the general register; and notice of all other entries is also to be given to him. The practice at Sheffield is to follow generally that at London, and an appeal is given from the company's decisions to the comptroller, and from him to the Court. The provisions of the company's Acts for the summary punishment of persons counterfeiting Sheffield corporate marks are to apply to marks entered in the new Sheffield Register. The old Cutlers' register of corporate marks was closed after five years from the commencement of the Act (*i.e.*, after five years from December 31st, 1883). The net result is to make the Sheffield Register an exact duplicate of the general register, so far as that relates to marks used for the specified goods within the specified limits.

The provisions of § 81 were altered to some extent by § 20 of the Act

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

of 1888, the principal alteration being the enlargement of the class of goods to which the section is made applicable. Such goods are now described by the term "metal goods," which is defined as meaning "all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal." The Sheffield Register is now governed by § 81 of the Act of 1883, as amended by the Act of 1888, and the Trade Mark Rules 56-59 of 1890.

Gold and Silver Plate.

England.

2 *Hen. VI. c.* 17 (in Ruffhead's ed. c. 14) (1423) (*a*).

No goldsmith or silversmith in the city of London to sell wrought silver of less than sterling fineness. No harness of silver to be offered for sale in that city, until touched with the touch of the leopard's head, if it may reasonably bear the same, and also with the workman's mark, under penalty of forfeiture of double value. The mark of every goldsmith to be known to the wardens of the same craft. In the cities of York, Newcastle-upon-Tyne, Lincoln, Norwich, Bristol, Salisbury, and Coventry, to be divers touches. In other places, where no touch is ordained, silver not to be worked of less than sterling fineness, nor to be offered for sale without the worker's mark. Penalty of double value (*b*).

18 *Eliz. c.* 15 (1576) (*c*).

If plate marked by the Goldsmiths' Company be found deceitful, the Company to forfeit the value.

8 *& 9 Wm. III. c.* 8 (1697).

§ 8 (in Ruffhead's ed. § 9) (*d*). No silver plate to be made of less fineness than 11 oz. 10 dwt. in the lb. troy (*e*), nor offered for sale until marked (*f*).

If plate marked by the Goldsmiths' Company be found deceitful, the Company to forfeit the value, half to the Crown, half to the informer.

(*a*) The earliest statute on the subject was 28 *Edw. I. c.* 20 (1300), by which it was provided, among other things, that no vessel of silver should pass out of the worker's hands until assayed by the wardens of the craft, and marked with the leopard's head, and that no worse gold should be worked than that of the touch of Paris. This Act was repealed, saving the King's prerogative, by 19 *&* 20 *Vict. c.* 64.

(*b*) 4 *Hen. VII. c.* 2 (1487) (repealed by 19 *&* 20 *Vict. c.* 64) required finers of gold and silver to put their marks upon the metal.

(*c*) It was provided by the earlier part of this Act (repealed by the Statute Law Revision Act, 1863) that gold should not be made or sold under 22 carats in fineness, nor silver under 11 oz. 2 dwt.; and that no silver plate should be sold without the worker's mark, under penalty of forfeiting the value.

(*d*) The remainder of the Act was repealed by the Statute Law Revision Act, 1867.

(*e*) The standard was thus raised from that fixed by the preceding Act (11 oz. 2 dwt.), but by 6 *Geo. I. c.* 11, both standards were established. See *infra*.

(*f*) The following marks are appointed by this Act:—

12 & 13 *Wm. III. c.* 4 (1700), "An Act for appointing wardens and assay masters for assaying wrought plate in the cities of York, Exeter, Bristol, Chester, and Norwich" (*a*).

§ 2. Goldsmiths, &c., of the cities of York, Exeter, Bristol, Chester, and Norwich, incorporated into respective companies, to be called respectively "The Company of Goldsmiths of——"

§ 3. No goldsmith, &c., in those cities to make silver plate of less fineness than the standard for the time being, nor sell it until marked with—

The worker's mark, to be expressed with the two first letters of his surname.

The lion's head erased and the figure of Britannia.

The arms of that one of the above cities in which the plate is assayed and marked.

A distinct variable mark or letter in Roman character to denote the year (*b*).

Penalty—Forfeiture of the plate or value, half to the Crown, half to the informer.

The Act also contains provisions with respect to the appointment of wardens and assayers, procedure, &c.

1 *Anne, c.* 3 (1 Anne, stat. 1, c. 9, in Ruffhead's ed.) (1701).

The provisions of the last Act extended to Newcastle-upon Tyne, and "The Company of Goldsmiths of Newcastle-upon-Tyne" incorporated.

6 *Geo. I. c.* 11 (1719) (*c*).

§ 1. The old silver standard of 11 oz. 2 dwt. restored.

§ 3. No goldsmith, &c., to work silver plate of less fineness than 11 oz. 2 dwt., nor to sell it, &c., until touched, assayed and marked, under the former penalties.

§ 41. Two standards of silver, 11 oz. 10 dwt. and 11 oz. 2 dwt., continued (*d*).

The worker's mark, to be expressed by the two first letters of his surname.

The mark of the mystery or craft of the goldsmiths, which, instead of the leopard's head and the lion, shall for this plate be the figure of a lion's head erased, and the figure of a woman commonly called Britannia.

A distinct variable mark to denote the year of manufacture of the plate.

Penalty—Forfeiture of the plate or its value, half to the Crown, half to the informer. See 12 *Geo. II. c.* 26, § 5.

(*a*) Bristol never exercised the powers hereby conferred. York and Norwich have discontinued doing so.

(*b*) See 12 *Geo. II. c.* 26, § 5.

(*c*) The whole of this Act but §§ 1-3 and § 41 repealed by Statute Law Revision Act, 1870.

(*d*) Silver plate of 11 oz. 10 dwt. to be marked with—

The workman's mark.

The mark of the wardens of the Goldsmiths' Company.

The figure of the lion's head erased.

The figure of Britannia.

Silver plate of 11 oz. 2 dwt. to be marked with—

The workman's mark.

The mark of the wardens of the Goldsmiths' Company.

The figure of a lion passant.

The figure of a leopard's head.

See 12 *Geo. II. c.* 26, § 5.

12 *Geo. II. c.* 26 (1739) (*a*).

§ 1. Gold plate not to be made under 22 carats in fineness, nor silver plate under 11 oz. 2 dwt. Penalty, 10*l.*

§ 5. Gold and silver plate not to be sold or exported until marked as follows:—

Gold plate of 22 carats fine and silver plate of 11 oz. 2 dwt., with—

The worker's mark, which shall be the first letters of his Christian and surname.

These marks of the Company of Goldsmiths in London, viz., the leopard's head, the lion passant (*b*), and a distinct variable mark or letter to denote the year. Or,

The worker's mark, and

The marks appointed to be used by the assayers at York, Exeter, Bristol, Chester, Norwich, or Newcastle-upon-Tyne.

Silver plate of 11 oz. 10 dwt., with—

The worker's mark as before.

These marks of the said Company, viz., the lion's head erased, the figure of Britannia, and the mark or letter to denote the year. Or,

The worker's mark, and

The mark of one of the said cities or towns.

Penalty—10*l.* fine, or, in default, hard labour not exceeding six months (*c*).

§ 21. All goldsmiths, &c., to enter their new marks, names, and places of abode in one of the assay offices at London, York, Exeter, Bristol, Chester, Norwich, or Newcastle-upon-Tyne. Such new marks to be of a character or alphabet different from their old marks; all old marks to be broken. Penalty—10*l.* fine, and 10*l.* more for using any other mark; in default, hard labour not exceeding six months.

13 *Geo. III. c.* 52 (1772), "An Act for appointing wardens and assay-masters for assaying wrought plate in the towns of Sheffield and Birmingham" (*d*).

§ 2. Incorporation of "The Guardians of the Standard of Wrought Plate for Birmingham" (*e*).

§ 4. No silversmith or plate worker in either of these towns, or within twenty miles thereof, to sell or export silver plate made in these towns and the specified limits until marked as follows;—

Silver plate of 11 oz. 2 dwt., with—

The mark of the worker or maker, which shall be the first letters of his Christian and surname.

The lion passant.

(*a*) Repealed in part, 30 *Geo. III. c.* 31, § 1; Statute Law Revision Act, 1867.

(*b*) By 38 *Geo. III. c.* 69, § 2, gold plate of 18 carats fine is to be marked with a crown and 18, instead of the lion passant, and by 7 & 8 *Vict. c.* 22, § 15, gold of 22 carats with a crown and 22.

(*c*) See *Robinson* v. *Currey*, 6 Q. B. D. 21; 7 *ib.* 465.

(*d*) Repealed as to Birmingham, by 5 *Geo IV. c. lii.* (local). As to Sheffield, see 24 *Geo. III. sess.* 2, *c.* 20. The present Act only deals with silver.

(*e*) Or "Sheffield."

The mark of the company in whose assay office the plate was assayed and marked.
A distinct variable mark or letter to denote the year.
Silver plate of 11 oz. 10 dwt., with—
The worker's mark.
The figure of Britannia.
The mark of the Company, and
The mark or letter to denote the year.
Penalty—Forfeiture of the plate or value, half to the Crown, half to the informer.

§ 5. The peculiar mark of the Birmingham company to be an anchor, of the Sheffield company a crown.

The Act also contains provisions for the election of wardens and assayers, the process of assaying, punishment of counterfeiting, &c.

24 *Geo. III. sess.* 2, *c.* 20 (1784), relates to Sheffield.

§ 2. Manufacturers of goods plated with silver, within Sheffield or 100 miles thereof, may strike upon such goods their surname or the name of their firm, together with some other mark, figure, or device.

§ 3. Names to be in legible characters and struck with only one punch, and marks to be approved and registered by the Guardians for Sheffield.

24 *Geo. III. sess.* 2, *c.* 53 (1784) (*a*).

§ 5. The assaying officer to mark with an additional new mark, of the King's head, all gold and silver plate sent to be touched, marked and assayed, but to ask and receive duty before touching, marking, or assaying.

§ 8. Gold and silver plate not to be sold or exported until marked with the King's head. Penalty—50*l.*, or, in default, hard labour of not more than one year, nor less than six months. Also, forfeiture of the unmarked plate, half to the Crown, half to the informer.

30 *Geo. III. c.* 31 (1790).

This Act regulates the exemptions from marking.

38 *Geo. III. c.* 69 (1798).

§ 1. Gold plate may be manufactured down to 18 carats fine.

§ 2. Such gold plate not to be sold or exported until marked with a crown and the figures 18, instead of the lion passant. Penalty—10*l.*

§ 3. Gold plate of 18 carats fine may be marked by the various goldsmiths' companies, &c., as before, with the exception of the alteration of this mark.

§ 4. Gold plate of 22 carats may still be made, sold, exported, &c.

§ 5. This Act not to authorise the application of the mark used before the Act to gold plate of less than 22 carats fine.

§ 6. Penalty of 50*l.* for selling, exporting, &c., gold plate not marked with one of the marks.

(*a*) Repealed in part 25 *Geo. III. c.* 64, § 2; 30 *Geo. III. c.* 31, § 1; Statute Law Revision Acts, 1861-71

§ 8 (*a*). Previous regulations for gold of 22 carats, except as to the mark of the lion passant, to apply to gold of 18 carats.

55 *Geo. III. c.* 185 (1815),

§ 7 (*b*). Penalties for forging duty marks on plate, or selling or exporting plate so marked, or possessing dies, &c.

5 *Geo. IV. c. lii.* (1824) (Local—Birmingham and thirty miles round).

§ 1. 13 *Geo. III. c.* 52, repealed, so far as relates to Birmingham.

§ 4. Re-incorporation of "The Guardians of the Standard of Wrought Plate in Birmingham," with authority within a radius of thirty miles.

§ 20. No goldsmith, silversmith, &c., within Birmingham or thirty miles thereof, to sell or export gold or silver plate made within the specified limits until marked as follows :—

Gold of 22 carats fine with the lion passant (*c*).
" 18 " " crown and 18.
Silver of 11 oz. 2 dwt. fine with the lion passant.
" 11 oz. 10 dwt. " Britannia.

And all gold and silver alike with the following additional marks :—

The worker's mark (the first letters of his Christian and surname, or in case of any partnership, the initials of the name or firm of such partnership).

The company's mark (an anchor).

A distinct variable mark or letter, to denote the year.

Penalty—Forfeiture of the plate or its value, half to the Crown, half to the informer.

§ 21. Goldsmiths, silversmiths, &c., within Birmingham and thirty miles, to enter their names, marks, and places of abode with the company. Penalty—100*l.*, half to the informer, half to the purposes of the Act.

§ 22. Penalties of counterfeiting, &c.

The Act also contains numerous provisions with respect to the constitution of the company, the election of its officers, its procedure, &c.

7 & 8 *Vict. c.* 22 (1844).

This Act (which see) regulates the punishments and penalties for counterfeiting, &c., hall marks (*d*).

(*a*) § 7 provided penalties for counterfeiting, but this was repealed as to England by 7 & 8 *Vict.* c. 22, § 1, though still unrepealed for Scotland.

(*b*) The greater part of this Act is repealed by 33 & 34 *Vict. c.* 99, and 36 & 37 *Vict. c.* 91.

(*c*) By 7 & 8 *Vict. c.* 22, § 15, a crown and 22.

(*d*) See *R.* v. *Lee*, 1 Leach, 416, and *R.* v. *Ogden*, 6 C. & P. 631, decided on the earlier statutes; also *R.* v. *Suter & Coulson*, 10 Cox, 577; and *R.* v. *Ardley*, L. R. 1 C. C. R. 301, 12 Cox, 23, in which a spurious hall mark was made the means of obtaining money by false pretences. In *R.* v. *Roberts*, 70 L. T. (Journal) 265, the jury found that the marks used by the defendant were not imitations of the genuine hall mark. An action by the Goldsmiths' Company for penalties under this Act is not an action by a common informer within 31 *Eliz. c.* 5, nor an action by a "party grieved" within 3 & 4 *Wm. IV. c.* 42, § 3, and can, therefore, be maintained after the lapse of two years from the commission of the offence, but (in the opinion of Lush, L. J.) not after twenty years; *Robinson* v. *Currey*, 6 Q. B. D. 21; 7 *ib.* 465.

ENGLISH HALL MARKS AT THE PRESENT DAY (*a*).

	GOLD.					SILVER.	
	22 CARATS.	18 CARATS.	15 CARATS.	12 CARATS.	9 CARATS.	11 OZ. 2 DWT.	11 OZ. 10 DWT.
Quality Mark	22	18	15·625	12·5	9·375	None (*b*).	None.
Standard Mark	Crown.	Crown.	None.	None.	None.	Lion passant.	Britannia.
Date Mark	Letter.	Letter.	Letter.	Letter.	Letter.	Letter.	Letter.
Maker's Mark	Initials.	Initials.	Initials.	Initials.	Initials.	Initials.	Initials.
Duty Mark	Sovereign's head.	Sovereign's head.	None.	None.	None.	Sovereign's head.	Sovereign's head.
Assay Town Mark	On all qualities of gold and silver the special mark of the town.						

The special marks of the assay towns are as follows:—London, a leopard's head (except for silver of 11 oz. 10 dwt., for which it is a lion's head erased); Exeter, a castle; Chester, a dagger and 3 sheaves; Newcastle, 3 castles; Sheffield, a crown; Birmingham, an anchor (*c*).

(*a*) Gold and silver of all these qualities are manufactured at London, Chester, Newcastle-on-Tyne, and Birmingham. At Exeter only gold of 22 carats and silver of 11 oz. 2 dwt. are manufactured; at Sheffield only silver of 11 oz. 2 dwt. and 11 oz. 10 dwt. At York and Norwich no plate is now manufactured. At Bristol the powers conferred by 12 & 13 *Wm. III. c.* 4, were never exercised.

(*b*) Except at Newcastle, where the mark of a leopard's head crowned is used.

(*c*) The marks for York and Norwich (now discontinued) were:—York, 5 lions on a cross; Norwich, a castle and a lion passant.

§ 15. Gold plate of 22 carats fine to be marked with a crown and 22, instead of the lion passant.

17 & 18 *Vict.* c. 96 (1854).

This Act authorises Her Majesty, by Order in Council, to allow any standard for gold plate, not being less than one-third part of the whole, and to approve thereby of the instrument for stamping such plate, setting forth in figures the actual fineness of the metal (*a*).

18 & 19 *Vict.* c. 60 (1855).

Gold wedding rings are to be assayed and marked in the same way as other gold plate.

5 & 6 *Vict.* c. 47 (1842) (Customs Act) (*b*).

§ 59. Foreign gold and silver plate imported from abroad shall be of the respective standards required for plate wrought in England, and it shall not be sold, &c., until assayed, stamped and marked in England, Scotland, or Ireland, as plate of the same description made in that country.

5 & 6 *Vict.* c. 56 (1842) (Customs Act).

§ 6 (*c*). Foreign ornamental plate, manufactured before 1800, and imported, is exempted from the operation of the last Act.

39 & 40 *Vict.* c. 35 (1876) Customs Act).

§ 2 (*d*). Foreign gold and silver plate imported and sent to an assay office in the United Kingdom for assay shall be marked, in addition to the marks ordinarily used at that office for British plate, with an F. on an oval escutcheon, to denote the foreign origin of the plate.

Scotland (*e*).

13 *Geo. III.* c. 59 (1773) (*f*).

§ 2, which provided penalties for counterfeiting, &c., the marks for plate, is unrepealed in Scotland.

38 *Geo. III.* c. 69 (1798) (see p. 605, *suprà*).

§ 7 (*g*), which provided penalties for counterfeiting, &c., the marks for plate, is unrepealed in Scotland.

(*a*) Accordingly the following reduced standards were ordered by the Council :—

15 carats, to be marked with 15 and 625.
12 „ „ „ 12 „ 500.
9 „ „ „ 9 „ 375.

The crown and sovereign's head are not placed on plate of these qualities.

(*b*) The entire Act but §§ 59 and 60 is repealed.

(*c*) The remainder of the Act is repealed by 8 & 9 *Vict.* c. 84, § 2.

(*d*) This re-enacts 30 & 31 *Vict.* c. 82, § 24, the whole of which Act is repealed by the present one. See also 46 & 47 *Vict.* c. 55, § 10, as to foreign plate. As to foreign watch-cases, see Merchandise Marks Act, 1887, § 8, and the order in council thereunder, also the table opposite.

(*e*) In the reign of James III. of Scotland (1483) gold 22 carats fine, and silver 11 penny fine were to be marked with the maker's mark, the mark of the deacon of the craft, and the mark of the town.

(*f*) This Act was repealed as to *England* by 7 & 8 *Vict.* c. 22, § 1. The first section was repealed by the Statute Law Revision Act, 1871.

(*g*) Repealed as to *England* by 7 & 8 *Vict.* c. 22, § 1.

HALL MARKS FOR IMPORTED FOREIGN WATCH-CASES (*a*).

	GOLD.						SILVER.
	22 CARATS.	20 CARATS.	18 CARATS.	15 CARATS.	12 CARATS.	9 CARATS.	
Quality Mark	22·917	20·833	18·75	15·625	12·5	9·375	None.
Date Mark	Letter.	Letter.	Letter.	Letter.	Letter.	Letter.	Letter.
Foreign Mark	"Foreign."	"Foreign."	"Foreign."	"Foreign."	"Foreign."	"Foreign."	"Foreign."
Shape of Shield	Cross.	Cross.	Cross.	Cross.	Cross.	Cross.	Octagon.
Assay Town Mark	On all qualities of gold and silver the special mark of the town.						

The special marks for this purpose of the assay towns are as follows:—London, Phœbus; Birmingham, an equilateral triangle; Chester, an acorn and two leaves; Sheffield, four crossed arrows; Edinburgh, a St. Andrew's cross; Glasgow, a Bishop's mitre; Dublin, a shamrock.

(*a*) Prescribed by the Order in Council of Nov. 28th, 1887, p. 564, *supra*.

6 & 7 *Wm. IV. c.* 69 (1836).

§ 1. Gold plate not to be made, sold, or exported, under 18 carats fine, nor silver under 11 oz. 2 dwt. fine. Penalty—Fine not exceeding 100*l.*

§ 2. Scotch goldsmiths to send their names, descriptions, and marks (to consist of the initial letters of their Christian and surnames, or, in the case of a partnership, of the initial letters of the firm name) for registration to the Goldsmiths' Company of Edinburgh, or of Glasgow.

§ 3. Gold plate of 22 carats fine, and silver plate of 11 oz. 2 dwt. to be sent, marked with the maker's mark, to the assay office, and to be there marked with—

The mark of the thistle.

A distinct variable letter to denote the year.

The mark of the assaying company.

Gold plate of 18 carats fine to be marked in addition with 18.

Silver plate of 11 oz. 10 dwt. fine to be marked in addition with the figure of Britannia.

§§ 16 and 17 contain certain exemptions from marking.

§§ 18, 19 and 21 contain penalties for selling or exporting plate not duly marked, counterfeiting marks, &c., marking base metal, &c.

The Act also contains provisions with respect to the assaying, recovering penalties, &c.

The following statutes mentioned above under the head of "England" are also in force in Scotland: 6 *Geo. I. c.* 11; 24 *Geo. III. sess.* 2, *c.* 53; 38 *Geo. III. c.* 69; 5 & 6 *Vict. c.* 47; 5 & 6 *Vict. c.* 56; 17 & 18 *Vict. c.* 96; 18 & 19 *Vict. c.* 60; and 39 & 40 *Vict. c.* 35.

IRELAND.

3 *Geo. II. c.* 2 (1730), (Irish Act) (*a*).

§ 32. Gold and silver plate not to be sold until assayed, touched and marked.

§ 33. Plate to be assayed by the Dublin Company of Goldsmiths. Gold of 22 carats, and silver of 11 oz. 2 dwt., to be touched by the wardens of the company, and marked with "the marks now usual for that purpose." On payment of duty, the plate to be marked with a mark to be appointed by the Commissioners of His Majesty's Revenue (*b*).

§ 38. Penalties for counterfeiting, &c., provided.

(*a*) This Act was repealed as to gold by 23 & 24 *Geo. III. c.* 23, § 1 (Irish). It fixed a standard of 22 carats for gold 33).

(*b*) The figure of Hibernia was accordingly appointed.

SCOTCH HALL MARKS AT THE PRESENT DAY (*a*).

	GOLD.					SILVER.	
	22 CARATS.	18 CARATS.	15 CARATS.	12 CARATS.	9 CARATS.	11 OZ. 2 DWT.	11 OZ. 10 DWT.
Quality Mark...	22	18	15	12	9	None.	Britannia.
Standard Mark—							
Edinburgh	Thistle.	Thistle.	None.	None.	None.	Thistle.	Thistle.
Glasgow	Lion rampant.	Lion rampant.	Lion rampant.	Lion rampant.	Lion rampant.	Lion rampant.	Lion rampant.
Date Mark	Letter.	Letter.	Letter.	Letter.	Letter.	Letter.	Letter.
Maker's Mark...	Initials.	Initials.	Initials.	Initials.	Initials.	Initials.	Initials.
Duty Mark	Sovereign's head.	Sovereign's head.	None.	None.	None.	Sovereign's head.	Sovereign's head.
Assay Town Mark	On all qualities of gold and silver the special mark of the town.						

The special marks of the assay towns are:—Edinburgh, a castle; Glasgow, a tree, fish, and bell.

(*a*) Gold and silver of all these qualities are manufactured at Edinburgh and Glasgow.

23 & 24 *Geo. III. c.* 23 (1783), (Irish Act).

§ 2. No gold plate to be made, sold, &c., except of 22 carats, 20 carats, or 18 carats fine. Penalty—Forfeiture and fine of 10*l.*

§ 3. The following marks appointed for gold of 22 carats:

The mark of the maker, which is the number 22, and the first letter of the maker's Christian and surname. And,

For Dublin a harp crowned.

For New Geneva (*a*), a like harp with a bar across the strings.

§ 4. Marks for gold of 20 carats:

The number 20.

The maker's initials. And,

For Dublin, a plume with three feathers.

For New Geneva, a plume with two feathers.

§ 5. Marks for gold of 18 carats.

The number 18.

The maker's initials. And,

For Dublin, an unicorn's head.

For New Geneva, an unicorn's head, with a collar round the neck.

§ 6 contains exemptions.

§ 11 provides for the registration of new marks.

§ 28 provides penalties for counterfeiting, &c.

47 *Geo. III. sess.* 2, *c.* 15 (1807).

§ 3. Irish gold plate of 22, 20 or 18 carats, and silver plate of 11 oz. 2 dwt., to be assayed by the Goldsmiths' Company of Dublin, touched and marked with "the marks now or hereafter to be used."

§ 6. On payment of duty, gold and silver plate to be marked with the King's head to denote that this has been done (*b*).

§§ 14, 15 and 16 provide penalties for persons selling or buying unmarked plate, or counterfeiting, &c., the marks used.

The Act also provides for the manner in which duty is to be paid, books kept, &c.

The following statutes mentioned above under the head of "England" are also in force in Ireland: 5 & 6 *Vict. c.* 47; 5 & 6 *Vict. c.* 56; 17 & 18 *Vict. c.* 96; 18 & 19 *Vict. c.* 60; 39 & 40 *Vict. c.* 35.

N.B.—For very full information on all points connected with Hall Marks, see Mr. Chaffers' book on Hall Marks, 6th ed., London, 1883, 8vo.

(*a*) This was a company of Geneva watchmakers, who established themselves in co. Waterford. They carried on operations only from about 1784 to 1790.

(*b*) The figure of Hibernia continued to be used in addition.

IRISH HALL MARKS AT THE PRESENT DAY (*a*).

	GOLD.						SILVER.
	22 CARATS.	20 CARATS.	18 CARATS.	15 CARATS.	12 CARATS.	9 CARATS.	11 OZ. 2 DWT.
Quality Mark	22	20	18	15·625.	12·5	9·375	None.
Standard Mark	Harp crowned.	Plume of 3 feathers.	Unicorn's head.	None.	None.	None.	Harp crowned.
Date Mark	Letter.	Letter.	Letter.	Letter.	Letter.	Letter.	Letter.
Maker's Mark	Initials.	Initials.	Initials.	Initials.	Initials.	Initials.	Initials.
Duty Mark	Sovereign's head.	Sovereign's head.	Sovereign's head.	None.	None.	None.	Sovereign's head.
Dublin Mark	Hibernia.	Hibernia.	Hibernia.	Hibernia.	Hibernia.	Hibernia.	Hibernia.

(*a*) The only assay town in Ireland is Dublin, where gold is manufactured of a standard (20 carats) not used in England or Scotland, but silver only of the earlier standard of 11 oz. 2 dwt., and none of 11 oz. 10 dwt.

PRINTS AND ENGRAVINGS.

8 *Geo. II. c.* 13 (1735).

§ 1. Copyright for fourteen years given to "every person who shall invent and design, engrave, etch, or work, in mezzotinto or chiaro-oscuro, or from his own works and invention shall cause to be designed and engraved, etched, or worked in mezzotinto or chiaro-oscuro" any print, "to commence from the day of the first publishing thereof, which shall be truly engraved with the name of the proprietor on each plate, and printed on every such print or prints" (*a*). Penalties for Piracy.

7 *Geo. III. c.* 38 (1766).

The former Act extended in various respects, including an extension of the term to twenty-eight years.

17 *Geo. III. c.* 57 (1777).

The former Acts further extended in various respects.

6 & 7 *Will. IV. c.* 59 (1836).

The former Acts extended to Ireland.

SCULPTURES.

54 *Geo. III. c.* 56 (1814) (*b*).

§ 1. Copyright for fourteen years given to "every person or persons who shall make or cause to be made any new and original sculpture, or model, or copy, or cast," to commence from the "first putting forth or publishing the same: Provided, in all and every case, the proprietor or proprietors do cause his, her, or their name or names, with the date, to be put on all and every such new and original sculpture, model, copy, or cast, and on every such cast from nature, before the same shall be put forth or published" (*c*).

(*a*) It is clearly settled law that both the date of publication and the name of the proprietor must appear with the engraving, in order to enable the proprietor to assert his statutory rights, notwithstanding *Blackwell* v. *Harper*, 2 Atk. 95, Barnard. 210; and *Roworth* v. *Wilkes*. 1 Camp. 94. See *Sayer* v. *Dicey*, 3 Wils. 60; *Harrison* v. *Hogg*, 2 Ves. Jun. 323; *Thompson* v. *Symonds*, 5 T. R. 41; *Bonner* v. *Field*, 5 T. R. 44; *Macmurdo* v. *Smith*, 7 *ib.* 518; *Newton* v. *Cowie*, 4 Bing. 234; *Colnaghi* v. *Ward*, 12 L. J. Q. B. 1; *Brooks* v. *Cocks*, 3 Ad. & Ell. 133; *Graves* v. *Ashford*, L. R. 2 C. P. 410; *Rock* v. *Lazarus*, L. R. 15 Eq. 104. The requirements of 8 Geo. II. c. 13 must be complied with in the case of engravings sought to be protected under the International Copyright Act, 1844 (7 & 8 Vict. c. 12, § 4): *Avanzo* v. *Mudie*, 10 Ex. 203.

(*b*) The earlier Act, 38 Geo. III. c. 71 (1798) was repealed by the Statute Law Revision Act, 1861 (24 & 25 Vict. c. 101).

(*c*) By the Registration of Designs Act, 1850 (13 & 14 Vict. c. 104, §§ 6, 7) sculptures, &c., were allowed to be registered under that Act, and penalties were imposed for infringement, but this was subject to the provision that every copy or cast of the sculpture, &c., must be marked with the word "registered" and the date of registration. By the Patents, &c., Act, 1883, the Act of 1850 is repealed, and sculptures, &c., within the protection of the Act of 1814, are excluded from registration for the future (see § 60). Existing registrations at the commence-

CLOCKS AND WATCHES, &c.

39 & 40 *Vict. c.* 36, § 42 (*a*), (1876).

Clocks and watches and other metal articles marked in imitation of British marks are forbidden to be imported into the United Kingdom (*b*).

METAL BUTTONS.

36 *Geo. III. c.* 60 (*c*), (1796).

§ 1 provides penalties for ordering metal buttons to be falsely marked in indication of quality, and for purchasing buttons so marked.

§ 2 provides penalties for falsely marking buttons in indication of quality, and for offering them for sale so marked.

§ 3. No marks indicative of quality are to be placed upon metal buttons, except the words "gilt," or "plated," respectively.

§ 4. The words "double gilt" and "treble gilt" may be placed upon buttons gilt to a specified degree.

§ 7 declares what quality is required to constitute a "gilt" or "plated" button.

The Act also contains provisions with respect to procedure, &c.

GUN-BARRELS.

By *Royal Charter*, 1637, "The Master, Wardens and Society of the Mystery of Gunmakers of the City of London" were incorporated, proof marks assigned to them, &c.

53 *Geo. III. c.* 115 (*d*), (1813).

§ 4 incorporates "The Guardians, Trustees and Wardens of the Gun-Barrel Proof House of the Town of Birmingham."

§ 7 appoints Birmingham proof marks (*e*).

18 & 19 *Vict. c. cxlviii.* (1855) (Local), "The Gun-Barrel Proof Act, 1855" (*f*).

§ 9 repeals the former Acts.

ment of the Act are, however, preserved (§ 113). The requirements of 54 Geo. III. c. 56 must be complied with in the case of sculptures, &c., sought to be protected under the International Copyright Act, 1844 (7 & 8 Vict. c. 12, § 4).

(*a*) This is a re-enactment, with some variations, of 16 & 17 *Vict. c.* 107, § 44.

(*b*) See p. 563. As to watches and watch-cases, see also §§ 7 and 8 of the Merchandise Marks Act, 1887, and the order in council thereunder, p. 564.

(*c*) Repealed in part, Statute Law Revision Act, 1871.

(*d*) Repealed by 18 & 19 *Vict. c.* cxlviii., § 9 (Local).

(*e*) 55 *Geo. III. c.* 59 (1815), further regulated the marking of gun-barrels, but was also repealed by 18 & 19 *Vict. c.* cxlviii., § 9 (Local).

(*f*) Repealed by 31 & 32 *Vict. c.* cxiii. (Local).

§ 12 continues the incorporation of the Birmingham Company, under the name of "The Guardians of the Birmingham Proof House."

Many provisions follow for the regulation of the Birmingham Company.

31 & 32 *Vict. c.* cxiii. (1868) (Local), "The Gun-Barrel Proof Act, 1868."

§ 9 repeals the Act of 1855.

§ 12 continues the incorporation of "the Guardians of the Birmingham Proof House." Many provisions follow for the regulation of the Birmingham Company.

§ 107. The London and Birmingham Companies to receive, prove, mark, and deliver barrels brought to them for proof.

§ 116. Barrels to be proved according to Rules, Regulations, and Scales in Schedule B to Act.

§ 117. Power given to the two companies, with approval of Secretary for War, to repeal or alter Rules, &c., and to make and alter any new Rules, &c.

§§ 121, 122. Penalties for offences with respect to proof-marks.

Schedule B provides proof and other marks for the two companies.

Rules and Regulations of December 1887 made by the two companies, with the approval of the Secretary for War, under the authority of the Act of 1868. (See *London Gazette* for January 3rd, 1888, p. 16.)

These repeal the Rules, &c., in Schedule B to the Act, and contain new Rules, Regulations, and Scales for proving and marking gun-barrels, and provide proof marks, view marks, and provisional proof marks for the two companies.

CHAIN CABLES AND ANCHORS.

27 & 28 *Vict. c.* 27 (1864); 34 & 35 *Vict. c.* 101 (1871); 35 & 36 *Vict. c.* 30 (1872); and 37 & 38 *Vict. c.* 51 (1874), regulate the testing, proving, and marking of chain cables and anchors, and provide penalties for falsely marking, &c.

By § 4 of the Act of 1874, every contract for the sale of a chain cable implies, in the absence of an express stipulation to the contrary, that the cable has been duly tested and marked.

PLAYING CARDS.

25 & 26 *Vict. c.* 22 (1862).

§§ 28-37 provide that playing cards are to be sold in separate packs, enclosed in wrappers to be provided by the Commissioners of Inland Revenue, on which the duty chargeable and the name of the maker are to be marked. Penalties for frauds, &c.

16 & 17 *Vict. c.* 107 (1853).

§§ 114-15. Imported playing cards are to be sold in separate packs, to be enclosed in proper wrappers to be provided by the Commissioners of Inland Revenue.

§ 116. Penalties for counterfeiting, &c., such wrappers.

PAINTINGS, DRAWINGS, AND PHOTOGRAPHS.

25 & 26 *Vict. c.* 68 (1862), "Copyright for Works of Art Act."

§ 7. By this section it is forbidden to do any of the following acts:—

1. Fraudulently sign any painting, drawing, photograph, or negative with any name, initials or monogram.

2. Fraudulently sell, publish, &c., any painting, &c., marked with the name, &c., of a person who did not execute such work.

3. Fraudulently utter any copy or colourable imitation of any painting, &c., whether the subject of subsisting copyright or not, as having been executed by the author of the original.

4. Where the author of any painting, &c., has parted with the possession of the work, and the work is altered by any other person, it is forbidden, during the life of the author, to make, sell, publish, &c., such work or a copy of it so altered as or for the unaltered work of the author.

The section provides penalties for offenders against its provisions, but limits the time during which they can be incurred to within twenty years after the death of the person whose works have been wrongfully dealt with.

HOPS.

54 *Geo. III. c.* 123 (*a*), (1814).

§ 1. Growers of hops are to mark the bags, in letters of specified dimensions, with their names, and the names of the parish and county in which the hops were grown, before putting the hops into the bag. Penalty for putting in the hops before marking the bag.

29 & 30 *Vict. c.* 37 (1866), "The Hop (Prevention of Frauds) Act, 1866."

§ 2. Growers of hops are to mark each bag, in addition to their own names and the names of the parish and county, with the year in which

(*a*) This Act is repealed in part. The former Acts, now repealed, were 14 *Geo. III.* c. 68, under which the excise officer was to mark each bag of hops with the weight of hops, the name and place of abode of the grower, and the date of the year; 39 & 40 *Geo. III. c.* 81, under which the grower was himself to mark his name and place of abode; the excise officer the weight, date, and progressive number of the bag; and 48 *Geo. III. c.* 134, under which the owner was in addition to mark the name of the parish and county in which the hops were grown.

the hops were grown, the progressive number of the bag, and its weight.

Penalties are provided for not marking, falsely marking, wilfully altering marks, &c. (*a*).

§ 18. The vendor is to be deemed to contract that the marks are genuine.

§ 20. The provisions of the Merchandise Marks Act, 1862, §§ 23 and 24, are incorporated.

LINEN.

17 *Geo. II. c.* 30 (*b*), (1743).

§ 1. Penalties provided for stamping foreign linens in imitation of British or Irish, and for placing counterfeit stamps on British or Irish linens.

18 *Geo. II. c.* 24 (*b*), (1744).

§ 1. Linens to be stamped must be sworn to be of the manufacture of [Scotland or] Ireland.

§ 2 (*c*). No bounty to be paid on British or Irish linens exported, but on such as are marked at both ends of every piece with the name and place of abode of the maker, the year of manufacture, the number of the piece in rotation, the name and place of abode of the exporter or seller for exportation; and unless the ends are also marked with the month and year when, and the name of the port at which, the linens are entered for exportation. The marks to be stamped with lamp black and burnt oil.

Penalties for falsely stamping, &c.

4 *Geo. IV. c.* 40 (1823), (Scotland).

§ 3. Every manufacturer or weaver of linen and dealer in linen in Scotland may weave his name, or fix any mark or seal, in any piece of linen of his make, to denote the length, breadth, or quality of the linen, or the maker's name. Penalties for counterfeiting.

5 & 6 *Wm. IV. c.* 27 (1835), (Ireland).

§ 4. Across each end of every piece of linen offered for sale in open fair or market in Ireland there are to be woven two coarse threads or cords at a distance of one-fourth of an inch, and close to such threads or cords on each end are to be written the Christian name, surname, and place of residence of the weaver or manufacturer, and on the outside fold of every piece its length and breadth.

(*a*) See *R.* v. *Morgan*, 1 Trade Marks, 313, in which the defendant was convicted at the Wandsworth Police Court, on May 18th, 1878, of selling inferior hops in the bags and as the hops of a well-known grower, under § 6 of the above Act, and fined £10, the maximum penalty; £44, the value of the hops; and £10 10s. costs.

(*b*) Repealed as to Scotland by 4 *Geo. IV. c.* 40, § 1.

(*c*) Repealed as to bounty by 6 *Geo. IV. c.* 105.

§ 14. The Lord Lieutenant to appoint a committee of twelve in each county, to superintend the brown linen trade.

§ 19. The committee in each county to prescribe the form and device of the seal or stamp to be used by the county sealmaster of brown linen.

§ 21. The sealmaster shall affix to each piece of brown linen brought for the purpose, and which shall be in accordance with the Act, an impression of the seal, in black, red, or blue; and shall also mark with the same ingredients on the back of each piece its length, breadth, name of sealmaster, and the parish and county where he resides, or the name of the market town to which he is appointed.

Regulations for sales, penalties for frauds, &c.

PUBLIC STORES.

38 & 39 *Vict. c.* 25 (*a*), (1875), "The Public Stores Act, 1875."

§ 4. The marks described in the First Schedule to the Act are appropriated to denote Her Majesty's property. Penalty for unauthorised use of such marks.

§ 5. Penalty provided for obliteration of marks.

§ 6. Penalty for unlawful possession of public stores (*b*).

(*a*) This Act repealed the following Acts, by which the Public Stores had previously been regulated:—9 *Wm. III. c.* 41 (1697); this Act provided penalties for forging the King's marks, or having in possession goods so marked; 9 *Geo. I. c.* 8 (1722); this Act modified the penalties contained in the former Act; 17 *Geo. II. c.* 40, § 10 (1743); this provided for the trial of offences against these Acts before any judge, justice, or justices at assizes, or justices of the peace at general quarter sessions; 39 & 40 *Geo. III. c.* 89 (1800); this Act provided penalties for selling or having in possession goods marked with the marks specified, or defacing, &c., such marks; 54 *Geo. III. c.* 60 (1814); this extended the provisions of the former Acts to cordage wrought with worsted threads; 54 *Geo. III. c.* 159, § 10 (1814): this provided a penalty for sweeping for lost anchors, cables, &c., belonging to the King's service; 55 *Geo. III. c.* 127 (1815); this extended the previous Acts to include all public stores; 30 & 31 *Vict. c.* 128 (1867), "*The War Department Stores Act*, 1867"; and 32 & 33 *Vict. c.* 12 (1869), "*The Naval Stores Act*, 1869." The following Acts have also from time to time regulated Naval Stores: 25 & 26 *Vict. c.* 64, "*The Naval and Victualling Stores Act*, 1862"; 27 & 28 *Vict. c.* 91, "*The Naval and Victualling Stores Act*, 1864"; 30 & 31 *Vict. c.* 119, "*The Naval Stores Act*, 1867"; all of which Acts were previously repealed.

(*b*) It has been repeatedly decided that on an indictment under 9 & 10 *Wm. III. c.* 41, for being unlawfully in possession of marked stores, the prisoner cannot be convicted unless he is in possession with knowledge of the marks. See *R.* v. ——, Foster Cr. Cas. 439; *R.* v. *Banks*, 1 Esp. 144; *R.* v. *Willmett*, 3 Cox, 281; *R.* v. *Cohen*, 8 Cox, 41; *R.* v. *Sleep*, 8 Cox, 472. In *R.* v. *Banks*, it was, indeed, held by Lord Kenyon, C. J., that it was sufficient for the prosecution to prove the finding of the marked goods in the prisoner's possession, the prisoner being allowed to obtain acquittal by proving his ignorance; but it is now for the prosecution to prove the knowledge, in the affirmative (see *R.* v. *Willmett*; *R.* v. *Cohen*; *R.* v. *Sleep*). Thus in *R.* v. *O'Brien*, 15 L. T. N. S. 419, it was held that for a conviction of persons in charge of closed and fastened cases, containing marked goods, to be

First Schedule.

Marks appropriated for use in or on Her Majesty's stores:

Stores.	Marks.
Hempen cordage and wire rope.	White, black, or coloured worsted threads laid up with the yarns and the wire respectively.
Canvas, fearnought, hammocks, and seamen's bags.	A blue line in a serpentine form.
Buntin.	A double tape in the warp.
Candles.	Blue or red cotton threads in each wick or wicks of red cotton.
Timber or metal. Any stores not before enumerated, whether similar to the above or not.	The name of Her Majesty, her predecessors, her heirs or successors, or of any public department or any branch thereof, or the broad arrow, or a crown, or Her Majesty's arms, whether such broad arrow, crown, or arms be alone or be in combination with any such name as aforesaid, or with any letters denoting any such name.

obtained, it must be proved that they knew that the goods in the cases were marked. Such knowledge may, however, be presumed by the jury from the circumstances attending the possession: *R.* v. *Sleep*. Although a specified certificate was required by 9 & 10 *Wm. III. c.* 41, to justify possession of marked goods, it was held that another form of certificate might be accepted (*R.* v. *Willmett*), or even the certificate be dispensed with altogether (*R.* v. ——; *R.* v. *Banks*), there being no proof of knowledge.

Possession by a railway company for purpose of transfer, on behalf of the prisoner, is such a possession by the prisoner as to justify a conviction: *R.* v. *Sunley*, 8 Cox, 179; and see *R.* v. *Sleep*, 8 Cox, 472, as to the words "receive or have" in 9 & 10 *Wm. III. c.* 41; and *R.* v. *Cole*, 8 East P. C. 767, as to the necessity for the marked articles to be found in the defendant's possession. In *R.* v. *Willmett*, 3 Cox, 281, it was held that a man could not be held criminally responsible for the act of his servants, who had, without his knowledge, improperly taken marked goods into his warehouse.

As to the exception in favour of contractors and contractors' servants, see *R.* v. *Silversides*, 3 Q. B. 406; and *R.* v. *Fitzgerald*, 43 C. C. C. Sess. Pap. 369.

APPENDIX H.

UNITED STATES STATUTE LAW.

Act of Congress of 1870 (*a*).

§ 77 (*b*). *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* (c) *of any lawful trade mark, or who intend to adopt and use any trade mark* (*d*), *for exclusive use within the United States, may obtain protection for such lawful trade mark* (*e*) *by complying with the following requirements* (*f*), *to wit :—*

First—*By causing to be recorded in the Patent Office* (*g*), *the names of the parties and their residences and place of business* (*h*), *who desire the protection of the trade mark.*

Second—*The class of merchandise* (*i*) *and the particular description of goods* (*k*) *comprised in such class, by which the trade mark has been or is intended to be appropriated.*

Third—*A description of the trade mark itself* (*l*) *with facsimiles thereof* (*m*) *and the mode in which it has been or is intended to be applied and used* (*n*).

Fourth—*The length of time, if any, during which the trade mark has been used* (*o*).

Fifth—*The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents* (*p*).

Sixth—*The compliance with such regulations as may be prescribed by the Commissioner of Patents* (*q*).

Seventh—*The filing of a declaration* (*r*), *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* (*s*), *and that the description and*

facsimiles presented for record are true copies of the trade mark sought to be protected.

(*a*) Although this Act is no longer in force, the Act of 1881 having been substituted for it, it is thought advisable to print the earlier Act, in order that the effect of the decisions upon it may not be misapprehended. In *Leidersdorf* v. *Flint* (1), 8 Biss. 327, the validity of the Act of 1870 was questioned by the U. S. Circuit Court, on the ground that the constitution of the United States did not authorise legislation by Congress on the subject of trade marks, except such as had been actually used in commerce with foreign nations, or with the Indian tribes; and in *U. S.* v. *Steffens*, 100 U. S. Rep. 82, the Act was formally declared by the Supreme Court to be on this ground unconstitutional and invalid. But this does not entitle persons registered under the invalid Act to recover back the fees paid by them (*Woodman* v. *U. S.*, 15 Ct. of Cl. 541), though they will be credited with such fees when applying for registration under the new Act. See Act of 1881, § 6, *infrà*. Nor does the invalidity of the Act justify the disregard of injunctions granted under the general jurisdiction of the Court: *U. S.* v. *Roche*, 1 McCrary, 385. And it has been held that registration of a mark under the invalid Act, even without re-registration under the Act of 1881, is sufficient to prevent registration of a similar mark under the new Act of 1881: *Ex parte Lyon, Dupuy & Co.*, 28 U. S. Pat. Gaz. 191. Since the passing of the Act of 1870, it has been considered in the U. S. Patent Office that, while, on the one hand, the benefits of registration as trade marks were to be reserved for trade marks, and for trade marks only (*e.g.*, in *In re Parker*, 13 U. S. Pat. Gaz. 323, registration as a trade mark was refused to that which could at most amount to a design), so, on the other hand, it was only by registering them as trade marks, and not by patenting them as designs (*Ex parte King*, U. S. Pat. Comm. Decis. 1870, 109; *In re Whyte*, *ib.* 1871, 304) or registering them as labels (*In re Godillot*, 6 U. S. Pat. Gaz. 641; *In re Simpson & Sons*, 10 *ib.* 333; *Ex parte Davids & Co.*, 16 *ib.* 94; *Ex parte Schumacher & Ettlinger* (1), 19 *ib.* 791) that statutory protection could be obtained for trade marks. Descriptive words, not registrable as trade marks, were properly allowed to be registered as labels: *Ex parte Waeferling*, 16 *ib.* 764; *Ex parte Brigham*, 20 *ib.* 891; *Ex parte Lutz*, 33 *ib.* 1389; and see *In re Park*, 12 *ib.* 2, in which it was sought to register as part of a label a device for which the applicant had previously sought registration as a trade mark. In *U. S.* v. *Marble*, 22 *ib.* 1366, however, the Supreme Court of Columbia held that the Commissioner of Patents had no authority to refuse registration to a label merely on the ground that it might have been registered as a trade mark; but in the later case of *Ex parte Schumacher & Ettlinger* (2), 22 *ib.* 1291, the Commissioner again refused registration as labels to what he considered to be trade marks; and in *Ex parte Moodie*, 28 *ib.* 1271, and *Ex parte Wiesel*, 36 *ib.* 689, the Commissioner repeated this decision, and his course was, in the former case, upheld on appeal by the Supreme Court of Columbia in *Moodie* v. *Butterworth*, 28 *ib.* 1271. The Federal Courts have also held that a trade mark must be registered as such, and not copyrighted as a label: *Schumacher & Ettlinger* v. *Wogram*, 35 Fed. Rep. 210. It is for the Commissioner to decide whether what is presented to him is a trade mark or a label: *Moodie* v. *Butterworth*, 28 U. S. Pat. Gaz. 1271.

(*b*) See Act of 1881, §§ 1, 2.

(*c*) In *McElwee* v. *Blackwell*, 15 U. S. Pat. Gaz. 658, it was held that, although, where registration had been wrongfully granted to one, it might subsequently be properly granted to another who was really entitled to the exclusive use, yet it would not be granted to another who was not entitled to the exclusive use, even though he might be entitled to use the mark to some extent. And see *Wright* v. *Simpson*, 15 *ib.* 968; also *Sorg* v. *Welsh*, 16 *ib.* 910, as to admissions of right in another; and *Yale Cigar Manufacturing Co.* v. *Yale*, 30 *ib.* 1183.

(*d*) Under these words a new trade mark might be registered prior to any actual use: *In re Rothschild*, 7 U. S. Pat. Gaz. 220; and see *Hoosier Drill Co.* v. *Ingels*, 14

ib. 785. This is not the case under the Act of 1881. See §§ 1 and 2, and *Ex parte Strasburger & Co.*, 20 *ib.* 155.

(*e*) As to what is a lawful trade mark, see *infrà*, § 79. Registration cannot make a lawful trade mark out of that which does not contain the necessary elements: *Moorman* v. *Hoge*, 2 Sawy. 78; *Schumacher & Ettlinger* v. *Schwenke* (2), 36 U. S. Pat. Gaz. 457; but by § 7 of the Act of 1881 registration is *primâ facie* evidence of ownership. It has been doubted whether the use of a registered trade mark can be restrained: *Decker* v. *Decker*, 52 How. Pr. 218; but in *Glen Cove Manufacturing Co.* v. *Ludeman*, 23 Bl. C. C. 46, an injunction was granted in such a case. See also *Schumacher & Ettlinger* v. *Schwenke* (2), 36 U. S. Pat. Gaz. 457. Separate registration must be obtained for each mark which differs from another by the addition of a symbol; *e.g.*, "X," "XX," "XXX," were held to require separate registration: *In re English*, U. S. Pat. Comm. Decis. 1870, 142; and see *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981.

(*f*) Absolute compliance with these requirements is necessary on the part of applicants: *In re Hankinson*, 8 U. S. Pat. Gaz. 89. But it is not necessary that the very words of the Act should be cited, so long as the spirit of it is satisfied: *In re Vidvard & Sheehan*, 8 *ib.* 143.

(*g*) In *Lacroix* v. *Escobal*, 37 La. Ann. 533, it was held that a French citizen, who had not deposited his mark in the U. S. Patent Office, as required by the Convention of 1869 between the U. S. and France, was not entitled to maintain an action for infringement. But see *Société, &c., de la Bénédictine* v. *Micalovitch*, 36 Alb. L. J. 364.

(*h*) The registration of the name, &c., of a firm has been held to be sufficient, without giving the particulars as to each of the partners: *Smith* v. *Reynolds* (2), 10 Bl. C. C. 100.

(*i*) This requirement has been interpreted to exclude from registration the marks of persons other than manufacturers or merchants, *e.g.*, a carpet cleaner: *In re Hankinson*, 8 U. S. Pat. Gaz. 89.

(*k*) It has been held that a description of the class and goods as "paints" is sufficient: *Smith* v. *Reynolds* (2), 10 Bl. C. C. 100; and so with "alcoholic spirits": *In re Boehm & Co.*, 8 U. S. Pat. Gaz. 319; but that "fancy goods" is insufficient, as being too general a term: *In re Lisner*, 13 *ib.* 455. Different persons may register the same trade mark for different descriptions of goods even in the same class: *Sorg* v. *Welsh*, 16 *ib.* 910. In *Smith* v. *Reynolds* (2), 10 Bl. C. C. 100, and S. C. (3), 13 *ib.* 458, it was held that a firm who had registered a trade mark for "paints" were not entitled to restrain the use of the mark on white lead by another firm who had used the mark on that variety of paint before the plaintiffs had used or registered their mark; and in the former case it was held that the registration being bad as to white lead was bad *in toto*, though but for that it might have been good.

(*l*) The trade mark must be sufficiently described for it to be possible to clearly distinguish between the essential and non-essential elements: *In re Volta Belt Co.*, 8 U. S. Pat. Gaz. 144; and see Rule 6, *infrà*.

(*m*) The facsimile limits the verbal description of the mark: *Duke* v. *Green*, 16 U. S. Pat. Gaz. 1094.

(*n*) The previous user of the applicants or their derivative title must be stated: *Ex parte Consolidated Fruit Jar Co.*, 16 U. S. Pat. Gaz. 679. Only one example of the mode of use will be admitted: *In re Kimball*, 11 *ib.* 1109; and see *Smith* v. *Reynolds*, (2), 10 Bl. C. C. 100.

(*o*) See *Ex parte Consolidated Fruit Jar Co.*, 16 U. S. Pat. Gaz. 679.

(*p*) A fee paid can only be recovered when it was paid by actual mistake, *e.g.*, a payment in excess, or one not required by law. When, therefore, an application has failed because the proposed mark was not registrable, the fee paid cannot be recovered, although a renewed application for the registration of an essentially different mark has proved successful: *In re Block & Co.*, 14 U. S. Pat. Gaz. 235. See note (*a*), *supra*, as to crediting fees paid under this invalid Act.

(*q*) See § 81, *infrà*, and note thereto.

(*r*) As to the necessity for the filing of this declaration, and for the production

of sufficient evidence of it on a trial for infringement, see *Smith* v. *Reynolds* (1), 10 Bl. C. C. 85, where an injunction was refused on the ground of a deficiency of such evidence.

(*s*) A declaration that no other person, firm, or corporation has a right to the use of the same, or substantially the same, mark, is a sufficient compliance with this requirement: *In re Vidvard & Sheehan*, 8 U. S. Pat. Gaz. 143.

§ 78 (*a*). *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 same 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* (*b*). *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.*

(*a*) See Act of 1881, §§ 5, 7, 11.

(*b*) See *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120, where the same mark was registered in two names; and *McElree* v. *Blackwell*, 15 *ib.* 658.

§ 79 (*a*). *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* (*b*), *shall be liable to an action on the case for damages for such unlawful use of such 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* (*c*). *The Commissioner of Patents* (*d*) *shall not receive and record any proposed trade mark which is not and cannot become a lawful trade mark* (*e*), *or which is merely the name of a person, firm, or corporation only* (*f*), *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 (g): 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 (h).

(*a*) See Act of 1881, §§ 7, 3.

(*b*) See *Osgood* v. *Rockwood*, 11 Bl. C. C. 310, where it was held that persons who had registered a trade mark for prints made according to a patented process were not entitled under this Act to an injunction against a person who had used the mark on prints not made in accordance with the patent.

(*c*) It seems that the U. S. Circuit Courts had jurisdiction under this Act in cases of infringement of trade mark, even when both parties were citizens of the same State: *Duvel* v. *Bohmer*, 14 U. S. Pat. Gaz. 270; but see *Leidersdorf* v. *Flint* (1), 8 Biss. 327, and §§ 7, 11 of the Act of 1881.

(*d*) As to the validity of the decisions of the acting commissioner, see *Simpson* v. *Wright* (2), 15 U. S. Pat. Gaz. 293.

(*e*) The question what may be registered as being a "lawful trade mark" has been considered in many cases. The device of a crown is a good trade mark: *Smith* v. *Reynolds* (2), 10 Bl. C. C. 100. The arms of one of the United States cannot, however, constitute of themselves a good trade mark: *Ex parte Davids & Co.*, 16 U. S. Pat. Gaz. 94; and it has been held that the same is the case with the Freemasons' square and compass: *In re Tolle*, 2 *ib.* 415; and the word "Masonic": *Ex parte Smith* (3), 16 *ib.* 764; though in *In re Thomas*, 14 *ib.* 821, the Freemasons' symbols were allowed to be registered in combination. In *Ex parte King* (2), 46 *ib.* 119, the decision in *In re Thomas*, 14 *ib.* 821, was followed, and the design of the badge adopted by the Grand Army of the Republic was allowed to be registered as a trade mark for writing paper by a person who had no connection with that Society, and it was said that, that Society not having used their badge as a mark on writing paper, they would be infringing the applicant's rights if they were to begin to do so. A word which has become common, *e.g.*, "Calhoun" plough, cannot be registered: *In re Hall & Co.*, 13 *ib.* 229. Registration has been refused to the following words and expressions, on the ground of descriptiveness:—"Beeswax oil," *In re Hauthaway* (1), U. S. Pat. Comm. Decis. 1871, 97; S. C. (2), *ib.* 284; "Razor Steel," *In re Roberts* (4), *ib.* 100; "Invisible" face powder, *Ex parte Palmer*, *ib.* 289; "A. Richardson's Patent Union Leather Splitting Machine," *In re Richardson*, 3 U. S. Pat. Gaz. 120; "Für Familien Gebrauch," and "Lawrence Feiner Familien Flannel," *In re Lawrence*, 10 *ib.* 163; "Croup Tincture," *In re Roach*, 10 *ib.* 333; "Crack-proof" india-rubber, *In re Goodyear Rubber Co.*, 11 *ib.* 1062; "Evaporated" articles of food, *Ex parte Alden*, 15 *ib.* 389; "Standard A" cigars, *Ex parte Cohn* (1), 16 *ib.* 680; Druggists' Sundries" cigars, *Ex parte Cohn* (2), 16 *ib.* 680; "Safety" powder, *Ex parte Safety Powder Co.*, 16 *ib.* 136; "Medicated Prunes," *Ex parte Smith* (2), 16 *ib.* 679; "Swing" scythe-sockets, *Ex parte Thompson, Derby & Co.*, 16 *ib.* 137; "Granulated Dirt-killer" soap, *Ex parte Waeferling*, 16 *ib.* 764; and "Satin polish" boots and shoes, *Ex parte Brigham*, 20 *ib.* 891. And the same has been the case with respect to the figure of a fish for fishing lines: *In re Pratt & Farmer*, 10 *ib.* 866; and the representation of a twig with three leaves and a plum for prunes: *Ex parte Smith* (2), 16 *ib.* 679; and see *Popham* v. *Wilcox*, 66 N. Y. 69. On the other hand, "The Blanchard Churn," *In re Porter Blanchard's Sons*, U. S. Pat. Comm. Decis. 1871, 97; "Beaverine" boots and shoes, *In re Francis & Mullon*, *ib.* 283; and "Dr. Lobenthal's Essentia Antiphthisica," *In re Rohland*, 10 U. S. Pat. Gaz. 980, have been admitted to registration as being non-descriptive. In a series of cases registration has been refused on the ground that the term claimed, if properly applicable to the goods with respect to which it was used,

was descriptive, but if not, was deceptive, *e.g.* "American Sardines," *In re American Sardine Co.*, 3 *ib.* 495; "Egg Macaroni," *In re Dole Bros.*, 12 *ib.* 939; "Cachemire Milano," *In re Warburg & Co.*, 13 *ib.* 44; "French Paints," *Ex parte Marsching & Co.*, 15 *ib.* 294; "London" animal foods, *Ex parte Knapp*, 16 *ib.* 318; but see *In re Green*, 8 *ib.* 729, where registration was granted to "German Sirup." On the latter ground of deceptiveness, the word "patent" cannot be registered as part of a mark for an article made under an expired patent: *In re Richardson*, 3 *ib.* 120. A geographical name is not usually registrable: *Armistead* v. *Blackwell*, 1 *ib.* 603, "Durham" tobacco; *In re Tolle*, 2 *ib.* 415, "Cherry Street Mills," and "Market Street Mills"; *Ex parte Knapp*, 16 *ib.* 318, "London" animal foods; *Ex parte Marsching & Co.*, 15 *ib.* 294, "French Paints"; *Ex parte Parnum & Co.*, 18 *ib.* 412, "Lancaster" goods. But such a name may be registered when arbitrarily selected: *In re Cornwall* (2), 12 *ib.* 312, "Dublin" soap. Similarly, numerals may be registered when arbitrarily selected: *Kinney* v. *Allen*, 1 Hughes, 106; *Ex parte Dawes & Fanning*, 1 U. S. Pat. Gaz. 27; *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338; but not otherwise: *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981. It has been held that a peculiarity in the form of a barrel is not registrable as a trade mark: *Moorman* v. *Hoge*, 2 Sawy. 78; nor a representation of such barrel when applied to the goods contained in it: *Ex parte Halliday Bros.*, 16 U. S. Pat. Gaz. 500; nor is a speciality in the hoops of the barrel registrable: *In re Kane & Co.*, 9 *ib.* 105. But see *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392. A special collar-box has been refused registration: *Harrington* v. *Libby*, 14 Bl. C. C. 128; and so have a sampler-pattern: *In re Parker*, 13 U. S. Pat. Gaz. 323; and a strip of tobacco intended to be wrapped round the mouthpiece of cigarettes, on the ground that it was intended to serve purposes of convenience rather than of identification: *In re Gordon*, 12 *ib.* 517; and the use of a tin tag or ticket on the goods, irrespective of shape and design, is no trade mark: *Lorillard* v. *Pride*, 28 Fed. Rep. 434; though a tin tag of special shape, size and colour may be: *Lorillard* v. *Wight*, 15 Fed. Rep. 383. There is no trade mark in the shape of a plug of tobacco: *Liggett & Myers Tobacco Co.* v. *Hynes*, 20 Fed. Rep. 883; or of a box: *Sawyer* v. *Horn*, 4 Hughes 239; *Ball* v. *Siegel*, 116 Ill. 137; or of sticks of chewing gum: *Adams* v. *Heisel*, 31 Fed. Rep. 279; or of the frame of a sewing machine originally made under a patent: *Wilcox & Gibbs Sewing Machine Co.* v. *Gibbons' Frame*, 21 Bl. C. C. 431; *Brill* v. *Singer Manufacturing Co.*, 41 Ohio St. 127; nor in a manner of arranging in boxes cakes of soap wrapped in differently coloured paper wrappers: *Davis* v. *Davis*, 27 Fed. Rep. 490; nor in a *nom de plume*: *Clemens* v. *Belford*, 11 Biss. 459. But registration has been granted to a peculiarly shaped stick intended to be so placed in a roll of carpet as to show an octagonal ring at each end: *Lowell Manufacturing Co.* v. *Larned*, Dig. 428. Registration cannot be granted to minor and non-essential features in a compound mark: *Ex parte Coats*, 16 U. S. Pat. Gaz. 544. Occasionally a mark has been allowed to be registered in alternative forms, *e.g.*, "The Star Shirt," the same words with the figure of a star, and "The * Shirt": *Morrison* v. *Case*, 9 Bl. C. C. 548; the figure of a lion, the word "Lion," or both: *In re Weaver*, 10 U. S. Pat. Gaz. 1; and see *In re Park*, 12 *ib.* 2; *In re Thomas*, 14 *ib.* 821; *Ex parte Peper*, 16 *ib.* 678. A bad trade mark does not become a good one by the addition of unobjectionable elements: *In re Blakeslee & Co.*, U. S. Pat. Comm. Decis. 1871, 284, "Cundurango Ointment, C. O.;" *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538, "D. D. & Co. Tasteless" drugs; *In re Rader & Co.*, 13 *ib.* 596, "Ironstone" in an oval border; but it appears to be possible for two marks, which separately are not good trade marks, to form one in combination: *Ex parte Davids & Co.*, 16 *ib.* 94. A trade mark cannot be registered for the purpose of being used by all the members of an association on goods of any quality, nor can a mark which is intended to be used in furtherance of a scheme for the restraint of trade: *Ex parte Cigar Makers' Association*, 16 *ib.* 958; and in *Schneider* v. *Williams*, 44 N. J. Eq. 391, the Court refused to protect such a mark at the instance of a member of the Association. In *Strasser* v. *Moonelis*, 108 N. Y. 611; *People* v. *Fisher*, 57 N. Y. Sup. Ct. 552; *Allen* v. *Macarthy*, 37 Minn. 347, and *Blocte* v. *Simon*, 19 Abb. N. C. 88, however, a different view was taken of the propriety of such a mark. It seems that the decision

of a competent Court as to the validity of a mark is binding upon the Patent Office : *In re India Rubber Comb Co.*, 8 U. S. Pat. Gaz. 905. If an application is refused on the ground that the proposed mark is not a registrable trade mark, a renewed application for the registration of a mark not open to objection must be treated as a new application, and it cannot be treated as an amendment of the original application, nor can the fee originally paid be returned : *In re Block & Co.*, 14 *ib.* 235.

(*f*) Thus in *In re Rowe & Post*, 9 U. S. Pat. Gaz. 496, the name "The New York Cutlery Co." was refused registration as a new mark. As to the registration of names as old marks, see note (*h*), *infrà*. See also *In re Porter Blanchard's Sons*, U. S. Pat. Comm. Decis. 1871, 97; *In re Roberts* (1), *ib.* 113; S. C. (2), *ib.* 100; S. C. (3) *ib.* 101; *In re India Rubber Comb Co.*, 8 U. S. Pat. Gaz. 905; *In re Consolidated Fruit Jar Co.*, 14 *ib.* 269; *Ex parte Davids & Co.*, 16 *ib.* 94. The prohibition does not extend to the registration of the name of a person other than the applicant, and such names may be registered, at all events with their owner's consent, if living : *Ex parte Sullivan & Burke*, 16 *ib.* 765 ; *Ex parte Pace, Talbott & Co.*, 16 *ib.* 909.

(*g*) Thus in *In re The American Lubricating Oil Co.*, 9 U. S. Pat. Gaz. 687, registration was refused to the word "Star" as a trade mark on oil, the device of a star having already been registered for the same article ; so in *In re Coggin, Kidder & Co.*, 11 *ib.* 1109, to a device in which the principal feature was the name "Haxall," which had long been the trade mark of another firm ; so in *In re Bush & Co.*, 10 *ib.* 164, to a combination mark consisting of the applicants' own registered trade mark and two other devices appropriated by other firms ; so in *Ex parte Caire*, 15 *ib.* 248, to the words "Black Swan," the word "Swan" being already registered ; so in *Ex parte Smith* (1), 16 *ib.* 679, to "A. S. California Family * Soap," "California" and "*" being already separately on the register ; and see *Ex parte Weisert Bros.*, 16 *ib.* 680. On the other hand, in *In re Imbs*, 10 *ib.* 463, registration was granted, notwithstanding that two other marks contained somewhat similar features; and in *In re Cornwall* (1), 12 *ib.* 138, a device of a star and crescent was registered, although there was a star already on the register.

(*h*) Under this proviso registration was granted to a name used as a trade mark before 1870, *e.g.*, "The India Rubber Comb Co. of New York," *In re India Rubber Comb Co.*, 8 U. S. Pat. Gaz. 905; "The Rubber Clothing Co.," *In re Rubber Clothing Co.*, 10 *ib.* 111. See *In re Dole Bros.*, 12 *ib.* 939 ; *In re Consolidated Fruit Jar Co.*, 14 *ib.* 269 ; *Ex parte Consolidated Fruit Jar Co.*, 16 *ib.* 679. This saving proviso is, however, omitted from the Act of 1881, so that the prohibition as to names, &c., is universal. See Act of 1881, § 3, and *Ex parte Fairchild*, 21 *ib.* 789, in which case registration was refused to a name which had been used as a trade mark for twenty years, and had been registered under the Act of 1870.

§ 80 (*a*). *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.*

(*a*) See Act of 1881, §§ 3, 4.

§ 81 (*a*). *And be it further enacted, that the Commissioner of Patents is authorised to make rules and regulations* (*b*) *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.*

(*a*) See Act of 1881, § 12.

(*b*) It was formerly decided that the authority given to the Commissioner by § 81 to make regulations, empowered him to declare an interference in a trade mark case, for the purpose of deciding a question of title to the trade mark, on the analogy of the practice in patent cases: *Lautz Bros. & Co.* v. *Schultz & Co.*, 9 U. S. Pat. Gaz. 791; *Duke* v. *Green*, 16 *ib.* 1094. And though it was thought in *Swift* v. *Peters*, 11 *ib.* 1110, that the question whether a registered proprietor of a mark was entitled to the exclusive use of it as against an ex-partner, was a question for a Court of law, and not for the Office, it was held in *Hoosier Drill Co.* v. *Ingels*, 14 *ib.* 785, that, in investigating the title to the mark, all matters relating to the ownership should be gone into; and in *Hanford* v. *Westcott*, 16 *ib.* 1181, the U. S. Circuit Court decided that a decision of the Examiner of Interferences, unappealed, was conclusive as to the right to a mark; and see *Josselyn* v. *Seeley & Dart*, 15 *ib.* 702, as to reopening the evidence taken on an interference, and *Simpson* v. *Wright* (1), 15 *ib.* 248, and S. C. (2), 15 *ib.* 293, as to rehearing an interference. After the case of *U. S.* v. *Steffens*, 100 U. S. Rep. 82, it was held that the Patent Office has no longer any authority to decide questions of disputed titles to trade marks, or to declare interferences in such cases: *Braun & Co.* v. *Blackwell*, 19 U. S. Pat. Gaz. 481; but see *Ex parte Strasburger & Co.*, 20 *ib.* 155, and *Jacoby & Co.* v. *Lopes & Co.*, 23 *ib.* 342; and in *Yale Cigar Manufacturing Co.* v. *Yale*, 30 *ib.* 1183, it was decided that a declaration of interference is authorised by § 3 of the Act of 1881. In such cases the only duty of the Office is to decide whether the opponent has or has not a better title than the applicant, not to decide any further question: *ib.* If, on an interference between an applicant and a registered proprietor with respect to the same mark, the right to registration is adjudged to the applicant, notwithstanding the opposition of the registered proprietor, the result is, while strictly giving the applicant merely the right to register, practically to displace the registered proprietor, though his mark is not removed from the register: *ib.*

§ 82 (*a*). *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.*

(*a*) See Act of 1881, § 9.

§ 83 (*a*). *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* (*b*).

(*a*) See Act of 1881, § 10.
(*b*) See *Osgood* v. *Rockwood*, 11 Bl. C. C. 310; *U. S.* v. *Roche*, 1 McCrary, 385.

§ 84 (*a*). *And be it further enacted, that no action shall be maintained 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 (*b*).

(*a*) See Act of 1881, § 8.

(*b*) It seems that this Act provided no means for removing from the register a mark which was wrongly registered—*e.g.*, a mark which did not contain any of the essential particulars. See *Armistead* v. *Blackwell*, 1 U. S. Pat. Gaz. 603; *McElree* v. *Blackwell*, 15 *ib.* 658; *Wright* v. *Simpson*, 15 *ib.* 968; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 *ib.* 1183.

Act of Congress of 1875 (*a*).

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled :—

§ 1. That every person who shall, with intent to defraud, deal in or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trade mark, pursuant to the statutes of the United States, to which, or to the package in which the same are put up, is fraudulently affixed said trade mark, or any colourable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment.

(*a*) So far as this Act was dependent on the Registration Act of 1870 it fell to the ground when that Act was declared invalid in *U. S.* v. *Steffens*, 100 U. S. Rep. 82.

§ 2. That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trade mark registered pursuant to the statutes of the United States, or any colourable imitation thereof, calculated to deceive the public, to any goods of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this Act (*a*).

(*a*) See the New York case of *People* v. *Fisher*, 57 N. Y. Sup. Ct. 552.

§ 3. That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trade mark, registered pursuant to the statutes of the United States, or any colourable imitation thereof, calculated to deceive the public, with any goods of substantially the same descriptive properties as those referred to in said registration, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this Act.

§ 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and wilfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representation, likeness, copy, or colourable imitation of any die, plate, brand, engraving or mould of any private label, brand, stamp, wrapper, engraving on paper or other substance, or trade mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as proscribed in the first section of this Act.

§ 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and wilfully make, forge or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colourable imitation of any private label, brand, stamp, wrapper, engraving, mould, or trade mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this Act.

§ 6. That any person who shall, with intent to injure or defraud the owner of any trade mark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in, or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trade mark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this Act.

§ 7. That if the owner of any trade mark, registered pursuant to the statutes of the United States, or his agent, make oath, in writing, that he has reason to believe, and does believe, that any counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, or moulds, of his said registered trade mark, are in the possession of any person with intent to use the same for the purpose of deception and fraud, or make such oaths that any counterfeits or colourable imitations of his said trade mark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trade mark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person with intent to use the same for purpose of deception and fraud, then the several judges of the circuit and district courts of the United States, and the commissioners of the circuit courts, may, within their respective jurisdictions, proceed under the law relating to search-warrants, and may issue a search-warrant authorising and directing the marshal of the United States for

the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, and said counterfeit trade marks, colourable imitations thereof, labels, brands, stamps, wrappers, engravings on paper, or other substance, and said empty boxes, envelopes, wrappers, cases, bottles, or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trade marks, colourable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner for the purpose of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trade marks, colourable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

§ 8. That any person who shall with intent to defraud any person or persons, knowingly and wilfully aid or abet in the violation of any of the provisions of this Act, shall, upon conviction thereof, be punished by a fine not exceeding five hundred dollars, or imprisonment not more than one year, or both such fine and imprisonment.

Act of Congress of 1881.

AN ACT TO AUTHORISE THE REGISTRATION OF TRADE MARKS AND PROTECT THE SAME.

Be it enacted by the Senate and House of Representatives of the United States in Congress assembled,

§ 1 (*a*). That owners of trade marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribe which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration (*b*) of such trade marks by complying with the following requirements:

1st. By causing to be recorded in the Patent Office a statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise and the particular description of goods comprised in such class to which the particular trade mark has been appropriated; a description of the trade mark itself, facsimiles thereof (*c*), and a statement of the mode in which the same is applied and affixed to goods and the length of time during which the trade mark has been used (*d*).

2nd. By paying into the Treasury of the United States the sum of twenty-five dollars and complying with such regulations as may be prescribed by the Commissioner of Patents.

(*a*) See Act of 1870, § 77.

(*b*) Registration is a mere record of a claim, and affords merely *primâ-facie* evidence of ownership. See § 7, *infrà*, and *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183.

(*c*) See *Adams* v. *Heisel*, 31 Fed. Rep. 279.

(*d*) In *Lacroix* v. *Escobal*, 37 La. Ann. 533, it was held that a French citizen who had not deposited his mark at the U. S. Patent Office, as required by the Convention of 1869 between the U. S. and France, was not entitled to maintain an action for infringement. But in *Société, &c., de la Bénédictine* v. *Micalovitch*, 36 Alb. L. J. 364, it was held that compliance with the terms of that Convention was not essential where the trade mark of a French company had been registered under this Act of Congress.

In California an exclusive right to the use of a trade mark or name cannot now be acquired without registration as required by the State Code: *Whittier* v. *Dietz*, 66 Cal. 78.

§ 2 (*a*). That the application prescribed in the foregoing section must, in order to create any right whatever in favour of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade mark is used in commerce with foreign nations or Indian tribes, as above indicated (*b*), and that the description and facsimiles presented for registry truly represent the trade mark sought to be registered.

(*a*) See Act of 1870, § 77.

(*b*) This Act only recognises trade marks actually in use, and not trade marks which it is only intended to use in the future; and the user must be user in commerce with foreign nations or the Indian tribes, and the declaration on oath (see Rule 7, *post*) that there has been such user is strictly insisted on: *Ex parte Strasburger & Co.*, 20 U. S. Pat. Gaz. 155.

§ 3 (*a*). That the time of the receipt of any such application shall be noted and recorded. But no alleged trade mark shall be registered unless the same appear to be lawfully used as such (*b*) by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant (*c*), nor which is identical with a registered or known trade mark (*d*) owned by another and appropriated to the same class of merchandise, or which so nearly resembles some other person's lawful trade mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers (*e*). In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim

to the alleged trade mark (*f*); and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases (*g*).

(*a*) See Act of 1870, § 80, 79.

(*b*) As to what may be lawfully used as a trade mark, see the cases cited in note (*e*) to § 79 of the Act of 1870, *ante*. Under the present Act it has been decided that "Albany Beef" was no trade mark for canned sturgeon, being descriptive: *Ex parte Ams*, 23 U. S. Pat. Gaz. 344; that, on the same ground, "Time-keeper" could not be registered as an essential part of a trade mark for watches: *Ex parte Strasburger & Co.*, 20 *ib.* 155; nor "Cristalline" as a trade mark for artificial brilliants: *Ex parte Kipling*, 24 *ib.* 899; but that "Invigorator" was not descriptive, but a good trade mark for spring bed-bottoms: *Ex parte Heyman*, 18 *ib.* 922. Registration has been refused to the geographical name "Raleigh" (*Ex parte Oliver*, 18 *ib.* 923), but granted to a distinctive band or ribbon, intended to be attached to cigar-boxes, as a trade mark for cigars, it serving no mechanical purpose: *Ex parte Straiton & Storm*, 18 *ib.* 923. There is no trade mark in the colour of an article or of the packets containing it. Thus registration was refused to a red bag intended to contain flower seeds offered for sale: *Ex parte Landreth*, 31 *ib.* 1441. See *Fleischmann* v. *Starkey*, 25 Fed. Rep. 127. A trade mark of an inherently deceptive character cannot be registered: *Ex parte Bloch & Co.*, 40 U. S. Pat. Gaz. 443. Compare, however, *Société, &c., de la Bénédictine* v. *Micalovitch*, 36 Alb. L. J. 364.

(*c*) This prohibition being so general, registration has been refused to a name which had been used for twenty years as a trade mark, and had been registered as such under the Act of 1870: *Ex parte Fairchild*, 21 U. S. Pat. Gaz. 789. And in *Ex parte Adriance, Platt & Co.*, 20 *ib.* 1820, registration was refused to a name as part of a trade mark which also included a device. But a name has been allowed to be registered as part of an old combination trade mark: *Ex parte Fricberg & Workum*, 20 *ib.* 1164.

(*d*) These words have been held to prohibit the registration under this Act of a mark identical with or only colourably differing from a mark registered under the invalid Act of 1870, and not re-registered under this Act: *Ex parte Lyon Dupuy & Co.*, 28 U. S. Pat. Gaz. 191. And the fact that the new applicant uses the mark in foreign or Indian commerce, and that it does not appear whether the registered mark was so used, makes no difference: *ib.* So, also, *Yale Cigar Manufacturing Co.* v. *Yale*, 30 *ib.* 1183. What the applicant has to show is: (1) that he has a right to use the mark, and that no one else has; (2) that it is not too similar to the registered or known mark of another; (3) that the applicant uses it in foreign or Indian commerce: *Ex parte Lyon Dupuy & Co.*, 28 *ib.* 191.

(*e*) In *Ex parte Strasburger & Co.*, 20 U. S. Pat. Gaz. 155, registration as part of a trade mark was refused to the word "Railway," that having already been registered by another manufacturer.

(*f*) The Court cannot grant registration; that is for the commissioner alone: *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183.

(*g*) Under this section the commissioner has power to declare an interference: *Yale Cigar Manufacturing Co* v. *Yale*, 30 U. S. Pat. Gaz. 1183; and it makes no difference that the parties are partners, nor that one is a company and the other a member of it: *ib.* If the better title is with the applicant, he will be registered, notwithstanding that the same mark is on the register in the name of another person with an inferior title: *ib.* As to interferences, see § 81 of Act of 1870, *supra*.

§ 4 (*a*). That certificates of registry of trade marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the Commissioner of Patents; and a record thereof, together with printed copies of the specifications,

shall be kept in books for that purpose. Copies of trade marks and of statements and declarations filed therewith and certificates of registry so signed and sealed, shall be evidence in any suit in which such trade marks shall be brought in controversy.

(*a*) See Act of 1870, § 80.

§ 5 (*a*). That a certificate of registry shall remain in force for thirty years from its date, except in cases where the trade mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this Act at the time that such trade mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

(*a*) See Act of 1870, § 78.

§ 6. That applicants for registration under this Act shall be credited for any fee or part of a fee heretofore paid into the Treasury of the United States with intent to procure protection for the same trade mark.

§ 7 (*a*). That registration of a trade mark shall be *primâ-facie* evidence of ownership (*b*). Any person who shall reproduce, counterfeit, copy, or colourably imitate any trade mark registered under this Act, and affix the same to merchandise of substantially the same descriptive properties as those described in the registration, shall be liable to an action on the case for damages for the wrongful use of said trade mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any Court having jurisdiction over the person guilty of such wrongful act; and Courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy (*c*).

(*a*) See Act of 1870, §§ 78, 79.

(*b*) The use of a trade mark which, though registered, is a colourable imitation of another, may consequently be restrained: *Glen Cove Manufacturing Co.* v. *Ludeman*, 23 Bl. C. C. 46; *Schumacher & Ettlinger* v. *Schwenke* (2), 36 U. S. Pat. Gaz. 457; determining the doubt suggested in *Decker* v. *Decker*, 52 How. Pr. 218. The registration of a mark does not deprive the public of the right to use a somewhat similar mark, which was of common right before the registration, *e.g.* where "La Normandi" had been registered, but "La Normanda" was already in common use, no injunction was granted to restrain the use of the latter: *Stachelberg* v. *Ponce*, 128 U. S. Rep. 686.

(*c*) See § 11, *infrà*.

§ 8 (*a*). That no action or suit shall be maintained under the provisions of this Act in any case when the trade mark is used in any unlawful business or upon any article injurious in itself, or which mark has been

used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

(*a*) See Act of 1870, § 84.

§ 9 (*a*). That any person who shall procure the registry of a trade mark, or of himself as the owner of a trade mark, or an entry respecting a trade mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party to be recovered in an action on the case.

(*a*) See Act of 1870, § 82.

§ 10 (*a*). That nothing in this Act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade mark might have had if the provisions of this Act had not been passed.

(*a*) See Act of 1870, § 83.

§ 11 (*a*). That nothing in this Act shall be construed as unfavourably affecting a claim to a trade mark after the term of registration shall have expired; nor to give cognisance to any Court of the United States in an action or suit between citizens of the same State (*b*), unless the trade mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe (*c*).

(*a*) See Act of 1870, § 78.

(*b*) The Federal Courts have now no jurisdiction to try a trade mark action between citizens of the same State, unless the pleadings allege that the plaintiff uses the trade mark on goods intended for foreign or Indian commerce: *Ryder* v. *Holt*, 128 U. S. Rep. 525; *Luyties* v. *Hollender* (1), 22 Bl. C. C. 413; *Schumacher & Ettlinger* v. *Schwenke* (1), 26 Fed. Rep. 818. The Federal Court is not limited in its jurisdiction to cases in which the defendant's profits have exceeded 500 dollars: *Symonds* v. *Greene*, 28 Fed. Rep. 834.

(*c*) Since under this Act the Federal Court cannot try a trade mark case between citizens of the same State unless the goods are intended for foreign or Indian commerce, there is no jurisdiction in such a case in respect of past wrongful acts: *Schumacher & Ettlinger* v. *Schwenke* (2), 36 U. S. Pat. Gaz. 457.

§ 12 (*a*). That the Commissioner of Patents is authorised to make rules and regulations and prescribe forms for the transfer of the right to use trade marks and for recording such transfers in his office.

(*a*) See Act of 1870, § 81.

§ 13. That citizens and residents of this country wishing the protection of trade marks in any foreign country the laws of which require

registration here as a condition precedent to getting such protection there, may register their trade marks for that purpose as is above allowed to foreignors, and have certificate thereof from the Patent Office.

Approved March 3rd, 1881.

Rules and Forms adopted by the U. S. Patent Office for the Registration of Trade Marks under Act of March 3rd, 1881.

Who may obtain Registration.

1. (a.) Any person, firm, or corporation domiciled in the United States or located in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States (*a*), and who is entitled to the exclusive use of any trade mark and uses the same in commerce with foreign nations or with Indian tribes.

(b.) Any citizen or resident of this country wishing the protection of his trade mark in any foreign country the laws of which require registration in the United States as a condition precedent.

(*a*) The United States acceded to the International Convention in 1887. See also the Treaty with the United Kingdom, p. 642, *infra*.

Statutory Requirements.

2. Every applicant for registration of a trade mark must cause to be recorded in the Patent Office—

(a.) The name, domicile, and place of business or location of the firm or corporation desiring the protection of the trade mark, and the residence and citizenship of individual applicants.

(b.) The class of merchandise and the particular description of goods comprised in such class to which the trade mark has been appropriated.

(c.) A description of the trade mark itself, with facsimiles thereof, and the mode in which it has been applied and used.

(d.) The length of time during which the trade mark has been used by the applicant on the class of goods described.

3. A fee of twenty-five dollars is required on filing each application, except in the cases hereinafter named. (See pars. 16 and 17).

The Application.

4. An application for the registration of a trade mark will consist of a statement and specification, a declaration or oath, and the facsimile, with duplicates thereof.

5. These should be preceded by a brief letter of advice requesting registration and signed by the applicant.

6. The statement should announce the full name, citizenship, domicile,

residence, and place of business of the applicant (or if the applicant be a corporation, under the laws of what state or nation incorporated), with a full and clear specification of the trade mark, particularly discriminating between its essential and non-essential features. It should also state from what time the trade mark has been used by the applicant, the class of merchandise, and the particular goods comprised in such class to which the trade mark is appropriated, and the manner in which the trade mark has been applied to the goods.

7. The declaration should be in the form of an oath by the person or by a member of the firm, or by an officer of the corporation making the application, to the effect that the party has at the time of filing his application a right to the use of the trade mark described in the statement; that no other person, firm, or corporation has a right to such use, either in the identical form, or in such near resemblance thereto as might be calculated to deceive; that such trade mark is used in lawful commerce with some foreign nation (or nations) or some Indian tribe (or tribes), and that it is truly represented in the facsimile presented for registry (*a*).

(*a*) This statement on oath will be insisted on: *Ex parte Strasburger*, 20 U. S. Pat. Gaz. 155.

8. This oath may be taken within the United States, before a notary public, justice of the peace, or the judge or clerk of any court of record. In any foreign country it may be taken before the secretary of a legation or consular officer of the United States, or before any person duly qualified by the laws of the country to administer oaths, whose official character shall be certified by a representative of the United States having an official seal.

Facsimiles to be Filed.

9. Where the trade mark can be represented by a facsimile which conforms to the rules for drawings of mechanical patents (*a*), such a drawing may be furnished by applicant, and the additional copies will be produced by the photo-lithographic process at the expense of the office. Or the applicant may furnish one facsimile of the trade mark, mounted on a card ten by fifteen inches in size, and ten additional copies upon flexible paper, not mounted; but in all cases the sheet containing the mounted facsimile or the drawing must be signed by the applicant or his authorised attorney.

(*a*) These rules are furnished on application by letter to the Commissioner.

Proceedings in the Office.

10. All applications for registration are considered in the first instance by the Trade Mark Examiner. An adverse decision by such examiner

upon the applicant's right to registration will be reviewed by the Commissioner in person upon petition without fee.

11. No trade mark will be registered unless it shall be made to appear that the same is used as such by the applicant in commerce with foreign nations or with Indian tribes, or is within the provisions of a treaty, convention, or declaration with a foreign power, nor which is merely the name of the applicant, nor which is identical with a known or registered trade mark owned by another, and appropriated to the same class of merchandise, or which so nearly resembles some other person's lawful trade mark as to be likely to cause confusion in the mind of the public or to deceive purchasers.

12. In case of conflicting applications for registration, or in any dispute as to the right to use which may arise between an applicant and a prior registrant, the office will declare an interference, in order that the parties may have opportunity to prove priority of adoption or right; and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents; but each applicant and registrant will be held to the date of adoption alleged in the statement filed with his application. On the petition of any party dissatisfied with the decision of the Examiner of Interferences the case will be reviewed by the Commissioner without fee (*a*).

(*a*) After *U. S.* v. *Steffens*, 100 U. S. Rep. 82, it was held that the U. S. Patent Office had no authority to decide disputed questions of title to trade marks, or to declare interferences: *Braun & Co* v. *Blackwell*, 19 U. S. Pat. Gaz. 481. But see *Ex parte Strasburger & Co.*, 20 *ib.* 155, and *Jacoby & Co.* v. *Lopes & Co.*, 23 *ib.* 342. And it is now decided that there is such authority: *Yale Cigar Manufacturing Co.* v. *Yale*, 30 *ib.* 1183. And see notes to § 81 of the Act of 1870, and to § 3 of the Act of 1881, *supra*.

13. When these requirements have been complied with, and the office has adjudged the trade mark lawfully registrable, a certificate will be issued by the Commissioner, under seal of the Interior Department, to the effect that applicant has complied with the law, and that he is entitled to the protection of his trade mark in such cases made and provided. Attached to the certificate will be a facsimile of the trade mark and a printed copy of the statement and declaration.

14. The protection for such trade mark will remain in force for thirty years, and may, upon the payment of a second fee, be renewed for thirty years longer, 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 will cease to have force in this country, by virtue of the registration, at the same time that the trade mark ceases to be exclusive property elsewhere.

15. The right to the use of any trade mark is assignable by an instrument of writing, and such assignment of a registered trade mark must be recorded in the Patent Office within sixty days after its execution, in

default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice. No particular form of assignment or conveyance is prescribed, but the trade mark should be identified by the certificate number.

16. Owners of trade marks for which protection has been sought by registering them in the Patent Office under the Act of July 8th, 1870 (declared unconstitutional by the Supreme Court of the United States), may register the same for the same goods, without fee, on compliance with the foregoing requirements. With each applicant of this character a specific reference to the date and number of the former certificate is required (*a*).

(*a*) See *Jacoby & Co.* v. *Lopes & Co.*, 23 U. S. Pat. Gaz. 342.

17. Applicants whose cases were filed under the Act of 1870, either prior to or since the decision of the Supreme Court declaring it unconstitutional, which are now pending before the office, are advised to prepare applications in conformity with the law and foregoing rules. On the receipt of such an application, referring to the date of the one formerly filed, all fees paid thereon will be duly applied. Those who have paid only ten dollars as a first fee are advised that the law does not provide for a division of the legal fee of twenty-five dollars, and that the remainder of the entire fee is required before the application can be entertained.

Copies and Publications.

18. Printed copies of the statement and declaration in each case, with a duplicate of the trade mark, can be furnished by the office. The *Official Gazette* of the Patent Office, published weekly, will contain a list of all trade marks registered, with the name and address of the registrant, a brief statement of the essential features of the trade mark, and the particular description of goods to which it is applied.

Fees.

19. On filing an application for registration of trade mark $25 00

For recording assignments—

Under 300 words	1 00
Over 300, and less than 1000, words . . .	2 00
Over 1000 words	3 00
For single printed copy of statement and declaration	25
Single copy *Official Gazette*	10
Annual subscription *Official Gazette* . . .	5 00

Correspondence.

20. All letters should be addressed to "The Commissioner of Patents," and all remittances by postal order, check, or draft should be to his order.

21. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relating to registered trade marks must refer to the name of registrant, number or date of certificate, and the class of merchandise to which the trade mark is applied.

22. The office cannot undertake to respond to inquiries propounded with a view to ascertain whether certain trade marks have been registered, or, if so, to whom or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed. A copy of these rules with this paragraph marked will be regarded as a courteous answer to all such inquiries.

Forms.

The following forms have been prepared to be used in filing applications for registration of trade marks. Their use is not absolutely required, but as they have been made to conform to the conditions of the law, applicants will find their business facilitated by following them closely.

Letter of Advice.

To the Commissioner of Patents:

The undersigned presents herewith a facsimile of his lawful trade mark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office in accordance with the law in such cases made and provided.

A. B.

Statement.

To all whom it may concern:

Be it known that I, A. B.,* a citizen of the United States, residing at , in the county of and State of , and doing business at , have adopted for my use a trade mark for ,* of which the following is a full, clear, and exact specification.

My trade mark consists of the letters and words (or arbitrary symbols, as the case may be) . These have generally been arranged as shown in the accompanying facsimile. (Here give a full description of the facsimile, including all its features.) But may be omitted

and changed at pleasure without materially altering the character of my trade mark, the essential features of which are .

This trade mark I have used continuously in my business since , 18 .

The class of merchandise to which this trade mark is appropriated is , and the particular description of goods comprised in such class on which I use the said trade mark is .† It has been my practice to (here state fully the manner of applying it to the goods or the packages containing them).

A. B.

Witnesses:
C. D.
E. F.

* The first paragraph of the statement should be modified to conform to the circumstances of each applicant. If a firm, the domicile and place of business are required; if a corporation, under what State or other laws incorporated, where located, and place of business; if a person not an American citizen, of what country he is a citizen (or subject, as the case may be), &c., &c.

† The description of the goods on which the trade mark is used should be in the same language in the first and last paragraphs of the statement.

Declaration.

State of , County of , ss:

A. B., being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that he has at this time a right to the use of the trade mark therein described; that no other person, firm, or corporation, has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that it is used in commerce with (here name one or more foreign nations or Indian tribes, or both, as the case may be); that the description and facsimiles presented for record truly represent the trade mark sought to be registered; and that he is a citizen of the United States.

Sworn and subscribed before me a this day of , 18 .

G. H., *J.P.*

If the application is made by a firm or corporation, or by a citizen or subject of a foreign power, this declaration should be modified accordingly.

APPENDIX I.

TREATY WITH THE UNITED STATES, 1877 (*a*).

Declaration between Great Britain and the United States for the Protection of Trade Marks.

The Government of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, and the Government of the United States of America, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:

The subjects or citizens of each of the contracting parties shall have, in the dominions and possessions of the other, the same rights as belong to native subjects or citizens, or as are now granted or may hereafter be granted to the subjects and citizens of the most favoured nation, in everything relating to property in trade marks and trade labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective countries.

In witness whereof the Undersigned have signed the present Declaration, and have affixed thereto the seal of their arms.

Done at London, the 24th day of October, 1877.

(L.S.) Derby.
(L.S.) Edwards Pierrepont.

(*a*) The importance of this Treaty has not yet disappeared. See opinion of the Attorney-General of the United States (47 U. S. Pat. Gaz. 397) as to the necessity for legislation, not yet passed, for giving effect to the International Convention of 1883.

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