The Law of

TRADE-MARKS, TRADE-NAME,

AND

MERCHANDISE MARKS,

WITH CHAPTERS ON TRADE SECRET AND TRADE LIBEL, AND

A FULL COLLECTION OF STATUTES, RULES,

FORMS AND PRECEDENTS.

BY

D. M. KERLY, M.A., LL.B.,

Sometime Fellow and MacMahon Law Student of St. John's College, Cambridge; Author of "An Historical Sketch of the Equitable Jurisdiction of the Court of Chancery,"

OF THE INNER TEMPLE, BARRISTER-AT-LAW.

S
UK
945
KER

LONDON:

SWEET AND MAXWELL, LIMD., 3, CHANCERY LANE

Law Publishers,

MEREDITH, RAY, & LITTLER, MANCHESTER;

HODGES, FIGGIS, & CO., LD., AND E. PONSONBY, DUBLIN;

C. F. MAXWELL, MELBOURNE & SYDNEY.

1894

TM
K396f

Rec. Feb. 23, 1899.

LONDON:

PRINTED BY C. F. ROWORTH, GREAT NEW STREET, FETTER LANE, E.C.

PREFACE.

THE progressive development in recent years of the law with regard to trade-marks and trade descriptions, and the growing importance of the rights which this branch of the law is designed to protect, originally suggested to the Author that a more detailed and systematised statement of the decisions and statutes in which it is contained than had previously been made might possibly be found useful. The presentation of such a statement has rendered it essential to trace the origin and growth of the rights and remedies which are involved, and to make some attempts at the definition of general principles and the formulation of rules; and this has been the more necessary because the leading authorities on trade-mark law are, in an unusual degree, involved with the facts of the particular cases in which they are embodied.

The Author has sought to present, in his Introductory Chapter, a general view of the law, to trace in outline its origin and history, and to mark the

improvement in the remedies for infringement of trade-mark rights which has attended the growing importance of the rights themselves. A consideration of the common law action on the case for damages for passing off goods as those of another, and the corresponding suit in Equity for an injunction, which seem to have been first admitted and recognised at the beginning of the present century, and which, in a developed form, still afford remedies of great value and importance, and a comparison of them with the highly specialized action for the infringement of a registered trade-mark at present in use, show an interesting and remarkable transition. And that the progress of the law has been beneficial is evidenced by the fact that, besides the many thousands of unregistered trade-marks which are in use, upwards of 70,000 trade-marks have been entered upon the Register.

In addition to the general matter already mentioned, Book I. sets forth the substantive law in relation to trade-mark, trade-name, and analogous rights, and deals with the provisions and effect of the Trade-Mark Acts, and the law and procedure generally with regard to the registration of trade-marks. It is hoped that sufficient regard has been had to the recent decisions which vindicate the principle that the right of property in trade-marks does not depend on registration. The common law right in trade-marks, which is now definitely

established, must obviously be of very great importance so long as the unregistered trade-marks continue to be numerous; and the Author has, accordingly, considered in separate chapters the definition and mode of acquisition of a trade-mark apart from registration, the effect of registration and of the want of it, and the infringement of an unregistered trade-mark.

Book II. is almost wholly occupied with a commentary on the Merchandise Marks Act of 1887. That statute is at present somewhat bare of judicial interpretation, although it is not without difficulties of construction. It has already operated with some success as a deterrent of frauds, especially by checking the importation of foreign goods bearing English names or marks, or other deceptive indications of an English origin. The Act would probably be found of still greater utility if it were so amended as to provide for the summary punishment of frauds effected under cover of false trade descriptions by word of mouth.

The Author has availed himself of the very valuable Report of the Departmental Committee over which the present Lord Chancellor presided in 1887; and also, in dealing with the Merchandise Marks Act, of the evidence given before the Select Committees of the House of Commons appointed in 1887 and 1890 to consider the law with regard to merchandise marks and false marking.

Regarding the procedure of the Customs Authorities as of much practical importance, he has also embodied so much of the Regulations and General Orders of the Commissioners of Customs as appeared to him likely to be of general use.

The Author is indebted to Mr. F. G. UNDERHAY, of the Inner Temple, for his kindness in reading the proof sheets of the work, and for a number of corrections and suggestions.

1, PAPER BUILDINGS,
Whitsun Vacation, 1894.

CONTENTS.

Book I.

The Law of Trade-Marks.

Chapter I.

PAGES

INTRODUCTION ..... 1—23

Trade-marks before the Registration Acts, 1. Registration of trade-marks, 5. Passing off and trade-name actions, 12. The Criminal Law of false marking, 17. International and Colonial arrangements, 21.

Chapter II.

THE DEFINITION OF A TRADE-MARK ..... 24—51

Definition, 25. The Registration Acts contain no definition, but they import the old law, 25. Definitions in the M. M. A. 1862...26. Definitions in the M. M. A. 1887...27. Judicial definitions, 27.

What symbols may be trade-marks, 28.

Applied or attached to goods, 29; the mark must go to market with the goods, 29; and must sell the goods, 30; trade-mark rights are restricted to the class of goods for which the mark is used, 31; the use of the trade-mark on other goods is not protected, 31; anyone may use the mark on the right goods, 32.

Offered for sale in the market, 33; long user of mark or proof of actual reputation is unnecessary, 34.

The mark must be distinctive, 35; what are distinctive marks, 36; descriptive marks and marks apparently descriptive, but having a secondary distinctive meaning, 36; name of a new pattern, *Ford* v. *Foster*, 37; test whether trade-mark has become *publici juris*, 37; the *Singer* cases, 38; no monopoly can be maintained in the reputation of goods which anyone may make and sell, 41; name of goods made under an expired patent, 42; name given to a new article cannot be monopolized, 43; *The Linoleum Case*, 43; "original," 44; name of place of origin, 44; "Anatolia liquorice," 45; *Seixo* v. *Provezende*, 45; "Glenfield starch," 46; advertisement of goods not a trade-mark, 47; *Leather Cloth Case*, 47; *Cheavin* v. *Walker*, 48.

Made, worked upon, imported, selected, certified, or sold, 49; connection of the owner of the trade-mark with the goods, 49; buyers rely on the reputation of the owner of the trade-mark, 49; trade-mark of selector, *Hirsch* v. *Jonas*, 50.

Registered under the Acts as a trade-mark, 51.

CHAPTER III.

PAGES

THE REGISTER OF TRADE-MARKS, AND THE TRADE-MARKS BRANCH OF THE PATENT OFFICE..... 52—57

The register, 52. The Manchester office and the Sheffield register, 52. The Comptroller, 53. Entries on the register, 53. No trusts to be entered, 54. Title conferred by registration, 54. Alterations of the register, 54. Falsification of the register, 55. Devolution of title, 55. Removal of entries, 55. Inspection of the register, 55. Searches, 55. Indexes, 56. Certified copies of the register to be evidence, 57. Comptroller's certificate, 57. Patent Office seal, 57. Notices and documents may be sent by post, 57.

CHAPTER IV.

REGISTRATION OF TRADE-MARKS..... 58—86

Section 62..59.

Who may apply to register, 60; the proprietor, 60; an importer, 61; application through an agent, 62; registration in the agent's name, 62.

The Comptroller's discretion, 63; reasons for refusal to register, 63; nature of the discretion, 64.

Procedure on application to register, 68; form of application, 68; abandonment of application, 69; advertisement, 69; registration, 70; death of applicant, 70; amendments, 71.

Opposition to registration, 71; sect. 69, rule 31..71; summary of procedure on an opposed application, 75; objections not contained in the notice, 76; amendments, 76; grounds of opposition, 77.

Appeal from the Comptroller, 78; notice of appeal and case, 79; appeal to the Court on reference by Board of Trade, 79; no appeal to the Court direct, 80; address for service, 82; evidence, 83; modification of application at the hearing, 83; the Court must consider all objections, 84.

Costs, 85.

CHAPTER V.

CLASSIFICATION OF GOODS..... 87—90

The classes, 88. Registration and protection for part of a class, 88. Series of trade-marks, 90.

CHAPTER VI.

SHEFFIELD MARKS ..... 91—102

The Cutlers' Company, 91. Old corporate marks, 93. Recent legislation and the company, 94. The Act of 1875..94. The Acts of 1883 and 1888..95. Effect of sect. 81 (Sheffield marks), 96.

CHAPTER VII.

PAGES
COTTON MARKS AND THE MANCHESTER OFFICE..... 103—105

The repealed Cotton Marks Rules, 103. The Cotton Marks Committee, 104. The Manchester branch office, 104. Jurisdiction of the Palatine Court of Chancery, 105.

CHAPTER VIII.

WHAT MARKS MAY BE REGISTERED AS TRADE-MARKS..... 106—163

Section 64..108. Additions and disclaimers, 108. Section 10 of the Act of 1875..109. New marks may be registered, 109. Applicant must intend to use the mark, 110. What Act applied to pending registrations, 111. Section 10 (sect. 64 (1)) is purely restrictive, 112.

Essential particulars, 112.

(a) NAME-MARKS, 114; mere name in nominative case, 115; particular and distinctive manner, 116.

(b) SIGNATURES, 117; signature of applicant, 117; *requirements for a good trade-mark*, 118.

(c) DISTINCTIVE DEVICE, &c., 118; meaning of distinctive, 119; (1.) What marks are to be distinguished, 122; common marks, 122; other trade-marks, registered or not, 125; abandoned trade-marks, 126; marks used as advertisements, 126. (2.) What degree of distinctiveness is required, 127; secondary distinctive meaning, 127; descriptive marks, 127.

DEVICE, 128; *devices as trade-marks*, 128; word or letter not a device, 129; colour, 129; portrait of inventor, 129; part of mark common to trade, 129; combination devices, 130; descriptive devices, 131.

MARK, 132.

BRAND, 133.

HEADING, 135; line headings for cotton goods, 136.

LABEL, 136; phrases and proverbs, 137; ordinary arrangement of common parts, 137; no disclaimer of common parts, 138; similar common words in contrasted labels, 139.

WORD MARKS, 140; *Words as trade-marks*, 140; Report of Lord Herschell's Committee, 141; geographical names, translated words, phonetic equivalents, 141.

FANCY WORD OR WORDS NOT IN COMMON USE, 142. (1.) Fancy word, 142; *Van Duzer's Case*, 143; the word must be obviously meaningless, 143; descriptive words, 145; words in a foreign language, 145; name of goods in a foreign language, 146; names of common marks, 147; secondary distinctive meaning does not constitute a word a fancy word, 147; geographical words, 147; name of a person, 149. (2.) Not in common use, 149; in the trade or popularly, 150; "the" prefixed to word, 150; examples from decided cases, 150.

(d) INVENTED WORDS, 152.

(e) WORDS HAVING NO REFERENCE TO GOODS, 153.

PAGES

Old marks, 153. (1.) Special and distinctive, 154; deceptive mark not distinctive, 155; descriptive words, 155; words with a secondary distinctive meaning, 155; examples of old word marks, 158. (2.) Used as a trade-mark, 158; use on bottles or boxes only, 159; where the applicant has another trade-mark, 159; the old mark must have been used as registered, and alone, 160; use for the same goods, 160; use in the United Kingdom, 161; fraudulent use, 161; temporary cession of user, 161; slight evidence of user sufficient, 161.

Colour, 162; section 67, registration in colours, 162; colour as an element of similarity, 163.

Chapter IX.

ADDITIONS AND DISCLAIMERS .....164—174

Additions, 165. Lord Herschell's Committee on additions and disclaimers, 165. Disclaimers to be included in the applications to register, 166. What are essential particulars of a registered mark, 166. The proprietor need not disclaim his own name, 167. Trade-name, 168. Additions which are common to the trade, 169. Section 74..169. The registration of common words in a trade-mark confers no monopoly, 170. Distinctive means *prima facie* distinctive, 171. Common to the trade, 171. Use by one trader only, 171. The three mark rule, 172. Common words in a distinctive label need not be disclaimed, 172. Common additions are not part of the trade-mark, 173. Effect of registration of additions with a disclaimer, 173. The advantages of it, 174.

Chapter X.

RESTRICTIONS ON REGISTRATION .....175—217

The comptroller's discretion not limited by the express restrictions, 176.

Duplicate marks for the same goods. Sects. 71 and 72 (1), 176. The three mark rule, 177; rule does not apply to new marks, 179; application of the rule, 179. The same goods or description of goods, 180. Section 72 is not limited by the register classes, 180; use or registration for part of a class, 181. Registration of a second mark by agreement, 182.

Mark resembling a registered mark. Sect. 72 (2), 182. The section extends beyond infringing marks, 183. Where the marks are used in different markets, 184. Deceptive resemblance calculated to deceive, 186.

What persons are to be considered, 186; ultimate purchasers, 187; foreigners, 187; ordinary persons, 187.

Rules of comparison, 188; what amount of resemblance is calculated to deceive, 188. (1.) The "idea of the mark" to be regarded, 188; the *Tico Elephant Case*, 190; the *Tuendelikker Case*, 191; marks to be compared as wholes, 192; general resemblance with differences in details, 192; included common marks not to be disregarded, 192. (2.) The marks are to be compared as fairly used in

PAGES

practice, 193; alterations of the marks from their registered forms, 195. (3.) The essential particulars are to be specially attended to, 196. (4.) All the circumstances of the trade to be considered, 197; numerous marks of the same description, 197; distinction may be of a well-known kind, 198; bearing of common marks on the comparison, 199. (5.) Where the opponent's goods are known by a name suggested by the mark, 199; answers to this objection, 201; (a) the name is descriptive of the goods, 201; (b) it is suggested by included matter common to the trade, 202; or by disclaimed matter, 203; or it is a common name, 203; (c) it gives a practical monopoly, 204.

EVIDENCE, 205; evidence of actual deception, 206; examples and illustrations, 207; contrasted devices and contrasted words, 207.

Deceptive marks. Sect. 73..209. The section extends beyond infringing marks, 210. Doubtful new marks to be rejected, *Eno* v. *Dunn*, 211. Mark containing name of the opponents' goods, 212. Device suggesting the name, 213. *Trade-mark* attached to part of the mark, 214. Threats of prosecution in trade-mark, 215. *Registered*, &c., 216. False representation as to origin of goods, 216. Mark originally used fraudulently, 216.

CHAPTER XI.

RECTIFICATION OF THE REGISTER.....218—251

Rectification under sect. 90..220.

"PERSONS AGGRIEVED," 221; all persons substantially inconvenienced if the registration is wrong, 221; the question is one of *locus standi* only, 221; *The Apollinaris Case*, 221; any person harassed or intimidated by the registration, 222; *Powell's Case*, 222; defendant in a passing off action, 223; where the respondent offers to disclaim, 223; exporter aggrieved by the registration of a mark for the home trade, 223; foreigner, 223; wider view now taken than in the earlier cases, 224.

THE EXERCISE OF THE JURISDICTION, 225; where the mark was incapable of registration it must be removed, 225; and the conduct of the applicant is immaterial, 225; where it was capable of registration, but might have been opposed, the Court has a discretion, 226; *Paine* v. *Daniells*, 226; independent title by registration and user, 228; mark allowed to remain in pursuance of a compromise, 228; the comptroller's decision is no bar to rectification, 229; nor is five years' registration, 229; nor, generally, delay on the part of the applicant, 229; but delay may have a bearing on the evidence, 229; entry to be vacated or rectified if originally wrongly made, 230; but not on account of subsequent events, 231.

THE ORDERS MADE, 231; (1) new entries, 231; new marks cannot be registered under sect. 90..231; (2) total removal, 232; reasons for removal, 232; alteration of circumstances, abandonment, misuser, 233; (3) partial removal, 233; deceptive marks wholly removed, 234; (4) registration of a disclaimer, 234; (5) limitation of the registration, 235; to particular goods or particular markets, 235; (6) variation of the mark, 235; (7) variation of the date of entry, 235; (8) variation of the name of the proprietor, 236; registration in the wrong name, 236.

PAGES

PROCEDURE, 237; the Court, 237; summons or motion, not counterclaim, 238; notice to the Comptroller, 239; service on the registered proprietor, 239; where the proprietor is resident abroad, 240; notice of motion not served out of the jurisdiction, 240; notice by letter, 240; foreigner appearing, liable for costs, 240; but not ordered to give security, 241.

EVIDENCE, 241; declarations of proprietor, 242; discovery and particulars, 242. Order to be served on the Comptroller, 243. Damages, 243. Costs, 244. Appeal, 245.

Correction and cancellation at the proprietor's request, sect. 91.. 246. Alteration of address, 246.

Alterations in non-essential particulars, sect. 92..247; essential particulars, 248; old marks not to be altered, 248; alterations of new marks, 249; procedure, 250; costs, 251.

CHAPTER XII.

EFFECT OF REGISTRATION .....252—271

Object of the Acts, 252.

Title to new trade-marks conferred by registration, sect. 75..253. Registration equivalent to user, 254; now and unused marks may be registered, 254.

Registration as evidence of title, sect. 76..255. Registered proprietor entitled to exclusive use of mark, 255; comparison with earlier Acts, 255; "subject to the provisions of this Act," 256; right limited to goods for which the mark is registered, 256; and actually used, 256; certificate of registration evidence of title *prima facie* or conclusive, 257; the register may be rectified at any time, 258; examples of rectification after five years, 259; sect. 76 is subordinate to sect. 90..260; registration is conclusive if there is no application under sect. 90..260.

Registration is a condition precedent to an action for infringement, sect. 77..260; corresponding sections of the earlier Acts, 261; Act of 1883..262; (a) new marks incapable of registration are within the prohibition, 262; (b) old marks refused registration are not, 263; certificate of refusal, 264; the section applies to foreigners, 264; section is a condition precedent to an action, but not to the acquisition of a trade-mark, 264; only the registered proprietor or his assignee can sue, 265; the assignee can sue before registration, 265.

THE PROHIBITION DOES NOT AFFECT PASSING OFF ACTIONS, 265; distinction between infringement and passing off actions, 265; unregistered trade-marks are practically protected, 266; the operation of sect. 77..268; proof of fraud is not necessary to escape the prohibition, 269; failure to register only deprives the proprietor of the assistance of the Acts, 269; and of the protection of the Merchandise Marks Act, 270.

Chapter XIII.

PAGES
ASSIGNMENT AND DEVOLUTION OF TRADE-MARKS..... 272—282

A trade-mark is assignable only with the goodwill, sect. 70..272. And passes with the goodwill by implication, 273. *Hall* v. *Barrows*, 273. Trade-mark comprising the name of the original proprietor, 274. *The Leather Cloth Case*, 275. No assignment if the use of the assigned mark by the assignee would be deceptive, 275. Lord Kingsdown's judgment, 275. The mark used by the assignee must indicate what it indicated when used by the assignor, 276. A mark comprising a trader's name is assignable, 276. Assignment with the goodwill of part of the business, 277. Transfer of goodwill and trade-mark not necessarily contemporaneous, 277. Dissolution of partnership, and bankruptcy, 278. Registration of assignments, sect. 87..278. Procedure and rules, 279. Refusal to register an assignment, 280. Action by assignee before registration, 280. Alteration of registered mark in consequence of an assignment, 280. Licence to use a trade-mark, 281. Lease of goodwill, 282. Action by licensee, 282.

Chapter XIV.

DETERMINATION OF TRADE-MARK RIGHTS 283—294

Loss of distinctiveness, 284; by the action of the proprietor, 285; by extensive piracy, 286; test whether the mark is *publici juris*, 286; mark *publici juris* for a particular class, 287.

Separation of the mark from the goodwill, sect. 70..287; removal of the mark, 288; temporary separation from goodwill, or disuse of mark, is immaterial, 288.

Abandonment, 289; agreement to abandon, 290; not mere disuse of mark, 290; adoption of a new mark, 290; use with the proprietor's name, 290; neglect to prosecute infringements, 290; Sheffield corporate mark by non-registration, 291.

Forfeiture of right to protection, 291.

Removal of mark from the register, 291; where it has determined, 291; for non-payment of fees, sect. 79..292; new mark may be deceptive by resembling the removed mark, 293; cause of the removal to be registered, 294; fees and forms, 294.

Chapter XV.

THE ACTION FOR INFRINGEMENT .....295—378

Comparison with passing off action, 296.

Commencement of the action, 298; in what Court, 298; service out of the jurisdiction, 299; notice of action unnecessary, 300.

The plaintiff's title, 301; joint trade-marks, 301; contract for exclusive sale, 302; one of several proprietors may sue, 302; action by executors, 303.

PAGES

Registration, 303; registration of assignment, 304; registration as evidence of title, 304.

What constitutes infringement, 305; definition, 305; isolated act of infringement, 306; use on goods which are not the plaintiff's, 308. (a) *Where the defendant copies the plaintiff's mark or pretends that it is his own*, 312. (b) *Where he copies an essential feature of it*, 313. (c) *Where his mark is a colourable imitation of it*, 314; test of infringement, 314; actual deception need not be proved, 316; nor intention to deceive, 316; what resemblance is calculated to deceive, 318; principles of comparison summarised, 318; what importance is to be attached to differences between the marks, 322; inconspicuous additions or explanations: "late of," "from," "equal to," 322.

Defences, 323. *Attack on the plaintiff's title or the registration of his mark*, 324; *concurrent or independent right*, 325; registration of the defendant's mark, 327; introduction into a new market, 328; trade-marks on dissolution of partnership, 329; or bankruptcy, 329; honest use of defendant's own name, 330.

ESTOPPEL, 330. (a) Personal estoppel, 330; agreement to condone infringement, 330; uncandid conduct, 331; use of mark in unregistered form, 331. (b) Acquiescence, 332; licence, 333. (c) Delay, 333; delay may modify the relief, or amount to abandonment, 334; it has a bearing on the evidence, 335. (d) Deceptive trade-mark or fraudulent trade, 336; collateral misrepresentation, 336; it is immaterial that the misrepresentation is too gross to deceive, 339; false claim of patent rights, 339; "trade-mark" affixed to part of mark only, 343; false assertion of registration, 345; other misleading statements, 346; fraudulent trade, 346; Havana cigars, 347; misrepresentation after action commenced, 347.

The relief granted, 348.

I. INJUNCTION, 348; form, 350; restricted to future consignments or a particular market, 351; refused because of delay, 353; interim injunction, 354; enforcement of the injunction, 355; choice of a new mark by the defendant, 356; delay in application to commit, 356.

II. DELIVERY UP OF THE MARKED ARTICLES, 357; erasure of the spurious marks, 357; bailee is not bound to deliver spuriously marked goods, 358.

III. DAMAGES, 359; where the plaintiff is not solely entitled, 360.

IV. ACCOUNT OF PROFITS, 360; refused or limited because of delay, &c., 362; form of order, 362; costs of inquiry or account, 363.

Costs, 364; infringer must offer complete redress, 364; stay of action, 366; not given in trivial cases, 366; where the plaintiff claims too much, 366; successful defendant may be refused costs, 367; costs on appeal, 368; higher scale, 369; certificate under sect. 77a, solicitor and client costs, 370; costs of motion to rectify, 370.

Appeal, 371.

Practice, 372; pleadings, 372; particulars, 373; discovery, 374; inspection, 375; evidence, 376.

Chapter XVI.

PAGES

THE ACTION FOR "PASSING-OFF"..... 379—430

Foundation of the action, 380. Comparison with the action for infringement, 380. It often succeeds where that action fails, 382. Common law trade-marks, 383. Now case of passing off or of fraud raised at the trial, 383. Proof of fraud not essential, 384. Property in trade-name, &c., 384. Inferiority of the spurious goods not essential, 385. Rules and practice of infringement action generally apply, 385.

Direct misrepresentation as to business or goods, 386; false pretence of business connection or of succession, 387; "late," 387; circulars, names over shops, executing orders intended for the plaintiff, 388; unauthorized use of name of a non-trader, 389.

Imitations of trade-name, get-up, &c., 389; evidence of repute, 390; assignment and devolution of trade-name, &c., 391.

A. The plaintiff's trade-name, 392; it may belong to others beside the plaintiff, 394; need not be the plaintiff's family name, 394; trade-name of a company, 395; sect. 20 of the Companies Act is supplementary to the common law, 395; *Hendriks* v. *Montagu*, 396; no monopoly in names merely descriptive, 397; cases of company trade-names collected, 398; *Tussaud* v. *Tussaud*, 399; right to use a name cannot be sold, 401; names of houses of business, 401.

B. The trade-name of the plaintiff's goods, 402; summary of principles, 403; names which are not distinctive, and descriptive names, 403; name of introducer or patentee, 405; common names, 406: mere use of descriptive word constitutes no cause of action, 406; disclaimed word, 407; expunged trade-mark, 407; use of common word by defendant may be an element in a "get-up" case, 408; honest description of defendant's goods constitutes no cause of action, 408; name of author, &c., name of book, 410.

C. Imitation of "get-up," 411; get-up common to the trade, 411; no monopoly in the constituent elements, 412; imitation of part of get-up, 412.

Use in connection with the defendant's goods, 413.

Probability of deception, 414; where deception is intended, 414; badges of fraud: unexplained similarities, colourable differences, gradual approximations, 414; proof of actual deception, 415.

Proof of damage, 415; probability or proof of damage is essential, 415.

Defences, 416; the usual defences summarised, 416; concurrent right, 417; partners after dissolution, 417; purchaser of goodwill, 417.

Right to trade under one's own name, 420; *Turton* v. *Turton*, 421; anyone may describe his firm in the ordinary mercantile way, 423; not necessarily by any fancy name, 423; *Burgess* v. *Burgess* and *Massam* v. *Thorley*, 423; the name must be the defendant's own, 425; not a bought name, or one altered to resemble the plaintiff's, 425; may be the defendant's name of repute, 425; must be used *simpliciter*, not garnished, 426; proximity as a badge of fraud, 427.

The relief granted, 427; injunction, 428; form of injunction in *Massam* v. *Thorley*, 428; only deceptive use of common word, &c. restrained, 429.

Costs, appeals, practice, &c. (reference to Chap. XV.), 430.

Chapter XVII.

PAGES

WARRANTY OF TRADE-MARKS AND TRADE DESCRIPTIONS .....431—437

Under the Merchandise Marks Act, 1887..431. Implied at common law, 432. Where goods are described by reference to a trade-mark, 433. Pictures ascribed to particular artists, 433. Remedies for breach of warranty, 434. Indemnity to manufacturer employed to apply an infringing mark, 437.

Chapter XVIII.

TRADE-LIBEL AND TRADE-NAME .....438—447

No action for threats lies in respect of a trade-mark, 438; but a threat may be libel, or slander of title, 439. A warning against infringements may be issued in good faith, 439; suggestion that goods are spurious, 440; evidence of damage, 441; the threat or warning must be *bond fide*, 442. Misleading report of a trade-mark action, 442. True statements are not libellous, 443. Publication of an apology, 443. Statements, pending proceedings, may be contempt of Court, 443; although published in reply, 444; undertaking as to damages, 445; contempts by editors of newspapers, 445. Injunctions to restrain trade-libels, 446; interlocutory injunctions, 446. The right of action survives to executors, 447.

Chapter XIX.

TRADE-SECRET AND TRADE-NAME .....448—453

Use of the trade-name of a secret preparation, 448. The use of the name or secret may be a breach of contract or of confidence, 449. Summary of the leading cases of trade-secret, 450: *Prince Albert* v. *Strange*; *Morison* v. *Moat*, 450; other examples, 451. The jurisdiction rests on implied contract, 452; *Reuter's Telegram Co.* v. *Byron*, 452. No injunction where no threat to use the information, 453.

Chapter XX.

REGISTRATION OF FOREIGN AND COLONIAL TRADE-MARKS.....454—459

Book II.

The Criminal Law of False Marking.

Chapter I.

PAGES

THE MERCHANDISE MARKS ACT, 1887 (50 & 51 Vict. c. 28) .....460—539

Section 2.—Offences against the Act, 462. Offences by a corporation or partnership, 463.

Forging trade-marks, 465; trade-mark. 465; what constitutes forgery of a trade-mark, 468; assent of the proprietor, 470; mark nearly resembling a trade-mark, 471; falsifying a genuine trade-mark, 472.

Falsely applying a trade-mark to goods, 472; what constitutes an application to goods, 474; what is a false application, 474.

Applying a false trade description to goods, 475; the Act does not extend to false descriptions of quality, 475.

Trade description, 476; not a verbal description, 476; words forming part of the goods, 478; a trade-mark may be a trade description, 479; number, measure, weight, 479; place or country of origin, 480; material, "patent," 483; custom of the trade, 485; Customs entry, 486.

What is a false trade description, 487; false in a material respect, 488; alteration of trade description, 491; application of false trade description, 491; false names and initials, 493; blind names, 497; conventional or generic description, 498.

Causing an offence to be committed, 500; master and servant, 500; persons employed, 502; accessories, 504; offences committed abroad, 504.

Defences under section 2 (1), 505; proof of innocence, 505; intent to defraud, 507; giving information as to principal offender, 509; evidence of defendant, 509.

Sale or possession of falsely-marked goods, 510.

Defences under section 2 (2), 511; giving information as to principal offender, 512.

Punishment, 513; forfeiture and destruction of the goods, 514, 522.

Prosecution, 514; official prosecutions, 515; right to be tried by indictment, 516; limitation of time, 517; Vexatious Indictment Act applies, 517; costs, 518; appeal, 519.

Saving of other proceedings, 520.

Search warrant, 520.

Marks on watch cases, 522.

Prohibitions on Importation, 526; The International Conventions, 529; only marked goods are affected, 530.

Goods forfeitable under section 2..531; goods bearing English words or names, 532.

Goods of foreign manufacture bearing British or Irish

PAGES

TRADE-MARKS OR NAMES, 532; Customs register of names and marks, 534; "made in Germany," 534; goods in transit, 535; goods bearing the name of a place in the United Kingdom, 535; Customs regulations, 536; proceedings against Customs officers, 538.

CHAPTER II.

MISCELLANEOUS MATTERS..... 540—545

APPENDIX ..... 546—714

PART I.

1. The Patents, Designs, and Trade-Marks Act, 1883, as amended by the Act of 1888, so far as it relates to trade-marks, 547.
2. The Patents, Designs and Trade-Marks Act, 1888..579.
3. The Trade-Marks Registration Acts, 1875—1877 (now repealed), 587.
4. The Rules of 1890..595. Table of fees, 606. Schedule of forms, 607. Classes of goods, 618.
5. Instructions to persons who wish to register trade-marks, 624.
6. Precedents of forms on an opposed application to register a trade-mark and on appeal, 635.
7. Notice of motion to rectify the register, 642.
8. Precedents of pleadings in actions for infringement and passing off, 643.
9. Forms of orders in trade-mark cases and cases analogous thereto, 348
10. Foreign states and British possessions to which sect. 103 of the Act of 1883 is applied, 656.
11. The International Convention, 658.

PART II.

12. The Merchandise Marks Act, 1887..666.
13. The Merchandise Marks Act, 1891..677.
14. General Orders under the Merchandise Marks Act, 678. Order in Council as to marks on watch-cases, 695.
15. Errors in trade descriptions of measure allowed under the Indian M. M. A., 705.
16. Regulations under the Act of 1891 as to prosecutions by the Board of Trade, 707.
17. Forms of indictment and informations, 708.
18. Statutes requiring particular classes of goods to be marked in a specified manner, 710.

INDEX..... 715

TABLE OF CASES

AND REFERENCES TO CONTEMPORARY REPORTS.

**** *Words and names of marks occurring in many of the decided cases will be found inserted in the Index, with cross-references to the Table of Cases.*

PAGE

ABBOTT *v.* The Bakers', &c. Association, Ld., W. N. (1872) 31 - 192
Abernethy *v.* Hutchinson, 3 L. J. Ch. O. S. 214 - - - 451
Accident, Disease, and General Insurance Co. Ld.; Accident Insurance Co., Ld. *v.*
Accident Insurance Co., Ld. *v.* The Accident, Disease, and General Insurance Co., Ld., W. N. (1884) 191; 54 L. J. Ch. 104; 51 L. T. 597 - - - - - - 398
Adams' Tm., 9 R. P. C. 174; 66 L. T. 610 - - 248, 249, 342
Ainslie & Co.'s Tm., 4 R. P. C. 212 - - - 151, 226
Ainsworth *v.* Walmsley, L. R. 1 Eq. 518; 35 L. J. Ch. 352; 14 L. T. (N. S.) 220; 14 W. R. 363; 12 Jur. (N. S.) 205 - - 368, 386, 393, 403
Albert (Prince) *v.* Strange, 1 Mac. & G. 25; 2 De G. & Sm. 652; 18 L. J. Ch. 120; 12 L. T. 367, 441; 13 L. T. 341; 13 Jur. 45, 109, 507 - - - - - - 450
Aleploglu; Gout *v.*
Alpine Tm., 29 C. D. 627; 54 L. J. Ch. 727; 53 L. T. 79; 33 W. R. 725 - - - 85, 142, 143, 149, 150, 152
American Leather Cloth Co.; Leather Cloth Co. *v.*
American Tobacco Co. *v.* Guest, (1892) 1 Ch. 630; 9 R. P. C. 218; 61 L. J. Ch. 242; 66 L. T. 257; 40 W. R. 364 - 318, 359, 366, 519
Anchor Tube Co.; Selby *v.*
Anderson's Case, 17 C. D. 373 - - - - - 243
Anderson's Tm., 54 L. J. Ch. 1084; affirming 26 C. D. 409; 53 L. J. Ch. 664; 32 W. R. 677 - - 76, 123, 129, 217
Anderson *v.* Liebig's Extract of Meat Co., 45 L. T. 757 - 440, 442
Andrews *v.* Barnes, 39 C. D. 133 - - - - 243
Anglesea Colliery Co., *Re*, L. R. 1 Ch. 555 - - - 531
Anglo-Swiss, &c. Co. *v.* Metcalf, 31 C. D. 454; 3 R. P. C. 28; 55 L. J. Ch. 463; 34 W. R. 345 - 187, 200, 201, 207, 235, 327
Anglo-Swiss Condensed Milk Co. *v.* The Swiss Condensed Milk Co., W. N. (1871) 163 - - - - 335, 351, 362
Apollinaris Co.'s Tm., (1891) 2 Ch. 186; 8 R. P. C. 137; 61 L. J. Ch. 625; 65 L. T. 6 - 8, 60, 61, 81, 110, 111, 112, 124, 138, 148, 151, 152, 172, 206, 214, 215, 221, 229, 230, 255, 263, 302, 303, 304, 343, 344, 346
Apollinaris Co.; Fisher *v.*

PAGE

Apollinaris Co. *v.* Herrfeldt, 4 R. P. C. 478; 4 Times L. R. 9 - 208, 260, 304, 321, 353, 354, 414, 467
Apollinaris Co. *v.* Snook, 7 R. P. C. 474 - - - 304, 355
Arbenz' Tm., 35 C. D. 248; 4 R. P. C. 143; 56 L. J. Ch. 524; 56 L. T. 252; 35 W. R. 527; 3 Times L. R. 460 - 81, 84, 142, 145, 201, 202, 229, 245
Archbold *v.* Sweet, 1 M. & R. 162; 5 C. & P. 219 - - 410
Argentino, L. R. 13 P. D. 191; 57 L. J. P. D. & A. 25 - - 437
Armstead; Betts *v.*
Army and Navy Co-operative Society, Ld. *v.* The Junior Army and Navy Stores, Ld., Seb. Dig. p. 393 - - - 399
Arnaud; Barry *v.*
Atkins' Tm., 3 R. P. C. 164; 1 Times L. R. 657; 2 Times L. R. 543 - - - - - - 138, 139
Atkins; Schweitzer *v.*
Attorney-General *v.* The North Metropolitan Tramways Co., (1892) 3 Ch. 70 - - - - - - 374
Attorney-General for New South Wales; Macleod *v.*
Australian Mortgage, Land, and Finance Co. *v.* The Australian and New Zealand Mortgage Co., W. N. (1880) 6 - 398, 399
Australian and New Zealand Mortgage Co.; Australian Mortgage, Land, and Finance Co. *v.*
Australian Wine Co., *Re*, 61 L. T. 427, n. - - 62, 237
Australian Wine Importers' Tm., 41 C. D. 278; 6 R. P. C. 311; 58 L. J. Ch. 380; 60 L. T. 436; 37 W. R. 578 - 31, 64, 67, 83, 180, 182, 183, 208, 308, 403
Avril, *Re*, Sebastian, 3rd ed. 404 - - - 237, 282

Badman; Pinto *v.*
Baird; Walker *v.*
Baker; Lawrie *v.*
Baker *v.* Rawson, 45 C. D. 519; 8 R. P. C. 89; 60 L. J. Ch. 49; 63 L. T. 306 - - 129, 193, 207, 208, 220, 222, 223, 230, 233, 259, 260, 367
Bakers', &c. Association, Ld.; Abbott *v.*
Balfour; Green *v.*
Balfour; Hooper *v.*
Balmer; Lamplough *v.*
Bancroft & Co.'s Tm., 5 R. P. C. 209 - - 82, 180, 241, 280
Bank of London; Lawson *v.*
Banks *v.* Gibson, 34 Beav. 566; 34 L. J. Ch. 591; 11 Jur. (N. S.) 680; 13 W. R. 1012; 6 N. R. 373 - - - 329, 417
Barber *v.* Manico, 10 R. P. C. 93 - 185, 314, 328, 351, 382, 383, 425
Barber; Willmott *v.*
Barham; Power *v.*
Barker's Tm., 53 L. T. 23 - - - - - - 190
Barlow; Broadhurst *v.*
Barlow *v.* Johnson, 7 R. P. C. 395; W. N. (1890) 110 146, 147, 221, 255, 265, 322, 455
Barnard *v.* Pillow, W. N. (1868) 94 - - - - 410
Barnes; Andrews *v.*
Barnett *v.* Leuchars, 13 L. T. (N. S.) 495; 14 W. R. 166 - - 310
Barrow's Tm., 5 C. D. 353; 46 L. J. Ch. 450, 725; 36 L. T. N. S. 291, 780; 25 W. R. 407, 564 - - 36, 90, 154, 156

PAGE

Barrows; Hall *v.*
Barry *v.* Arnaud, 10 Ad. & Ell. 670 - - - - 539
Barwick *v.* English Joint Stock Bank, L. R. 2 Ex. 259; 36 L. J. Ex. 147 - - - - - - 464
Baschiera's Tm., 33 S. J. 469; 5 T. L. R. 480 - -191, 200
Bass *v.* Dawber, 19 L. T. (N. S.) 626 - - - - 356
Bassett; MacAndrew *v.*
Batt's Tm., 6 R. P. C. 493 - - - - 148, 223
Batty *v.* Hill, 1 H. & M. 264; 8 L. T. (N. S.) 791; 11 W. R. 745; 2 N. R. 265 - - - - - - 416
Beachim; Braham *v.*
Beard *v.* Turner, 13 L. T. (N. S.) 746 - - 321, 325, 362
Beazley *v.* Soares, 22 C. D. 660; 52 L. J. Ch. 201; 31 W. R. 887 - - - - - - 303, 309, 390
Beddow and Sons *v.* Boyd, 4 R. P. C. 310 - - -208, 315
Bedford; Bury *v.*
Beeton; Bradbury *v.*
Beeton; Ward *v.*
Behn *v.* Burness, 3 B. & S. 756; 32 L. J. Q. B. 204 - - 436
Benbow *v.* Low, 16 C. D. 93; 50 L. J. Ch. 35; 44 L. T. 119; 29 W. R. 265 - - - - - -374, 375
Benbow *v.* Low, 44 L. T. 875; 29 W. R. 837 - 177, 329, 419, 448
Bennett; Hudson *v.*
Bennis; Proctor *v.*
Benson; Hall *v.*
Bentham Hemp Spinning Co.; Reddaway & Co. *v.*
Bent's Brewery Co., Ltd.; Thompson *v.*
Betts *v.* Armstead, 20 Q. B. D. 771 - - - - 507
Betts; De Vitro *v.*
Betts; Neilson *v.*
Biegel's Tm., 4 R. P. C. 525; 57 L. T. 247 - 163, 195, 207, 234
Bingham; Licensed Victuallers' Newspaper Co. *v.*
Binning; Day *v.*
Birmingham Dairy Co.; Parsons *v.*
Birmingham Vinegar Co.'s Tm., 11 R. P. C. 195 - - 137
Birmingham Vinegar Brewery Co.; Champion & Co. *v.*
Birmingham Vinegar Brewery Co. *v.* Liverpool Vinegar Co., W. N. (1888) 139; 4 Times L. R. 613 - 394, 401, 425
Blackwell *v.* Crabb, 36 L. J. Ch. 504 - - - - 321
Blair *v.* Stock, 52 L. T. 123 - - - 202, 234, 364
Blake; Jacobsohn *v.*
Blanchard *v.* Hill, 2 Atk. 484 (1742) - - - - 2
Blay; Street *v.*
Blofeld *v.* Payne, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 - 4, 34. 306, 359, 385, 412
Blyth and Young, *Re*, 13 C. D. 416 - - - - 245
Bodega Co. *v.* Owens, 7 R. P. C. 31; 6 R. P. C. 236; 23 L. R. Ir. 371 - - - - 36, 154, 156, 317, 401, 415
Bodega Co., Ltd. *v.* Riviere, 6 R. P. C. 243 - - - 350
Boehm; Mouson *v.*
Bolton; Kinahan *v.*
Bonnard *v.* Perryman, (1891) 2 Ch. 269 - - -389, 446
Borthwick *v.* "The Evening Post," 37 C. D. 449; 57 L. J. Ch. 406; 58 L. T. 252; 36 W. R. 434 -315, 369, 381, 384, 403, 410, 415
Boughtwood; Pain *v.*

PAGE
Boulnois *v.* Peake, 13 C. D. 512, n. - - - 401, 414
Bowker; Carver *v.*
Boyd; Beddow and Sons *v.*
Boyd; Punch *v.*
Braby & Co.'s Applications, 21 C. D. 222; 51 L. J. Ch. 637; 46 L. T. 380; 30 W. R. 675 - - - 89, 90, 181
Brackell; Schiele *v.*
Bradbury *v.* Beeton, 39 L. J. Ch. 57; 21 L. T. (N. S.) 323; 18 W. R. 33 - - - - - - - 315
Bradbury *v.* Dickens, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. (O. S.) 54 - - - - - - - 410
Bradley's Tm., 9 R. P. C. 205 - - 113, 117, 137, 138, 371
Braham *v.* Beachim, 7 C. D. 848; 47 L. J. Ch. 348; 38 L. T. (N. S.) 640; 26 W. R. 654 - - 351, 401, 408, 430
Braham *v.* Bustard, 1 H. & M. 447; 9 L. T. (N. S.) 199; 11 W. R. 1061; 2 N. R. 572 - - - 48, 290, 320
Brain; Purser *v.*
Bramble, Wilkins & Co.; Marcovitch *v.*
Brandreth's Tm., 9 C. D. 618; 47 L. J. Ch. 816; 27 W. R. 281 - - - - - - - - 86
British Linen Co. Bank; Mansell *v.*
British Mutual Banking Co., Ltd. *v.* Charnwood Forest Rail. Co., 18 Q. B. D. 714; 56 L. J. Q. B. 449 - - - 464
British Tea, &c. Association; Hanson *v.*
Broad; Woolley *v.*
Broadhurst *v.* Barlow, W. N. (1872) 212; L. R. 17 Eq. 38 - 48
Brook *v.* Evans, 29 L. J. Ch. 616; 2 L. T. (N. S.) 740; 3 L. T. 571; 6 Jur. 1025 - - - - - - 445
Brooks; Dicks *v.*
Brotherhood; Halsey *v.*
Brown; Collings Co. *v.*
Brown *v.* Foot, 61 L. J. M. C. 110; 66 L. T. 649; 56 J. P. 581 - 500
Brown; Wheat *v.*
Browne *v.* Freeman (1), 12 W. R. 305 (1864); 4 New Rep. 476 - 44, 289, 368, 404
Browne *v.* Freeman (2), W. N. (1873) 178 - - 44, 289, 404
Brownrigg; Day *v.*
Broxburn Oil Co.; Burland *v.*
Bryant & May's Tm., 8 R. P. C. 69; 59 L. J. Ch. 763; 63 L. T. 676; 4 T. L. R. 675 - - 114, 123, 137, 249, 281, 325
Budd *v.* Lucas, (1891) 1 Q. B. 408; 60 L. J. M. C. 95; 64 L. T. 292; 17 Cox, 248 - - -464, 474, 480, 489, 500, 508, 510
Bumsted *v.* The General Reversionary Co., Ld., 4 Times L. R. 621 - - - - - - - - 399
Burgess *v.* Burgess, 3 De G. M. & G. 896; 22 L. J. Ch. 675; 21 L. T. (O. S.) 53; 17 Jur. 292 - 17, 44, 371, 387, 388, 400, 413, 420, 423, 426, 508
Burgess *v.* Hateley, 26 Beav. 249 - - - - 300
Burgess *v.* Hills, 28 Beav. 244; 28 L. J. Ch. 356; 5 Jur. (N. S.) 233; 32 L. T. (O. S.) 328; 7 W. R. 158 - - - - 365
Burgess; Wood *v.*
Burgoyne's Tm., 6 R. P. C. 227; 61 L. T. 39; 5 Times L. R. 326 - - - - - 112, 145, 147, 150, 151, 209
Burham Brick, &c. Co.'s Tm., 9 R. P. C. 422 - - 248, 250
Burke's Tm., W. N. (1891) 2 - - - 249, 250

PAGE

Burland *v.* Broxburn Oil Co., 42 C. D. 274; 6 R. P. C. 482; 58 L. J. Ch. 816; 61 L. T. 618; 38 W. R. 89 - 119, 123, 124, 151, 171, 172, 173, 178, 234, 300, 407
Burness; Behn *v.*
Burrows *v.* Foster, 32 Beav. 18; 1 N. R. 156 - - - 388
Bury *v.* Bedford, 4 De G. J. & S. 352; 32 L. J. Ch. 741; 33 L. J. Ch. 465; 10 L. T. (N. S.) 470; 8 L. T. (N. S.) 847; 10 Jur. (N. S.) 503; 9 Jur. (N. S.) 956; 12 W. R. 727; 11 W. R. 973; 4 N. R. 180; 1 N. R. 5 - - 93, 274, 277, 278
Bussey; Hammond *v.*
Bustard; Braham *v.*
Butcher; Richards *v.*
Butler: Wood *v.*
Byles; Kelly *v.*
Byron (Lord) *v.* Johnson, 2 Mer. 29 - - - - 410
Byron; Reuter's Telegram Co. *v.*

Caird *v.* Sime, 12 App. Cas. 326; 57 L. J. P. C. 2 - - 451
Californian Fig Syrup Tm., 40 C. D. 620; 6 R. P. C. 126; 58 L. J. Ch. 341; 60 L. T. 590; 37 W. R. 268 - 22, 457, 458, 459, 529
Callow *v.* Young, 56 L. T. 147 - - - - - 355
Campbell; Charleston *v.*
Canham *v.* Jones, 2 V. & B. 218 - - - - 448, 450
Capital & Counties Bank; London & County Banking Co. *v.*
Carle *v.* Elkington, 40 W. R. 510 - - - - 516
Carlile; Cartier *v.*
Carrington; Entick *v.*
Carter Medicine Co.'s Tms., (1892) 3 Ch. 472; 9 R. P. C. 401; 61 L. J. Ch. 716; 67 L. T. 747; 41 W. R. 13; 8 Times L. R. 639 - - - - - - 457, 458, 459, 529
Cartier *v.* Carlile, 31 Beav. 292; 8 Jur. (N. S.) 183 - - 362
Cartier *v.* May, Seb. Dig. p. 111 - - - - - 357
Carver *v.* Bowker, Seb. Dig. p. 581 - - 136, 185, 351
Carver *v.* Pinto Leite, L. R. 7 Ch. 90; 41 L. J. Ch. 92; 25 L. T. 722; 20 W. R. 134 - - - - - 374
Cave *v.* Myers (1868), Seb. Dig. p. 181 - - - - 362
Chadwick; Coats *v.*
Challender *v.* Royle, 36 C. D. 425; 4 R. P. C. 363 - - 438
Chambers; Martin Hunt *v.*
Champion & Co. *v.* The Birmingham Vinegar Brewery Co., 10 Times L. R. 163 - - - - - - - 447
Chandler; Cocks *v.*
Chappell *v.* Davidson, 2 K. & J. 123; 8 De G. M. & G. 1 - 337
Chappell; Franke *v.*
Chappell *v.* Griffiths, 53 L. T. (N. S.) 459 - - - 417, 418
Chappell *v.* Sheard, 2 K. & J. 117; 1 Jur. (N. S.) 996; 3 W. R. 646 - - - - - - - - 337
Charbonnel; Robineau *v.*
Charleston *v.* Campbell, Sess. Cas. 4th Ser. IV. 149 - - 401
Charnwood Forest Rail. Co.; British Mutual Banking Co., Ltd. *v.*
Chatteris *v.* Isaacson, 57 L. T. (N. S.) 177 - - - 417
Cheavin *v.* Walker, 5 C. D. 850; 46 L. J. Ch. 686; 36 L. T. (N. S.) 938; reversing 46 L. J. Ch. 265; 33 L. T. (N. S.) 757 - 14, 48, 341, 342

PAGE

Child; Sands *v.*
Chilworth Gunpowder Co.; Starey *v.*
Chisholm *v.* Doulton, 22 Q. B. D. 736; 58 L. J. M. C. 133 - 464, 500
Chisholm; Paine *v.*
Chorlton and Dugdale's Tm., 53 L. T. 337; 34 W. R. 60; 1 Times L. R. 643 - - - - - 158, 161
Christiansen's Tm., 3 R. P. C. 54; 2 Times L. R. 317 - 139, 186, 191, 193, 194, 195, 206, 314
Chubb *v.* Griffiths, 35 Beav. 127 - - - - 366
Churton *v.* Douglas, Johns. 174; 28 L. J. Ch. 841; 33 L. T. (O. S.) 57; 5 Jur. (N. S.) 887; 7 W. R. 365 - 387, 418, 419, 426
City of Glasgow Bank; Houldsworth *v.*
Civil Service Supply Association *v.* Dean, 13 C. D. 512 - 315, 415
Clark; Ellington *v.*
Clark; Fennessy *v.*
Clark *v.* Freeman, 11 Beav. 112; 17 L. J. Ch. 142; 12 Jur. 149; 11 L. T. (O. S.) 22 - - 389, 390, 394, 416
Clark *v.* Leach, 32 Beav. 14; 1 De G. J. & S. 409; 32 L. J. Ch. 290 - - - - - - - 387
Clarke; Tipping *v.*
Clay and Bock & Co.'s Tm., (1892) 3 Ch. 549; 9 R. P. C. 449; 62 L. J. Ch. 143; 67 L. T. 614 - - 171, 215, 248, 249, 281
Clayton *v.* Day, 26 Sol. J. 43 - - - - - 424
Clement *v.* Maddick, 1 Giff. 98; 33 L. T. (O. S.) 117; 5 Jur. (N. S.) 592 - - - - - - - 384
Clements, *Re*, 46 L. J. Ch. p. 383 - - - - 445
Clements; Shipright *v.*
Clybouw; Moet *v.*
Coats *v.* Chadwick, (1894) 1 Ch. 347 - - - 440, 444
Cockburn *v.* Edwards, 18 C. D. 449 - - - - 243
Cocks *v.* Chandler, L. R. 11 Eq. 446; 40 L. J. Ch. 575; 24 L. T. (N. S.) 379; 19 W. R. 593 - - - - 44
Coleman *v.* West Hartlepool Rail. Co., 8 W. R. 734 - - 444
Collard *v.* Marshall, (1892) 1 Ch. 571 - - - 389, 446
Colley *v.* Hart, 44 C. D. 179; 6 R. P. C. 17 - - - 439
Colley; Hart *v.*
Collins Co. *v.* Brown, 3 K. & J. 423; 3 Jur. (N. S.) 929; 5 W. R. 676; 30 L. T. (O. S.) 62 - - - - - 300
Collins Co. (The) *v.* Reeves, 28 L. J. Ch. 56; 6 W. R. 717; 4 Jur. (N. S.) 865; 33 L. T. (O. S.) 101 - - 21, 300, 454
Collyer; Sayers *v.*
Colman's Tm., W. N. (1894) 30; 11 R. P. C. 129 - 85, 115, 168
Colman's Tm., (1891) 2 Ch. 402; 8 R. P. C. 209; 60 L. J. Ch. 550; 64 L. T. 507; 39 W. R. 488; 7 Times L. R. 425 - 215, 249
Colonial Fire Assurance Co. *v.* The Home and Colonial Assurance Co., Ld., 33 Beav. 548; 33 L. J. Ch. 741; 10 L. T. (N. S.) 448; 12 W. R. 783; 10 Jur. (N. S.) 967 - 398, 399, 407
Commissioners of the Inland Revenue; Onslow *v.*
Compagnia Général de Tobacos *v.* Rehder, 5 R. P. C. 61 - 158, 206, 304, 324, 382
Compagnie Générale d'Eaux Minérales Tms., (1891) 3 Ch. 451; 8 R. P. C. 446; 60 L. J. Ch. 728; 40 W. R. 89 - - 240
Concorun; Witt *v.*
Condy *v.* Mitchell, 37 L. T. (N. S.) 268, 766; 26 W. R. 269 - 329, 410, 418, 448
Condy; Sanitas Co. *v.*

PAGE

Condy *v.* Taylor, 56 L. T. 891; 3 Times L. R. 565 - 309, 310, 350, 447, 470

Cooper; Hennessy *v.*
Cooper *v.* Whittingham, 15 C. D. 501; 49 L. J. Ch. 752 - 519
Cope *v.* Evans, 18 L. R. Eq. 138; 30 L. T. (N. S.) 292; 22 W. R. 453 - - - - 183, 206, 312, 315, 378
Core *v.* James, L. R. 7 Q. B. 135 - - - - - 500
Cotton *v.* Gillard, 44 L. J. Ch. 90 - - - 31, 277
Coulson (William) & Sons *v.* James Coulson & Sons, 3 Times L. R. 740, 876 - - - - - 440, 446
County Court Judge of Halifax; Queen *v.*
Courtenay; Mogford *v.*
Couston; Moet *v.*
Crabb; Blackwell *v.*
Crane *v.* Laurence, 25 Q. B. D. 152 - - - - 511
Croft *v.* Day, 7 Beav. 84; 28 Leg. Obs. 378; Seb. Dig. p. 39 - 356, 425, 426
Crown Bank, *Re*, 44 C. D. 649 - - - - - 446
Cruttwell *v.* Lye, 17 Ves. 335 - - - - 3, 418
Curling; Jones *v.*
Currie; Wotherspoon *v.*
Curtis and Harvey *v.* Pape, 5 R. P. C. 146 - 321, 366, 382

Dale; United Telephone Co. *v.*
Dallison; Wriggleworth *v.*
Dalton; Oakley *v.*
Daniells & Sons' Breweries; Paine & Co. *v.*
Davenport *v.* Rylands, L. R. 1 Eq. 302; 35 L. J. Ch. 204; 14 L. T. (N. S.) 53; 14 W. R. 243; 12 Jur. (N. S.) 71 - - 360
Davidson; Chappell *v.*
Davis; Malham *v.*
Davis & Co. *v.* Stribolt & Co., 6 R. P. C. 207; 59 L. T. 854; 5 Times L. R. 13 - - - - - 145, 146
Dawber; Bass *v.*
Dawson; Labouchere *v.*
Day *v.* Binning, C. P. Cooper, 489 - - - - - 323
Day *v.* Brownrigg, 10 C. D. 294; 48 L. J. Ch. 173; 39 L. T. (N. S.) 553; 37 W. R. 217 - - - - 402, 415
Day; Clayton *v.*
Day; Croft *v.*
Day *v.* Day, Eden on Injunctions, ed. 1821, p. 314; Seb. Dig. p. 10 - - - - - - - - 3
Day & Kossuth; Emperor of Austria *v.*
Day & Martin; Fennessy *v.*
De la Rue *v.* Dickinson, 3 K. & J. 388 - - - - 375
De Vitre *v.* Betts, L. R. 6 H. L. 319 - - - - 361
De Otaduy's Tm., W. N. (1885) p. 177 - - - - 54
Dean; Civil Service Supply Association *v.*
Del Valle *v.* Mayer, Seb. Dig. p. 195 - - - - 354
Delondre *v.* Shaw, 2 Sim. 237 - - - - 309, 415
Dence *v.* Mason, W. N. (1877) 23; W. N. (1878) 42 - 323, 394, 425
Denham; Hirst *v.*

PAGE

Dennis; Edwards *v.*
Dent *v.* Turpin, 2 John. & Hem. 139; 30 L. J. Ch. 495; 7 Jur. (N. S.) 673; 6 W. R. 548; 4 L. T. (N. S.) 637 - - 303, 357, 360, 394
Derby Photographic Dry Plate Co., Ltd. *v.* Pollard, 2 Times L. R. 276 - - - - - - - 353
Derry *v.* Peek, 14 App. Cas. 337 - - - - - 384
Devey; Earl of Lytton *v.*
Dewhurst, *Re*, Sebastian 3rd ed., p. 364 - - - 118
Dexter's Tm., (1893) 2 Ch. 262; 10 R. P. C. 269; 62 L. J. Ch. 545; 68 L. T. 793 - - - 203, 212, 338, 345, 347
Diaper; Orr *v.*
Dickens; Bradbury *v.*
Dickinson; De la Rue *v.*
Dicks *v.* Brooks, 15 C. D. 22; 49 L. J. Ch. 812; 43 L. T. 71; 29 W. R. 87 - - - - - - 439, 441
Dicks *v.* Jackson, Sebastian, 3rd ed., p. 255 - - - 363
Dicks; Weldon *v.*
Dicks *v.* Yates, 18 C. D. 76; 50 L. J. Ch. 809; 44 L. T. 660 - 410, 519
Dickson *v.* McMaster & Co., 18 Ir. Jur. 202 - - - 418
Dixon *v.* Fawcus, 3 E. & E. 537; 30 L. J. Q. B. 137; 3 L. T. (N. S.) 693; 9 W. R. 414; 7 Jur. N. S. 895 - - 359, 437
Douglas; Churton *v.*
Doulton; Chisholm *v.*
Dowman; Motley *v.*
Du Boulay *v.* Du Boulay, L. R. 2 P. C. 430; 17 W. R. 594; 38 L. J. P. C. 35; 6 Moo. P. C. (N. S.) 31; 22 L. T. (N. S.) 228 - - - - - - - 393, 415
Dugdale, *Re*, 49 L. J. Ch. 303; 28 W. R. 436 - - - 104
Duncan *v.* Sparling, Times Newspaper, 9th March, 1894 - 445
Dunn's Tm., see Eno *v.* Dunn.
Dunn; Eno *v.*

Easterbrook; Saxby *v.*
Ede & Co., *Ex parte*, 28 W. R. 436 - - - - 104
Edelsten *v.* Edelsten, 1 De G. J. & S. 185; 10 L. T. (N. S.) 780; 7 L. T. (N. S.) 768; 9 Jur. (N. S.) 479; 12 W. R. 1026; 11 W. R. 328 - 4, 5, 29, 34, 206, 306, 316, 350, 361, 363, 364, 385
Edelsten *v.* Vick, 11 Hare, 78; 18 Jur. 7; 1 Eq. Rep. 413 - 340, 342, 541
Edge's Tm., 8 R. P. C. 207 - - 138, 144, 153, 173, 234
Edge *v.* Johnson, 9 R. P. C. 134 - - - - 371
Edgington's Tm. (Edgington *v.* Edgington) 6 R. P. C. 513; 61 L. T. 323 - - - - 158, 162, 230, 233, 370
Edgington *v.* Edgington, 10 L. T. (N. S.) 299 - - - 388
Edwards; Cockburn *v.*
Edwards *v.* Dennis, 30 C. D. 454; 55 L. J. Ch. 125; 54 L. T. 112; 2 Times L. R. 112 - 8, 88, 89, 110, 235, 254, 257, 259, 265, 269, 277, 284, 297, 304, 308, 312, 315, 324
Edwards *v.* Elkan, 5 R. P. C. 70 - - 324, 325, 355
Elkington; Carlo *v.*
Ellen *v.* Slack, 24 Sol. J. 290 - - - - - 362
Ellinger & Co.; Twentsche Stoom Bleekery Goor *v.*
Ellington *v.* Clark, 58 L. T. 818 - - - - 369

PAGE

Elliot; Free Fishers of Whitstable *v.*
Emmott; Walker *v.*
Emperor of Austria *v.* Day and Kossuth, 3 De G. F. & J. 217; 30 L. J. Ch. 690; 2 Giff. 628; 4 L. T. (N. S.) 274, 494; 9 W. R. 568, 712 - - - - - - - 349
English Joint Stock Bank; Barwick *v.*
Eno *v.* Dunn, 15 App. Cas. 252; 7 R. P. C. 311; 41 C. D. 439; 58 L. J. Ch. 604; 63 L. T. 6; 39 W. R. 161 - 11, 65, 66, 81, 84, 112, 184, 188, 209, 210, 213, 226, 308, 320, 339
Eno *v.* Dunn, 10 R. P. C. 261 - - - - 320, 339
Eno *v.* Stephens, Seb. Dig. 372 - - - - - 320
Entick *v.* Carrington, 19 State Trials, 1043 - - - 539
Ermen and Roby's Tm., 4 R. P. C. 70; 56 L. J. Ch. 177; 56 L. T. 230 - - - - - - - 250
Estcourt *v.* The Estcourt Hop Essence Co., L. R. 10 Ch. 276; 44 L. J. Ch. 223; 32 L. T. (N. S.) 80; 31 L. T. (N. S.) 567; 23 W. R. 313 - - - - 206, 333, 368
Evans; Brook *v.*
Evans; Cope *v.*
Evans; Lamb *v.*
Evans; Rose *v.*
Evans *v.* Norton, (1893) 1 Ch. 252 - - - - 355
Evans *v.* Smith, 3 Times L. R. 390 - - - - 352
"Evening Post"; Borthwick *v.*

Fane *v.* Fane, 13 C. D. 228 - - - - - 518
Farbenfabriken Vormals Fried Bayer & Co.'s Tm., 11 R. P. C. 84; (1894) 1 Ch. 645 - - - 67, 85, 86, 152
Farina, *Re*, 27 W. R. 456 - - - - -291, 332
Farina's Tm., 44 L. T. 99, n.; 29 W. R. 391 - - 62, 236
Farina *v.* Silverlock, 1 K. & J. 509; 6 De G. M. & G. 214; 24 L. J. Ch. 632; 26 L. J. Ch. 11; 27 L. T. (O. S.) 277; 30 L. T. (O. S.) 342; 31 L. T. (O. S.) 99; 2 Jur. (N. S.) 1008; 3 W. R. 532; 4 W. R. 731; 4 K. & J. 650 - 32, 35, 118, 309, 310, 357, 447, 469, 470
Farquharson; Plating Co. *v.*
Farrow's Tm., W. N. (1890) 113; 7 R. P. C. 260; 63 L. T. 233; 6 Times L. R. 319 - - - 83, 193, 205, 208
Fawcus; Dixon *v.*
Feltham; Slazenger *v.*
Fenner *v.* Wilson, (1893) 2 Ch. 656 - - - - 445
Fennessy *v.* Clark, 37 C. D. 184; 57 L. J. 398; 58 L. T. 289 - 298, 375
Fennessy *v.* Day and Martin, 55 L. T. 161 - - - 365
Fennessy *v.* Rabbits, 56 L. T. 138 - - - - - 298
Field *v.* Lewis, Seb. Dig. 167 - - - - - 364
Field; Schauer *v.*
Findlater; Raggett *v.*
Findlater; Siegert *v.*
Findlay; Robinson *v.*
Fisher *v.* Apollinaris Co., L. R. 10 Ch. 297; 44 L. J. Ch. 500; 23 W. R. 460; 32 L. T. (N. S.) 628 - - 6, 443, 515
Flavel *v.* Harrison, 10 Hare, 467; 22 L. J. Ch. 866; 1 W. R. 213; 17 Jur. 368 - - - - - 340, 342

PAGE

Foot; Brown *v.*
Foot *v.* Lea, Ir. 13 Eq. Rep. 464 - - - - 323, 388
Footman; Symington *v.*
Ford *v.* Foster, L. R. 7 Ch. 611; 41 L. J. Ch. 662; 27 L. T. (N. S.) 219; 20 W. R. 818 - 4, 27, 37, 122, 187, 284, 285, 286, 287, 291, 312, 314, 320, 334, 336, 347, 348, 361, 362, 404, 500
Forester; Upmann *v.*
Foster; Burrows *v.*
Foster; Ford *v.*
Foster *v.* Great Western Rail. Co., 8 Q. B. D. 515 - - 519
Foster; Savage *v.*
Fox; Millington *v.*
Franke *v.* Chappell, 57 L. T. (N. S.) 141 - - - - 395
Franks; Pierce *v.*
Franks *v.* Weaver, 10 Beav. 297; 8 L. T. (O. S.) 510 - - 412
Free Fishers of Whitstable *v.* Elliot, W. N. (1868) 27; 4 Times L. R. 273 - - - - - - - 409
Freeman; Brown *v.*
Freeman; Clarke *v.*
Freeman; Hargreaves *v.*
Friedlander's Tm., W. N. (1885) 85 - - - - 151
Fuente's Tm., (1891) 2 Ch. 166; 8 R. P. C. 214; 60 L. J. Ch. 308; 64 L. T. 196; 39 W. R. 489; 7 Times L. R. 289 - - 86, 160, 217, 347
Fullwood *v.* Fullwood, 9 C. D. 178; 47 L. J. Ch. 459; 38 L. T. (N. S.) 380; 26 W. R. 435 - - - - - 334
Fullwood *v.* Fullwood, W. N. (1873) 93, 185 - - 387, 426

Game, Harrison, and Larner, Ld.; Hanson *v.*
General Reversionary Co., Ld.; Bamstead *v.*
Giannelis' Tm., 6 R. P. C. 467; 58 L. J. Ch. 782 - 116, 223, 244, 374

Gibson; Banks *v.*
Gillard; Cotton *v.*
Glenny *v.* Smith, 2 Dr. & Sm. 476; 11 Jur. (N. S.) 964; 13 W. R. 1032; 13 L. T. (N. S.) 11; 6 N. R. 363 - - 323
Glover; Leahy, Kelly, and Leahy *v.*
Goodall's Tm., 42 C. D. 566; 38 W. R. 189 - - 167, 203
Goodall; Pirie *v.*
Goodbody; Lewis *v.*
Goodfellow *v.* Prince, 35 C. D. 9; 56 L. J. Ch. 545; 56 L. T. 617; 35 W. R. 488; 3 Times L. R. 385 - 62, 264, 266, 270, 300, 302, 390, 415, 454

Goodwin; Lever *v.*
Goodwin *v.* Venning, 24 Sol. J. 690 - - - - 327
Goulard *v.* Lindsay, 4 R. P. C. 189 - - - - 444
Gout *v.* Aieploglu, 6 Beav. 69, n. - - - - - 129
Governor and Company of the Bank of England *v.* Vagliano Brothers, (1891) A. C. 107; 60 L. J. Q. B. 145; 64 L. T. 353 - - - - - - - - 498
Graham; Ransome *v.*
Gravoley *v.* Winchester, Seb. Dig. 162 - - - 388, 426
Gray *v.* Smith, 43 C. D. 208; 59 L. J. Ch. 145; 62 L. T. 335; 38 W. R. 319 - - - - - - 418

PAGE

Great North of England Rail. Co.; Queen *v.*
Great Tower Street Tea Co. *v.* Langford, 5 R. P. C. 66 -267, 383, 412, 413
Great Tower Street Tea Co. *v.* Smith, 6 R. P. C. 165; 5 Times L. R. 232 - 110, 123, 136, 139, 150, 151, 229, 267, 369, 407
Great Western Rail. Co.; Foster *v.*
Green and Balfour, *Re*, 63 L. T. 97, 325; W. N. (1890) 139 -436, 480
Greenlees' Tm., 9 R. P. C. 93 - - - - 62, 277
Gridley *v.* Swinborne, 52 J. P. 739, 791; 5 Times L. R. 71 - 20, 340, 485, 489, 500, 508, 513, 541
Griffiths; Chappell *v.*
Griffiths; Chubb *v.*
Griffiths; Wilkinson *v.*
Groenings; Moul *v.*
Grossmith's Tm., 6 R. P. C. 180; 9 R. P. C. 93; 60 L. T. 612 - 64, 151, 157, 158, 208, 236
Grosvenor Library Co., Ld.; Hoby *v.*
Guardian and General Insurance Co.; Guardian Fire and Life Assurance Co. *v.*
Guardian Fire and Life Assurance Co. *v.* The Guardian and General Insurance Co., 50 L. J. Ch. 253; 43 L. T. 791 - - 398
Guest; American Tobacco Co. *v.*
Guinness & Co.'s Tm., 5 R. P. C. 316 - - 248, 249, 281
Guinness *v.* Heap, Seb. Dig. 377 - - - - - 349
Guinness *v.* Ullmer, 10 L. T. (O. S.) 127 - - - 310

Haines, Batchelor & Co.'s Tm., 5 R. P. C. 669 - 194, 195, 208
Haley; Lee *v.*
Hall *v.* Barrows, 4 De G. & S. 150; 32 L. J. Ch. 548; 33 L. J. Ch. 204; 9 L. T. (N. S.) 561; 12 W. R. 322; 1 N. R. 543; 3 N. R. 259; 10 Jur. (N. S.) 55 - 5, 35, 148, 268, 273, 277, 278, 308, 314, 329, 390, 417
Hall *v.* Benson, 7 C. & P. 711 - - - - - 485
Hall; Haslam *v.*
Hall; Roach *v.*
Hallam; Vernon *v.*
Halsey *v.* Brotherhood, 15 C. D. 514; 19 C. D. 386; 51 L. J. Ch. 233; 45 L. T. (N. S.) 640; 30 W. R. 279 - - - 439
Hammond *v.* Bussey, 20 Q. B. D. 79; 57 L. J. Q. B. 58 - - 436
Hammond *v.* Malcolm, Brunker & Co., 9 R. P. C. 301; 8 Times L. R. 324 - -114, 139, 174, 196, 209, 215, 277, 278, 288, 330, 332, 344, 412
Hanbury; Liebig's Extract of Meat Co. *v.*
Hannay's Tm., 7 R. P. C. 46 - - - - - 151
Hanson's Tm., 37 C. D. 112; 5 R. P. C. 130; 57 L. J. Ch. 173; 57 L. T. 859; 36 W. R. 134; 4 Times L. R. 77 - 129, 151, 162, 195, 319
Hanson *v.* British Tea, &c. Association, Sebastian, 3rd ed., p. 368 - - - - - - - 162
Hanson *v.* Game, Harrison and Larner, Ltd., 9 R. P. C. 186 - 278, 329, 333
Harbord's Tm. See *Perry Davis* v. *Harbord.*
Harbord; Perry Davis and Son *v.*

PAGE
Harden Star Hand Grenade Co.'s Tm., 3 R. P. C. 132; 55 L. J. Ch. 596; 54 L. T. 834 - - - - - - 151
Hargreave's Case, 11 C. D. 669; 27 W. R. 450 - - 197
Hargreaves *v.* Freeman, (1891) 3 Ch. 39; 8 R. P. C. 237; 61 L. J. Ch. 23; 65 L. T. 487; 7 Times L. R. 535 - 89, 182, 257, 265, 309, 347, 368
Harpers *v.* Pearson, 3 L. T. (N. S.) 547 - - 302, 388
Harris' Tms., 9 R. P. C. 492 - - - - - 151
Harris *v.* Petherick, 4 Q. B. D. 611 - - - - 516
Harris; Smith *v.*
Harrison, McGregor & Co.'s Tm., 42 C. D. 691; 7 R. P. C. 25; 59 L. J. Ch. 22; 61 L. T. 484 - - - 228, 259
Harrison; Flavel *v.*
Harrison *v.* Taylor, 11 Jur. (N. S.) 408; 12 L. T. (N. S.) 339 - 362
Harrison *v.* Woodroffe (Harrison's Tm.), 42 C. D. 691; 7 R. P. C. 25 - - - - 89, 159, 160, 245, 404
Hart *v.* Colley, 44 C. D. 193; 7 R. P. C. 93; 59 L. J. Ch. 355; 62 L. T. 623; 6 Times L. R. 216 - 89, 256, 265, 267, 309, 382, 413
Hart; Colley *v.*
Harter *v.* Souvazaglu, W. N. (1875) pp. 11, 101 - - - 136
Hartley; Heap *v.*
Harvey *v.* Harvey, 26 C. D. p. 654 - - - - 355
Haslam & Co. *v.* Hall, 5 R. P. C. 144 - - - - 370
Hatchard *v.* Mège, 18 Q. B. D. 771; 56 L. J. Q. B. 397; 56 L. T. 662; 35 W. R. 576 - - - - - 447
Hately; Burgess *v.*
Hayward's Tm., 54 L. J. Ch. 1003; 53 L. T. 487 - 69, 159, 170, 230, 234, 235, 258
Hayward & Co. *v.* Hayward & Sons, 34 C. D. 198; 56 L. J. Ch. 287; 55 L. T. 729; 35 W. R. 392 - 441, 442, 443
Hazzopulo *v.* Kaufmann, 23 Sol. J. 819 - - 261, 265, 303
Heap; Guinness *v.*
Heap *v.* Hartley, 42 C. D. 461; 5 R. P. C. 603 - - 282, 302
Heaton's Tm., 27 C. D. 570; 53 L. J. Ch. 959; 51 L. T. 220; 32 W. R. 951 - - - - - 78, 161, 286
Holleley; Johnson *v.*
Henderson *v.* Jorss, Seb. Dig., p. 110 - - - - 321
Hendriks *v.* Montagu, 17 C. D. 638; 50 L. J. Ch. 257, 456; 44 L. T. 89, 879; 30 W. R. 168 - 168, 395, 396, 401, 413, 414, 422, 423, 428
Henley; Rose *v.*
Hennessy *v.* Cooper, Seb. Dig. p. 327 - - - - 310
Hennessy *v.* Kennett, Seb. Dig. p. 331 - - - - 306
Henry; Mitchell *v.*
Henry Clay. See *Clay.*
Henshaw; Ihlee *v.*
Henshaw; Steinway *v.*
Herbert & Co., Upper Assam Tea Co. *v.*
Herrfeldt; Apollinaris Co. *v.*
Hewitt *v.* Mansell, 29 Sol. J. 66 - - - - 356
Heyworth *v.* Hutchinson, L. R. 2 Q. B. 447 - - - 436
Hills' Tm., 10 R. P. C. 113 - - 216, 226, 234, 245, 259
Hill; Batty *v.*
Hill; Blanchard *v.*
Hill; Thorneloe *v.*

PAGE

Hills; Burgess *v.*
Hine *v.* Lart, 7 L. T. (O. S.) 41; 10 Jur. 106 - - - 303
Hirsch *v.* Jonas, 3 C. D. 584; 45 L. J. Ch. 364; 35 L. T. (N. S.) 228 - - - - - 50, 61, 62, 302
Hirschfield; Leather Cloth Co. *v.*
Hirst *v.* Denham, L. R. 14 Eq. 542; 41 L. J. Ch. 752; 27 L. T. (N. S.) 56 - - - - - - 404
Hitchcock; Hopkins *v.*
Hoby *v.* The Grosvenor Library Co., Ltd., 28 W. R. 386 - 396, 398
Hodge; Williams *v.*
Hodgson *v.* Sinclair, 9 R. P. C. 22; 8 Times L. R. 45 144, 146, 148, 149, 228
Hogg *v.* Kirby, 8 Ves. 215 - - - - 3, 337
Hogg; Maxwell *v.*
Hogg *v.* Scott, L. R. 18 Eq. 444 - - - - - 333
Holeton, *Re*, Times, 29th June, 1885; Stone's J. M. 23rd ed. p. 508 - - - - - - - 516
Holloway *v.* Holloway, 13 Beav. 209 - - 338, 414, 426
Holt *v.* Smith, 4 Times L. R. 329 - - - - 426
Home & Colonial Assurance Co., Ltd.; Colonial Fire Assurance Co. *v.*
Hookham *v.* Pottage, 8 L. R. Ch. 91; 27 L. T. (N. S.) 595; 26 L. T. 755; 21 W. R. 47; 20 W. R. 720 - 278, 323, 388
Hooper *v.* Balfour, W. N. (1890) 61; 62 L. T. 646 - 436, 480, 500
Hopkins *v.* Hitchcock, 14 C. B. (N. S.) 65; 32 L. J. C. P. 154; 8 L. T. (N. S.) 204; 11 W. R. 597 - - - - 433
Hopkinson's Tm., (1892) 2 Ch. 116; 9 R. P. C. 102; 61 L. J. Ch. 337; 66 L. T. 487 - 36, 116, 119, 120, 154, 156, 158
Horsburgh & Co.'s Application, 53 L. J. Ch. 237, n.; 50 L. T. 23, n.; 32 W. R. 530, n. - - - - 139, 202, 210
Houldsworth *v.* City of Glasgow Bank, 5 App. Cas. 317 - 464
Hovenden *v.* Lloyd, 18 W. R. 1132 - - - - 333
How; Pidding *v.*
How; Southern *v.*
Howe *v.* McHerman, 30 Beav. 547 - - - 374, 388
Hudson's Tm., 32 C. D. 311; 3 R. P. C. 155; 55 L. J. Ch. 531; 55 L. T. 228; 34 W. R. 616; 2 Times L. R. 466 - 51, 60, 63, 86, 110, 112, 138, 139, 170, 173, 214, 254, 257, 313, 343
Hudson *v.* Bennett, 14 L. T. (N. S.) 698; 14 W. R. 911; 12 Jur. (N. S.) 519 - - - - - - - 365
Hudson *v.* Osborne, 39 L. J. Ch. 79; 21 L. T. (N. S.) 386 - 277, 330, 338, 387, 401, 418, 419
Hudson *v.* Osgerby, 50 L. T. 323; 32 W. R. 566 - - 369
Hughes and Young's Tm., 10 R. P. C. 369 - - - 197
Humphries *v.* Taylor Drug Co., 39 C. D. 693; 5 R. P. C. 687; 59 L. T. 177; 37 W. R. 192 - - - - - - 373
Humphries *v.* Taylor Drug Co., 59 L. T. 820; 5 Times L. R. 41 - - - 124, 151, 171, 243, 244, 314, 368
Hunt *v.* Chambers. See *Re* Martin.
Hunt *v.* Maniere, 34 Beav. 157; 34 L. J. Ch. 142; 11 L. T. (N. S.) 469, 723; 13 W. R. 312; 11 Jur. (N. S.) 28 - - 358
Huntley & Palmers *v.* The Reading Biscuit Co., 10 R. P. C. 277 - - - - - - 47, 404, 424
Hutchinson; Abernethy *v.*
Hutchinson; Heyworth *v.*

PAGE

Hyde & Co.'s Tm., 7 C. D. 724; 54 L. J. Ch. 395, n.; 38 L. T. 777; 26 W. R. 625 - - - 122, 244, 259, 286, 335, 364

Ihlee *v.* Henshaw, 31 C. D. 323; 3 R. P. C. 15; 55 L. J. Ch. 273; 53 L. T. 949; 34 W. R. 269 - 265, 280, 304, 469
India and China Tea Co. *v.* Teide, W. N. (1871) 241 - - - 398
Isaacson; Chatteris *v.*
Isaacson *v.* Thompson, 41 L. J. Ch. 101; 20 W. R. 196 - 335, 353, 394, 425

Jackson & Co.'s Tm., 6 R. P. C. 80; 60 L. T. 93 - 145, 147, 185, 209
Jackson; Dicks *v.*
Jackson & Co. *v.* Napper, 35 C. D. 162; 4 R. P. C. 45; 56 L. J. Ch. 406; 55 L. T. 836; 35 W. R. 228; 3 Times L. R. 238 - 62, 69, 83, 161, 178, 179, 180, 205, 232, 242, 256, 326
Jacobsohn *v.* Blake, 6 M. & G. 919; 7 Scott, N. R. 772; 13 L. J. C. P. 89; 2 L. T. (O. S.) 310 - - - - - 539
James' Tm., 31 C. D. 340; 33 C. D. 392; 3 R. P. C. 340; 55 L. J. Ch. 915; 55 L. T. 415; 35 W. R. 67; 1 Times L. R. 318 - - - - 36, 120, 131, 196, 346, 541
James; Core *v.*
James *v.* James, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. 568; 20 W. R. 434 - - - - 406, 425, 448
James *v.* Parry. See *James' Tm.*
James; Oldham *v.*
Jay *v.* Ladler, 40 C. D. 649; 6 R. P. C. 136; 60 L. T. 27; 37 W. R. 505; 5 Times L. R. 57 - 89, 256, 265, 267, 309, 310, 332, 367, 382, 383, 413, 429
Jeffrey & Co., *Re*, Sebastian, 3rd ed. 368 - - - 163
Jelley, Son and Jones' Application, 51 L. J. Ch. 639, n.; 46 L. T. 381, n. - 89, 160, 172, 177, 178, 179, 181, 194, 205, 207
Jeudwine *v.* Slade, 2 Esp. N. P. C. 572 - - - 434
Johnson; Barlow *v.*
Johnson; Byron (Lord) *v.*
Johnson; Edge *v.*
Johnson *v.* Edge, (1892) 2 Ch. 1; 9 R. P. C. 142 - - - 438
Johnson *v.* Holleley, 34 Beav. 63; 34 L. J. Ch. 32, 179; 2 De G. J. & S. 446; 11 L. T. (N. S.) 581; 13 W. R. 229 - 418
Johnson, Philpott & Co., *Re*, Sebastian, 3rd ed. p. 368 - - 163
Johnson *v.* Raylton, 7 Q. B. D. 438; 50 L. J. Q. B. 735; 45 L. T. 374; 30 W. R. 350 - - - - - 433
Johnston *v.* Orr-Ewing, 7 App. Cas. 219; 13 C. D. 434; 51 L. J. Ch. 797; 46 L. T. 416; 30 W. R. 419 - 165, 187, 190, 194, 197, 200, 204, 269, 314, 316, 318, 321, 322, 328, 349, 351, 378, 384, 429
Jonas; Hirsch *v.*
Jones' Tm., 53 L. T. (N. S.) 1 - - 51, 62, 216, 301, 329
Jones; Canham *v.*
Jones *v.* Curling, 13 Q. B. D. 265 - - - - 519
Jones; Newman *v.*
Jones; Henderson *v.*
Joule's Tms. See *Montgomery v. Thompson.*
Junior Army and Navy Stores, Ltd.; Army and Navy Co-operation Society, Ltd. *v.*

PAGE

Kaufmann; Hazzopulo *v.*
Kearley *v.* Tonge, 60 L. J. M. C. 159 - - - - 500
Keep's Tm., 26 C. D. 187; 54 L. J. Ch. 637; 50 L. T. 453; 32 W. R. 427 - - - - - 54, 90, 182, 184
Kelly *v.* Byles, 13 C. D. 682; 49 L. J. Ch. 131; 42 L. T. 338; 28 W. R. 587 - - - - - 407
Kennett; Hennessy *v.*
Kenrick & Jefferson's Tm., 7 R. P. C. 321 - - 82, 83, 90
Kimbal; Singer Manufacturing Co. *v.*
Kinahan & Co.'s Tm., 10 R. P. C. 393 - - - 30, 159
Kinahan *v.* Bolton, 15 Ir. Ch. 75 - - 286, 291, 320, 333
Kinahan *v.* Kinahan, 45 C. D. 78; 8 R. P. C. 18; 62 L. T. 715 - 241, 299, 300
King & Co.'s Tm., (1892) 2 Ch. 462; 9 R. P. C. 350; 62 L. J. Ch. 153; 67 L. T. 33; 40 W. R. 580; 8 Times L. R. 593 - 82, 238, 239, 240, 300
Kingsford & Son's Application, 6 R. P. C. 413; 61 L. T. 426 - 63, 236
Kirby; Hogg *v.*
Kitcat *v.* Sharp, 31 W. R. 227 - - - - - 444
Knight; Salmons *v.*
Knott *v.* Morgan, 2 Keen, 213 - - - - 408, 411
Knott; Prudential Assurance Association *v.*
Knott; Welch *v.*
Kuhn & Co.'s Tm., 53 L. J. Ch. 238, n. - 122, 123, 129, 166, 244, 286, 364
Kuhnow's Tm. 10 R. P. C. 401 - - 186, 195, 206, 214, 349

Labouchere *v.* Dawson, L. R. 13 Eq. 322; 41 L. J. Ch. 427; 25 L. T. 894; 20 W. R. 309 - - - - 387, 418
Ladler; Jay *v.*
Laight; Shrimpton *v.*
Lamb *v.* Evans, (1892) 3 Ch. 462; (1893) 1 Ch. 218 - 451, 453
Lambert's Tm., 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138; 37 W. R. 154; 4 Times L. R. 677; 5 Times L. R. 367 - 96, 98, 194, 195, 206, 208
Lambert; Wood *v.*
Lamplough *v.* Balmer, W. N. (1867) 293 - - - 342
Langford; Great Tower Street Tea Co. *v.*
Lart; Hine *v.*
Laurence; Crane *v.*
Lauri *v.* Renad, (1892) 3 Ch. 402 - - - - - 529
Lawford, The, W. N. (1885) 124 - - - 149, 152
Lawrence, *Ex parte*. See *Marler's Tm.*
Lawrie *v.* Baker, 2 R. P. C. 213 - - - - - 313
Lawson *v.* The Bank of London, 18 C. B. 84; 25 L. J. C. P. 188; 27 L. T. (O. S.) 134; 4 W. R. 481 - - 33, 390
Lazenby *v.* White, 40 L. J. Ch. 576; 41 L. J. Ch. 354; L. R. 6 Ch. 89; 24 L. T. (N. S.) 280; 19 W. R. 595 - 44, 286 371
Lea; Foot *v.*
Lea *v.* Miller, Seb. Dig. p. 305 - - - - - 291
Leach; Clark *v.*
Leaf's Tm., 34 C. D. 623; 33 C. D. 477; 4 R. P. C. 31; 3 R. P. C. 289; 56 L. J. Ch. 370; 56 L. T. 286; 35 W. R. 294 - 85, 143, 152

PAGE

Leahy, Kelly & Leahy *v.* Glover, 10 R. P. C. 141 - 260, 277, 306, 383, 403, 415

Leather Cloth Co. *v.* American Leather Cloth Co., 1 H. & M. 271; 4 De G. J. & S. 137; 12 W. R. 289; 13 W. R. 873; 9 L. T. (N. S.) 558; 12 L. T. (N. S.) 742; 2 N. R. 481; 3 N. R. 264; 6 N. R. 209; 11 Jur. (N. S.) 513; 11 H. L. C. 523; 32 L. J. Ch. 721; 33 L. J. Ch. 199; 35 L. J. Ch. 53 - 5, 27, 31, 35, 47, 120, 156, 160, 238, 273, 275, 312, 314, 336, 338, 340, 342, 367, 369

Leather Cloth Co. *v.* Hirschfeld, L. R. 1 Eq. 299; 1 H. & M. 295; 1 N. R. 551; 11 W. R. 933 - - - 360, 375

Leather Cloth Co. *v.* Lorsont, L. R. 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. (N. S.) 661; 18 W. R. 572 - - - 341, 342

Lee *v.* Haley, L. R. 5 Ch. 155; 39 L. J. Ch. 284; 21 L. T. (N. S.) 546; 22 L. T. 251; 18 W. R. 181, 242 - 346, 362, 381, 427

; Osborn *v.*

Leicester Case, Times Newspaper, 20th October, 1893 -483, 489

Leonard and Ellis' Tm. (Leonard *v.* Wells), 26 C. D. 288; 53 L. J. Ch. 603; 51 L. T. 35; 32 W. R. 530 - 41, 119, 134, 135, 136, 139, 156, 160, 161, 202, 233, 259

Leuchars; Barnett *v.*

Lever *v.* Goodwin, 36 C. D. 1; 4 R. P. C. 492; 57 L. T. 583; 36 W. R. 177; 3 Times L. R. 650 - 150, 151, 187, 257, 304, 361, 363, 382, 390, 408, 411, 413, 493, 507

Levy *v.* Walker, 10 C. D. 436; 48 L. J. Ch. 273; 27 W. R. 370; 39 L. T. 654 - - - - 307, 393, 417, 418

Lewis; Field *v.*

Lewis *v.* Goodbody, 67 L. T. 194 - - - - - 345

Licensed Victuallors' Newspaper Co. *v.* Bingham, 38 C. D. 139; 58 L. J. Ch. 36; 59 L. T. 187; 36 W. R. 433 - 391, 410

Liebig's Extract of Meat Co. *v.* Anderson, 55 L. T. 206 - 41, 129, 404, 440, 441, 443

Liebig's Extract of Meat Co., Ltd. *v.* Hanbury, 17 L. T. (N. S.) 298 - - - - - -41, 129, 404

Lindsay; Goulard *v.*

Linoleum Manufacturing Co. *v.* Nairn, 7 C. D. 834; 47 L. J. Ch. 430; 38 L. T. 448; 26 W. R. 463 - 43, 202, 285, 311, 314, 354, 404

Lipton; R. *v.*

Liverpool Vinegar Co.; Birmingham Vinegar Brewery Co. *v.*

Lloyd and Sons' Tm., 27 C. D. 646; 54 L. J. Ch. 66; 51 L. T. 898 - - - - - - - - 259

Lloyd and Sons' Tm., 10 R. P. C. 281 - - -142, 145

Lloyd; Hovenden *v.*

Loftus' Tm., (1894) 1 Ch. 193; 11 R. P. C. 29- 62, 69, 139, 174, 202, 203

Loftus; Rose *v.*

London Assurance *v.* London and Westminster Assurance Corporation, 32 L. J. Ch. 664; 8 L. T. (N. S.) 497; 9 Jur. (N. S.) 497 - - - - - - - 399

London and County Banking Co. *v.* Capital and Counties Bank, 9 C. D. 560 - - - - - - - 399

London and Provincial Law Assurance Society *v.* London and Provincial Joint Stock Life Assurance Co., 17 L. J. Ch. 37; 10 L. T. (O. S.) 127; 11 Jur. 938 - - - - 399

PAGE
London and Provincial Supply Association; Pharmaceutical Society *v.*
London and Westminster Assurance Corporation; London Assurance *v.*
Londonderry (Marquis of) *v.* Russel, 2 Times L. R. 843; 3 Times L. R. 360 - - - - - 335, 351
Longman *v.* Winchester, 16 Ves. (1809) - - - - 3
Loog: Singer Manufacturing Co. *v.*
Lorsont; Leather Cloth Co. *v.*
Low; Benbow *v.*
Lucas; Budd *v.*
Lye; Cruttwell *v.*
Lyndon's Tm., 32 C. D. 109; 3 R. P. C. 102; 55 L. J. Ch. 456; 54 L. T. 405; 34 W. R. 403; 1 Times L. R. 629; 2 Times L. R. 356 - - - 186, 194, 195, 207, 252, 254, 269
Lytton (Earl of) *v.* Devey, 54 L. J. Ch. 293 - - - 451

McAndrew *v.* Bassett, 4 De G. J. & S. 380; 33 L. J. Ch. 561; 10 L. T. (N. S.) 65, 442; 10 Jur. (N. S.) 492, 550; 4 N. R. 12, 123; 12 W. R. 777 - 34, 35, 45, 308, 361, 365, 391, 404
McKernan; Howe *v.*
McLeod *v.* Att.-Gen. for New South Wales, (1891) A. C. 455 - 505
McMaster & Co.; Dickson *v.*
Macrae; Young *v.*
Maddick; Clements *v.*
Maignen's Tm., 28 W. R. 759 - - - - - 171
Malachy *v.* Soper, 3 Bing. N. C. 371 - - - - 439
Malcolm, Brunker & Co.; Hammond *v.*
Mallam *v.* Davis, 3 Times L. R. 221 - - - - 388
Manico; Barber *v.*
Maniere; Hunt *v.*
Mansell *v.* The British Linen Co. Bank, (1892) 3 Ch. 159 - 354
Mansell; Howitt *v.*
Marcovitch *v.* Bramble, Wilkins & Co., Seb. Dig., p. 363 - 355
Marler's Tm., 44 L. T. 98, n; 29 W. R. 392, n. - - 62, 236
Marshall; Collard *v.*
Marshall *v.* Marshall, 38 C. D. 330; 59 L. T. 484 - 241, 299, 300
Marshall *v.* Ross, L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. (N. S.) 260; 17 W. R. 1086 - - - - 341, 342
Martin, *Re*, Hunt *v.* Chambers, 20 C. D. 365 - - - 298
Martin *v.* Wright, 6 Sim. 297 - - - - - 410
Mason; Denco *v.*
Mason *v.* Queen, 23 Scot. Law Rep. 641 - - - 402
Massam *v.* Thorley's Cattle Food Co., 6 C. D. 574; 14 C. D. 748; 46 L. J. Ch. 707; 36 L. T. (N. S.) 848; 41 L. T. 543; 42 L. T. 851; 28 W. R. 966 - 118, 303, 404, 406, 412, 413, 424, 426, 427, 428, 429
Maxwell *v.* Hogg, L. R. 2 Ch. 307; 36 L. J. Ch. 433; 15 L. T. (N. S.) 204; 16 L. T. 130; 15 W. R. 841, 467 - 33, 34, 331, 368, 389, 390
May; Cartier *v.*
Mayer; Del Vallo *v.*
McAdam; Morgan *v.*
Mceus' Tm., (1891) 1 Ch. 41; 8 R. P. C. 25; 60 L. J. Ch. 96; 63 L. T. 610; 39 W. R. 216 - - 85, 161, 167, 201, 203

PAGE

Mège; Hatchard *v.*
Meikle's Tm., 46 L. J. Ch. 17; 24 W. R. 1067 - - 215
Melachrino and Co. *v.* Melachrino Egyptian Cigarette Co., 4 R. P. C. 215 - - 139, 174, 196, 332, 345, 425, 426, 427
Mellin *v.* White, W. N. (1894) 59 - - - - 441
Merchant Banking Co. of London *v.* Merchants' Joint Stock Bank, 9 C. D. 560; 47 L. J. Ch. 828; 26 W. R. 847 - 396, 399
Merryweather *v.* Moore, (1892) 2 Ch. 518; 61 L. J. Ch. 505; 66 L. T. 719; 40 W. R. 540 - - - 451, 452, 453
Metcalf; Anglo-Swiss, &c. Co. *v.*
Metzler *v.* Wood, 8 C. D. 606; 47 L. J. Ch. 625; 38 L. T. (N. S.) 541; 26 W. R. 577 - - - 347, 366
Meyerstein's Tm., 43 C. D. 604; 7 R. P. C. 114; 59 L. J. Ch. 401; 62 L. T. 526; 38 W. R. 440 - - - 142, 152
Midland Railway Co.; Stark *v.*
Miller; Lea *v.*
Miller's Patent, W. N. (1894) 4; 11 R. P. C. 55 - - 241
Millington *v.* Fox, 3 My. & Cr. 338 - 4, 12, 37, 135, 268, 316, 349, 365
Mitchell's Tm., 7 C. D. 36; 46 L. J. Ch. 876; 16 W. R. 326 - 129, 154
Mitchell & Co.'s Tm., 28 C. D. 666; 54 L. J. Ch. 216, 809; 51 L. T. 900; 52 L. T. 575; 33 W. R. 148, 480 - 54, 182, 235, 253
Mitchell; Condy *v.*
Mitchell *v.* Henry, 15 C. D. 181; 43 L. T. 186 - 163, 194, 198, 199, 206, 265, 266, 269, 284, 315, 355
Moat; Morison *v.*
Moët's Tm., 7 R. P. C. 226 - - - - 77, 78
Moët *v.* Clybouw, Seb. Dig., p. 316 - - - 30, 426
Moët *v.* Couston, 33 Beav. 578: 10 L. T. (N. S.) 395; 10 Jur. (N. S.) 1012; 4 N. R. 86 - - - 350, 362, 365, 366
Moët *v.* Pickering, 6 C. D. 770; 8 C. D. 372; 47 L. J. Ch. 527; 38 L. T. (N. S.) 799; 26 W. R. 637 - 30, 358, 359, 365
Mogford *v.* Courtenay, 45 L. T. (N. S.) 303; 29 W. R. 864 - 388, 418, 420
Mogul Steamship Co. *v.* McGregor, Gow & Co., 15 Q. B. D. 476 - - - - - - - - 447
Monck's Application, 50 L. T. 12 - - - - - 161
Monkseaton (The), 14 P. D. 51 - - - - 519
Monson *v.* Tussaud, 10 Times L. R. 227 - - - 389, 447
Montagu; Kendriks *v.*
Montgomery *v.* Thompson, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361; 60 L. J. Ch. 757; 64 L. T. 784; 5 Times L. R. 51, 305 - - 12, 14, 47, 157, 159, 160, 204, 213, 266, 270, 350, 351, 381, 382, 401, 405, 409, 429
Moore; Morryweather *v.*
Morgan *v.* McAdam, 36 L. J. Ch. 228; 15 L. T. (N. S.) 348 - 340, 341, 342, 368
Morgan; Knott *v.*
Morison *v.* Moat, 9 Hare, 241; 20 L. J. (N. S.) Ch. 513; 21 L. J. Ch. 248; 15 Jur. 787; 16 Jur. 321 - - 450, 452, 453
Motley *v.* Downman, 3 My. & Cr. 1; 6 L. J. Ch. (N. S.) 308 - 273, 302
Mottram; Walker *v.*
Moul *v.* Grocninge, (1891) 2 Q. B. 443; 39 W. R. 691 - - 455

PAGE

Mouson *v.* Boehm, 26 C. D. 398; 53 L. J. Ch. 932; 50 L. T. 784; 32 W. R. 612 - 60, 125, 161, 228, 232, 256, 290, 325, 332
Münch's Application, 50 L. T. 12 - - - 60, 172, 178
Murphy's Tm., 7 R. P. C. 163; W. N. (1890) 84 - 196, 198, 208, 249, 281

Myers; Cave *v.*

Nähmaschinen Fabrik, &c. *v.* Singer Manufacturing Co., 10 R. P. C. 310 - - - - - - - 443
Nairn; Linoleum Manufacturing Co. *v.*
Napper; Jackson *v.*
Nassau, *Ex parte*, 2 T. L. R. 339 - - - - 486
Native Guano Co. *v.* Sewage Manure Co., 4 R. P. C. 478; 8 R. P. C. 125; 3 Times L. R. 693; 4 Times L. R. 372 - 314, 372, 383, 416
Neilson *v.* Betts, L. R. 5 H. L. 1; 40 L. J. Ch. 317; 19 W. R. 1121 - - - - - - - 361, 376
Newman *v.* Jones, 17 Q. B. D. 132 - - - - 500
Newman *v.* Pinto, 4 R. P. C. 508; 57 L. T. 31; 3 Times L. R. 386; 4 Times L. R. 685 - 196, 332, 338, 339, 347, 368, 369
Nixey *v.* Roffey, W. N. (1870) 227 - - - - 342
Normal Co.'s Tm., 35 C. D. 231; 3 R. P. C. 232, 269; 4 R. P. C. 123; 56 L. J. Ch. 513; 56 L. T. 246; 35 W. R. 464; 2 Times L. R. 885; 3 Times L. R. 407 - 53, 68, 80, 220, 262
Norman; Raddle *v.*
Norris; Rivers *v.*
North Metropolitan Tramways Co.; Attorney-General *v.*
Norton; Evans *v.*
Norwich Town Close Estate Charity, *Re*, 40 C. D. 310 - - 242
Nowill; Rodgers *v.*
Nuthall *v.* Vining, 28 W. R. 330 - - - - 319

Oakey *v.* Dalton, 35 C. D. 700; 4 R. P. C. 313; 56 L. J. Ch. 823; 57 L. T. 18; 35 W. R. 709; 3 Times L. R. 701 - - 303
O'Connor; Wolmershausen *v.*
Oldham *v.* James, 13 Ir. Ch. 393; 14 Ir. Ch. 81 - 281, 331
O'Meara; Reed *v.*
Onslow *v.* The Commissioners of the Inland Revenue, 25 Q. B. D. 465 - - - - - - - - 245
Orr *v.* Diaper, 4 C. D. 92; 46 L. J. Ch. 41; 35 L. T. 468; 25 W. R. 23 - - - - - - - 374
Orr-Ewing & Co's Tms., 28 W. R. 412 - - - - 81
Orr-Ewing's Tm. See *Orr-Ewing v. The Registrar of Tms.*
Orr-Ewing; Johnston *v.*
Orr-Ewing *v.* The Registrar of Trade-marks, 4 App. Cas. 479; 8 C. D. 794; 47 L. J. Ch. 807; 48 L. J. Ch. 180, 707; 38 L. T. 313, 695; 41 L. T. (N. S.) 239; 26 W. R. 259, 777; 28 W. R. 17 - 35, 66, 79, 104, 113, 119, 122, 130, 139, 193, 197, 198, 248, 261, 263, 264, 268
Osborn *v.* Lees, 9 Mod. 96 - - - - - 331
Osborne; Hudson *v.*
Osgerby; Hudson *v.*
Otaday's (De) Tm., W. N. (1885) 177 - - - - 54
Ottos Kopje Diamond Mines, Ltd., (1893) 1 Ch. 618 - - 244
Owens; Bodega Co. *v.*

PAGE
Pain *v.* Boughtwood, 24 Q. B. D. 353 - - - - 500
Paine's Case, W. N. (1892) 56; 9 R. P. C. 130; 61 L. J. Ch. 365; 66 L. T. 642 - - - - 134, 148, 150
Paine *v.* Chisholm, (1891) 1 Q. B. 531 - - - - 369
Paine & Co. *v.* Daniells & Sons' Breweries, (1893) 2 Ch. 567; 10 R. P. C. 219; 62 L. J. Ch. 732; 68 L. T. 801; 42 W. R. 40 - - 60, 126, 134, 138, 139, 185, 206, 226, 227, 229, 232, 307, 313, 316, 318, 370, 384, 407
Paine; Stevens *v.*
Palmer's Tm., 21 C. D. 47; 24 C. D. 504; 46 L. T. 787; 50 L. T. 30; 32 W. R. 306; 51 L. J. Ch. 673 - 8, 155, 158, 160, 161, 202, 259
Palmer's Tm., 22 C. D. 88; 48 L. T. 52; 31 W. R. 33 - 245, 371
Pape; Curtis and Harvey *v.*
Parsons *v.* Birmingham Dairy Co., 9 Q. B. D. 172 - - 516
Patent Plumbago Crucible Co.'s Tms., 7 R. P. C. 282 - - 237
Payne; Blofeld *v.*
Peake; Boulnois *v.*
Pearson; Harper *v.*
Pearson *v.* Pearson, 27 C. D. 145; 54 L. J. Ch. 32; 51 L. T. 311; 32 W. R. 1006 - - - - - 418, 420
Peek; Derry *v.*
Peel; Stephens *v.*
Perceval *v.* Phipps, 2 Ves. & B. 19 - - - - 451
Perry-Davis' Tm., 5 R. P. C. 333; 58 L. T. 695 - - 244, 371
Perry-Davis and Son *v.* Harbord, 15 App. Cas. 316; 7 R. P. C. 336; 58 L. T. 695; 60 L. J. Ch. 16; 4 Times L. R. 483 - 120, 149, 154, 157, 158, 160
Perry *v.* Truefitt, 6 Beav. 66; 1 L. T. (O. S.) 384 - - - 320
Perryman; Bonnard *v.*
Petherick; Harris *v.*
Peto; Ponsardin *v.*
Pharmaceutical Society *v.* London and Provincial Supply Association, 5 App. Cas. 869 - - - - - 464
Pharmaceutical Society *v.* Wheeldon, 24 Q. B. D. 683; 59 L. J. Q. B. 400; 62 L. T. 727; 54 J. P. 293 - - - 501
Phillips' Tm., (1891) 3 Ch. 139; 8 R. P. C. 469; 61 L. J. Ch. 40; 65 L. T. 373 - - - 170, 215, 248, 249
Philpott & Co.; Johnson *v.*
Phipps; Perceval *v.*
Photographic Co.; Pollard *v.*
Pickering; Moët *v.*
Pidding *v.* How, 8 Sim. 477; 6 L. J. Ch. (N. S.) 345 - - 336
Pierce *v.* Franks, 15 L. J. Ch. 122; 10 Jur. 25 - 300, 366
Pillow; Barnard *v.*
Pinto *v.* Badman, 8 R. P. C. 181; 7 Times L. R. 317 - - 25, 138, 148, 173, 205, 209, 238, 257, 268, 273, 276, 277, 287, 304, 324, 371, 392, 467
Pinto Leite; Carver *v.*
Pinto; Newman *v.*
Pinto *v.* Trott, 8 R. P. C. 173 - - - - - 209
Pirie *v.* Goodall, (1892) 1 Ch. 35; 9 R. P. C. 17; 61 L. J. Ch. 79; 65 L. T. 640; 66 L. T. 255; 40 W. R. 81; 8 Times L. R. 62 - - - 115, 116, 119, 134, 149, 173, 203, 305
Pirie & Sons; Towgood Brothers *v.*
Plating Co. *v.* Farquharson, 17 C. D. 49 - - - - 445

PAGE
Plumbago Crucible Co.'s Tms., 7 R. P. C. 282 - - - 237
Pollard; Derby Photographic Dry Plate Co., Ltd. *v.*
Pollard *v.* Photographic Co., 40 C. D. 345; 58 L. J. Ch. 251 - 451
Ponsardin *v.* Peto, 33 Beav. 642; 33 L. J. Ch. 371; 3 N. R. 237; 9 L. T. (N. S.) 567; 10 Jur. (N. S.) 66; 12 W. R. 198- 358
Pooley's Trustee *v.* Whetham, 33 C. D. 120 - - - - 369
Pottage; Hookham *v.*
Powell's Tm., (1893) 2 Ch. 388; (1894) A. C. 8; 10 R. P. C. 63, 195; 11 R. P. C. 4; 62 L. J. Ch. 848; 69 L. T. 60; 41 W. R. 627 - - 29, 30, 34, 49, 159, 160, 221, 222, 225
Power *v.* Barham, 7 C. & P. 356; 4 Ad. & E. 472; 5 L. J. K. B. (N. S.) 88 - - - - - - - 434
Price's Patent Candle Co.'s Case, 27 C. D. 681; 54 L. J. Ch. 210; 51 L. T. 653 - - - 113, 117, 137, 138
Priester; Tuck & Sons *v.*
Prince; Goodfellow *v.*
Proctor *v.* Bennis, 36 C. D. 740 - - - 331, 333
Provezende; Seixo *v.*
Provincial Joint Stock Life Assurance; London and Provincial Law Assurance Society *v.*
Prudential Assurance Association *v.* Knott, L. R. 10 Ch. 142; 44 L. J. Ch. 192; 31 L. T. (N. S.) 866; 23 W. R. 249 - 446
Punch *v.* Boyd, 16 L. R. Ir. 476 - - - - 446
Purser *v.* Brain, 17 L. J. (N. S.) Ch. 141 - - - 388, 390

Queen *v.* County Court Judge of Halifax, (1891) 2 Q. B. 263 - 299
Queen *v.* Great North of England Rail. Co., 9 Q. B. Rep. 315; 16 L. J. M. C. 16 - - - - - - 464
Queen; Mason *v.*
Queen *v.* Stephens, L. R. 1 Q. B. 702; 35 L. J. Q. B. 251; 14 W. R. 859; 12 Jur. (N. S.) 961 - - - - - 464
Queen *v.* Tyler, (1891) 2 Q. B. 588 - - - - 464

R. *v.* Ardley, L. R. 1 C. C. R. 301; 40 L. J. M. C. 85; 24 L. T. (N. S.) 193; 19 W. R. 478; 12 Cox, 23 - - - - 469
R. *v.* Crampton, 3 R. P. C. 367 - - - - 484
R. *v.* Dundas, 6 Cox, 380 - - - - - - 469
R. *v.* Francis, L. R. 2 C. C. R. 128; 43 L. J. M. C. 97; 30 L. T. (N. S.) 503; 12 Cox, 612 - - - - - 510
R. *v.* Holt, 30 L. J. M. C. 11; 9 W. R. 74; 8 Cox, 411 - - 510
R. *v.* Lipton, 32 L. R. Ir. 115 - - - 483, 490, 494, 498
R. *v.* Smith, 8 Cox, 32; 27 L. J. M. C. 225; 31 L. T. (O. S.) 135; 6 W. R. 495 - - - - - - 469
R. *v.* Wallis, 3 R. P. C. 1 - - - - - - 484
R. *v.* Woodfall, 5 Burr. 2667, note (1) - - - - 507
Rabbits; Fennessy *v.*
Rabone Bros. & Co., *Re*, Seb. Dig. p. 395 - - 54, 182, 184
Radcliff; Woollam *v.*
Radde *v.* Norman, L. R. 14 Eq. 348; 41 L. J. Ch. 525; 26 L. T. 788; 20 W. R. 766 - - - - - - 353
Raggett *v.* Findlater, L. R. 17 Eq. 29; 43 L. J. Ch. 64; 29 L. T. (N. S.) 448; 22 W. R. 53 - - - - 48, 157
Ralph's Tm., 25 C. D. 194; 53 L. J. Ch. 188; 49 L. T. 504; 32 W. R. 168 - - - - - 55, 223, 288

PAGE
Ransome *v.* Graham, 51 L. J. Ch. 897; 47 L. T. 213 - 341, 342
Rawson; Baker *v.*
Raylton; Johnson *v.*
Read *v.* Richardson, 45 L. T. (N. S.) 54 - 200, 327, 345, 352, 354, 417
Read; Townsend *v.*
Reading Biscuit Co.; Huntley & Palmer *v.*
Reddaway & Co. *v.* Bentham Hemp Spinning Co., (1892) 2 Q. B. 639; 9 R. P. C. 503; 67 L. T. 301; 8 Times L. R. 734 - - 12, 15, 156, 206, 263, 316, 382, 383, 384, 495
Reed *v.* O'Meara, 21 L. R. Ir. 216 - - - - 403
Reeves; Collins Co. *v.*
Registrar of Trade-Marks; Orr-Ewing *v.*
Rehder; Compagnia Général de Tobacos *v.*
Reinhardt *v.* Spalding, 49 L. J. Ch. 57; 28 W. R. 300 - - 135, 138, 328
Reiss' Tm., 5 R. P. C. 291 - - - - 249, 251
Renad; Lauri *v.*
Rendle *v.* Rendle, 63 L. T. 94 - - - - - 399
Reuter's Telegram Co. *v.* Byron, 43 L. J. Ch. 661 - 451, 452
Reynolds; Rosenthal *v.*
Reynolds; Southorn *v.*
Richards *v.* Butcher, (1891) 2 Ch. 522; 8 R. P. C. 249; 60 L. J. Ch. 530; 62 L. T. 867 - 28, 30, 120, 154, 156, 159, 160, 265, 280, 282, 371
Richards *v.* Butcher, 7 R. P. C. 288 - - - 302, 307
Richards *v.* Williamson, 30 L. T. (N. S.) 746; 22 W. R. 765 - 310
Richardson; Read *v.*
Riley; Springhead Spinning Co. *v.*
Rivero *v.* Norris, Seb. Dig. p. 178 - - - - - 354
Rivière's Tm., 26 C. D. 48; 53 L. J. Ch. 455, 578; 55 L. J. Ch. 545; 49 L. T. 506; 50 L. T. 763; 53 L. T. 237; 32 W. R. 390 - - - 62, 221, 224, 232, 236, 245, 301, 389
Rivière; Bodega Co., Ltd. *v.*
Roach *v.* Hall, 2 Atk. 469 - - - - - 444
Robertson, Sanderson & Co.'s Tm., (1892) 2 Ch. 245; 9 R. P. C. 264; 61 L. J. Ch. 470; 66 L. T. 673; 40 W. R. 569; 8 Times L. R. 497 - - - - - 77, 82, 83, 241
Robertson, Sanderson & Co.'s Tm., 9 R. P. C. 213 - - 241
Robin, The, (1892) P. 95 - - - - - - 369
Robineau *v.* Charbonnel, W. N. (1876) 160 - - - 390
Robinson's Tm., 29 W. R. 31 - - - - 162, 194
Robinson *v.* Findlay, 9 C. D. 487; 39 L. T. N. S. 398; 27 W. R. 294 - - - - 51, 62, 138, 301, 329
Rodgers *v.* Nowill, 3 De G. M. & G. 614; 6 Hare, 325; 22 L. J. Ch. 404; 1 W. R. 122, 205, 216; 17 Jur. 109, 171; 5 C. B. 109; 17 L. J. C. P. 32 - - 6, 315, 332, 357, 359
Rodgers *v.* Rodgers, 31 L. T. (N. S.) 285; 22 W. R. 837 - 206, 333, 335, 367
Rodgers & Sons *v.* Rottgen, 5 Times L. R. 678 - 308, 352, 369, 505
Roffey; Nixey *v.*
Rose *v.* Evans, 48 L. J. Ch. 618 - - - - 140, 223
Rose *v.* Henley, 47 L. J. Ch. 577; 38 L. T. (N. S.) 410 - 310
Rose *v.* Loftus, 47 L. J. Ch. 576; 38 L. T. (N. S.) 409 - 310, 321, 349, 361, 366

PAGE

Rosenthal *v.* Reynolds, (1892) 2 Ch. 301; 9 R. P. C. 189; 61 L. J. Ch. 508; 67 L. T. 162; 40 W. R. 521 - 173, 203, 304, 407
Rosing's Tm., 54 L. J. Ch. 975, n. - - -95, 194, 207
Ross; Marshall *v.*
Rotherham's Tm., 11 C. D. 250; 14 C. D. 585; 49 L. J. Ch. 511; 40 L. T. 387; 43 L. T. 1; 27 W. R. 503 - - 85, 129
Rottgen; Rodgers and Sons *v.*
Rowe; Rudd *v.*
Rowland; Scott *v.*
Royal British Bank, *Re*, *Ex parte* Nicol, 3 De G. & J. 387; 28 L. J. Ch. 257 - - - - - - 464
Royle; Challender *v.*
Rudd *v.* Rowe, L. R. 10 Eq. 610 - - - - - 366
Rugby Portland Cement Co., Ltd. *v.* Rugby and Newbold Portland Cement Co., Ltd., 8 R. P. C. 241; 9 R. P. C. 46 - 311, 314, 404, 407
Russel; Marquis of Londonderry *v.*
Rust's Tm., 44 L. T. 98, n.; 29 W. R. 393, n. - 62, 236
Rylands; Davenport *v.*

Salomons *v.* Knight, (1891) 2 Ch. 294 - - - - 447
Sands *v.* Child, 3 Lev. 352 - - - - - 539
Sanitas Co.'s Tm., 4 R. P. C. 533; 58 L. T. 166 - 85, 86, 146, 147, 151
Sanitas Co. *v.* Condy, 4 R. P. C. 195, 530; 56 L. T. 621; 3 Times L. R. 226; 4 Times L. R. 474 - 208, 361, 369, 415
Saunders *v.* Sun Life Assurance Co., (1894) 1 Ch. 537; 70 L. T. 755; 10 Times L. R. 183 - - - - 17, 399
Savage *v.* Foster, 2 White & Tudor's Leading Cases, 6th ed. 680 - - - - - - - - 331
Saxby *v.* Easterbrook, 3 C. P. D. 339; 27 W. R. 188 - - 446
Sayers *v.* Collyer, 28 C. D. 103 - - - - - 351
Schauer *v.* Field, (1893) 1 Ch. 35 - - - 78, 455
Schembri; Somerville *v.*
Schiele *v.* Brackell, 11 W. R. 796 - - - - - 388
Schmincke; Schove *v.*
Schove *v.* Schmincke, 33 C. D. 546; 55 L. J. Ch. 892; 55 L. T. 212; 34 W. R. 700 - - - - - 407, 410
Schweitzer *v.* Atkins, 37 L. J. Ch. 847; 19 L. T. (N. S.) 6; 16 W. R. 1080 - - - - - -425, 426
Scott; Hogg *v.*
Scott *v.* Rowland, 26 L. T. (N. S.) 391; 20 W. R. 508 - 418
Scott *v.* Scott, 16 L. T. (N. S.) 143 - - -387, 388
Scottish Val de Travers Paving Co.; Stuart & Co. *v.*
Seixo *v.* Provezende, L. R. 1 Ch. 192; 14 L. T. (N. S.) 314; 14 W. R. 357; 12 Jur. (N. S.) 215 - 45, 135, 148, 183, 187, 188, 193, 199, 351, 404, 429, 430
Selby *v.* The Anchor Tube Co., W. N. (1877) 191 - 387, 388
Sewage Manure; Native Guano Co. *v.*
Shakespear; Wheeler and Wilson Manufacturing Co. *v.*
Sharp; Kitcat *v.*
Shaw; Delondre *v.*
Sheard; Chappell *v.*
Shipright *v.* Clements, 19 W. R. 599 - - - - 273

PAGE

Shove; Thynne *v.*
Shrimpton *v.* Leight, 18 Beav. 164 - - - 319, 425
Siegert *v.* Findlater, 7 C. D. 801; 47 L. J. Ch. 233; 38 L. T. (N. S.) 349; 26 W. R. 459 - 310, 347, 351, 430, 448, 449
Silverlock; Farina *v.*
Simo; Caird *v.*
Simpson, Davies and Sons' Tm., *Re*, 15 C. D. 525; 42 L. T. 675; 28 W. R. 760 - - - - - 76, 81, 177
Sinclair; Hodgson *v.*
Singer Manufacturing Co. *v.* Kimbal, 11 Ct. of Sess. Cas. 3rd ser. 267 - - - - - - - 38, 147
Singer Manufacturing Co. *v.* Loog, 18 C. D. 395; 8 App. Cas. 15; 52 L. J. Ch. 481; 44 L. T. (N. S.) 888; 48 L. T. 3; 29 W. R. 699; 31 W. R. 325 - 1, 4, 15, 40, 147, 187, 266, 306, 311, 315, 317, 384, 385, 391, 404
Singer Manufacturing Co. *v.* Loog, 11 C. D. 656; 48 L. J. Ch. 649; 27 W. R. 903 - - - - - - 293
Singer Manufacturing Co.; Nähmaschinen Fabrik, &c. *v.*
Singer Manufacturing Co. *v.* Spence & Co., 10 R. P. C. 297 - 39, 41, 147, 287, 404
Singer Manufacturing Co. *v.* Wilson, 2 C. D. 434; 3 App. Cas. 376; 45 L. J. Ch. 490; 47 L. J. Ch. 481; 34 L. T. (N. S.) 858; 38 L. T. (N. S.) 303; 24 W. R. 1023; 26 W. R. 664 - 13, 29, 31, 38, 147, 201, 285, 311, 312, 316, 317, 384, 404
Slack; Ellen *v.*
Slade; Joudwine *v.*
Slazenger & Sons *v.* Feltham & Co., 6 R. P. C. 531; 5 Times L. R. 365 - 147, 202, 209, 313, 350, 358, 414, 425, 429, 514
Schmidt's Tm. (See *Jackson* v. *Napper*.)
Smith; Evans *v.*
Smith; Glenny *v.*
Smith; Gray *v.*
Smith; Great Tower Street Tea Co. *v.*
Smith *v.* Harris, 48 L. T. 869 - - - - - 376
Smith; Holt *v.*
Smith *v.* Smith, L. R. 20 Eq. 500 - - - - - 333
Smokeless Powder Co.'s Tm., (1892) 1 Ch. 590; 9 R. P. C. 109; 61 L. J. Ch. 391; 66 L. T. 407; 40 W. R. 507; 8 Times L. R. 348 - - - - - 138, 169, 172, 213
Snook; Apollinaris Co. *v.*
Soares; Beazley *v.*
Société Anonyme des Manufactures des Glaces *v.* Tilghman's Patent Sand Blast Co., 25 C. D. 1; 53 L. J. Ch. 1; 49 L. T. 451; 32 W. R. 71 - - - - - - 446
Société Anonyme des Verreries de l'Etoile, (1894) 1 Ch. 61; W. N. (1894) 42; 10 R. P. C. 436; 11 R. P. C. 142; 10 Times L. R. 314 - 163, 184, 200, 223, 229, 308, 352, 505
Société Anonyme des Verreries de l'Etoile's Tm., 10 R. P. C. 290 - - - - - - - - 241
Somerville *v.* Schembri, 12 App. Cas. 453; 4 R. P. C. 179; 56 L. J. P. C. 61; 56 L. T. 454; 3 Times L. R. 443 - 31, 87, 381
Soper; Malachy *v.*
Southern *v.* How, Cro. Jac. 471; 2 Rolle, 28; Popham, 144 - 2
Southorn *v.* Reynolds, 12 L. T. (N. S.) 75 - 303, 360, 394, 425
Souvazoglu; Harter *v.*

PAGE

Spalding; Reinhardt *v.*
Sparling; Duncan *v.*
Speer's Tm., 4 R. P. C. 521; 55 L. T. 880 - 183, 194, 200, 207
Spence & Co.; Singer Manufacturing Co. *v.*
Spencer's Tm., 3 R. P. C. 73; 54 L. T. 659; 2 Times L. R. 243; 3 Times L. R. 270 - - - - 158, 160
Sphincter Co.'s Tm., 10 R. P. C. 84 - - - 126, 132
Spratt's Patent *v.* Ward & Co., 11 C. D. 240; 48 L. J. Ch. 649; 40 L. T. 250; 27 W. R. 470 - - - - - 298
Springhead Spinning Co. *v.* Riley, L. R. 6 Eq. 551; 37 L. J. Ch. 889; 19 L. T. (N. S.) 64; 16 W. R. 1138 - - - 389
Standish *v.* Whitwell, 14 W. R. 512 - - - 325, 366
Starey *v.* Chilworth Gunpowder Co., 24 Q. B. D. 90; 59 L. J. M. C. 13; 62 L. T. 73; 38 W. R. 204; 54 J. P. 436 - 49, 433, 474, 492, 508
Stark *v.* Midland Rail. Co., 16 C. D. 81 - - - 363
Steinway *v.* Henshaw, 5 R. P. C. 77 - - - - 208
Stephens, *Ex parte*, 3 C. D. 659; 46 L. J. Ch. 46; 24 W. R. 963 - - 9, 114, 117, 129, 140, 144, 153, 165, 476, 491
Stephens; Eno *v.*
Stephens; Queen *v.*
Stephens *v.* Peel, 16 L. T. (N. S.) 145 - - - - 412
Stevens *v.* Paine, 18 L. T. (N. S.) 600 - - - - 388
Stock; Blair *v.*
Strange; Albert (Prince) *v.*
Street *v.* Blay, 2 B. & Ad. 460 - - - - - 436
Street *v.* Union Bank of Spain and England, 30 C. D. 156; 55 L. J. Ch. 31; 53 L. T. 262; 33 W. R. 901 - - 402, 415
Stribold; Davis *v.*
Stringer's Application, 8 R. P. C. 445 - - - - 82
Stuart & Co. *v.* Scottish Val de Travers Paving Co., 13 Sess. Cas. 4th Ser. 1 - - - - - 149, 151, 304
Sun Life Assurance Co.; Saunders *v.*
Sweet; Archbold *v.*
Swift Specific Co.'s Tm., 6 R. P. C. 352 - - 83, 209
Swinburne; Gridley *v.*
Swiss Condensed Milk Co.; Anglo-Swiss Condensed Milk Co. *v.*
Sykes' Tms., 43 L. T. 626; 29 W. R. 235 - - - 104, 182
Sykes *v.* Sykes, 3 B. & Cr. 541; 3 L. J. K. B. (O. S.) 46 - 3, 29, 33, 342, 360
Symington *v.* Footman, 56 L. T. 696 - - - - 404

Talbot's Tm., 11 R. P. C. 77; W. N. (1894) 12 - 151, 152, 206, 229, 245
Talbot *v.* Webley, 3 R. P. C. 276 - - 158, 159, 310
Taylor's Drug Co.; Humphries *v.*
Taylor; Condy *v.*
Taylor; Harrison *v.*
Taylor *v.* Taylor, 23 L. J. Ch. 255; 2 Eq. Rep. 290; 22 L. T. (O. S.) 271 - - - - 313, 414, 425, 426
Teedo; India and China Tea Co. *v.*
Thewlis and Blakey's Tm., 10 R. P. C. 369 - 123, 197, 201, 242
Thomas *v.* Williams, 14 C. D. 864; 49 L. J. Ch. 605; 43 L. T. 91; 28 W. R. 983 - - - - - 441, 446
Thompson's Tm., 6 R. P. C. 213 - - - - 151

PAGE
Thompson *v.* Bent's Brewery Co., Ltd., 8 R. P. C. 479 - - 429
Thompson; Isaacson *v.*
Thompson *v.* Montgomery, (1891) A. C. 217; 41 C. D. 35; 6 R. P. C. 213, 404; 8 R. P. C. 361; 58 L. J. Ch. 93, 374; 60 L. J. Ch. 757; 64 L. T. 748; 5 Times L. R. 51, 305 - 29, 32, 44, 45, 86, 124, 127, 172, 225, 227, 228, 245
Thorley's Cattle Food Co. *v.* Massam, 6 C. D. 582; 14 C. D. 763; 46 L. J. Ch. 713; 41 L. T. 543; 42 L. T. 851; 28 W. R. 295, 966 - - - - - - 440, 446
Thorneloe *v.* Hill, W. N. (1894) 15 - - - - 392
Three Towns Banking Co. *v.* Maddever, 27 C. D. 533 - - 333
Thynne *v.* Shove, 45 C. D. 577; 49 L. J. Ch. 509 - - 278, 418
Tilghman's Patent Sand Blast Co.; Société Anonymo des Manufactures des Glaces *v.*
Tipping *v.* Clarke, 2 Haro, 383 - - - - 451
Tonge; Kearley *v.*
Tonge *v.* Ward, 21 L. T. (N. S.) 480 - 307, 349, 363, 364
Towgood Bros. *v.* Pirie & Sons, 4 R. P. C. 67; 56 L. T. 394; 35 W. R. 729; 3 Times L. R. 356 - - - - 143
Townsend *v.* Read, 10 C. B. N. S. 317; 30 L. J. M. C. 245 - 495
Trott; Pinto *v.*
Truefitt; Perry *v.*
Tuck & Sons *v.* Priester, 19 Q. B. D. 629; 56 L. J. Q. B. 553 - 451
Turner; Beard *v.*
Turney & Sons' Tm., 11 R. P. C. 37; 10 Times L. R. 175 - 163, 181, 207, 308
Turpin; Dent *v.*
Turton *v.* Turton, 42 C. D. 128; 58 L. J. Ch. 677; 61 L. T. 571, 575; 38 W. R. 22 - 16, 17, 44, 330, 378, 384, 385, 400, 421, 423, 425, 426, 427
Tussaud; Monson *v.*
Tussaud *v.* Tussaud, 44 C. D. 678; 59 L. J. Ch. 631; 62 L. T. 633; 38 W. R. 503 - - - 168, 330, 399, 424, 425
Twentsche Stoom Bleekery Goor *v.* Ellinger & Co., 26 W. R. 70 - - - - - - 264, 300, 307
Tyler; Queen *v.*

Ullmer; Guinness *v.*
Union Bank of Spain and England; Street *v.*
United Telephone Co. *v.* Dale, 25 C. D. 778 - - - 355
United Vineyards, &c. Co. (1889) - - - - - 325
Upmann *v.* Elkam, L. R. 7 Ch. 130; L. R. 12 Eq. 140; 41 L. J. Ch. 246; 25 L. T. (N. S.) 813; 20 W. R. 131 - 349, 357, 358, 359, 365
Upmann *v.* Forester, 24 C. D. 231; 52 L. J. Ch. 946; 49 L. T. 122; 32 W. R. 28 - 300, 307, 318, 349, 359, 364, 519
Upper Assam Tea Co. *v.* Herbert & Co., 7 R. P. C. 183 - 182, 208, 315, 327

Vagliano Bros.; The Governor and Company of the Bank of England *v.*
Van Duzer and Leaf's Tm., 34 C. D. 623; 4 R. P. C. 31; 55 L. J. Ch. 812; 56 L. J. Ch. 370; 56 L. T. 286; 35 W. R. 298; 2 Times L. R. 798, 863; 3 Times L. R. 322 - 8, 10, 86, 112, 140, 142, 143, 145, 147, 151, 152, 153, 158, 263, 382

PAGE

Venning; Goodwin *v.*
Vernon *v.* Hallam, 34 C. D. 748; 56 L. J. Ch. 115; 55 L. T. (N. S.) 676; 35 W. R. 156 - - - - 388, 418
Vick; Edelsten *v.*
Vignier's Tm., 6 R. P. C. 490; 61 L. T. 495; 5 Times L. R. 686 - - - - - - 136, 145, 459
Vining; Nuthall *v.*

Walkdon, &c. Co.'s Application, 54 L. J. Ch. 394, n. - 172, 177
Walker *v.* Baird, (1892) A. C. 491; 61 L. J. P. C. 92; 67 L. T. 513 - - - - - 457, 530, 539
Walker; Cheavin *v.*
Walker; Levy *v.*
Walker *v.* Mottram, 19 C. D. 355; 51 L. J. Ch. 108; 45 L. T. (N. S.) 659; 30 W. R. 165 - - - - - 419
Walmsley; Ainsworth *v.*
Walter *v.* Emmott, 54 L. J. Ch. 1059; 53 L. T. 437 - - 403
Ward *v.* Beeton, L. R. 19 Eq. 207; 23 W. R. 533 - - 410
Ward & Co.; Spratt's Patent *v.*
Ward, Sturt and Sharp, *Re*, 50 L. J. Ch. 347; 44 L. T. (N. S.) 97; 29 W. R. 395 - - - - 104, 111, 231, 233
Ward; Tonge *v.*
Warner *v.* Warner, 5 Times L. R. 327, 359 - 401, 421, 424
Waterman *v.* Ayres, 39 C. D. 29; 5 R. P. C. 368; 57 L. J. Ch. 893; 59 L. T. 17; 37 W. R. 110; 4 Times L. R. 533 - 119, 144, 145, 146, 152, 202
Watt *v.* O'Hanlon, 4 R. P. C. 1 - - 156, 203, 314
Weaver; Franks *v.*
Webley; Talbot *v.*
Webster *v.* Webster, 3 Swan. 490 - - - - 273, 418
Weild; Wren *v.*
Welch *v.* Knott, 4 K. & J. 747; 4 Jur. (N. S.) 330 - 306, 310
Welcome's Tm., 32 C. D. 213; 3 R. P. C. 76; 55 L. J. Ch. 542; 54 L. T. 493; 34 W. R. 453 - 62, 236, 277, 288, 291
Weldon *v.* Dicks, 10 C. D. 247; 48 L. J. Ch. 201; 39 L. T. 467; 27 W. R. 639 - - - - - 332, 333
West Hartlepool Rail. Co.; Coleman *v.*
Wheat *v.* Brown (1892), 1 Q. B. 418; 61 L. J. M. C. 94; 66 L. T. 464; 40 W. R. 462; 56 J. P. 153 - - - - 511
Wheeldon; The Pharmaceutical Society *v.*
Wheeler and Wilson Manufacturing Co. *v.* Shakespear, 39 L. J. Ch. 36 - - - - - - 43, 202, 388
Whetham; Pooley's Trustee *v.*
White; Lazenby *v.*
White; Mellin *v.*
White Rose Tm., 30 C. D. 505; 54 L. J. Ch. 961; 53 L. T. 33; 33 W. R. 796 - - - - - - 178, 208
Whiteley's Tm., 43 L. T. 627, n.; 29 W. R. 235, n. - - 182
Whitstable. See *Free Fishers, &c.* v. *Elliot.*
Whitwell; Standish *v.*
Wilkinson *v.* Griffith, 8 R. P. C. 370 - 187, 193, 197, 200, 204, 207, 208, 328, 352
Williams *v.* Hodge, 4 Times L. R. 175 - - - 389, 416

PAGE

Williamson; Richards *v.*
Willmott *v.* Barber, 15 C. D. 96; 17 C. D. 772 - - 331, 518
Wills' Tms., (1892) 3 Ch. 201; 9 R. P. C. 346; 61 L. J. Ch. 546; 67 L. T. 453 - - - - 242, 374, 376
Wills' Tm., *Re*, (1893) 2 Ch. 262; 10 R. P. C. 269; 62 L. J. Ch. 545; 68 L. T. 793 - - - 203, 214, 259, 345
Wilson; Fenner *v.*
Winchester; Graveley *v.*
Winchester; Longman *v.*
Winyard; Yount *v.*
Witt *v.* Concoran, 2 C. D. 69; 45 L. J. Ch. 603; 34 L. T. (N. S.) 550; 24 W. R. 501 - - - - 389, 419, 426
Wittingham; Cooper *v.*
Wolmershausen *v.* G. S. Wolmershausen & Co., Ltd., W. N. (1892) 87 - - - - - - - 399
Wolmershausen *v.* O'Connor, 36 L. T. (N. S.) 921 - - - 387
Wood's Tm. See *Wood* v. *Butler.*
Wood *v.* Burgess, 24 Q. B. D. 162; 59 L. J. M. C. 11; 61 L. T. 593; 38 W. R. 311 - - - - 474, 507
Wood *v.* Butler } 32 C. D. 247; 3 R. P. C. 81; 55 L. J. Ch.
Wood *v.* Lambert } 377; 54 L. T. 314; 1 Times L. R. 435; 2 Times L. R. 232 - 119, 155, 201, 259, 285, 338, 339, 346, 406
Wood; Metzler *v.*
Woodroffe; Harrison *v.*
Woollam *v.* Radcliff, 1 H. & M. 259 - - 315, 408, 413
Woolley *v.* Broad, (1892) 1 Q. B. 806; 9 R. P. C. 208, 429; 40 W. R. 511; 8 Times L. R. 213 - - 80, 282, 302
Worthington's Tm., 14 C. D. 8; 49 L. J. Ch. 646; 42 L. T. 563; 28 W. R. 747 - - - - 163, 195, 207
Wotherspoon *v.* Currie, L. R. 5 H. L. 508; 42 L. J. Ch. 130; 22 L. T. (N. S.) 443; 27 L. T. (N. S.) 393; 18 W. R. 942 - 46, 148, 187, 204, 316, 321, 404, 405
Wragg's Tms., 29 C. D. 551; 54 L. J. Ch. 391; 52 L. T. 467; 1 Times L. R. 268 - - - 172, 177, 259, 260
Wren *v.* Weild, L. R. 4 Q. B. 213, 730; 38 L. J. Q. B. 88; 20 L. T. (N. S.) 277 - - - - - - 439
Wriggleworth *v.* Dallison, Doug. 201; 1 Sm. L. C. 8th ed., p. 569 - - - - - - - - 485
Wright; Martin *v.*

Yates; Dicks *v.*
Yountt *v.* Winyard, 1 Jac. & W. 394 - - - - 451
Young; Callow *v.*
Young *v.* Macrae, 9 Jur. (N. S.) 322 - - - 43, 142
Younge; Blyth *v.*

TABLE OF STATUTES.

PAGE

2 Hen. 6, c. 17 711
21 James 1, c. 31 (local) 91
12 & 13 Will. 3, c. 4 711
1 Anne, c. 3 711
5 Geo. 1, c. 11 475
6 Geo. 1, c. 11 712
4 Geo. 2, c. 14 475
12 Geo. 2, c. 26 .....711, 712
17 Geo. 2, c. 30 711
18 Geo. 2, c. 24 711
13 Geo. 3, c. 52 711
17 Geo. 3,
c. 11 714
c. 29 475
24 Geo. 3, sess. 2, c. 53 ....712, 713
30 Geo. 3, c. 31 712
31 Geo. 3, c. 58 (local) 92, 545
36 Geo. 3, c. 60 710
38 Geo. 3, c. 69 712
41 Geo. 3, c. 97 (local) 92
53 Geo. 3, c. 115 510
54 Geo. 3,
c. 119 (local) 92, 544
c. 123 711
59 Geo. 3, c. 7 510
5 Geo. 4, c. lii (local) 711
6 & 7 Will. 4, c. 37 .....475, 710
5 & 6 Vict.
c. 45 265
c. 47 712
c. 56 712
7 & 8 Vict. c. 22 712
11 & 12 Vict. c. 43 517
16 & 17 Vict. c. 107 710
17 & 18 Vict.
c. 96 712
c. 104 710
18 & 19 Vict. c. 6. 712
20 & 21 Vict. c. 4 520
22 & 23 Vict. c. 1, ... 517
23 Vict. c. xliii (local) 93
24 & 25 Vict.
c. 96 .....506, 507
c. 97 507

24 & 25 Vict. PAGE
c. 98 .....469, 506, 507
c. 99 506
25 & 26 Vict.
c. 22 710
c. 88 (Merchandise Marks Act, 1862) 7
s. 1 .....26, 49
ss. 2, 3 18
s. 5 472
s. 6 512
s. 7 .....22, 475, 488
s. 9 499
s. 12 507
s. 13 504
s. 18 517
s. 19 .....7, 431
s. 21 ..7, 348, 357, 375, 514
s. 25 94
c. 89 (Companies Act, 1862) . 54, 220, 243, 395, 531
26 & 27 Vict.
c. 7 714
c. 119 711
27 & 28 Vict. c. 56 710
29 & 30 Vict. c. 37 .....433, n., 711
31 & 32 Vict. c. 121 501
32 & 33 Vict. c. 112 475
36 & 37 Vict. c. 66 .....238, 334, 336
37 & 38 Vict.
c. 49 475
c. 51 ..... 433, n., 710
38 & 39 Vict.
c. 17 711
c. 25 .....506, 713
c. 63 ..475, 500, 504, 505, 507, 516
c. 77 .....245, 334, 336
c. 91 (Trade Marks Act, 1875) 8, 587
s. 1 .....52, 261, 382
s. 2 ..51, 87, 89, 179, 272, 287
s. 3 ....8, 51, 179, 255, 260
s. 5 .....66, 176, 220, 224
s. 6 ..95, 176, 178, 180, 183, 209

33 & 39 Vict. PAGE
c. 91 (Trade Marks Act, 1875),
s. 7 52
s. 8 377
s. 9 .....94, 95
s. 10 .... 9, 26, 28, 49, 107, 109, 142—152, 154, 165, 248, 254
39 & 40 Vict.
c. 33 (Trade Marks Act, 1876) 8, 9, 67, 261
c. 35 .....523, 712
c. 36 ..18, 238, 527, 710, 711, 713
40 & 41 Vict. c. 13 538
41 & 42 Vict. c. 49 714
42 & 43 Vict.
c. 30 475
c. 49 .....515, 516, 519, 520
44 & 45 Vict. c. 58 713
45 & 46 Vict. c. 41 711
46 & 47 Vict.
c. 55 .....523, 529
c. 57 (Patents, &c. Act, 1883) *see p.* 547

PAGE
48 & 49 Vict. c. 51 475
50 & 51 Vict.
c. 28 (Merchandise Marks Act, 1887) .....*see p.* 666
c. 29 ....475, 504, 507, 510, 711
51 & 52 Vict.
c. 43 298
c. 50 (Patents, &c. Act, 1888) *see pp.* 547, 579
52 & 53 Vict.
c. 21 714
c. 63 463
53 Vict. c. 8 712
53 & 54 Vict.
c. 37 505
c. 44 364
54 Vict. c. 15 (Merchandise Marks Act, 1891) ..*see p.* 677
56 & 57 Vict.
c. 56 475
c. 61 538

ERRATUM.

Page 238, note (*e*), the reference for *Welcome's Tm.* should be 32 C. D. 213; 3 R. P. C. 76.

Book I.

THE LAW OF TRADE-MARKS.

CHAPTER I.

INTRODUCTION.

	PAGE
1. Trade-marks before the Registration Acts	1
2. Registration of trade-marks	5
3. Passing off and trade-name actions	12
4. The Criminal Law of false marking	17
5. International and Colonial arrangements	21

1. Trade-Marks before the Registration Acts.

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

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

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

(*a*) *Singer Manufacturing Co.* v. *Loog*, 18 C. D. p. 412 (1880).

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

Early trade-mark cases at law and in equity.

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

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

(*b*) Popham, 144; Cro. Jac. 471; 2 Rolle, 28.

(*c*) Popham, p. 144.

(*d*) Cro. Jac. 471.

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

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

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

Early cases at common law.

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

Sykes v. *Sykes*.

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

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

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

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

Inferiority of the infringer's goods.

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

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

An important step was taken in 1838, by the decision of Lord Cottenham in *Millington* v. *Fox* (*o*), that an injunction could be obtained to restrain infringement of a trade-mark, even though the infringement was due to ignorance, and was without fraudulent intent. This decision led, by an obvious deduction, to the establishment of a right of property in trade-marks; and, although the nature of this right gave rise to much discussion, and was

Property in a trade-mark.

defined in different terms by Chancery judges in subse-

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

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

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

(*n*) See per Lord Blackburn in *Singer Manufacturing Co.* v. *Loog*, 8 App. Ca. p. 30.

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

quent cases, it soon became firmly established, and the protection of trade-marks in equity was expressly based upon it (*p*). No similar step was taken by the common law courts, and in them fraud remained an essential ingredient of a cause of action for the infringement of a trade-mark down to the date of the amalgamation effected by the Judicature Acts.

2. Registration of Trade-Marks.

Development of the specialized action of infringement.

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

Difficulty and cost of the old trade-mark suits.

The litigation of trade-mark cases was, however, found to be extremely costly, and otherwise unsatisfactory. The essence of a trade-mark right being the reputed association in the market of the symbol in question with the goods of

(*p*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Hall* v. *Burrows*, 4 De G. & S. 150; 32 L. J. Ch. 548; 33 L. J. Ch. 204; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; 32 L. J. Ch. 721; 33 L. J. Ch. 199; 35 L. J. Ch. 53 (all in 1863).

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

The Committee of 1862.

These evils, and the unsatisfactory state of the law in regard to the false marking of goods in general, led to an urgent demand from the traders of the country for more efficient protection, and in 1862 a Select Committee of the House of Commons were appointed to consider several trade-marks and merchandise-marks Bills then before Parliament. The Committee were strongly urged to report in favour of the establishment of a register of

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

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

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

The Merchandise Marks Act of 1862.

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

(*s*) See "Sheffield Marks," below, p. 91.

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

(*u*) Sect. 19, see now M. M. A., 1887, s. 17; Chap. XVII., p. 431.

(*x*) Sect. 22.

(*y*) Sect. 21.

criminal law effected by the Act, and which are referred to in a later section of this chapter.

The Registration Act of 1875.

Thirteen years later the Trade-Marks Registration Act, 1875 (*z*), which came into operation on the 13th of August, 1875, established the present register of trade-marks. The object of the Act was two-fold; it was directed, on the one hand, to diminish the difficulty and cost of, or to altogether remove the necessity for the proof of title by use and reputation, which had cast so great a burden upon the owners of trade-marks in proceedings to restrain infringement, and, on the other, to secure the publication of marks which had been appropriated as trade-marks, and to define the rights of their proprietors, for the information of traders, and, further, to limit the classes of marks which should be capable of being so appropriated (*a*). The Act, accordingly, provided that registration should be *primâ facie* evidence of the right of the registered proprietor to the exclusive use of the trade-mark (*b*) in connection with goods of the class for which it was registered and used (*c*), and should, after the expiration of five years, be conclusive evidence of such right, so long as the trade-mark remained upon the register (*d*); provided that the proprietor of the mark remained the owner of the goodwill of the business in which it was used. And, with a view to compelling registration, the Act provided that from and after the 1st of July, 1876 (a date which was extended by the amending Acts (*e*)), a person should not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by the Act until and unless such trade-mark was registered in pursuance of the Act, or, according to a

(*z*) 38 & 39 Vict. c. 91. See the chapter on "The Register," below, p. 52.

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

(*b*) Sect. 3.

(*c*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.; below, p. 257.

(*d*) *Palmer's Tm.*, 21 C. D. 47; 24 C. D. 504 (1882), C. A.; below, p. 258.

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

subsequent modification, in the case of any mark in use as a trade-mark before the passing of the Act of 1875, until and unless registration of the mark as a trade-mark should have been refused (*f*).

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

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

The Act attained a considerable measure of success, and 27,844 trade-marks were registered under it, but its provisions did not allow words to be registered as trade-marks (*h*) unless they were old marks, or were registered in combination with one or more of the enumerated essential particulars; and as word-marks are exceedingly popular in this country, and were admitted and protected as trade-marks abroad, an alteration of the definition clause was determined upon (*i*). This was effected by the Patents, Designs, and Trade-Marks Act, 1883 (*j*), which came into operation on the 1st of January, 1884. The new Act repealed the Act of 1875, with its amending Acts of 1876 and 1877, but re-enacted, in substance, their principal provisions. It directed that the register of trade-marks, of which the old register is to be deemed to be a part (*k*), should be kept at the Patent Office established by the

The Registration Act of 1883.

(*f*) 39 & 40 Vict. c. 33, s. 1. See now sect. 77 of the Act of 1883, below, p. 260.

(*g*) Sect. 10.

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

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

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

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

Act (*l*), and should be under the control of the Comptroller-General of Patents, Designs, and Trade-marks, who acts under the superintendence and direction of the Board of Trade (*m*). It also introduced a number of new rules and provisions to regulate applications for, oppositions to, and rectifications of registration, and effected important changes with regard to the Sheffield cutlery marks (*n*), which the older Act had, substantially, left untouched.

"Fancy words" allowed to be registered.

The most material alteration introduced by the Act of 1883 was the power it conferred to register a mark of which the essential particular should be a "fancy word or fancy words not in common use." What was intended by a fancy word not in common use the Act did not define, and the omission was the cause of a great deal of litigation; but a fairly definite meaning was at length put upon the phrase by the Court of Appeal, in the *Melrose* hair restorer, and the *Electric* velveteen cases (*o*). To fall within the meaning, a word must, the Lords Justices held, be "obviously not intended to be descriptive," and must "speak for itself and be a fancy word of its own inherent strength," and be "so obviously and notoriously inappropriate as neither to be deceptive or descriptive, nor calculated to suggest deception or description."

Lord Herschell's Committee, 1887.

Soon after the decisions just referred to, a very distinguished Committee, presided over by Lord Herschell, were appointed by the Board of Trade to inquire into the duties, organization, and arrangements of the Patent Office under the Act of 1883, as far as related to trade-marks and designs, and in August, 1887, the Committee presented an interim, and in March, 1888, a final report, dealing not only with the matters specified, but with the general question of the registration of trade-marks. These important reports are frequently referred to in subsequent pages of this book, and it will be sufficient here to refer to

(*l*) Sect. 78.
(*m*) Sect. 82.
(*n*) Sect. 81, see below, p. 91.
(*o*) *Van Duzer and Leaf's Tms.*, 34 C. D. 623; 4 R. P. C. 31 (1887). See below, p. 143.

a few only of the suggestions made by the Committee. They recommended that a new definition clause should be enacted, stating what symbols might be registered, and substituting for the fancy-word phrase in the Act of 1883 the phrases "An invented word or invented words; or a word or words having no reference to the character or quality of the goods, and not being a geographical name" (*p*), and that additions to registered trade-marks (that is, matter other than their essential particulars registered with them) should be expressly disclaimed by the applicants for registration (*p*). The alterations and some minor changes were passed into law by the amending Act of 1888 (*q*), which came into operation on the 1st of January, 1889.

Invented word or words.

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

Doubtful marks to be rejected.

(*p*) Act of 1888, s. 10.
(*q*) 51 & 52 Vict. c. 50.
(*r*) Interim Report, par. (2).
(*s*) *Eno* v. *Dunn*, 15 App. Ca. 253; 7 R. P. C. 311. (*Fruit-Salt Baking Powder.*)

made the choice of a new trade-mark, or the registration of an existing one, often a matter of considerable uncertainty and trouble.

Unregistered trade-marks are still numerous.

Down to the end of the year 1892, 70,625 trade-marks had been registered under the Acts, and some five or six thousand applications are annually made for registration (*t*); but a very large number of trade-marks in actual use in the country still remain unregistered, either because they are not capable of registration for the reason that they do not fall within the definition clause of the Act (*u*), or because their proprietors do not think it worth while to seek to register them. These unregistered trade-marks, notwithstanding the prohibitory sections of the Acts (*x*) already mentioned, which make registration, in general, a condition precedent to litigation to restrain or to obtain damages for infringement, are in many cases to a great extent protected by the Courts in the passing off actions, next to be referred to. For it is now well settled that if the use by the defendant upon his goods of an unregistered trade-mark belonging to the plaintiff is calculated to pass off or cause to be passed off the defendant's goods as the goods of the plaintiff, an injunction may be granted to restrain such use (*y*), and this whether the use be deliberately fraudulent and intended by the defendant to be deceptive, or not (*z*).

3. Passing off and Trade-name Actions.

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

(*t*) Comptroller's Report for 1892.

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

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

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

(*z*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503; C. A., see below, p. 265.

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

(*b*) See the next chapter.

the decisions upon them, the conditions under which a right of property in a trade-mark may be acquired, and the manner and degree in which it will be protected, have been fully established; but the symbol which a trader adopts as his trade-mark is only one of the badges or *indicia* by which his trade and the goods he deals in are identified with him, and distinguished from the trade of his rivals in business and similar goods which are not his but theirs. These badges are generally numerous, and they comprise in particular the name under which he trades, that is, his trade-name; the names or titles by which his goods are referred to, that is, the trade-name of his goods; and the fashion or "get up" in which the goods appear in the market, so far as these are distinctive of his trade and goods. The principles of the decisions cited above, from which the law of trade-marks was specialized, apply to these cases—of "trade-name" and "passing off" as they are comprehensively termed—also; but the law applicable to them is not so clearly ascertained, and chiefly because, in the earlier stages of its development, the distinction between trade-mark and trade-name was not adverted to. Now, however, when trade-marks, unless registered, cannot generally be protected as such, the distinction must not be overlooked. The first reported judgment in which the two classes of cases were formally contrasted is that of Jessel, M. R., in *The Singer Manufacturing Co.* v. *Wilson* (*c*). "The cases which have come before the Court," the late Master of the Rolls said, "may, I think, be conveniently divided into two classes; the first class, which is the more numerous one, consists of cases where the goods manufactured are distinguished by some description or device in some way or other affixed to the article sold. It may be, as I said before, description, that is, it may consist of a name or names, or a lengthy description consisting of names with superadded words, and that description may be either affixed to, or impressed upon, the goods them-

Trade-names and "get up."

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

(*c*) 2 C. D. 434 (1874).

"selves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods. Now, as to this class, it is quite immaterial that the maker of the goods to which—what I will call for the sake of shortness—the trade-mark is affixed did not know that it was a trade-mark, and had not the slightest intention of defrauding anybody.

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

It will be seen that the late Master of the Rolls here limited the right to redress in the second class of cases to cases where the defendants had acted with fraudulent intentions, and for the purpose of deceiving the customers, or intending customers, of the plaintiffs, and in this his judgment was endorsed and approved by the Court of Appeal (*e*). In the House of Lords, however, this distinction between the two classes of cases was not accepted. Lord Cairns said there was no such difference in point of principle (*f*), and that, since the decision in *Millington* v. *Fox* (*g*), it was necessary neither to aver nor to prove fraud. "In the present case," he added, "the question must, as it seems to me, be: Are the advertisements of the defendant, having

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

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

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

(*f*) 3 App. Ca. p. 389 (1877).

(*g*) Above, p. 4.

"regard to the evidence in the case, calculated to mislead an unwary purchaser of the machines." In this opinion Lord O'Hagan concurred, but Lord Blackburn expressed considerable doubt on the subject, and the remaining judge, Lord Gordon, refrained from discussing it.

The question whether—in order to restrain the defendant from continuing conduct which leads, or is calculated to lead, the public, or some class of the public, to buy his goods as and for those of the plaintiff—it is necessary for the latter to prove that the deception was fraudulently sought and intended by the defendant, came up again in *Singer Manufacturing Company* v. *Loog* (*h*); and, although the case was decided on the ground that the evidence showed that the conduct of the defendant in question was not, in fact, calculated to deceive, several of the judgments delivered contain passages which are in accordance with Lord Cairns' opinion. James, L. J., summed up the law in the words quoted at the beginning of this chapter; and Lord Selborne used language to the same effect. "It was contended" (*i*), he said, "that the acts of the defendant enabled his wholesale customers to show these documents to their own retail customers, for the purpose of passing off the goods bought from the defendant as the plaintiffs' manufacture. The answer is, that, unless the documents were fabricated with a view to such a fraudulent use of them, or *unless they were in themselves of such a nature as to suggest, or readily and easily lend themselves to such a fraud*, . . . the supposed consequence is too remote, speculative, and improbable to be imputed to the defendant, or to be a ground for the interference of a court of justice with the course of the defendant's business."

And it may now be taken as settled that (*k*), even where there is no question of a registered trade-mark, a trader will not be allowed to act in a manner which leads, or is

(*h*) 18 C. D. 395 (1879); 8 App. Ca. 15 (1882).

(*i*) 8 App. Ca. p. 21.

(*k*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.

calculated to lead, to deception, although the deception is entirely unintended by him, unless he has some special justification for his conduct, as, for instance, an independent right to use a name similar to the plaintiff's name (*l*). He does, in fact, commit a fraud when he continues his conduct after discovering its dangerous character (*m*).

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

Trade-names.

The protection of the trade-names of individuals, firms, and companies from deceptive imitations is an important application of the principles just stated (*o*); and in connection with them, the chief practical exception to the rule that the defendant will not be allowed to continue conduct

(*l*) See *Turton* v. *Turton*, 42 C. D. 128 (1889), C. A., and below, pp. 420 *et seq.*

(*m*) See below, p. 317.

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

(*o*) See below, Chap. XVI., p. 379.

which is calculated to lead to his goods or trade being taken to be the goods or trade of the plaintiff, is found in the rule that a man may honestly trade under his own name, and describe his goods by it, whatever the consequences may be (*p*).

Right to trade under one's own name.

4. The Criminal Law of False Marking.

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

(*p*) See *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), L.JJ.; *Turton* v. *Turton*, 42 C. D. 128 (1889), C. A.; *Saunders* v. *Sun Life Assurance Co.*, (1893) W. N. 190. See below, pp. 420 *et seq.*

(*q*) See below, p. 544.

(*r*) See Book II., p. 469.

(*s*) Above, p. 7.

(*t*) Merchandise Marks Act, 1887, s. 3.

law was wholly inadequate to cope with these evils. Unfortunately, however, the committee declined several drastic proposals for amendment, which were afterwards adopted with conspicuous success in the Merchandise Marks Act of 1887, as they refused to recommend the establishment of a register of trade-marks, and the Act, which was passed upon their report, the Merchandise Marks Act of 1862, was, it is believed, a dead letter from its first enactment. At any rate, when another committee on merchandise marks were appointed, in 1887, complaints, precisely similar to those made to the former committee, were urgently repeated to them.

The Merchandise Marks Act of 1862.

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

The International Convention.

In 1884 Great Britain acceded to the International Convention for the protection of industrial property, to which all important civilized states, except Germany, Austria and Russia, now belong (*z*), and thereby formally engaged to co-operate in the execution of the stipulations contained in the convention and protocol (*a*) agreed upon

(*u*) Sect. 2.

(*x*) Sect. 3.

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

(*z*) See list, Appendix, p. 656.

(*a*) See Appendix, p. 658.

between the original parties thereto, at Paris, in the previous year. And by Article IX. of the convention, it is provided that all goods illegally bearing a trade-mark or trade-name may be seized on importation into those States of the Union where the mark or name has a right to legal protection, and that the seizure shall be effected at the request of either the proper public department, or of the interested party, pursuant to the internal legislation of each country. It became necessary, accordingly, to amend the law, and out of several bills introduced into Parliament for this purpose, the Committee of the House of Commons selected and amended the Merchandise Marks Law Consolidation and Amendment Bill, which subsequently became the Merchandise Marks Act of 1887.

The Merchandise Marks Act of 1887.

The last-mentioned Act (*b*) provides that any person shall be guilty of an offence, punishable on indictment or on summary conviction by fine or imprisonment, who either (1) forges a trade-mark by making or imitating it without the consent of the proprietor, or by falsifying any genuine mark; or (2) falsely applies any trade-mark to goods, by applying it, or an imitation of it, without the consent of the proprietor; or (3) applies to goods any false trade description, that is, a description or indication as to the number, quantity, measure, &c., or the place or country of origin of the goods, or the mode of manufacturing them, or their material, or as to their being the subject of an existing patent, privilege, or copyright, which is false in a material respect; or (4) sells or exposes, or has in his possession for sale, or any purpose of sale or manufacture, any goods to which a forged trade-mark or false trade description is applied, or to which any trade-mark, or imitation of a trade-mark, is falsely applied (*c*). A criminal intention on the part of the person charged is a necessary element of each of the offences (*d*), but the

(*b*) See Book II., Chap. I., p. 462.

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

(*d*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L.C.J., and Grantham, J.; and see below, p. 508.

burden of proving that he has acted with the consent of the proprietor of the trade-mark, or without intent to defraud, or otherwise innocently, as also the burden of establishing any of the special excuses allowed by the Act, is cast upon the person charged as soon as it is established that he has done any of the acts which, coupled with such criminal intention and in the absence of these excuses, bring him within the definition of an offence under the statute. The Act, moreover, forbids (*e*) the importation of goods by means of or in relation to which an offence against it has been committed, and also of all goods of foreign manufacture bearing any name or trade-mark being or purporting to be that of a manufacturer or trader within the country, unless it be accompanied by a definite indication of the country where the goods were made or produced. It contains also some special provisions with regard to the marking of watch cases.

The Act is only directed against false marking.

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

The Merchandise Marks Act Committee of 1890.

The Act appears to have attained a considerable success, but it did not fully satisfy the trading community, and three years after its passing another Committee of the House of Commons were appointed to consider its working. And by their report (*g*) the Committee stated that, while there was a consensus of opinion that the Act of 1887 had generally been most beneficial to the manufacturing interests of the country, and that the importation of fraudulently marked goods, or of goods bearing a false indication of origin, had materially diminished since the Act came into operation, yet complaint had been made that its operation in regard to goods in transit to foreign states had occa-

(*e*) Sect. 16, below, p. 526.
(*f*) Below, p. 476.
(*g*) M. M. A. Report, 1890.

sioned serious inconvenience and loss to the shipping industries. This complaint, however, the Committee believed to be ill-founded, and they refused to recommend the exemption from the Act of the goods referred to. They refused also to accept either a proposal to increase the stringency of the Act by providing that all foreign goods should be marked with an indication of origin, or a proposal to relax it by allowing the general mark "made abroad," where the Act now requires the particular country of origin to be signified (*h*). On the other hand, to stop the importation of adulterated articles, which, if they bore no trade description at all, did not come under the Act, they recommended that the "Customs Entry" (*i*), in which both the description of goods imported, and the port from which they come, must be stated, should be made a "trade description" within the Act, and that, in cases affecting the general interest of the country, or of a section of the community, or of a trade, prosecutions under the Act should be undertaken by the State. The Merchandise Marks Act of 1891 was passed to carry these proposals into effect.

The Merchandise Marks Act, 1891.

5. International and Colonial Arrangements.

The owner of a trade-mark, acquired as such in England by use and consequent reputed connection with its owner, has always had the same right to protection in our Courts as a subject of the United Kingdom (*k*) (unless he happened to be an alien enemy), and neither the Registration Act of 1875, nor the Merchandise Marks Acts of 1862 or 1887 conferred any special privilege or right of protection for their trade-marks or trade-names upon subjects of this, as contrasted with subjects of other States. Many treaties existed, moreover, by which this country agreed to give to the subjects of other countries the same right of protection

(*h*) See below, p. 531.
(*i*) See below, pp. 476, 486.
(*k*) *The Collins Co.* v. *Reeves*, 23 L. J. Ch. 50 (1853), Stuart, V.-C.

in respect of their trade-marks as were enjoyed by its own subjects (*l*). On the other hand, when registration of the trade-mark concerned became, under the Acts of 1875 and 1883, in general, a condition precedent to the bringing of an action of infringement, as such (*m*), it was required in the case of foreign as well as of other plaintiffs, and the acquisition of a trade-mark abroad gave no title or right to priority of registration of a trade-mark in the English register.

When the Act of 1883 was passed the International Convention (*n*), already referred to, had just been drawn up, and in contemplation of the accession of this country thereto, which took place in the following year (*o*), sect. 103 (*p*) was inserted, with the view, apparently, of fulfilling the obligations entered into by the United Kingdom with the other contracting states. The section, however, meets those obligations but very imperfectly (*q*), and the bulk of its provisions are inapplicable to trade-marks. Its only substantial operation in regard to them, indeed, is to confer upon an applicant for the protection of a trade-mark, in one of the other contracting states, a priority over other applicants for registration here during the space of four months, without conferring any title to registration based upon the success of the application in the foreign state, or any exemption from the conditions and formalities to be fulfilled and complied with by ordinary applicants for registration here.

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

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

(*m*) Act of 1883, s. 77, Chap. XII., p. 260.

(*n*) See Appendix, p. 653.

(*o*) 17 March, 1884.

(*p*) See Chap. XX., p. 454.

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

(*r*) See the list, Appendix, p. 656.

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

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

(*t*) Below, p. 656.

(*u*) M. M. A., 1887, s. 3 (1), Book II., Chap. I., p. 465, "trade-mark."

CHAPTER II.

THE DEFINITION OF A TRADE-MARK.

PAGE

Definition 25
The Registration Acts contain no definition, but they import the old law 25
Definitions in the M. M. A., 1862 26
,, ,, M. M. A., 1887 27
Judicial definitions 27

1. What symbols may be trade-marks 28

2. Applied or attached to goods 29
the mark must go to market with the goods 29
and must sell the goods 30
trade-mark rights are restricted to the class of goods for which the mark is used 31
the use of the trade-mark on other goods is not protected .. 31
anyone may use the mark on the right goods 32

3. Offered for sale in the market 33
long user of mark or proof of actual reputation is unnecessary 34

4. The mark must be distinctive 35
what are distinctive marks 36
descriptive marks and marks apparently descriptive, but having a secondary distinctive meaning 36
name of a new pattern. *Ford* v. *Foster* 37
test whether trade-mark has become *publici juris* 37
the *Singer* cases 38
no monopoly can be maintained in the reputation of goods which anyone may make and sell 41
name of goods made under an expired patent 42
name given to a new article cannot be monopolized 43
The Linoleum Case 43
"original" 44
name of place of origin 44
"Anatolia liquorice" 45
Seixo v. *Provezende* 45
"Glenfield starch" 46
advertisement of goods not a trade-mark 47
Leather Cloth Case 47
Cheavin v. *Walker* 48

PAGE
5. Made, worked upon, imported, selected, certified, or sold .. 49
connection of the owner of the trade-mark with the goods .. 49
buyers rely on the reputation of the owner of the trade-mark .. 49
trade-mark of selector. *Hirsch* v. *Jonas* 50

6. Registered under the Acts as a trade-mark 51

Definition.

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

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

The Registration Acts contain no definition;

The Registration Acts contain no definition of what is a trade-mark, though they do contain enumerations of the classes of symbols which are capable of registration under

(*a*) Below, p. 28.
(*b*) Page 29.
(*c*) Page 33.
(*d*) Page 35.
(*e*) See Chap. XIII., Assignment and Devolution of Trade-Marks, p. 272; and *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), per Fry, L.J.
(*f*) Page 49.
(*g*) Page 51; and see Chap. XII., Effect of Registration, p. 252. As to Cutlers' corporate marks, see Chap. VI., p. 91.
(*h*) Act of 1883, s. 75; Act of 1888, s. 17. See below, p. 51; and Chap. XII., Effect of Registration, p. 252.

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

but they import the old law.

Definitions in the Merchandise Marks Act of 1862.

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

(*i*) See Chap. VIII., "What marks may be registered," p. 106.

(*k*) See below, p. 265.

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

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

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

The Merchandise Marks Act, 1887.

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

Judicial definitions.

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

Lord Westbury.

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

Bacon, V.C.

And in *Ford* v. *Foster* (*p*), Bacon, V.-C., described a trade-mark in the following terms: "The meaning and use of a trade-mark is that the same person dealing in

(*n*) Sect. 3 (1), below, p. 465.

(*o*) 4 De G. J. & S. p. 142; 33 L. J. Ch. 199 (1863).

(*p*) L. R. 7 Ch. p. 616 (1872).

"goods, no matter of what kind, whether of his own manufacture or not, having a certain defined shape, if he stamps upon them some indication that that particular article is his and his only, may thereby acquire so far an exclusive right to it that no man may imitate his mark, and the legal right goes no further than that."

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

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

A Symbol.

What symbols may be trade-marks.

Before the Trade-Marks Registration Act, 1875 (*s*), no restriction was placed upon the kind or class of symbols which, if adopted and used as a trade-mark, would be protected against infringement or piracy, except that the Courts refused to interfere where the symbols contained misrepresentation (*t*), or were, or were so used as to be, calculated to deceive, and they would, no doubt, if any case had occurred, have refused to interfere also where the symbols

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

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

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

(*t*) See below, pp. 336 *et seq.*

themselves were scandalous or indecent. The only general limit, therefore, put upon the choice of a trade-mark was that it should be capable of distinctive user in accordance with the terms of the definition (*u*).

Applied or attached to Goods (*x*).

It is immaterial whether the mark is attached to the goods or to the covering in which they are sold (*y*). It may be impressed, stamped, cut, drawn, painted, or stained on the goods themselves, as the words *Sykes' Patent* were in *Sykes* v. *Sykes* (*z*), or on their envelope, as are labels on bottles, and brands on corks, or in any other way attached to the goods, for instance, by being marked upon tallies (*a*) tied on to them, or upon reels upon which the goods are wound. All that is necessary is that there shall be some physical connection between the goods and the mark so that the mark shall go with the goods into market (*b*). A device is not a trade-mark unless it is so applied or attached, although it may be used by a trader in his advertisements, price lists, or trade circulars, so as to become commonly associated with him and his goods, as, for instance, lithographs of Millais' picture "Bubbles" are associated with Pears' Soap.

The mark must go to market with the goods;

Thus, in *Thompson* v. *Montgomery* (*c*), the ale of the plaintiffs had been known for many years as *Stone Ale*, and there was evidence that that name had been used in ordering goods from them, and in selling goods to their customers, as a description of the ale, or of a particular class of ale made by them. Beyond this there was no

(*u*) See below, p. 35.

(*x*) See the *dicta* quoted above, p. 28, and below, p. 158.

(*y*) *Singer* v. *Wilson*, 2 C. D. p. 441, Jessel, M.R., and pp. 451, 455, James and Mellish, L.JJ. (1876).

(*z*) 3 B. and Cr. 541; 3 L. J. K. B. O. S. 46 (1824).

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

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

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

evidence of the use of the name as a trade-mark, and the Court of Appeal accordingly held that the words had been wrongly claimed as a trade-mark in use before 1875, and ordered them to be removed from the register. So, in *Powell's Case* (*d*) it was decided that the use of the words *Yorkshire Relish* upon the rough packing cases in which the bottles of sauce were placed for safe carriage was not, under the circumstances of the case, use of the words as a trade-mark. "The function of a trade-mark," Bowen, L.J., said (*e*), "is to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods—to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market. Accordingly, it may either be marked on the goods themselves, or, if that is not possible or convenient, it may be marked on the vehicle of the goods, and may be, and sometimes, I dare say, is, marked upon a covering or exterior, such as a packing case. But when you are considering a mark upon the vehicle as distinct from a mark upon the goods, you must ask yourself carefully, is this mark used as a trade-mark?" And the test to be applied was otherwise stated in the same case to be the question, Does the alleged trade-mark sell the goods?

and must sell the goods.

Use on corks.

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

(*d*) Note (*b*); cf. *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A., *Monopole* used on packing cases and wine corks.

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

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

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

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

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

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

(*g*) *Somerville* v. *Schembri*, 12 App. Ca. 453 (1887), on appeal from Malta. As to registered trade marks, see below, pp. 256, 308.

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

(*i*) Per Jessel, M.R., in *Singer* v. *Wilson*, 2 C. D. p. 443 (1876). And see Chap. XV., on Infringement, below, p. 308. Cf. *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311, cited, p. 180.

(*k*) 44 L. J. Ch. 90 (1874). So, a trade mark cannot be separated from the goodwill of the business to which it has been attached: see below, pp. 272 and 287.

under the mark, as the original sauce, an imitation of his own.

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

Anyone may apply the mark to the right goods.

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

(*l*) Below, p. 49; and see Chap. XII., p. 252, Effect of Registration.

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

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

(*o*) See below, p. 314.

(*p*) See per Cotton, L.J., in *Thompson* v. *Montgomery*, 41 C. D. p. 48; 6 R. P. C. 213 (1889).

Offered for Sale in the Market.

The mark must be applied to goods offered for sale.

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

This dictum was cited with approval by Lord Cairns, in *Maxwell* v. *Hogg* (*s*). In that case the defendant registered at Stationers' Hall the word *Belgravia* as the name of an intended new mazagine, in the year 1863. In 1866 the plaintiff began to advertise a different intended new magazine under the same name. The defendant thereupon hurriedly brought out a number of his magazine in September, 1866, and the plaintiff followed in October, and cross suits were then brought by each to restrain the other from using the name. Both suits failed. The plaintiff's was dismissed because his advertisements and expenditure gave him no title to the name before the defendant's first number appeared, and the defendant's because of his uncandid conduct in rushing forward his magazine, knowing of the plaintiff's undertaking, without giving him warning. That the trader's goods should have acquired any reputation for special excellence or quality in order that his mark should be protected, was, however,

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

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

(*s*) L. R. 2 Ch. 307 (1867).

Lord Cairns declared, unnecessary; but, he said (*t*), all the definitions of trade-mark rights given in Equity, "seem to me to be opposed to the idea that protection can be given where there has been no sale or offering for sale of the articles to which the name is to be attached." According to the decisions, he added, no property in a name (or mark) could be acquired except through the process of sale or offering for sale in the market.

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

Long user of mark or proof of actual reputation unnecessary.

It is not, however, necessary that the goods should be in the market with the mark affixed for any definite or any considerable time. Thus it was no objection to the defendant's counterclaim in *Maxwell* v. *Hogg* (*y*), that he had brought out but one number of his magazine, and that only a few days before the plaintiff's issue appeared, and in the same case, as already stated, Lord Cairns decided that reputation for quality was immaterial for the acquisition of the legal right (*z*).

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

(*t*) L. R. 2 Ch. p. 314.

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

(*x*) See also *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 195, cited above, p. 30.

(*y*) L. R. 2 Ch. 307 (1867).

(*z*) So it is unnecessary for the plaintiff in an infringement action to allege that the defendant is selling inferior goods under his mark: *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. 62 (1833); *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863).

v. *Barrows* (*a*), to seek to discover when first a mark acquired a distinctive character in the market as denoting the goods of the trader who first used it.

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

Mark must be distinctive.

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

"The right which a manufacturer has in his trade-mark," Lord Cranworth said, in the *Leather Cloth Case* (*c*), "is the exclusive right to use it for the purpose of indicating where or by whom or at what manufactory the article to which it is affixed was manufactured." And the same judge, in *Farina* v. *Silverlock* (*d*), after distinguishing copyright from the right to a trade-mark, added, "anyone who has acquired a particular mode of designating his particular manufacture, has a right to say, not that other persons shall not sell exactly the same article, better or worse, or looking exactly like it, but that they may not so sell it as to steal the plaintiff's trade-mark, and make purchasers believe it is the manufacture of somebody else."

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

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

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

(*d*) 6 De G. M. & G. 214; 26 L. J. Ch. p. 12 (1856).

The provision in the Registration Acts, allowing 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 commencement of the Act of 1875," to be registered as a trade-mark, was intended to include all marks which were trade-marks before the Acts (*e*). And it is held that the qualification "special and distinctive" does no more than embody the requirements of the existing law in regard to what were or might be trade-marks (*f*).

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

What are distinctive marks.

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

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

The question whether a mark is merely descriptive can hardly arise except with regard to word-marks (*h*). It may be stated in either of the following forms: do the words which are claimed as a trade-mark (or trade-name, for the same principles apply to both), merely denote the

(*e*) *Barrow's Tm.*, 5 C. D. 353 (1877), Malins, V.-C.; *Bodega Co.* v. *Owens*, 6 R. P. C. 241 (1888), Chatterton, V.-C., in Ireland. See Chap. VIII., p. 154, below.

(*f*) *Hopkinson's Tm.*, (1892) 2 Ch. 116, Kekewich, J.

(*g*) As to marks common to the trade, see below, pp. 122 and 169.

(*gg*) Chap. VIII., p. 118.

(*h*) As to pictures of the goods, see *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A. (*Dome Black Lead*), and below, p. 131.

goods, or have they a secondary meaning connoting a connection with the persons who claim them as a trade-mark? or, are the words the known description of all goods of the class by whomsoever they are made or sold, or only of the species within it which are made or sold by those particular manufacturers or traders?

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

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

In *Ford* v. *Foster* (*k*) the plaintiff sought to restrain the defendants from placing the word *Eureka* upon shirts of the defendants' manufacture. The plaintiff had introduced into the market shirts of a certain shape, which he sold as *Ford's Eureka Shirts*, and the defendants alleged that the word in question was the known description of shirts of that particular shape. They were at liberty to make and sell the shirts, and consequently, they urged, to use the name also. Bacon, V.-C., was in favour of the defendants, upon the evidence as to this, but he decided the case on the ground that the word *Eureka* was only part of the plaintiff's trade-mark, and that he had no right to its exclusive use. The plaintiff appealed, and the decision was reversed, the Lords Justices finding that retail buyers would be led to believe by the use of the word that the goods were goods made by the plaintiff. The test whether a name has become *publici juris*, Mellish, L.J., said (*l*), must be "whether the use of it by other persons may still have the effect of inducing the public to buy goods not

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

(*i*) 3 My. & Cr. 338 (1839), Cottenham, L.C.

(*k*) L. R. 7 Ch. 611 (1872).

(*l*) Page 628.

"made by the original owner of the trade-mark as if they were his goods." If not, he added, "however hard, to some extent, it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade-mark, the right to the trade-mark must be gone." An injunction was accordingly granted to restrain the defendants from applying the mark *Eureka* to any shirts not manufactured by the plaintiff (*m*); but the defendants were left at liberty to advertise the name between themselves and the trade, as the Court thought that in the trade the name had the meaning contended for by them, and that the use of it in the manner stated could not lead to deception.

The *Singer* cases.

Singer v. *Wilson.*

The most important cases on the subject are two cases in which the Singer Manufacturing Co. sought to maintain a monopoly in the use of the name *Singer* for sewing machines manufactured by them. The cases were, in fact, trade-name not trade-mark cases, but the principles upon which they proceeded, and the judgments delivered in them, are equally applicable to both marks and names. The plaintiffs were an American company carrying on a business, originally founded by one J. M. Singer, in sewing machines which they and their predecessors had extensively advertised under the name in question, and they alleged that their machines were not of any particular type which was known as the *Singer Machine*, but were of many varieties, some of which had specific names appropriated to them. They were accustomed to place a distinctive trade-mark, comprising their name and a particular device, upon each of their machines, but it was not alleged in either case that the defendant had infringed this trade-mark. The defendant in the earlier case (*n*) had issued advertise-

(*m*) For form of injunction, see 7 Ch. p. 634; Appendix, p. 650.

(*n*) *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. 434 (1875); 3 App. Cas. 376 (1877). See also the Scotch case of *Singer Manufacturing Co.* v. *Kimball*, 11 Court of Sess. Cas. 3rd series, 267, where an injunction was granted. It has recently been held, that to a large part of the

ments and price lists in which he professed to sell *Singer* and *New Singer* machines, but in which he described them as manufactured by himself. He had not infringed the plaintiffs' distinctive trade-mark. For the defence it was alleged that the name *Singer* meant one of two particular types of machine, that it had come to be like *Hansom* and *Brougham*, the "name of the article, and not a mark or sign indicating the manufacturer" (*o*). The case took a somewhat unusual course. It was dismissed by Jessel, M.R., without the defendant having been called upon, and this decision was upheld by the Court of Appeal, but reversed by the House of Lords, the House deciding that, upon the evidence of the plaintiffs, an answer was called for, and that, therefore, the defendant ought to be required to prove the allegation on which he relied (*p*).

In non-suiting the plaintiffs, Jessel, M.R., proceeded on the ground that as the word *Singer* was not attached to the goods it was not a trade-mark, and that the plaintiffs could, therefore, only succeed by making out a case of fraudulent personation (*q*). The representations made in the defendant's price lists and advertisements, were, he held, incapable of misleading anyone as to the origin of the machines. The Court of Appeal took the same view of the representations, and relied chiefly on that in upholding the decision. In the House of Lords, Lord Cairns said the question must be, "Are the advertisements of the defendant, having regard to the evidence in the case, calculated to mislead an unwary purchaser of the machines?" And this question might still be answered affirmatively, he thought, although when the advertisements came to be spelt out with care, there was no actual representation on them that the goods they referred to

public *Singer* denotes the manufacture of the Singer Co.: *Singer Manufacturing Co.* v. *Spence & Co.*, 10 R. P. C. 297 (1893), Romer, J.

(*o*) *Per* Lord Cairns, 3 App. Cas. p. 385.

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

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

were made by the plaintiffs. And he rejected the distinction suggested by Jessel, M.R., between cases where a trade-mark used on the goods was infringed, and cases where the name by which the goods were advertised and known was pirated. Fraud, or intent to deceive, need not, he said, be alleged or proved in either case (*r*). The other law lords agreed that the plaintiffs had made out a case to show that the defendant's advertisements might lead to his goods being bought as and for theirs, and that, therefore, the defendant ought to have been called upon to displace this case, or to establish by evidence his own contention as to the meaning of *Singer*. The case was sent down for a new trial, but there is no further report of it.

Singer v. *Loog.* Many of the same questions were discussed again in the case of the *Singer Manufacturing Co.* v. *Loog* (*s*). There the defendant had placed upon the machines he sold a plate marked *Singer machine*, but bearing also words referring to the foreign makers of the goods. This plate he offered to abandon, but he claimed the right to use the word *Singer* to describe his machines. He did not, in fact, call his machines *Singers*, but advertised them as *our Singer machines*, and as machines made on the *Singer system*. Both the Court of Appeal and the House of Lords, reversing the judgment of Bacon, V.-C., decided that the documents issued by the defendant were not calculated to deceive, and the action, consequently, failed. The question as to the secondary meaning of the word *Singer* did not, therefore, call for decision (*t*); but it was agreed by all the judges, and was admitted by the plaintiffs themselves, that they could claim no exclusive use of the word if the defendant could show that the article in question was a specific article known by a specific name, and that, as in the case of the Wellington boots and

(*r*) 3 App. Cas. p. 391; and see above, p. 14.

(*s*) 18 C. D. 395 (1879); 8 App. Cas. 15 (1882).

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

Hansom cabs, he was unable to designate the article in any other way than by its known name (*u*). Lord Selborne, however, found as a fact that the term *Singer* did signify a system of construction for sewing machines known to the trade (*x*).

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

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

The Liebig's Extract Case (*z*) affords a good example of a name which was held to be merely the name of the goods, common to all the world, and subject to no monopoly rights. There Baron Liebig, the inventor of the process by which the extract was prepared, had pur-

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

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

(*y*) 8 App. Cas. p. 27; see also *Leonard and Ellis' Tm.*, 26 C. D. p. 297 (1884), C. A.

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

ported to confer upon the plaintiffs an exclusive right to use his name in connection with the goods, and they sought to restrain the defendant from using the words *Liebig's Extract*. The process of manufacture had, however, been long published and largely employed, and the goods were commonly known by the name in question. The injunction was accordingly refused.

Name of goods made under an expired patent.

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

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

The cases of *The Wheeler and Wilson Manufacturing Co.*

(*a*) Report of 1888, p. xiv.

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

The name given to a new article cannot be monopolised.

The Linoleum Case.

In *The Linoleum Case* (*d*), the plaintiffs used a trade-mark containing the word *Linoleum* for a floor-cloth which had been first manufactured and sold by them under a patent, and they unsuccessfully endeavoured to restrain the defendants from selling similar cloth as *Linoleum Floor Cloth* after the patent had expired. Fry, J. found as a fact that the word *Linoleum*, which was taken by the defendants, was not an essential part of the plaintiffs' trade-mark, but was descriptive only. It was, he said, the name of the thing, and the defendants were not bound to invent a new name for it if they made it. The name, he added (*e*), "only secondarily means the manufacture of the plaintiffs', and has that meaning only so long as the plaintiffs are the sole manufacturers. In my opinion, it would be extremely difficult for a person who has been, by right of some monopoly, the sole manufacturer of a new article, and has given a new name to the new article, meaning that

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

(*c*) 7 C. D. 834 (1878), Fry, J.

(*d*) *The Linoleum Co.* v. *Nairn*, 7 C. D. 834 (1878); cf. *Young* v. *Macrae*, 9 Jur. N.S. 332 (1862), Wood, V.-C., *paraffin* not a trade-mark.

(*e*) Page 837.

"new article and nothing more, to claim that the name is to be attributed to his manufacture alone after his competitors are at liberty to make the same article. It is admitted that no such case has occurred, and I believe it could not occur" (*f*).

Original.

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

Name of the place of origin.

The name of the place of origin of the goods would, on the same principles, in general, be bad as a trade-mark, for any importer from the same place would be at liberty to use it; but where the name has acquired a secondary meaning, identifying the goods upon which it appears with a particular trader, the trader has frequently been protected against fraudulent imitators. Even in cases where this secondary meaning has been acquired, however, according to the rules adopted in analogous cases of a trader using his own name, although it closely resembles, or is identical with, that of an earlier established and competing trader (*h*), the Courts would not interfere to restrain a second trader honestly using the name in question merely for the purpose of indicating the place of origin of his goods, although they might require him to use it in the less deceptive of two or more alternative forms (*i*). At

(*f*) See below, p. 201.

(*g*) *Cocks* v. *Chandlers*, L. R. 11 Eq. p. 447 (1871); see also *Browne* v. *Freeman* (1), 12 W. R. 305 (1864); S. C. (2), W. N. (1878), 178, (*Chlorodyne*); *Lazenby* v. *White*, 40 L. J. Ch. 576; 41 L. J. Ch. 364 (1870), (*Harvey's sauce*).

(*h*) See *Burgess* v. *Burgess*, and *Turton* v. *Turton*, below, pp. 421, 424.

(*i*) There are dicta in the *Stone Ales Case*, in the House of Lords, which suggest that a practical monopoly might be acquired of the use of the name of a place where goods are manufactured; but they

any rate, there is no reported authority in favour of such interference.

Anatolia liquorice.

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

Seixo v. *Provezende.*

In *Seixo* v. *Provezende* (*l*) part of the plaintiff's trade-marks consisted of the word *Seixo*, which was his own name, and also the name of the estate from which the wine, in connection with which the mark was used, came. The defendants adopted the same word in their trade-mark, and they alleged that their wine came from an estate adjoining the plaintiff's and also known as *Seixo*. It appeared that the produce of the defendants' estate was far less in quantity than that of the plaintiff, that the plaintiff's wine was well known by his trade-mark, and that the district in which both estates were situate was

must, it is submitted, be read by reference to the facts of the case, which was one of deliberate fraud. *Thompson* v. *Montgomery*, (1891) A. C. 217; 8 R. P. C. 365; above, p. 29.

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

(*l*) L. R. 1 Ch. 192 (1865).

known as "Sitio do Seixo," meaning "the stony country." Wood, V.-C., granted an injunction to restrain the defendants from using the word in question without clearly distinguishing the wines they sold under it from the wines of the plaintiff (*m*), and, on appeal, Cranworth, L.C., upheld this decision. "Assuming the truth of what is contended for by the defendants," the Lord Chancellor said (*n*), "that is, that parts of their vineyards are known by the name *Seixo*, that does not justify them in adopting a device or brand the probable effect of which is to lead the public when purchasing their wine to suppose that they are purchasing wine produced from the vineyards, not of the defendants, but of the plaintiffs."

Glenfield starch.

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

"I take it to be clear from the evidence," Lord Westbury said (*p*), "that, long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It

(*m*) See form of injunction, L. R. 1 Ch. p. 194; Appendix, p. 649.

(*n*) Page 198.

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

(*p*) Page 521.

"was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants."

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

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

Advertisement of the goods not a trade-mark.

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

Leather Cloth Case.

The trade-mark of the plaintiffs in that case consisted of a circle formed by the words *Crocketts' International Leather Cloth Company, Newark, N. Y., U. S. A., West Ham, England*, inside of which in the upper half was an eagle, with the word *Excelsior* over it, and the words *Crocketts & Co., tanned leather cloth* below it, and in the lower half the words *Patented, January* 24, 56, *I. R. and C. P. Crockett, Manufacturers*, 12 *yards*. The defendants had a trade-mark containing features similar to some of these. Wood, V.-C., granted an injunction (*t*), but on appeal (*u*) this was rescinded by Lord Westbury on the ground that the plaintiffs' trade-mark contained material misrepresentations which disentitled them to relief. When the case came before him again, in the House of Lords, however,

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

(*r*) Act of 1938, s. 10 (1) (e), below, p. 156, see also, p. 147.

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

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

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

Lord Westbury said (*x*): "I am satisfied that I ought to have regarded this affix to the plaintiffs' goods, which is here denominated a trade-mark, as something which, according to the anterior usage and application of the words trade-mark, by no means resembles or comes within the description of anything that has hitherto been properly designated by that name." It was, he added, "in reality, an advertisement of the character and quality of their goods."

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

Cheavin v. *Walker*.

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

The essential quality of distinctiveness as a necessary element in a trade-mark has been carefully preserved by

(*x*) 35 L. J. Ch. p. 66.
(*y*) *Raggett* v. *Findlater*, L. R. 17 Eq. p. 29 (1873).
(*z*) *Broadhurst* v. *Barlow*, (1872) unreported; see L. R. 17 Eq. p. 38.
(*a*) *Braham* v. *Bustard*, 1 H. & M. 447 (1863).
(*b*) 5 C. D. 854 (1876), C. A.
(*c*) Page 863.

the Acts, and by the decisions upon them. These are dealt with in a subsequent chapter (*d*).

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

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

The office of the trade-mark is to indicate some connection between the goods to which it is applied and a particular trader (*e*). What this connection is, is immaterial; but it should be a constant one. If a maker chooses to sell under a trade-mark identified with goods of his manufacture goods made by others, his conduct will tend to destroy the original significance of the mark, and eventually to confer upon it a new meaning; but, until the alteration is known, buyers may justly complain of deception (*f*). All that a trade-mark can effect, however, is to associate the reputation of its owner with the quality and character of the goods upon which it appears, and it will generally be immaterial to anyone who deals with a manufacturer, upon the strength of his reputation for good workmanship, whether he passes off under the mark the goods of other people, or inferior goods of his own,—the reputation will be no longer deserved.

Buyers rely on the reputation of the owner of the trade-mark.

The connection most commonly intended by a trade-mark is that of origin or manufacture; but, as already said, many others may be connoted. This is succinctly expressed in the statement of Bowen, L.J., in a recent case (*g*), that the function of a trade-mark is to give an indication of "the trade source from which the goods come, or the trade-hands through which they pass on their way to the market." And in the Merchandise Marks Act of 1862 (*h*),

(*d*) See 38 & 39 Vict. c. 91, s. 10; 46 & 47 Vict. c. 57, s. 64; 52 & 53 Vict. c. 50, s. 10; and below, Chap. VIII., What may be Registered, p. 106.

(*e*) See the *dicta* cited above, p. 27.

(*f*) The deception may constitute the offence of applying a false trade description. See *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90; and the Merchandise Marks Act, 1887, Book II., Chap. I., pp. 475 *et seq.*

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

(*h*) Sect. 1, quoted above, p. 26.

the words used were manufacture, workmanship, production, or merchandise.

Trade-mark of selector of goods.

In some cases it is difficult to decide what the precise meaning of a trade-mark is, for instance, where A. has selected and imported goods made by B. for many years, and has sold them under a particular trade-mark. If A. has been the sole importer, does the reputation of the mark refer to his selection and importation, or to B.'s manufacture? Such a case arose in *Hirsch* v. *Jonas* (*i*). There the plaintiff bought cigars of a foreign maker, who, at his request, placed a label, designed and registered as his copyright by the plaintiff, upon the boxes. Subsequently, the maker began to supply to the defendants for sale in the market similar cigars, not purchased by the plaintiff, but bearing the same label, and this the plaintiff unsuccessfully sought to restrain. The name of the plaintiff did not appear on the boxes, but that of the maker did. "The trade-mark of manufactured goods," said Jessel, M.R. (*k*), "means, I suppose, that the goods are manufactured by the person whose trade-mark it purports to be. I can understand a man saying, 'I am not the actual manufacturer of goods, but the selector of goods, and my reputation for cleverness and selection is so great, that goods marked with a mark to show that they have been selected and approved of by me will fetch a higher price in the market.' If Hirsch had put on the box '*Gloria de Inglaterra Havannah* Cigars selected by *Hirsch*,' he might have had a case to prevent other people imitating that. It would show that the cigars selected were approved of by him. If he got a great reputation in that way, I can understand he would have a right of protection for that which indicates to the public that the cigars were selected and approved of by him. That is not his case. There is nothing on the boxes to show anything about Hirsch at all. All he says is that the trade knows this mark as denoting cigars sold by him, which I dare say it does."

Hirsch v. *Jonas*.

(*i*) 3 C. D. 584 (1876). (*k*) 3 C. D. p. 586.

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

Registered under the Acts as a Trade-Mark.

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

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

(*l*) 9 C. D. 487 (1877), Bacon, V.-C., and C. A.; *Jones's Tm.*, 53 L. T. n.s. 1 (1885), C. A.

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

(*n*) See Chap. VI. Sheffield Marks; below, p. 91.

(*o*) Act of 1888, sect. 17, replacing sect. 75 of the Act of 1883, and sect. 2 of the Act of 1875; below, p. 254.

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

(*q*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.; below, p. 254.

(*r*) Chap. VIII., What may be Registered, p. 106. Chap. XII., Effect of Registration, p. 252.

CHAPTER III.

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

	PAGE
The register	52
The Manchester office and the Sheffield register	52
The Comptroller	53
Entries on the register	53
No trusts to be entered	54
Title conferred by registration	54
Alterations of the register	54
Falsification of the register	55
Devolution of title	55
Removal of entries	55
Inspection of the register	55
Searches	55
Indexes	56
Certified copies of the register to be evidence	57
Comptroller's certificate	57
Patent office seal	57
Notices and documents may be sent by post	57

The register.

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

The Manchester office and the

There are also registers at Manchester and Sheffield. The former, a copy of the register at the Patent Office, so

(*a*) Sects. 1 and 7.

(*b*) 25, Southampton Buildings, Chancery Lane, London, E.C. The Sales Department is in Cursitor Street, Chancery Lane.

(*c*) Act of 1883, s. 114.

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

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

Any act or thing directed by the Acts to be done by or to the Comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade (*gg*).

In addition to the matters directed by sect. 78, quoted above, to be entered upon the register there are entered also the name, address, and description of the proprietor of each mark (*h*), the date of the application for registration (*i*), a statement of the class or classes of goods for which the mark is registered (*k*), disclaimers under sect. 74 Entries on the register.

(*d*) Below, p. 621.

(*e*) As to the Manchester office, see below, p. 104, and as to the Sheffield registry, p. 97.

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

(*g*) Sect. 95. This power is referred to by Lindley, L.J., in *Re Tm. Normal*, 35 C. D. p. 245 (1887), C. A.

(*gg*) Sect. 82 (4).

(*h*) Rule 32.

(*i*) Rule 34.

(*k*) Sect. 65. See form of application, Form F., Appendix, p. 608.

of the Act (*k*), a note of the orders of the Court made under sects. 62, 69, 72, 90, or 92, and affecting the mark (*l*), and such other particulars as the comptroller thinks necessary (*m*). And these last particulars include notes entered on the register in pursuance of undertakings by the proprietor to confine the use of his mark to a certain district, or to the goods forming part only of a class (*n*), and in regard to other restrictions on the full rights ordinarily conferred by a simple registration.

No trusts to be entered.

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

Title conferred by registration.

There is no patent or other document issued by the comptroller in respect of the title to a trade-mark, but the application, followed by the registration of the trade-mark, is equivalent to the public user (*q*), by which, and by which alone, title to a trade-mark was acquired before the Acts (*r*), and registration confers a right to the exclusive use of the mark (*s*), and, in the case of any trade-mark which is capable of registration, except an old mark of which registration has been refused, is a condition precedent to any proceedings for the infringement of the trade-mark (*t*). The person registered as proprietor has power to assign the trade-mark (*u*).

Alterations of the register.

Provision is made for the rectification of the register, and also for its alteration in any non-essential particular,

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

(*l*) Rule 46.

(*m*) Rule 34.

(*n*) See below, pp. 182 and 235; and *Re Rabone & Co.*, Seb. Dig. p. 395 (1879), Jessel, M.R.; *De Otaduy's Tm.* (1885), W. N. p. 177, Pearson, J.; *Mitchell & Co.'s Tm.* (2), 28 C. D. 666 (1885), Chitty, J.; *Keep's Tm.*, 26 C. D. 187 (1884), Pearson, J.

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

(*p*) *De Otaduy's Tm.* and *Mitchell & Co.'s Tm.*, above.

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

(*r*) See the last Chapter.

(*s*) Sect. 76. See Chap. XII.; below, p. 252, Effect of Registration.

(*t*) Sect. 77. See Chap. XII.; below, p. 260.

(*u*) Sect. 97.

by order of the Court (*x*), and for the correction of clerical errors (*y*), and the entry of changes of address (*z*), by the comptroller.

Falsification of the register.

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

Devolution of title.

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

Removal of entries.

A trade-mark may, probably, be removed from the register because the business, to the goodwill of which the rights conferred by the registration are attached (*c*), has come to an end, and it may also be removed, after fourteen years, for non-payment of fees, under sect. 79 (*d*). In the latter case a record of the removal and of the cause thereof is inserted on the register (*e*).

Inspection of the register.

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

Searches.

It is generally advisable before offering a trade-mark

(*x*) Sects. 90 and 92. Rules 46 to 50. See Chap. XI.; below, p. 218, Rectification of the Register.

(*y*) Sect. 91.

(*z*) Rule 48.

(*a*) Sect. 93; below, p. 541.

(*b*) Sect. 87. Rules 36 to 40. See Chap. XIII.; below, p. 272, Assignment and Devolution of Trade-Mark.

(*c*) Sect. 70. *Ralph's Tm.*, 25 C. D. 194 (1883), Pearson, J. There is no rule in the present code corresponding to r. 34 of the Rules of 1876. See Chap. XIV.; below, p. 283.

(*d*) Page 292.

(*e*) Rule 47.

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

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

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

Indexes.

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

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

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

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

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

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

(*h*) Instructions (7). See sects. 72 and 73, and Chap. X.; below, p. 175.

(*i*) Report of 1888, p. ix.

of such words, added to this index, of words accepted as marks or parts of marks.

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

Certified copies of the register to be evidence.

Comptroller's certificate to be evidence.

Rule 60 requires that every certificate of registration shall have specified on the face of it a statement whether it is intended to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country, or for other purposes; and the fees payable for the certificates vary according to the uses which they are to serve (*n*).

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

Patent Office seal.

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

Notices and documents may be sent by post.

(*k*) Sect. 88. For fees, see Appendix, p. 606.

(*l*) Sect. 89.

(*m*) Sect. 96.

(*n*) For fees, see Appendix, p. 606; and for form of request for certificates, Forms K., R., S., T., and form of certificate, U.; below, pp. 607 *et seq.*

(*o*) Sect. 84.

(*p*) Sect. 97.

CHAPTER IV.

REGISTRATION OF TRADE-MARKS.

	PAGE
Section 62	59
1. Who may apply to register	60
the proprietor	60
an importer	61
application through an agent	62
registration in the agent's name	62
2. The comptroller's discretion	63
reasons for refusal to register	63
nature of the discretion	64
3. Procedure on application to register	68
form of application	68
abandonment of application	69
advertisement	69
registration	70
death of applicant	70
amendments	71
4. Opposition to registration	71
sect. 69, rule 31	71
summary of procedure on an opposed application	75
objections not contained in the notice	76
amendments	76
grounds of opposition	77
5. Appeal from the comptroller	78
notice of appeal and case	79
appeal to the Court on reference by Board of Trade	79
no appeal to the Court direct	80
address for service	82
evidence	83
modification of application at the hearing	83
the Court must consider all objections	84
6. Costs	85

THE registration of trade-marks is governed by sects. 62 to 69, and 71 to 74 of the Act of 1883. Of these, sect. 64

(1) and (3) (ii.), declaring what may be registered (*a*); sects. 71, 72, and 73, imposing certain restrictions on registration (*b*), and sects. 74, and 64 (2) and (3) (i.) providing for additions and disclaimers (*c*), are dealt with in other chapters of this book. The present chapter deals with the application for registration and the procedure consequent upon it.

By sect. 62—

Sect. 62. Application for registration.

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

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

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

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

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

(*a*) Chap. VIII. p. 106.
(*b*) Chap. X. p. 175.
(*c*) Chap. IX. p. 164.
(*d*) Act of 1888, s. 8.
(*e*) Chap. V. p. 87.
(*f*) Page 79.
(*g*) Page 81.

"[(6.) Where an applicant for the registration of a trade-mark otherwise than under an international convention (*h*) 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 "] (*i*).

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

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

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

The proprietor.

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

(*h*) Chap. XX. p. 454.

(*i*) Act of 1888, sect. 8.

(*k*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. 186; 8 R. P. C. 137. See Chap. XI. p. 218.

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

(*m*) Rule 7.

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

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

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

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

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

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

(*q*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. pp. 226—230; 8 R. P. C. 137, C. A.

(*r*) Cf. the judgment of Jessel, M.R., in *Hirsch* v. *Jonas*, 3 C. D. 584 (1876), cited, p. 60.

manner in which the mark and goods are put before the public (*s*).

Application through agent.

The application for registration, and all other communications between the applicant and the comptroller, may be made by or through an agent duly authorized to the satisfaction of the comptroller (*t*), and the proprietor may appoint an agent to act on his behalf for all purposes connected with the registration (*u*). If he does so, he will be bound by the agent's acts, so that where, under the Act of 1883, by the default of the agent, the registration was not completed within twelve months, it was deemed to have been abandoned (*u*). Under the Act of 1888, in any such case notice of the non-completion is sent from the Patent Office to the principal, and he is allowed fourteen days, or such further time as the comptroller may direct, to complete the registration (*x*).

Registration in the agent's name.

If the mark is, as sometimes happens, by the agent's mistake or fraud, registered in the name of the agent instead of that of his principal, it may be removed and a new application made (*y*). In some cases, where there has been no wrongful intention on the part of the agent, an assignment to the principal (*z*), or to his successor in business (*a*) has been permitted, or a rectification of the register effected (*b*); but the authorities are conflicting upon the question whether either of these courses ought to be allowed (*c*). Where an agent acting for two separate

(*s*) See *Hirsch* v. *Jones*, note (*r*), and Chap. II., p. 50. *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.; *Robinson* v. *Finlay*, 9 C. D. 487 (1877), C. A.; and *Jones' Tm.*, 53 L. T. 1 (1885), C. A., were cases of joint ownership of trade-marks.

(*t*) Rule 9. Sect. 63.

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

(*x*) Act of 1888, s. 2, amending s. 63 of the Act of 1883.

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

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

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

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

(*c*) See *Rivière's Tm.*, 55 L. J. Ch. 545 (1886), C. A., and the next case. See also Chap. XI., p. 236, below.

principals has, by mistake, registered the trade-mark of one in the name of the other, removal and a fresh application are necessary (*d*).

2. The Comptroller's Discretion.

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

(1.) The application is not made by or on behalf of any person (properly) claiming to be the proprietor of the mark (*e*).
(2.) It is not made in proper form (*f*).
(3.) It is deemed to be abandoned (*g*).
(4.) The mark tendered does not consist of or contain any of the essential particulars of a registerable trade-mark (*h*).
(5.) The application is successfully opposed (*i*). Besides any other ground for refusal, an opponent may show that the registration of the proposed mark would be unjust to him, *e. g.*, by giving to the applicant the exclusive right to use a mark which he is already lawfully using, though not as a trade-mark (*k*), or he may show that it is a common mark (*l*).
(6.) Where there are conflicting claims to registration, the comptroller may refuse to register upon any of them until the decision of the Court has been obtained (*m*).

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

(*e*) Sect. 62 (1); above, p. 60.

(*f*) Sects. 62 (2), 64 (2), 74 (2), Rules 7—16, Instructions 8—14, Appendix pp. 596, 608 and 628.

(*g*) Sect. 63, p. 68.

(*h*) Sect. 64 (1), Chap. VIII., p. 106.

(*i*) Sect. 69, pp. 71 *et seq.*

(*k*) See per Cotton, L.J., in *Hudson's Tm.*, 32 C. D. p. 320; 3 R. P. C. 155 (1886), and see Chap. X., p. 175.

(*l*) Chap. VIII., p. 122. Of course a common mark is not distinctive, and therefore falls under the fourth objection.

(*m*) Sect. 71. Rules 43—45.

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

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

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

(10.) Its use would, in the comptroller's opinion, be contrary to law or morality (*p*).

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

The comptroller's discretion to refuse to register.

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

"The comptroller," Kay, J., said in *The Emollio Case* (*r*), "when he is asked to register a trade-mark, is bound to consider whether, looking to all the circumstances of the case, he can exercise his discretion by permitting the trade-mark to be registered." And in *The Australian Wine Importers' Case* (*s*), the same learned judge said: "Does

(*n*) Sect. 72, pp. 177, 182.
(*o*) Sect. 73, p. 209.
(*p*) Sect. 86.
(*q*) Instructions 28—30; p. 631, below.
(*r*) *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 312 (1889).
(*s*) 41 C. D. 278; 6 R. P. C. 311 (1889).

"it follow that because (the opponent) could not get an injunction, that (the applicant) is entitled to put the trade-mark on the register? In my opinion it does not follow at all, and I have said so many times. In my opinion, the comptroller ought to exercise his discretion in a wise (*t*) and comprehensive way." The existence of a discretion to refuse registration was asserted in the most decisive manner by the majority of the Law Lords in the House of Lords in *The Fruit Salt Case* (*u*). There, Lord Herschell said: "The case was argued on behalf of the respondent as if he had an absolute right to have any trade-mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. Those sections prohibit the registration of a trade-mark in certain specified cases, but there is no duty cast upon the comptroller of registering every other trade-mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion, whether to register or not, appears to me to be in all other cases plainly conferred. Of course, this discretion must be reasonably and not capriciously exercised; but it is, in my opinion, a reasonable exercise of it to refuse registration when it is not clear that deception might not result from it." And Lord Watson said that in cases where it is doubtful whether a trade-mark tendered for registration is calculated to deceive or not, the application ought to be disallowed. Lord Halsbury, who dissented from the conclusion arrived at in the case, treated the comptroller's discretion as more closely limited. "While I agree," he said, "that no absolute right to the registration of a trade-mark is given to an applicant for registration, the meaning and intent of the statute itself is that, unless for some of the reasons contemplated by the statute there is an objection to the registration, the trade-mark ought to be registered.

Eno v. *Dunn*.

(*t*) *Quære* wide.

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

"Unless we are of opinion that there is something in the proposed trade-mark which the statute renders an objection to its registration, we ought to grant the application" (to register). And this opinion accords with that expressed by Lord Blackburn in *The Orr-Ewing Case*, soon after the passing of the Act of 1875 (*x*). "I cannot construe this section" (*y*), his Lordship said, "as meaning anything else than that, when the Court of Chancery is satisfied that the applicant is a person who is, for the time being, entitled to the exclusive use of a trade-mark in accordance with law, and that the trade-mark is one within (the definition section of the Act); the Court is, *ex debito justitiæ*, to rectify the register (*z*), just as it would, before the Act of 1875, have been bound *ex debito justitiæ* on similar proof, to prevent anyone infringing the trade-mark shown to be his property. The burden of proof lies upon the person making the application to amend the register; but if he does produce such proof as would, in the opinion of the Court, entitle him to an injunction, I do not think the words, 'if satisfied of the justice of the case' can, or ought to be, construed as meaning to give the Court a discretion to consider whether the nature of the trade-mark is such as to make it inconvenient that he should exercise the right of property which it is proved he actually has."

The Orr-Ewing Case.

The opinion last cited was delivered in a case where the marks concerned were old marks, and the apparent conflict between it and the opinions of the majority of the Law Lords in *The Fruit Salt Case* may probably be reconciled by treating the doctrine of a right *ex debito justitiæ* to register as applicable only to marks used as trade-marks before the 13th of August, 1875. Sect. 77 expressly excepts from the prohibition of actions for the infringement of unregistered trade-marks the cases of such old

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

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

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

marks as have been refused registration, and the corresponding section previously in force contained a similar exception (*a*). This last mentioned exception was, however, cited by Lord Blackburn in his opinion. He stated that it did not affect the conclusion he had arrived at.

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

Comptroller to hear applicant before refusing the application.

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

The decision of the comptroller against an applicant (*c*) for, or against an opponent (*d*) of, the registration of a mark is subject to appeal to the Board of Trade, who may refer the question to the Court (*e*).

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

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

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

(*c*) Sect. 62 (4), (5); *Re Australian Wine Importers, Limited*, 41 C. D. p. 235.

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

(*e*) Page 78, below.

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

The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of the Act, apply to either of the law officers for directions in the matter (*f*). It is also provided by sect. 82 (3), that he shall act under the superintendence and direction of the Board of Trade. It was formerly the practice for him to consult the Board in regard to his decisions in individual cases, but Lord Herschell's Committee recommended that this practice should be abandoned: they said, "we think it was only intended that the Board of Trade should give general directions or settle questions of general practice; not that they should interfere with the personal responsibility of the comptroller in individual cases, except when the matter comes before them in due course of appeal" (*g*).

3. Procedure on application to Register.

The procedure by which an application to register is to be made is described in the paragraphs 8 to 27 of the instructions printed in the appendix (*h*), and by Rules 7 to

Form of application.

16. A printed form of application corresponding with the form F. (*i*) attached to the rules, which is the form at present in use, may be obtained, and it must be filled up, and the necessary representations of the mark must be attached to and sent with it, in accordance with the rules, and the directions given in the notes to the form.

Essential particulars and disclaimers.

The applicant for registration must state in his application the essential particulars of the trade-mark, and must disclaim any right to the exclusive use of the additional matter, if there is any in the mark, and a copy of the statement and disclaimer are to be entered upon the register (*k*).

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

The address of the applicant must in every case be stated

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

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

(*h*) Page 628.

(*i*) Page 608. Sect. 62 (2).

(*k*) This is an addition to sect. 64 (2) made by sects. 10 and 16 of the Act of 1888.

(*l*) Page 106.

(*m*) Page 164.

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

Abandonment of the application.

It is provided by sect. 63 that—

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

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

Sect. 63, as amended, was held to be retrospective (*q*), but not to operate so as to prevent a fresh application being made in a case where the merits of the abandoned application had never been gone into or considered (*p*).

Advertisement.

The comptroller may either accept the mark tendered or refuse it. Unless he refuses to entertain the application (*r*), he is directed to cause it to be advertised (*s*) in the official

(*n*) Sects. 8, 62 (6).

(*o*) Sect. 103. Chap. XX. p. 454.

(*p*) 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.; *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29, North, J.

(*q*) *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J., and the last case.

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

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

paper during such times and in such manner as he thinks fit (*t*), the advertisement either comprising a representation of the mark or a reference to the place where a specimen or representation is deposited for exhibition (*t*); and it is then open for any one who objects to the registration, within one month, or such further time, not exceeding three months, as the comptroller may allow, of the advertisement, to send in notice of opposition (*u*).

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

The registration.

"As soon as may be after the expiration of one month from the date of the advertisement of the application the comptroller shall, subject to the opposition to the application (if any) and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee (*x*), 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" (*y*),

Death of the applicant before registration.

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

Refusal to register.

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

Certificate of refusal to register an old mark.

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

(*t*) Rules 27—30.

(*u*) Sect. 69, as amended by sect. 13 of the Act of 1888. See p. 71, below.

(*x*) See Table of Fees, p. 606.

(*y*) See Chap. III. p. 64, on the Register, and Rule 34.

(*z*) Rule 33.

(*a*) Sect. 94. Rules 17—19.

(*b*) £1, see Table of Fees, p. 600.

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

Amendments.

Amendment of application.

The comptroller may, on request in writing accompanied by the prescribed fee (*d*), correct any clerical error in, or in connection with an application for registration of a trade-mark (*e*), and may permit an applicant for registration of a trade-mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the trade-mark to be registered (*f*). And a more general power of amendment is provided by rule 54, by which, "any document or drawing or other representation of a trade-mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the comptroller may be obviated without detriment to the interests of any person may be corrected, if the comptroller think fit, and on such terms as he may direct" (*g*).

Enlargement of the prescribed times.

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

4. Opposition to Registration.

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

Opposition to registration.

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

Sect. 69. "(1.) Any person may within *two months*

(*d*) 5*s*.

(*e*) Sect. 91 (a).

(*f*) Act of 1888, ss. 24, 91 (d).

(*g*) For the decisions under this with regard to notices of opposition, see p. 77, below.

(*h*) Rule 55.

(*i*) Cf. sect. 90.

(*k*) Below, p. 78.

(*l*) These are summarised in par. 32 of the Instructions, Appendix, p. 632.

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

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

"[(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 (*n*) he shall give the comptroller an address for service in the United Kingdom.]"

(*m*) Cf. sect. 63, above, p. 68.

(*n*) Cf. sect. 62 (6), above, p. 59.

Notice of opposition.

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

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

"(2.) Where the ground, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade-mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade-mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the register of such trade-mark already on the register (*p*).

Opponent's evidence.

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

Applicant's evidence.

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

(*o*) Appendix, p. 610.

(*p*) Sect. 72, Chap. X., p. 176. The date and number can be ascertained by inspecting the register.

(*q*) See Rule 61, p. 605.

(*r*) Ibid.

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

Evidence in reply.

" 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.

Closing of evidence.

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

Applications for leave to adduce further evidence.

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

Appointment of time for hearing.

" (7.) On the completion of the evidence, the comptroller shall, upon application by either party, upon Form E. (*t*) in the Second Schedule to these Rules, and upon payment of the prescribed fee (*u*), appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Disallowance of opposition in certain cases.

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

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

(*t*) Appendix, p. 608.
(*u*) £1, see p. 606, below.
(*x*) Cf. Rule 31 (2), *supra*.

Summary of procedure on an opposed application.

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

(1) Application (*y*).

[(2) Notice of refusal of comptroller to entertain the application (*z*).

(3) Notification by applicant to the comptroller that he intends to be heard, five days from receipt of (2) (*z*).

(4) Ten days' notice of appointment for hearing from comptroller to applicant.

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

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

(7) Notice of opposition, one month from advertisement. Notice to be in duplicate, with grounds of opposition, and address in United Kingdom, and to be signed by opponent or his solicitor (*c*).

(8) Counter-statement, one month from receipt of (7) from comptroller. To be in duplicate with grounds of application (*d*).

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

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

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

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

(*y*) Page 68. Form F., p. 608.
(*z*) Page 67. Form E., p. 608.
(*a*) Rules 20—26, below, p. 79.
(*b*) Page 69.
(*c*) Form J., Appendix, pp. 610, 635.
(*d*) See form in Appendix, p. 636.
(*e*) Appendix, pp. 610, 637.

Forms of the several notices and other documents referred to in the above table are set out in the Appendix, pp. 635 to 641.

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

Objections not contained in the notice of opposition.

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

Amendments and enlargement of times by the comptroller.

The comptroller's powers under sect. 91 and Rules 54 and 55 to amend clerical errors in connection with any application for registration, and to allow the amendment

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

(*g*) As to the old practice, see *Re Simpson, Davies & Sons' Tm.*, 15 C. D. 525 (1880); *Anderson's Tm.*, 26 C. D. 409 (1884), Sebastian, 3rd ed., p. 434.

(*h*) See p. 86, below.

(*i*) See p. 84, below.

(*k*) Under sect. 62, see p. 63, above.

of any document, drawing, or representation of a trade-mark, for the amendment of which no special provision is made by the Acts, and to enlarge the times prescribed by the rules for doing any act or taking any proceeding thereunder, have already been stated (*l*).

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

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

Grounds of Opposition.

The reasons for refusing to register a mark which is propounded for registration are dealt with in detail else-

(*l*) Page 71, above, cf. also Rule 53 (power to dispense with evidence), Appendix, p. 603.

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

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

where (*o*). Those which are most commonly relied on by an opponent are the following:

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

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

(iii.) That the mark propounded is his mark, and not that of the applicant (*t*), or that it has been acquired by the applicant in fraud of his rights (*u*).

5. Appeal from the Comptroller.

By sect. 62 (4) and (5), and sect. 69 (3) and (4) (*x*), which are in similar terms, an appeal to the Board of Trade from the decision of the comptroller refusing to register the trade-mark, is given whether there has or has not been any opposition. In the latter case it would still be open to the comptroller, after a successful appeal from

(*o*) See above, p. 63, and the Chapter on Rectification of the Register, p. 218; Forms, Appendix, pp. 635 *et seq.*

(*p*) Sect. 72 (2), p. 182.

(*pp*) Rule 31 (2) and (3) above, p. 73.

(*q*) Page 125.

(*r*) Page 126.

(*s*) Page 122.

(*t*) Sects. 71 and 72 (1), p. 176, and see "proprietor," p. 60. The mark may be copyright. As to a copy of a foreign picture, see *Schauer* v. *Field*, (1893) 1 Ch. 35, C. A.

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

(*x*) Above, p. 59.

his refusal to accept a mark, on notice of opposition from an opponent under sect. 69, to refuse registration (*y*). An appeal is also given by sect. 69 to an opponent who has unsuccessfully resisted the registration of a mark. These appeals were introduced by the Act of 1883.

Appeal to the Board of Trade.

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

Notice of appeal.

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

Grounds of appeal to be stated.

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

Transmission of notice.

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

Directions by Board.

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

(*y*) See the judgments in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cs. 479 (1879).

No appeal unless notice duly given.

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

Evidence on appeal.

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

Notice of and case on appeal.

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

The case frequently concludes with a request that the appeal may be referred to the Court, and unless the Board of Trade see some reason to differ from the comptroller, they usually so refer it at once without hearing the parties themselves, in accordance with the recommendation of Lord Herschell's Committee (*a*). It is presumed that where any real question was raised either of law or fact the Board would, if requested, refer the matter to the Court (*b*).

No appeal to the Court direct.

There is no other appeal, than that given by this section, open to an unsuccessful applicant, for he cannot apply to the Court under sect. 90 as a person aggrieved by the omission of his name from the register (*c*); but the authority referred to does not directly apply to the case of an unsuccessful opponent, although much of the reasoning of

(*z*) Page 610.

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

(*b*) See the *Normal Co.'s Tm.*, 35 C. D. 231; 3 R. P. C. 260; 4 R. P. C. 123 (1886).

(*c*) *Normal Co.'s Tm.*, and cf. *Woolley* v. *Broad*, (1892) 1 Q. B. 806.

it does. It would, however, be anomalous that any other person aggrieved should be able to apply to remove a mark from the register, but that one who had opposed the registration before the comptroller should be barred. No doubt, if the opposition had come before the Court the matter would be *res judicata* between the registered owner and the opponent (*d*).

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

The comptroller may, however, under sect. 71, submit, or require the claimants to submit, their rights to the Court direct in any case where each of several persons claims to be registered as proprietor of the same trade-mark. The submission is, unless the Court otherwise directs, by a special case, which may be settled by the comptroller in case of difference (*f*). Reference of rival claims to the same mark to the Court direct.

The appeal may be brought before the Court on summons or by motion (*g*), asking that the appeal may be heard and decided, and that the comptroller be directed to proceed, or not to proceed, as the case may be, with the registration of the mark in question. Procedure by summons is the more usual course (*h*); but as the summons is always adjourned into Court, no expense is saved in this way. Some of the judges (*i*), however, object to determining what are really trials of causes, often involving property rights of considerable value, in the hurry of motion-day. An adjourned summons has, too, the ad- Appeal by summons or notice of motion.

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

(*e*) Sect. 117 (1). So that an order of the House of Lords allowing an appeal from the Comptroller should be remitted to the High Court for execution: *Re Orr-Ewing & Co.*, 28 W. R. 412.

(*f*) Rules 44, 45.

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

(*h*) It was adopted in the *Apollinaris Cases*, (1891) 2 Ch. 186; 8 R. P. C. 137; and in *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1839).

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

vantage of coming on in its turn, according to its place in the list at a time which can, to some extent, be guessed by anticipation, so that procedure by summons is usually the more convenient course. But a motion can generally, in case of necessity, be brought to a hearing very rapidly, and it may accordingly be advisable, in some cases, to proceed by way of motion.

Notice of the motion or summons should be given to the comptroller, so that he may appear if he thinks fit, and the opponent, or the applicant, as the case may be, should be made a respondent. And if there has been no opposition, but the comptroller has refused to register because of the presence of marks similar to the mark in question on the register, the Court generally requires notice of the appeal to be sent to the owners of such marks (*k*). If the appeal is allowed, the successful party must forthwith leave an office copy of the order at the Trade Marks Branch of the Patent Office, and the register is thereupon to be rectified or altered, or the purport of the order to be otherwise duly entered in the register, as the case may be (*l*).

Address for service where the applicant or opponent is abroad.

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

Scotch or Irish applicant or opponent.

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

(*l*) Rule 46.

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

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

(*o*) *King & Co.'s Tm.*, (1892) 2 Ch. 402; 9 R. P. C. 350, Kekewich, J., and C. A.

Evidence upon the appeal.

The evidence before the comptroller, in the case of an opposition, is given by statutory declarations (*p*), or, in special cases, in such other way as the comptroller directs (*q*). The declarations are not, however, evidence upon an appeal to the Court, and the proper course is for the deponents to verify their declarations by affidavit (*r*). The Board of Trade, in referring an appeal to the Court, generally give the appellant liberty to adduce such further evidence as he is advised; and this is usually given on affidavit also (*s*). Where the application to the Court is by summons, the evidence should be completed before the summons is adjourned to the judge (*ss*).

Modification of the application on the appeal.

As already stated, the Court has no jurisdiction to amend the application or notice of opposition on appeal (*t*). And it will not generally be influenced by an offer in Court by the appellant to modify his application (*tt*); but in a case where, after the comptroller's decision, the applicant offered to allow a disclaimer sufficient for the protection of the opponent to be entered with his mark on the register, the Court allowed the appeal without costs (*u*). And where the comptroller refused to register on the ground that two other marks already on the register contained the prominent word of the mark in question; and, the owners of these marks having been served with notice of the appeal, one of them did not appear, and the other was satisfied by the consent of the appellant to restrict the rights conferred by the registration to particular goods, the appeal was allowed on payment of costs (*x*).

And by the express terms of sect. 62 (4) and (5), and

(*p*) Rule 61.

(*q*) Rule 53.

(*r*) *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

(*s*) In accordance with Order XXXVIII. r. 1 of the Supreme Court Rules.

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

(*t*) *Robertson, Sanderson & Co.'s Tm.*, (1892) 2 Ch. 245; 9 R. P. C. 215, Stirling, J.

(*tt*) It is therefore too late to offer to disclaim on the appeal, see below, p. 167.

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

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

sect. 69 (3) and (4), the Board of Trade and the Court on appeal may respectively make orders for registration, subject to any conditions they may think proper to impose. The conditions usually imposed are the alteration of the mark, *e. g.*, by adding the applicant's name to it, the registration of a disclaimer, or the restriction of the use of the mark to a limited portion of the goods within the class in respect of which it is registered (*y*). The Court cannot, of course, impose conditions except at the applicant's request, or with his consent; and it rarely does so in any case unless the parties have come to terms (*z*).

The Court must consider all objections.

On the appeal the Court has jurisdiction to enter into and determine all questions arising on the objections, including, of course, in a case where the comptroller has already registered the mark, the question whether the mark has been rightly admitted to the register. So, where the appeal against the refusal of the comptroller to register the word *Gem* had been allowed by Kay, J., and the registration had been made accordingly, and it was argued, in the Court of Appeal, that the only questions which could be considered by the Court were the rights as between the applicant and the opponent, treating the registration, subject to those rights, as properly made, and it was alleged that the opponent had obtained the rights on which he relied by fraud on the applicant. The Court of Appeal rejected this suggestion. "The Court is bound," Cotton, L.J., said, "to enter into all the considerations which must be determined in order to see whether the particular mark or word is rightfully on the register," and, *inter alia*, the question whether the word was, and it was held that it was, a descriptive word (*a*). And in the *Sanitas Case*, where the comptroller had refused registration on the ground of the precedent registration of other

Appeal after actual registration.

(*y*) Cf. Rectification, under sect. 90, Chap. XI., p. 234.

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

(*a*) In *Re Arbenz's Application*, 35 C. D. 248; 4 R. P. C. 143 (1886).

marks, and he desired on the appeal to argue also (1) that the word in question was not a fancy word, and (2) that it was part of the appellant's name, Kay, J., said, in answer to an objection to this, "I shall have to consider every possible objection" (*b*).

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

6. Costs.

Costs of the appeal.

The Court has no jurisdiction to make the comptroller pay costs (*d*), and the ordinary rule is that even a successful appellant pays the costs of the comptroller as well as his own. In the *Alpine Case* (*e*), Mr. Justice Chitty said that the comptroller's costs were deemed to be costs incidental to registration. "In fact," he added, "the only method by which the successful appellant might escape paying the costs would be by showing that the refusal to register emanated from personal impropriety on the part of the officers refusing." This statement seems to be somewhat too strongly put, for in several cases a successful appellant has not been ordered to pay costs (*d*), although no suggestion of improper conduct or motive on the part of the comptroller was made.

If the opponent appeals, or appears as a respondent to the applicant's appeal, the costs of the application to the Court generally follow the event; but the Court has jurisdiction, which it frequently exercises, to refuse to make any order for costs where it is dissatisfied with the conduct of the successful party. Thus, where the applicants based

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

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

(*d*) *Rotherham's Tm.*, 14 C. D. 585 (1880), C. A.; *Leaf's Tm.*, 33 C. D. 477; 3 R. P. C. 289 (1886), Bacon, V.-C.; *Colman's Tm.*, 11 R. P. C. 129, (1894) Stirling, J. See next page, "test case."

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

their case in part on an alleged exclusive right to the use of certain words in their label and they had no such right (*f*), and where the judge thought that both appellant and respondent had behaved improperly, no costs were given (*g*).

Test case.

So, too, where the case was argued as a test case, no costs were given, although the application failed (*h*); and in another case where the comptroller took a new point in Court, after the objection upon which he had refused registration had been removed, and succeeded upon it, he did not press for costs (*i*).

New objection at the hearing.

Costs before the comptroller.

No costs of the proceedings before the comptroller, except so far as these are allowed by the taxing master as costs of or occasioned by the proceedings in Court, can be given (*k*); and the same rule applied under the old Act (*l*). But the comptroller has power, where an applicant abandons his application after notice of opposition has been given, in accordance with sect. 69, to direct the applicant to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable (*m*). This power was conferred upon the recommendation of Lord Herschell's Committee (*n*), in order to spare owners of existing marks from the expense of contesting unwarrantable applications to register marks which would prejudice their rights.

(*f*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), (*Carbolic Acid Soap Powder*), C. A.; cf. Chap. XI., p. 251.

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

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

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

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

(*l*) *Brandreth's Tm.*, 9 C. D. 618 (1878), Jessel, M.R.

(*m*) Sect. 69 (5); p. 72, above.

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

CHAPTER V.

CLASSIFICATION OF GOODS.

PAGE

Tho classes 88
Registration and protection for part of a class 88
Series of trade-marks 90

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

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

And that—

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

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

(*a*) *Ante*, p. 29; and see *Somerville* v. *Schembri*, 12 App. Cas. 453; 4 R. P. C. 179 (1887).

(*b*) Act of 1883, s. 65, following Act of 1875, s. 2

(*c*) Act of 1883, s. 70, following Act of 1875, s. 2. As to Assignments, see Chap. XIII., p. 272.

Classes.

Accordingly, goods have been divided by the draughtsman of the Trade-Mark Rules into forty-nine classes, and a miscellaneous and residuum class, and the rules provide that if any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the comptroller, and that any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the comptroller may desire (*d*). For the convenience of applicants for registration an alphabetical guide to the classification of goods has also been drawn up and published (*e*), and in case of uncertainty, upon application by letter to the comptroller, giving a full description of the goods and the purposes for which they are used, the comptroller will inform any intending applicant what class he should name in his application.

Many of the classes comprise a number of very different kinds of goods, for example, Class 6: "Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in class 7," comprises both engine-boilers and sewing machines. Registration in a class does not, however, confer on the registered proprietor rights in regard to goods of kinds other than those for which he uses his mark. Thus, where the owner of a mark comprising the word *Neptune*, who had used it only for iron sheets, although class 5, for which it was registered, includes also wire, brought an action against a person who had registered and used a mark comprising the same word for wire, the Court of Appeal refused to grant an injunction, and they ordered the register to be rectified by restricting the registration of the plaintiff's mark to iron sheets only (*f*). In this case the plaintiff claimed the mark as assignee of the goodwill of a business which dealt only in the iron sheets, and it was held that, as assignee,

Registration and protection for part of a class.

(*d*) Rule 6. Sch. 3. Appendix, p. 618.

(*e*) It can be procured at the Sales Department of the Patent Office, Cursitor Street, Chancery Lane.

(*f*) *Edwards* v. *Dennis*, 30 C. D. 454, C. A. (1885).

his trade-mark rights under the Acts must, in any event, be restricted to the goods with which the business assigned to him was concerned (*g*); but Cotton, L.J., stated that, in his opinion, it was not the intention of the Act (of 1875) that a man registering a trade-mark for an entire class, and using it only for one article in that class, should be able to claim for himself the exclusive right to use the mark for every article in the class, and with this opinion the other Lords Justices seem to have agreed. This opinion was endorsed and followed by Chitty, J., when the question arose in an action brought by the original proprietors of a trade-mark (*h*), who endeavoured, but unsuccessfully, to secure exclusive rights for cigars in a trade-mark which they had registered in the tobacco class, but which, as it comprised the word "mixture," was appropriate, and had at first been used, only for cut tobacco (*hh*).

A trade-mark may be originally registered for certain only of the goods comprised in a class, and it will then, of course, be protected as to those goods only (*i*). And if it be registered for the whole class, but the proprietor of it be entitled to protection for part of the class only, the Court may rectify the register by restricting the entry, as it did in *Edwards* v. *Dennis* (*k*) and in *Harrison* v. *Woodroffe* (*l*). In the latter case Kekewich, J., said: "It was never intended that a man, having a trade-mark for one class of machinery, should register it for all." In practice, leave to register a mark is frequently given, and oppositions to registration are frequently withdrawn, or overruled, on the terms that the registration be restricted in this way to part of a register class (*m*). The restriction is

(*g*) Act of 1875, s. 2. Act of 1883, s. 70.

(*h*) *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237.

(*hh*) Cf. Instructions, 31, *post*, p. 632.

(*i*) *Jay* v. *Sadler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*k*) 30 C. D. 454, C. A. (1885).

(*l*) 42 C. D. 691; 7 R. P. C. 25 (1889).

(*m*) See, for instance, *Jelley's Application*, 51 L. J. Ch. 639 n. (1878), Jessel, M.R.; *Braby & Co.'s*

effected by the entry of a note upon the register, and in a case where, without any formal opposition, it had been agreed between the applicant and an objector, that the registration should be restricted to certain goods in the class for which it was effected, Pearson, J., on an *ex parte* application, directed the comptroller to enter a note of the restriction on the register (*n*).

Series of Marks.

By sect. 66 it is provided that—

"When a person claiming to be proprietor of several trade-marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade-marks, they may be registered as a series in one registration. A series of trade-marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade-marks composing a series shall be deemed and treated as registered separately."

Registration of a series of marks.

The section was probably introduced to clear up the difficulties which arose under the earlier Act upon the question how such series were to be registered (*o*).

When an application is made for such a series, a representation of each of the marks included in the series must be affixed to the form of application (*p*), and of the additional representation of the trade-mark sent with the application (*q*).

Applicatione, 21 C. D. 222 (1882), North, J.: and *Konrick and Jefferson's Tm.*, 7 R. P. C. 321 (1890), Chitty, J.

(*n*) *Keep's Tm.*, 26 C. D. 187 (1884); see also Chap. XI.; p. 235, and Chap. X., p. 181.

(*o*) See *Barrow's Tms.*, 5 C. D. 353 (1877), C. A.

(*p*) Chap. IV., p. 68, above; Rule 14. Separate electrotypes must be sent also, Rule 30.

(*q*) Instructions, 17; App. p. 630.

CHAPTER VI.

SHEFFIELD MARKS.

PAGE

The Cutlers' Company 91
Old corporate marks 93
Recent legislation and the company 94
The Act of 1875 94
The Acts of 1883 and 1888 95
Effect of sect. 81 (Sheffield marks) 96

Sheffield Marks and the Cutlers' Company.

THE care of the register, and the registration of marks to be used on metal goods registered under the present Act by a person carrying on business in Hallamshire, or within six miles thereof, is committed, by sect. 81 (*r*) of the Act, *to* the Cutlers' Company.

The Cutlers' Company.

This company was incorporated by the Act 21 James I., c. 31, and its members and proceedings are regulated by several Cutlers' Company Acts, referred to below. But long before the seventeenth century Hallamshire had been noted for its cutlery manufactures, and from time to time a jury of cutlers was empannelled with the other juries of the local Court Leet, to assign marks to the different manufacturers, wherewith to distinguish their respective wares; and in the Court Rolls of the Manor of Sheffield of the 7th of Elizabeth, and, again, in the Rolls of 1590, presentments of the regulations governing persons engaged in the knife-making and certain other cutlery trades are recorded (*s*). The seventh of these regulations provided that no person should strike any

(*r*) See below; p. 96.

(*s*) Hunter's History of Sheffield: London, 1819, p. 118.

mark upon his wares but that which was assigned him in the Lord's Court, under a penalty of ten shillings. The cutlers had also a charter granted by the lords of the manor (*t*).

The incorporating Act, the Cutlers' Company Act, 1623 (*u*), laid down certain regulations for the control of persons engaged in the businesses of manufacturing knives, shears, scissors, or other cutlery wares, within the specified district, and incorporated the persons then so engaged, and it fixed the limits of the district concerned, as they have ever since remained, to be those of the lordship of Hallamshire, and within six miles compass from it. The Act, in particular, provided that persons engaged in the businesses mentioned, in the said district, should strike such marks, and such marks only, as should be assigned to them by the company. These regulations were repealed by the Cutlers' Company Act of 1791 (*x*), and fresh regulations, chiefly relating to the admission of new freemen and to the taking of apprentices, were enacted. By sect. 17 of the Act last mentioned, members of the company, who alone were then permitted to manufacture the goods referred to (*y*), were forbidden, under a penalty, to strike, engrave, or use any mark like, or counterfeiting a mark assigned to any other person. The Cutlers' Company Act of 1801 (*z*) empowered any freeman of the company to bequeath his mark, as his other personalty, by his will, his widow not to be thereby prevented from carrying on the trade, or selling the right to the mark, for her lifetime, to any other person entitled to carry on the trade. The Cutlers' Company Act of 1814 (*a*) threw open the specified trades to all persons, and removed the existing restrictions as to taking apprentices. It provided, further (sect. 3), that all manufacturers, whether freemen or not, on application, should have marks assigned to them by the company, the marks not to be

(*t*) M. M. A. Report, 1862. Evidence of Mr. Jackson, Q. 104.

(*u*) 21 James 1, c. 31, local.

(*x*) 31 Geo. 3, c. 58, local.

(*y*) Knives, sickles, shears, scissors, razors, files, and forks, or any of them, sect. 3.

(*z*) 41 Geo. 3, c. 97, local.

(*a*) 54 Geo. 3, c. 119, local.

marks previously assigned, and at the time continuing to be the property of any persons other than the applicants, and not to consist of surnames; (sect. 4) that marks in common use should not be assigned; and (sect. 6) that an assigned mark might be bequeathed by will, and if it were not bequeathed, it should go to the widow and family of the proprietor on his death, but not so as to give power to more than one person in the family to use it at the same time. The last Cutlers' Company Act, that of 1860 (*b*), extended the provisions of the Acts to all persons within the district using or exercising the trades of manufacturers of steel, makers of saws and edged tools, and other articles of steel, or steel and iron combined, having a cutting edge, and it enabled persons carrying on any of the trades within the Acts, and not being freemen of the company, to become freemen on payment of the proper fees, and to have marks assigned to them.

Corporate marks were assignable in gross.

It will be seen that, under these Acts, the old corporate marks were assignable personal property of the grantee; this was, at all events, the case where the marks were owned by non-freemen, and where they did not comprise any personal elements calculated to make their use by others than the original grantees misleading (*c*). In this respect they differed from ordinary trade-marks, which are, and always have been, assignable or capable of transmission only in connection with the business in which they are used.

Grant of a corporate mark.

The right to the mark originated in the grant by the company, and lasted for the lives of the grantee and his widow. The grant was made upon the application of the grantee after a search, carried out by the searchers of the company, to ascertain whether the mark applied for was the subject of a then existing grant. Marks, as they lapsed, were re-granted over and over again (*d*).

(*b*) 23 Viet. c. xliii.

(*c*) *Bury* v. *Bedford*, 32 L. J. Ch. 741; 33 L. J. Ch. 465; 4 De G. J. & S. 352 (1863), M.R. and L.JJ.

(*d*) See the evidence of Mr. Jackson, Qq. 113, 117, 142, and Mr. Hunter, Q. 1899; M. M. A., 1862.

Recent legislation and the Cutlers' Company.

The rights and privileges of the Cutlers' Company were expressly saved by sect. 25 of the Merchandise Marks Act, 1862. There is no similar provision in the Merchandise Marks Act of 1887, but, except in so far as that Act restricts the use of particular marks as being forged trade-marks, or false trade descriptions, it does not in any way affect the rights or privileges of the company. The Act of 1875 (*e*) empowered the owner of a Sheffield corporate mark to have it registered under that Act in the same manner and on the same terms as if it were not a Sheffield corporate mark.

Closing of the register.

Under the Act of 1883 the old register of corporate marks was closed on the 31st of December, 1888 (*f*).

The Act of 1875.

The Act of 1875 left the register of the Cutlers' Company, and the power of the company to assign marks, untouched, except that it restricted the latter power in regard to marks identical with, or so nearly resembling as to be calculated to deceive, marks registered under the Act in the manner mentioned below (*g*). And it provided generally that:—

"(7.) *Nothing in this Act shall prejudice or affect the rights and privileges of the Cutlers' Company, nor, save as is otherwise in this Act expressly provided, shall any of the provisions of this Act apply to or in the case of any Sheffield corporate mark.*"

The Act provided (*h*) further, (1) for copies of all the Sheffield corporate marks in force to be delivered to the registrar; (2) for notices of new applications to the company for the assignment of corporate marks, and copies of the marks applied for to be delivered to the registrar, and for notices of applications to the registrar for registration under the Act of marks belonging to any goods or class of goods within the Cutlers' Company Acts (*i*), and copies of the marks referred to, to be delivered to the company (*k*); and (3) for notices of assignment and registration.

(*e*) Sect. 9 (6), set out below.
(*f*) Sect. 81 (9).
(*g*) Sect. 9 (5).
(*h*) Sect. 9. Appendix, p. 590.
(*i*) See list below; p. 96.
(*k*) The company sometimes op-

Sub-sections (4), (5), and (6) of section 9 of the Act of 1875 were in the terms following:—

Mark resembling a corporate mark not to be registered.

"(4.) *The registrar, under this Act without the special leave of the Court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with respect to which a Sheffield corporate mark shall have been assigned and actually used, and of which mark a copy, or description, or notice of the assigning whereof shall have been delivered or given to the registrar as aforesaid, register a trade-mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive* (*l*).

Corporate mark resembling registered mark not to be assigned.

"(5.) *The masters, wardens, searchers, and assistants of the Cutlers' Company shall not assign to any person a mark or device identical with any trade-mark registered under this Act, and notice of the registration whereof shall have been given to the Cutlers' Company as aforesaid, or so nearly resembling the same as to be calculated to deceive* (*l*).

Corporate mark might be registered.

"(6.) *Any person to whom a Sheffield corporate mark legally belongs shall be entitled to have the same mark registered also as a trade-mark under this Act, in respect of any particular goods or classes of goods, in the same manner and upon the same terms and conditions in and upon which he might have registered the same if it were not a Sheffield corporate mark.*"

The Act of 1883.

The Act of 1883, on the other hand, provided for the closing, within five years from the commencement of the Act (*m*), of the register of corporate marks, and for the commencement of a new register of trade-marks to be kept at Sheffield by the Cutlers' Company, to which the corporate marks might be transferred; and it directed that all corporate marks entered on the register of corporate marks

posed the registration of marks which they deemed to too closely resemble corporate marks in use. See *Re Rosing*, 54 L. J. Ch. 975, n. (1878).

(*l*) Cf. sect. 6 of the Act of 1875, and sect. 72 of the Act of 1883.

(*m*) 1st January, 1884, sect. 3.

and not entered on the new register before the closing of the former, should be deemed to have been abandoned (*m*).

The Act of 1888.

Sect. 81, which is the part of the Act relating to the Sheffield marks, and containing the provisions just referred to, has been amended by sect. 20 of the Act of 1888, the principal alteration being occasioned by the substitution of, and the extension thereby of the section to, "metal goods," meaning "all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal," in place of "cutlery, edge tools, raw steel, goods made of steel, or of steel and iron combined, whether with or without a cutting edge." The last-mentioned class of goods had been inserted in the original section in the place of the list taken by the Act of 1875 from the Cutlers' Co. Act of 1860, namely, knives, sickles, shears, scissors, razors, files, forks, saws, edge tools, or other articles of steel, or of steel and iron combined, having a cutting edge.

The section is set out below, the words printed in italics being repealed, and those in brackets introduced by the amending Act (*n*).

The effect of sect. 81.

The general effect of the section is to make the Sheffield register a branch of the principal register for trade-marks used on metal goods and registered by persons carrying on business in Hallamshire or within six miles thereof, and to place the local register under the charge of the Cutlers' Company.

Duties of the Cutlers' Company with regard to registrations.

The duties of the company are, however, ministerial only as regards the registration of old corporate marks (*o*); as regards the registration of other marks, the company are substituted for the comptroller, subject to his veto upon any particular registration (*p*), unless such veto is overruled on appeal by the Court, and subject, in cases where the comptroller's veto is not exercised, to appeal from the company to him (*q*).

(*m*) Sect. 81 (9).
(*n*) Act of 1883, s. 20.
(*o*) *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344 (1889), C. A.
(*p*) Sub-sect. (5).
(*q*) Sub-sect. (12).

The section is as follows:

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 (*r*) by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect: Registration by Cutlers' Company of Sheffield marks.

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade-marks (in this Act called the Sheffield register): Cutlers' Company to open a new register;

(2.) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next subsection all the trade-marks entered before the commencement of this Act* (s) *in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade-Marks Registration Act*, 1875, *belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade-Marks Registration Act*, 1875.

[(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods (*t*) as defined in this section, all the trade-marks entered before the 1st day of January, 1889 (*u*), to enter on it the Sheffield marks on the old registers for metal goods, and old corporate marks.

(*r*) *i.e.*, registered under the Act of 1875.

(*s*) 1st January, 1884.

(*t*) Metal goods are defined by sub-sect. (14), below.

(*u*) Commencement of the Act of

" 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 (*c*), enter in the Sheffield register, in respect of metal goods (*x*), all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the 1st day of January, 1884 (*y*), but which have not been entered in either of the said registers] (*z*).

Application for Sheffield mark.

(3.) An application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge* [on metal goods] (*a*), 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 (*b*):

Notice to comptroller.

(4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner (*c*), and unless the

1888. As regards the registration of old corporate marks, the duties of the company are ministerial only. *Lambert's Tr.*, p. 96, *supra*.

(*v*) *i.e.*, made according to the last Form in the Rules, Appendix, p. 617. The application must be in duplicate, Rule 56. The procedure is generally the same as on an application to the comptroller. Chap. IV., p. 58.

(*x*) Metal goods are defined by sub-s. (14), below.

(*y*) Commencement of the Act of 1883.

(*z*) Act of 1888, s. 20 (1).

(*a*) Act of 1888, s. 20 (2).

(*b*) The effect of this sub-section and sub-sect. (7) is to constitute the Sheffield register a branch register for metal goods. The application must be on Form F., Appendix, p. 608; see Instructions (33), p. 632.

(*c*) A copy of the application is to be sent within seven days, with two representations of the mark for each class, Rule 57.

" comptroller within the prescribed time (*d*) 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 (*e*).

(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 (*f*): Veto by comptroller.

(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: Entry on register also.

(7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade-marks, the effect of such registration, and the assignment and transmission of rights in a registered trade-mark shall apply in the case of applications and registration in the Sheffield register; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that*

(*d*) The time is one month from receipt of notice, Rule 58 (1).

(*e*) *i. e.*, as an ordinary application is proceeded with by the comptroller, sub-sect. (7), Rule 59. If no such objection is made by the comptroller, the Cutlers' Co. shall require the applicant to send the comptroller a wood block or electrotype, as the comptroller may direct, and the comptroller shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office. Rule 58 (2).

(*f*) The Court is defined by sects. 117 and 111. Cf. sub-sect. (12), which gives an appeal from the company to the comptroller.

"*the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register :*

Procedure and rules.

[(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 (*g*) 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] (*h*).

Widow's corporate mark.

Application for Sheffield mark to comptroller.

(8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof, an application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with*

(*g*) The corporate marks were assigned for the life of the assignee and his widow ; see *ante*, p. 93, and the Cutlers' Company Act, 1814, *ante*, p. 92.

(*h*) Act of 1888, s. 20 (3).

"*or without a cutting edge* [on metal goods] (*i*), he shall in the prescribed manner (*k*) notify the application and proceedings thereon to the Cutlers' Company:

Closing of Cutlers' register.

(9.) At the expiration of five years from the commencement of this Act (*l*) 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 (*m*):

Registration for two Sheffield marks.

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade-marks:

Firm or company.

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade-mark or trade-marks (*n*):

Appeal to the comptroller.

(12.) Any person aggrieved (*o*) by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner (*p*), appeal to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court (*q*):

Counterfeiting Sheffield marks.

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Com-

(*i*) Act of 1888, s. 20 (2).

(*k*) *i. e.*, by sending a copy of the official paper, the Trade-Marks Journal, containing the application; Rule 58 (3).

(*l*) 1st of January, 1884.

(*m*) See Chap. XIV., p. 283.

(*n*) Person in the Act includes a body corporate, sect. 117; and in sect. 62 (application for registration), it includes a firm, Rule 7.

(*o*) See sect. 90, p. 221.

(*p*) Form W., Appendix, p. 616. No time for appeal has been fixed.

(*q*) Cf. sub-sect. (5), above.

" pany'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 (*r*), shall apply to any mark entered in the Sheffield register (*s*) :

Metal goods.

[(14.) For the purposes of this section the expression 'metal goods' means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal (*t*) :]

Certificate of master of the company.

[(15.) For the purpose of legal proceedings in relation to trade-marks entered in the Sheffield register a certificate, under the hand of the master of the Cutlers' Company, shall have the same effect as the certificate of the comptroller" (*u*).]

(*r*) For the sections referred to, the Cutlers' Company's Acts and see p. 544, below.

(*s*) The effect of this is to extend the last-mentioned sections to all the locally registered metal goods marks.

(*t*) For the list of goods to which the Act of 1875 applied, see pp. 92, 93; and for the list to which the unamended Act of 1883 applied, see the repealed sub-sect. (2).

(*u*) The certificate is evidence, sect. 96; Rule 60, above, p. 57.

CHAPTER VII.

COTTON MARKS AND THE MANCHESTER OFFICE.

PAGE
The repealed Cotton Marks Rules 103
The Cotton Marks Committee 104
The Manchester branch office 104
Jurisdiction of the Palatine Court of Chancery 105

The repealed Cotton Marks Rules.

By the rules issued under the Act of 1875 (*a*), marks for cotton goods in Classes 23, 24, and 25 (*b*) were specially treated. An office was set up at Manchester for the exhibition of all devices, marks, &c., used in the cotton trade, and in the rules called *cotton marks*, and every person using any cotton mark was required to send to the office three representations of it. A committee of persons versed in the usages of the cotton trade were appointed to consider the cotton marks, of which representations were sent in to the Manchester office, and to divide them into two classes: (a) those which were, in the opinion of the committee, trade-marks within the meaning of the Act; and (b) those which were not; and power was given to the Commissioners of Patents to add any cotton marks to either class (*c*). It was provided that any proprietor of a cotton mark not specified in class (b) might apply to be registered as proprietor of the mark in the manner and subject to the conditions in and under which he might have applied to be registered in respect of any other trade-

(*a*) Now repealed, see Chitty's Statutes. Rules 57—63a.

(*b*) Class (23), cotton yarn and thread (under the present Rules this is replaced by (a) cotton yarn, and sewing cotton not on spools or reels, (b) sewing cotton on spools or reels); (24) cotton piece goods of all kinds; (25) cotton goods not included in Classes 23, 24, or 38. Class 38, articles of clothing.

(*c*) Rule 58 (a) of March, 1883.

mark, but that it should not be lawful to register any person as proprietor of any cotton mark in class (b) except in pursuance of an order of the Court.

The Cotton Marks Committee.

The committee so appointed was held not to be a judicial tribunal, but merely a body appointed to consider and give an opinion on technical matters peculiarly within the knowledge of its members, and it was decided that its decisions could be reconsidered or disregarded by the Court, or by the registrar by direction of the Court, notwithstanding that it had acted fairly and properly, and had not proceeded on any wrong principle in arriving at them (*d*). And in a number of cases applications to the Court in respect of marks placed by the committee in class (b) were successful, and the marks were registered as trade-marks (*e*).

The Manchester Branch Office.

The special rules have now been repealed (*f*) and the committee of experts dissolved (*g*); but the Manchester office is maintained, and has been constituted a branch office of the registry, and applications for the registration of marks in Classes 23, 24, and 25 must be addressed and sent to it (*h*). Searches also in respect of marks in classes of textiles from Classes 23, 24, and 25 may be made in the Manchester office (*i*).

(*d*) *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. 479; H. L. reversing the judgment of the C. A. 8 C. D. 794 (1877).

(*e*) *Exp. Ede & Co.*, 28 W. R. 436; *Re Dugdale*, 49 L. J. Ch. 303; *Re Ward, Sturt & Sharp*, 50 L. J. Ch. 347; *Re Sykes*, 43 L. T. 626; and see Sebastian, 3rd ed. p. 548, where the cases are collected.

(*f*) But by the existing r. 13, four representations of marks must accompany an application to register in the cotton classes instead of two only.

(*g*) Lord Herschell's Committee refused to adopt a recommendation that honorary trade assessors be appointed to pass or reject cotton trade-marks, on the grounds that their appointment would diminish the sense of responsibility of the office, and that they did not feel sure that the creation of such a tribunal, reserving power to override its decisions, would give general satisfaction. Report of 1888, p. x.

(*h*) Rule 8. The address is: The Comptroller, Manchester Trade-Marks Branch, 48, Royal Exchange, Manchester.

(*i*) Instructions (34).

The Palatine Court of Chancery.

A *co-ordinate jurisdiction* with that of the High Court of Justice is vested in the Court of Chancery of the County Palatine of Lancashire in respect of any action or other proceeding in relation to trade-marks, the registration whereof is applied for in the Manchester office, subject to the ordinary right of appeal from decisions of that Court (*k*).

(*k*) Act of 1888, sect. 26. This provision was inserted in compliance with a recommendation of Lord Herschell's Committee (Report, p. x.). The other paragraphs of the reports of the committee, in regard to the Manchester office, may be of interest. The committee said, in an interim report of the previous year: "A very large proportion of the marks registered in the cotton classes, probably not less than 90 per cent., are the result of applications made by Manchester houses, or by houses having a representative in Manchester. We think it would add much to the smooth working of ths Act if applications in these classes were, as far as possible, dealt with by the head of the Manchester branch of the Trade-Marks Office. It is, we think, essential that the registration should take place in London, and that the final decision should rest with the comptroller as head of the office; but we recommend that in the case of each application, the head of the Manchester office should report his opinion as to whether the mark ought to be accepted or refused, and that his opinion should be acted upon, unless the comptroller sees clear reason to come to a contrary conclusion. We think that this duty of revision should in all cases be discharged by the comptroller personally." And these recommendations are endorsed in the final Report of 1888 (19).

CHAPTER VIII.

WHAT MARKS MAY BE REGISTERED AS TRADE-MARKS.

PAGE

Section 64 108
Additions and disclaimers 108
Section 10 of the Act of 1875 109
New marks may be registered 109
applicant must intend to use the mark 110
What Act applied to pending registrations 111
Section 10 (sect. 64 (1)) is purely restrictive.. 112

Essential particulars 112

(a) NAME-MARKS 114
mere name in nominative case 115
particular and distinctive manner 116

(b) SIGNATURES 117
signature of applicant 117
requirements for a good trade-mark 118

(c) DISTINCTIVE DEVICE, &c. 118
meaning of distinctive 119
1. What marks are to be distinguished 122
common marks 122
other trade-marks, registered or not 125
abandoned trade-marks 126
marks used as advertisements 126
2. What degree of distinctiveness is required 127
secondary distinctive meaning 127
descriptive marks 127
DEVICE 128
Devices as trade-marks 128
word or letter not a device 129
colour 129
portrait of inventor.. 129
part of mark common to trade 129
combination devices.. 130
descriptive devices 131
MARK 132
BRAND 133
HEADING 135
line headings for cotton goods 136
LABEL 136
phrases and proverbs 137
ordinary arrangement of common parts 137
no disclaimer of common parts 138
similar common words in contrasted labels 139

(c) DISTINCTIVE DEVICE, &c.—*continued.* PAGE
WORD MARKS 140
Words as trade-marks 140
Report of Lord Herschell's Committee 141
geographical names, translated words, phonetic equivalents .. 141
FANCY WORD OR WORDS NOT IN COMMON USE 142
1. Fancy word 142
Van Duzer's case 143
the word must be obviously meaningless 143
descriptive words 145
words in a foreign language 145
name of *goods* in a *foreign language* 146
names of common marks 147
secondary distinctive meaning does not constitute a word a fancy word 147
geographical words 147
name of a person 149
2. Not in common use 149
in the trade or popularly 150
"the" prefixed to word 150
Examples from decided cases 150
(d) INVENTED WORDS 152
(e) WORDS HAVING NO REFERENCE TO GOODS 153
Old marks 153
1. Special and distinctive 154
deceptive mark not distinctive 155
descriptive words 155
words with a secondary distinctive meaning 155
Examples of old word marks 158
2. Used as a trade-mark 158
use on bottles or boxes only 159
where the applicant has another trade-mark 159
the old mark must have been used as registered, and alone .. 160
use for the same goods 160
use in the United Kingdom 161
fraudulent use 161
temporary cession of user 161
slight evidence of user sufficient 161
Colour 162
Section 67, registration in colours 162
Colour as an element of similarity 163

THE marks which may be registered as trade-marks were determined, from the commencement of the register until the end of 1883, by sect. 10 of the Act of 1875; from the last-mentioned date until the end of 1888, by sect. 64 of the Act of 1883, and they are at present, and from the beginning of 1889 they have been, determined by the revised and amended sect. 64, enacted by sect. 10 of the Act of 1888. Sect. 64 is printed below; the ordinary type

showing the terms as revised and at present in force, the words in brackets being added by the Act of 1888, and the italic type showing the parts of the Act of 1883 which have been repealed.

Sect. 64. "**64.** (1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:

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

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

(c) A distinctive device, mark, brand, heading, label, ticket, *or fancy word or words not in common use* (*bb*);

[(d) An invented word or invented words (*c*); or]

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

Additions and disclaimers. (2.) (*f*) There may be added to any one or more of *these* [the essential] particulars [mentioned in this section] any letters, words, or figures, or combination of letters, words, or figures, or of any of them [but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark (*g*), 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] (*f*).

[(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

(*a*) Page 114.
(*b*) Page 117.
(*bb*) For references, see p. 106.
(*c*) Page 152.
(*d*) Page 153.
(*e*) Page 147.
(*f*) See Chap. IX., p. 164.
(*g*) See Chap. IV., p. 68.

" such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.]

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

Sect. 10 of the Act of 1875.

Sect. 10 of the Act of 1875 (now repealed) was as follows:—

" *For the purposes of this Act:*

A trade-mark consists of one or more of the following essentials; that is to say,

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

A written signature or copy of a written signature of an individual or firm (*k*); *or*

A distinctive device, mark, heading, label, or ticket (*l*).

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 (*m*) *may be registered as such under this Act*" (*n*).

Now marks may be registered.

Before the Registration Acts it was necessary for the plaintiff in a trade-mark action to plead that the mark in question had acquired a reputation and become known as his by user in connection with his goods; but the Court did not require him to prove that the user had extended

(*h*) Page 154.

(*i*) The same as (a) in sect. 64.

(*k*) (b) adds "applying for registration thereof as a trade-mark."

(*l*) (c) adds "brand," and (d) and (e) admit the word-marks.

(*m*) 13th of August, 1875.

(*n*) 64 (3) (ii) adds "letter, figure," and combination of "letters and figures."

over any long or defined period, and it was therefore practically open to a trader to obtain protection against infringers of a newly devised mark which had hardly been used at all (*o*). The Acts have provided an additional mode of acquiring trade-mark rights, for it is held that marks which have never been used may be registered as trade-marks, and a right of property thereby acquired in them (*p*). "In my opinion," Cotton, L.J., said, in *Hudson's Case*, "the language (of the Act of 1875 (*q*)), though not appropriate, means this, that a man who designs one of those special things pointed out in sect. 10, is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled within the meaning of the Act to the exclusive use of that which in fact he has never in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it as that his user would be interfered with by the registration."

Applicant must intend to use the mark.

But the applicant for the registration of a new and unused mark must intend to use it, as a trade-mark, forthwith, for it is not permitted to place marks on the register merely to prevent other traders using and appropriating them (*r*). Moreover, there can be no infringement of an unused mark (*s*). It will usually be presumed that the applicant does intend so to use the mark, but in a case where it was shown that the registered proprietor of a

(*o*) See above, Chap. II., p. 34.

(*p*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.; *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165 (1889), North, J.

(*q*) The Court held that it made no difference to this matter whether the case were treated under the Act of 1875 or the Act of 1883. They, in fact, dealt with the case under the former Act.

(*r*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. 186, see at p. 234; 8 R. P. C. 137, C. A.

(*s*) *Per* Cotton, L.J., in *Hudson's Tm.*, 32 C. D. p. 319; 3 R. P. C. 155; and see *Edwards & Dennis' Tm.*, 30 C. D. 454 (1885), C. A.; and Chap. XV., below, p. 308.

mark was an importer of foreign goods, and had caused the mark to be registered only for the purpose of excluding from the English market goods similar to those in respect of which the registration was effected, and which had the mark affixed to them by the foreign producer to whom it belonged, the goods being intended by the producer for foreign markets only, the registration was held to be irregular, and was expunged (*t*).

Section 10 of the Act of 1888. (Sect. 64.)

This section governs all applications for registration, and all registrations made or taken to be made since the commencement of the Act, the 1st of January, 1889; but, as the question whether an omission from, or an entry in, the register was made without sufficient cause, and ought, consequently, to be rectified under sect. 90, must be considered with reference to the law in force at the date when the registration complained of was made, or is taken to have been made (*u*), it is necessary to consider the terms of the corresponding sections in the earlier Acts and to compare them with those of this section.

What Act applied to pending registrations.

Both the Act of 1883 (*v*) and the Act of 1888 contain saving clauses (*x*), and where an application was made two days before the Act of 1883 came into operation, and the registration was opposed, and the matter came before the Court for decision, the Court of Appeal thought it "undoubtedly the better course" to treat the question as governed by the old Act of 1875. In the particular case,

(*t*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. 186, see at p. 234; 8 R. P. C. 137, C. A.

(*u*) See the section, and *Ward, Sturt, & Sharp's Tms.*, 50 L. J. Ch. 347 (1881), Hall, V.-C.; and Chap. XI., below, p. 230.

(*v*) Sect. 113: "this repeal of enactments shall not affect the past operation of any of those enactments, or any . . . right to use a trade-mark granted or acquired, or application pending, . . . or right . . . acquired, . . . or anything duly done . . . under . . . any of those enactments before or at the commencement of this Act."

(*x*) Sect. 27: "nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act."

however, it made no difference (*y*). So, in *Burgoyne's Case* (*z*), where the application was made in December, 1887, but did not come before the Court until February, 1889, Chitty, J., held that it must be treated as made under the Act of 1883, and that the applicant, therefore, could claim registration of his mark as a "fancy word."

In the *Apollinaris Case* (*a*), Kekewich, J., put a still more favourable construction upon sect. 27 of the Act of 1888, for he held that, under circumstances similar to those of the last cited case, the applicants were entitled to registration if they could bring their mark within the terms of either the Act of 1883 or that of 1888.

Sect. 10 is purely restrictive.

The section is purely restrictive, as were also the corresponding sections of the earlier Acts, which it has replaced. It is intended to limit and curtail the numerous forms of words and other things which, before the Acts, were appropriated as trade-marks (*b*).

No mark can be put upon the register unless it complies with the terms of this section, but the presence in it of one or more of the specified particulars does not make the mark a good trade-mark, or, of necessity, entitle it to registration. Some restrictions on registration are imposed by the Act itself (*c*), and the comptroller has, as is shown elsewhere (*d*), discretion to allow or refuse registration where all the conditions of the Acts are complied with (*d*).

Essential Particulars.

A registered trade-mark must contain one or more of the essential

No trade-mark can be properly registered unless it contains one or more of the essential particulars enumerated in the Act under which the registration is made (*e*),

(*y*) *Hudson's Tm.*, 32 C. D. p. 317, Cotton, L.J.; 3 R. P. C. 115 (1886).

(*z*) 6 R. P. C. 227; 61 L. T. 39.

(*a*) (1891) 2 Ch. p. 201; 8 R. P. C. 137.

(*b*) *Per* Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 634; 4 R. P. C. 31 (1887).

(*c*) Sects. 72, 73 and 86. See Chap. X., below, p. 176.

(*d*) Chap. IV., p. 63; *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890); and see *per* Lindley, L.J., above, p. 67.

(*e*) Above, p. 111.

or unless it is within the proviso relating to old marks. This is clear enough from the Acts, but it is also supported by judicial authority. Thus, in *The Orr-Ewing Case*, Lord Cairns said (*f*): "I cannot think that the Vice-Chancellor Hall sufficiently appreciated the object and provisions of the Act of Parliament when he said that he considered that, in each case, a device or label, registration of which is applied for, must be looked at as a whole, and that if it appears to be such as in the ordinary course of business would be distinguished from other devices or labels it should be registered. To some extent, no doubt, this is true; but I apprehend the first duty cast upon the Court is to ascertain whether some one, or more than one, of the essential particulars of a trade-mark, as defined by the Act, is found to exist, so that the mark may be described with the one, or more than one, essential particular or particulars which distinguish it." And in a later case, Chitty, J., said (*g*): "The argument is that, though neither of the particulars is within the 64th section, the mark must be looked at as a whole; and being looked at as a whole, it is brought within the sub-section (c) (as a device or label) because as a whole it is distinctive. This point was raised before Mr. Justice Pearson, in *Price's Patent Candle Co.'s Case* (*h*), and without success. It is quite true that the mark must be looked at as a whole, but we must find in the whole, one at least of the essential particulars; and not one of the essential particulars, in my opinion, can be found in this mark." particulars, or be an old mark.

To one or more of the essential particulars there may be added any of the other matters enumerated in sect. 64 (2), but the applicant for registration of any such additional matter must now, under the amendment of that sub-section Additions.

(*f*) *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. p. 484 (1879).

(*g*) *Bradley's Tm.*, 9 R. P. C. p. 207 (1892). The mark in question consisted of the words *Worth's Corsets* printed in ordinary type, between two co-axial ovals.

(*h*) 27 C. D. 681 (1884). A conventional label with the words *National Sperm* printed on it. As to labels, see further, pp. 137 to 139.

introduced by the Act of 1888 (*i*), state in his application the essential particulars of the trade-mark, and must also disclaim (*k*), in his application also, any right to the exclusive use of the added matter, and a copy of the statement and disclaimer is to be entered on the register.

The power conferred by sect. 92 of the Act to alter registered marks, does not extend to the alteration of their essential particulars (*l*).

Name-marks.

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

Names are highly valued as trade-marks, or as essential particulars of trade-marks, and they were often adopted and protected as such before the Acts (*m*). Clause (a) is taken from sect. 10 of the original Act.

There is nothing in the clause to restrict the choice of the name, and comparison with the following clause shows that it need not be the name of the individual or firm applying for registration, as the signature referred to in the last-mentioned clause must. The practice of adopting trade-names, which are different from those of the traders or of the partners in the firms using them, is very common and is perfectly lawful, and as this is allowed there is no reason why a trader should not adopt as his trade-mark the name of a stranger or of an imaginary person, for the office of the mark is not necesarily to connect the goods which bear it with him, but to connect them with the business which he conducts in them (*n*).

The question whether the signature of the applicant's predecessor in business can be registered under this subsection is considered under clause (b) (*o*).

(*i*) Sect. 10 and sect. 16; *Bryant & May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.

(*k*) See Chap. IX. p. 166.

(*l*) See Chap. XI. p. 248.

(*m*) "The name of a firm is a very distinctive word indeed": *per* Jessel, M.R., in *Exp. Stephens*, 3 C. D. p. 660.

(*n*) See *per* Chitty, J., in *Hammond* v. *Brunker*, 9 R. P. C. p. 308 (1890); see also Chap. XVI. p. 394.

(*o*) Below, p. 117.

It does not follow that every name of an individual or firm printed, &c. as required by the sub-section which an applicant may select is entitled to registration, for, apart from the general restrictions expressly specified by the Act (*p*), the comptroller, in the exercise of his discretion (*q*), would, no doubt, reject any name which, contrary to the fact, tended to suggest that the goods on which it was used were the manufacture or merchandise of, or had some connection with a particular person or firm, or were goods of a particular kind, especially if the name were not the proper name of the applicant or of his predecessors in trade.

Name must be mere name in nominative case.

The name must be the mere name in the nominative case. Thus, where *Pirie's Parchment Bank* was registered as a trade-mark, and the two latter words were disclaimed, Lindley, L.J., held that *Pirie's* was not the name of a firm within the sub-section (*r*).

And as regards the registration of names in the possessive case, generally, Lord Herschell's Committee reported (*s*), that "complaints have also been made that where words have been refused as not being distinctive, they have afterwards been allowed where the applicant has applied for a mark consisting of the same word preceded by the applicant's name with an apostrophe. We think," they added, "that this course ought not to be pursued. Little or no mischief might result where the name of the applicant was an uncommon one; but where the name was a common one the result would be to deprive all persons bearing the same name of their right to use a common word in connection with their own name, and even if the name were an uncommon one it would be impossible to say that there were not other persons bearing it who might wish to use it in connection with the common word which it is sought to monopolise."

The report continues: "Evidence has been given that

(*p*) Sects. 72, 73 and 86; Chap. X. p. 175.

(*q*) See p. 63.

(*r*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17; cf. *Colman's Tm.*, 11 R. P. C. 129; W. N. (1894) 30, where Stirling, J., held that *Colman's* occurring in a label need not be disclaimed under sect. 64 (3) (1).

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

marks consisting of a combination of the applicant's name "with the article he manufactures or sells are highly valued. There can be no doubt that if a manufacturer or vendor has obtained for his goods a reputation amongst the public, he could, by process of law, quite apart from the Trade-Marks Act, prevent goods that were not his from being offered to the public on the representation that they were so. But it would be quite a different thing to give, by virtue of registration under the Trade-Marks Act, a right to prevent another manufacturer or merchant honestly describing his own goods by his own name" (*s*).

The effect of the decision in *Pirie* v. *Goodall* will, no doubt, be to put a stop for the future to the registrations which the committee thought objectionable.

Printed, &c. It may be assumed that *printed*, *impressed*, or *woven* must be construed to include any method of marking the name upon, or attaching it to, the goods which it is to distinguish.

Particular and distinctive manner. The word "distinctive," where it appears in this section, in sub-sect. (c), and, in conjunction with "special," in sub-sect. (3) (ii.), has been repeatedly construed by the Court (*t*); but in the present clause it does not seem to present any difficulty. The intention of the requirement that the name should be printed (&c.) in a *particular and distinctive manner* was obviously to prevent a name being so taken as a trade-mark, that any trader might unintentionally infringe it by an honest use of his own name (*u*). This intention would be carried into effect by construing the words to mean "not ordinary, having regard to the practice in the trade concerned."

Ordinary type. A name printed in ordinary type, or in type in ordinary use, as, for instance, capitals (*x*), or common ornamental

(*s*) See *Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102, Kekewich, J., where something like this seems to have been done by the registration of a name as an old mark.

(*t*) See below, pp. 118—127.

(*u*) See the extract quoted above from the report of Lord Herschell's Committee. As to the right of a man to trade under his own name, see clause 3 (1), and below, p. 167; but cf. *Hopkinson's Tm.*, note (*s*).

(*x*) *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 732 (1889), North, J., (*Gianaclis Cigarettes*).

letters (*y*), is not within the sub-section; and the addition of marks which are common to the trade makes the words no better as a trade-mark (*z*).

Signature of the applicant.

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

Under the Act of 1875 the latter words of the clause ran "of an individual or firm." The addition "applying for registration" was effected by the Act of 1883. One result of the alteration is, as Mr. Sebastian points out (*a*), that a trader cannot register the signature of his predecessor in business under this sub-section. He may, however, if it falls within the terms of (3) (ii.) be able to register it as an old mark (*b*); and if the signature is printed (&c.) in a distinctive manner, he can register it under sub-sect. (a) (*c*), unless it should be held that it must be implied from the presence of this clause (b) that signatures were intended to be excluded from clause (a) (*d*); but this is not a necessary or, it is submitted, the true, construction of the section. The object of the insertion of clause (b) may well have been to preclude any question whether a name, reproduced as ordinarily signed by its owner, did or did not fall within (a), although, had (*a*) stood alone, it would not have been open to doubt that any characteristic signature was within it. Of course, the signature of a predecessor in business, *properly registered by him and assigned or transmitted*, as a trade-mark, together with the goodwill of the business, is usually as available for use by the successors, and can be as readily protected, as if it had been originally registered by them (*e*).

(*y*) *Re Price's Patent Candle Co.*, 27 C. D. 681 (1884); Pearson, J.

(*z*) *Ibid.*, and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.; (*Worth's Corsets*) printed between two co-axial ovals.

(*a*) 3rd edition, p. 36.

(*b*) Below, p. 153.

(*c*) Above, p. 144.

(*d*) Cf. *Exp. Stephens*, 2 C. D. 659 (1876), when, in refusing registration, under the Act of 1875, to the word *Acilyton*, Jessel, M.R., asked: "Why should a written signature be specified, if any signature will do?"

(*e*) See Chap. XIII., p. 272, Assignment and Devolution of Trade-marks.

Requirements for a good trade-mark.

Copies of written signatures were frequently protected as trade-marks, or as material parts of trade-marks before the Acts (*f*). As a man's signature has for several centuries been the mark in universal use to authenticate documents which are his, it might have been expected that it would have been used also to authenticate his goods, and that signatures would have occupied a more prominent place among trade-marks than they do. There are, however, several objections to a signature as a trade-mark. A good trade-mark must not only enable a customer to recognize the goods which bear it when he sees them, as those of the manufacturer or trader with whom he wishes to deal, but must also enable him to describe and call for them. As regards the latter requirement, a signature is usually nothing more than a bare name-mark, for the manner of writing it will rarely be such as to enable even a person, who could read and recognize it at sight, to recollect and describe it; and it is obvious that for customers—foreigners, for instance—who are unable to read the signature, it, or, indeed, any name-mark, fulfils neither of the requirements referred to.

The signature itself, being an essential particular of a registered trade-mark, cannot be altered under sect. 92. A corresponding decision was given by Jessel, M.R., under the Act of 1875 (*g*).

Distinctive device, &c.

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

Brand did not appear in the Act of 1875. It was added by the Act of 1883. The latter Act contained also the clause "fancy word or words not in common use," which is now replaced by sub-sects. (d) and (e) (*h*).

Distinctive governs, and is to be read with, each of the words which follow it (*i*). It merely incorporates what

(*f*) As in *Farina* v. *Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 24 L. J. Ch. 632; 26 L. J. Ch. 11; and 4 K. & J. 650 (1855), Wood, V.-C., and Lord Cranworth; *Massam* v. *Thorley's Cattle Food Co.*, 6 C. D. 574; 14 C. D. 748 (1877), Malins, V.-C., and L.JJ.

(*g*) *Re Dewhurst*, 11th June, 1880, stated in Sebastian, 3rd ed. p. 364.

(*h*) Below, p. 152.

(*i*) *Waterman* v. *Ayres*, 39 C. D.

was law before the Registration Acts, in so far as it requires that, in order to be a trade-mark, a symbol must be capable of distinguishing the goods upon which it is placed from similar goods, so as to identify them with the business of the proprietor of the mark (*j*).

"Distinctive."

The word standing alone in this clause, and coupled with *special*, in clause (3) (ii) (*k*), has been construed in a number of cases. In *Leonard and Ellis' Case*, Fry, L.J., expressed an opinion that the words *special and distinctive* of sub-sect. (3) (ii), "import the specializing of the make and manufacture of a particular maker from all other manufacturers, and distinguishing the manufacture of one person from the manufacture of all others" (*l*). In *Wood* v. *Butler* (*m*) Lindley, L.J., said that distinctive trade-mark "must mean some mark which distinguishes the goods to which it is attached as those made or sold by the person who uses the mark"; and Fry, L.J., repeated his definition from the earlier case. The whole Court held that it was not sufficient for the mark to be distinctive as regards the trade, it must be distinctive in the eyes of the ultimate customers, the consumers. "It ought," said Lopes, L.J., "to be a special and distinctive mark, not only recognizable by the trade, but also recognizable by the consumer, as connecting the article with the manufacturer. So that, as the proprietor of the mark had put upon the boxes in which his goods were enclosed, words suggesting that they were made, not by him, but by a foreigner, although the suggestion was, as the trade knew, false, he had by his own act prevented the mark from being distinctive.

29; 5 R. P. C. 368 (1888), C. A.; *Burland* v. *The Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J.; *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, C. A.

(*j*) See Chap. II., p. 35; *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. 479 (1879), and *Hopkinson's Tm.*, (1892) 2 Ch. p. 121; 9 R. P. C. 102, Kekewich, J.

(*k*) Below, p. 154.

(*l*) 26 C. D. p. 304 (1884), C. A. *Valvoline* for valve oil.

(*m*) 32 C. D. 247; 3 R. P. C. 81 (1886), *Eton* for cigarettes, claimed as an old mark.

Lord Halsbury defined the word in similar language to that of Fry, L.J., quoted above, in *Perry-Davis & Son* v. *Harbord* (*n*), distinctive, he said, "means distinguishing a particular person's goods from somebody else's,—not a quality attributed to the particular article, but distinctive in that respect that it means that it is a manufacture of his distinguished from somebody else's" (*n*). And he held that the word *pain-killer*, as applied to a patent medicine, was neither special nor distinctive (*o*).

"The essence of a trade-mark," said Kay, J., in *Richards* v. *Butcher*, "is that it is some distinctive thing which points out that the goods are the goods of A. B." (*p*).

And in *Hopkinson's Trade-Marks* (*q*) Kekewich, J., said: "In order to protect a trade-mark before the Act, you were obliged . . . to prove by evidence, and satisfy the Court, that the words used as a trade-mark were known in the market, and—I think it is Lord Westbury's phrase (*r*)—gave a vendible character to the articles to which they were attached, made these articles recognized as coming from a particular manufactory, and so gave them a character different from every other article in the trade. Therefore, it seems to me, that the legislature here (*s*) did no more than adopt the language of the cases."

James' Tm.

In *The Dome Black Lead Case* (*t*) Lopes, L.J., put a somewhat different interpretation on the word *distinctive*. It

(*n*) 15 App. Cas. p. 320; 7 R. P. C. 336 (1890) *Pain-killer* claimed as an old mark for medicine.

(*o*) So also did Lord Morris, in the House of Lords, and Fry and Lopes, L.JJ., in the Court of Appeal.

(*p*) (1891) 2 Ch. p. 536; 8 R. P. C. 249, Kay, J., and C. A. *Monopole* for wines. In each of the last three cases, the marks were claimed as special and distinctive words used as trade-marks before 13th August, 1875. They were all rejected.

(*q*) (1892) 2 Ch. p. 121; 9 R. P. C. 102; *J. & J. Hopkinson* for pianos, claimed and allowed as an old mark.

(*r*) *The Leather Cloth Co.* v. *The American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. 199 (1863), cited above, p. 47.

(*s*) *i. e.*, by the use of the phrase "special and distinctive" in the old mark clauses of the Acts.

(*t*) *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

means, he said, "that it must be a mark or device of such a kind as, in case of infringement, it shall be clear what it is that is being infringed, and that the mark is something distinct from all other marks used in the same class of goods." And the Court of Appeal there held, that, upon the evidence, a sketch of a short cylinder terminated by a hemisphere was a distinctive design for black-lead, which was in fact made up for sale in pieces of the shape shown by the sketch. There is, however, no disagreement between the two interpretations, and on consideration it will be seen that the first assumes the second, for no mark can distinguish the goods which bear it from all similar goods, or can create a species within the genus, unless it has itself some recognizable and characteristic peculiarity to separate it from other marks which may be found upon some or all of them. Moreover, a mark which satisfies the second test, and possesses such a peculiarity as is referred to, if this is recognized with sufficient readiness as a peculiarity, must of necessity, when it becomes known, distinguish the goods which bear it in the manner required by the test suggested by the *dicta* first cited. In the case of new marks which have, and can have, acquired no connection by reputation with their owner, all that can be demanded of the mark is that it shall be capable of distinguishing the goods to which it is applied in the required manner, and this accords with the old law (*u*).

Meaning of "distinctive."

In order to be distinctive, then, a mark must be different from other marks used upon or in connection with the same goods, and the difference must be such as, in the case of a mark already used and known, to distinguish the goods which bear it as the goods of its proprietor; or, in the case of a new mark, to be capable of so distinguishing, and to be likely when used and known, to so distinguish, the goods. Three questions arise upon this:—

Questions to be considered.

(1) What are the other marks from which a mark under consideration is to differ? (2) What kind and degree of

(*u*) See Chap. II., p. 35.

difference will suffice? and (3) What is the function of evidence in the determination of the inquiry? The second and third questions may be more conveniently considered in connection with the restriction put upon the registration of marks which too nearly resemble previously registered marks by sect. 72 (*x*).

1. What Marks are to be distinguished.

Common marks.

In many trades there are a great number of common marks, which have been generally adopted for ornament or some similar purpose, or which—having been in the first instance appropriated as trade-marks—by abandonment, by wide-spread piracy (*y*), or, in the case of word-marks, by becoming the names (*z*), and therefore descriptive, of the goods, have become *publici juris*. And a mark, to be distinctive, must be distinguishable from all of these.

Thus the committee of experts appointed under the Act of 1875 (*a*), to classify the marks tendered for registration in respect of cotton goods, rejected some marks bearing arrangements of elephants, lions, and crowns, on the ground that such devices or symbols in themselves, and by reason of the extensive use of lions and demi-lions, and crowns and elephants by the trade, were not private property, and did not possess a distinctive character; and on the appeal from the registrar's refusal to register, evidence was given that among the marks rejected by the committee were 31 crowns used by 18 different firms, 52 elephants used by 30 different firms, and 137 lions and demi-lions used by 64 different firms (*b*). In the same case it was shown that triangular tickets in green and gold were in common use in the cotton trade.

The Orr-Ewing Case.

In the early years of the existence of the register, a

(*x*) Chap. X., p. 186. As to question (2), see also below, p. 127.

(*y*) See *Ford* v. *Foster*, 7 Ch. 611 (1872); and above, p. 37.

(*z*) See Chap. II., p. 36.

(*a*) See Chap. VII., p. 103.

(*b*) *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. p. 485 (1879); and see *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878); and *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878), both Jessel, M.R.

number of common marks were accepted and placed upon it in ignorance of their true character. The committee of experts, to which reference has been made, was instituted to assist the registrar, and, after 1884, the comptroller, in determining what marks were common in the cotton class, and it was the practice of these officers in other cases to consult the representatives of the trade concerned on the subject (*c*).

What marks are common.

It is clear that such marks as these which are in common use in the trade must be standards of comparison by which the distinctiveness of a new mark must be tested (*d*); and some assistance in determining when a mark is to be taken to be in common use, may be obtained from the decisions on other parts of the Act. Thus, sect. 64 (c) of the Act of 1883 (now repealed) allowed fancy words not in common use to be registered, and on this it was held, that use by several firms in the trade in question, and by others in different trades, was common use (*e*). And sect. 74 (*f*) provides for the registration, as additions to a trade-mark, in the case of any mark used as a trade-mark before 13th August, 1875, of any distinctive (*g*) device, mark, brand, heading, label, letter, word, or figure, or combination of letters, words, or figures; and in the case of any mark not so used of any distinctive (*g*) word or combination of words, though the same be respectively common to the trade in the goods with respect to which the application is made. The section also provides (3) that a mark which was, before the 13th of August, 1875, publicly used by more than three

(*c*) *Per* Jessel, M.R., in *Kuhn's Case*, *supra*.

(*d*) See *Bryant & May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.; the cases cited in note (*b*); *Anderson's Tm.*, 26 C. D. 409, Chitty, J.; affirmed on appeal, 54 L. J. Ch. 1084 (1884); and *Thewlis & Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J. *Ancross* rejected because anchors were common in the trade.

(*e*) *Great Tower Street Teas Co.* v. *Smith*, 6 R. P. C. p. 172 (1889), *Tower Tea*; and see below, p. 149.

(*f*) See Chap. IX., p. 164, Additions and Disclaimers.

(*g*) This means *primâ facie* distinctive. *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J., (*Washerine*).

persons on the same or a similar description of goods shall, for the purposes of the section, be deemed common to the trade in such goods (*h*).

In *The Washerine Case* (*i*) Chitty, J., held, that marks might be *common to the trade* within the sect. 74, though not publicly used by more than three persons, as required by sub-sect. (3), and that the words do not mean "in common use in the trade," but "open to the trade," and this interpretation was adopted by Kekewich, J., in *The Apollinaris Case* (*k*). In an earlier case the last-named judge said: "Any word which the trade might have used at the date of the registration is, as I construe the Act, common to the trade. I think it means that a word, which might have been used for these particular goods by any other persons at the time is common to the trade" (*l*). Obviously this construction must be read with some limitation, or no new mark could ever be registered, for every unused mark is open to the trade until it is monopolised by someone, either by registration or by user, as a trade-mark. It is submitted that what is meant is that a mark common to the trade is one known in the trade and not appropriated, and this is consonant with the contexts of the passages cited above, and Chitty, J., gives, as an example, the case of a mark widely used and then abandoned by all but two or three persons in the trade. In *The Apollinaris Case* the word in question was the name of a mineral water which might have been sold by the proprietors to other traders than the claimants of the mark, although they were, for the time, the sole importers of it. And in *The Herbalin Case* the word had been extensively used before registration both by the plaintiff and the defendant. They were all cases of descriptive words.

In *The Stone Ales Case* (*m*) Lindley, L.J., expressed an

(*h*) See below, pp. 172 and 177. The three mark rule.

(*i*) *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889).

(*k*) (1891) 2 Ch. p. 209; 8 R. P. C. 137.

(*l*) *Humphries* v. *Taylor Drug Co.*, 59 L. T. 820 (1888), (*Herbalin*).

(*m*) *Thompson* v. *Montgomery*, 41 C. D. p. 49; 6 R. P. C. 404 (1889).

opinion that a mark used by one person in the trade only could not be common to the trade.

How far marks which are or have been used by one or more persons in the trade, but which are not commonly used, or common to the trade in the sense just suggested, and are not trade-marks, are to be regarded—in judging whether a mark tendered for registration is distinctive—is unsettled.

Other trade-marks, registered or unregistered.

Where the marks are trade-marks, whether registered or unregistered, it is clear that they are obstacles to the registration of any mark which so closely resembles them as to be calculated to deceive, unless the applicant has an independent trade-mark right in the mark he puts forward (*n*). This is expressly enacted by sect. 72, in regard to registered trade-marks (*o*); and it follows, in the case of such unregistered trade-marks as are words, from the prohibition placed by sect. 73 upon the registration of any words, the use of which, by reason of their being calculated to deceive or otherwise, would be deemed disentitled to protection in a Court of Justice (*p*). Apart from these sections, however, it is clear that a mark which is calculated to deceive the public by leading them to believe that it is the trade-mark of some person other than its proprietor cannot be distinctive in accordance with the explanations of the term given in the judgments cited above. In the very extraordinary circumstances of the case of *Mouson* v. *Boehm* (*q*), it was held that a trade-mark which had been registered at a time when a similar and previously acquired unregistered trade-mark for the same goods was in existence might be allowed to remain on the register, on the ground that the later mark had been registered in good faith and in ignorance of the earlier unregistered mark, and had remained unchallenged on the register for two years, during which time it had been extensively used in its

(*n*) Cf. Chap. XV., pp. 325 *et seq.*, Infringement.

(*o*) Chap. X., p. 175.

(*p*) Page 209.

(*q*) 26 C. D. 398 (1884), Chitty, J. The facts are stated below, p. 325.

proprietor's business; but the case was treated as exceptional, and the earlier trade-mark was admitted upon the register also.

Abandoned trade-mark.

But an abandoned unregistered trade-mark is, as such, no obstacle to the registration of a similar mark (*r*), that is, unless it has become a common mark in the trade.

Marks used in advertisements.

Besides common marks and trade-marks, there are, however, other marks used by traders in their businesses; for instance, marks employed in advertisements, or in the "get up" of his goods by a single trader. Are these to be taken as standards in estimating the distinctiveness of a new mark? This, it is submitted, depends upon the extent to which they are known and used. On the one hand, it would be absurd to compel a trader to collect and discriminate all the marks used by his fellow-traders, otherwise than as recognized trade-marks, in or in connection with their businesses, on peril of finding that the mark he has selected or invented for registration is bad; and, on the other hand, it would be a great hardship, to take a single example, to compel a rival trader to omit a material part of a well-known advertisement of his trade, because someone had registered it as a trade-mark. If a mark is well-known in connection with a particular trader, though not used as a trade-mark by him, its use upon the goods of another would be likely to identify them with him rather than with the latter, and it would not, therefore, be distinctive in regard to such goods, in the sense explained above. Thus, in a recent case (*s*), Kekewich, J., refused to direct the registration, as a trade-mark for wire-bound india-rubber hose, of a device consisting of a sketch of an elaborate knot of the hose, on the ground that it too closely resembled a picture of similar hose printed by the opponents in their price lists, notwithstanding that the device had been employed as an advertisement by the

(*r*) See the last case and *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, C. A., (*John Bull beer*).

(*s*) *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893).

applicants in their own price lists, and was registered as their copyright design.

2. What Degree of Distinctiveness is required.

What degree of distinctiveness is required.

The question, what degree of difference from other marks will entitle a mark to be registered, is considered in the chapter dealing with restrictions on registration, and, in particular, with sect. 72 (*t*). In addition to what is there said, it may be pointed out that, although a mark offered for registration may be fairly distinguishable from each of several others, yet the existence of these, if they are in use, opposes a cumulative weight of objection to any new mark which has an apparent resemblance to a number of them (*tt*).

Secondary distinctive meaning.

It has never been suggested that a secondary meaning acquired by user in connection with the applicant's goods, which would have sufficed to create trade-mark rights in an apparently descriptive mark before the Acts (*u*), will enable such a mark to be registered under them, unless it was used as a trade-mark before the 13th of August, 1875, and in *The Stone Ales Case* (*x*) the mark *Stone Ale* was removed from the register on the ground that there was no evidence of its separate user as a trade-mark before the date mentioned, altho its secondary meaning was not only fully established, but was the basis of the injunction granted against the defendant in the case.

Descriptive Marks.

Descriptive marks.

According to the construction placed upon the Acts, a descriptive mark cannot be distinctive. So that any mark which describes, either directly or by suggestion, the nature of the goods, their quality, or the purpose to which

(*t*) Page 186.

(*tt*) Cf. below, pp. 197, 198.

(*u*) Chap. II., p. 36.

(*x*) *Thompson* v. *Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal on this point to the House of Lords. As to old marks, see below, p. 155.

they are to be applied, is not registerable, and this rule has been applied far more strictly than that which rejected mere descriptive words as trade-marks before the Acts (*y*). This subject is discussed under the head of Word-Marks, below (*z*).

Device.

Devices as trade-marks.

Devices have been registerable under all the Acts. They are the oldest, and, in many ways, they form the most valuable kind of trade-marks. Before the description of shops and factories by street and number became the common and convenient method of identification, every trader had his characteristic "sign," and it was an obvious and natural step to transfer the sign from the shop to goods which it was desired to show had come out of it. And this was done in very early days. Fragments of classic pottery bear the potter's mark of their maker, and, to come to later times, the early editions of the Aldine Classics bear the device of a dolphin wound round an anchor (*a*). A good trade-mark which has a device as its central feature has this peculiar advantage, that its use is not restricted to customers who speak any one language. It is not, of course, necessarily equally useful or distinctive everywhere. For instance, pictures of a stag and a buffalo, though perfectly different to people who are acquainted with the forms of both animals, might well be indistinguishable by the inhabitants of some of the Pacific islands where no quadruped is known which is larger than a pig, and who would have no name for either. The chief objection to a device trade-mark is the difficulty of choosing one which shall be sufficiently simple and striking to fix itself in the customer's memory, and which shall readily suggest a name or description by which it can be referred to, and yet, at the same time, be distinguishable from the other marks in use for the same goods or description of goods.

(*y*) Chap. II., p. 36.
(*z*) Pages 140 *et seq.*
(*a*) Salaman on Trade-Marks, p. 1.

Word or letter is not a device.

It was decided under the Act of 1875, which did not provide for the registration of words, that a collection of English letters (*b*), or a single letter (*c*), could not, but that a word printed in Oriental characters might, be registered as a device (*d*).

Colour.

The device must be distinctive, irrespective of the colours in which it is printed, although a trade-mark may be registered in colours so as to appropriate to the owner the exclusive right to use it in those or any other colours (*e*).

Portrait of inventor.

In *Anderson's Case* (*f*) a device consisting of a portrait of Baron Liebig, with the words *Brand* above and *Baron Liebig* below it, was rejected as a trade-mark for Liebig's extract of meat, on the ground that the words *Baron Liebig* were open to the trade (*g*), and that the portrait of the inventor of the goods was not a distinctive device, it being, as Cotton, L.J., and Chitty, J., found, a common practice for those engaged in trade to place a photograph of the inventor on the particular article, in order to show that he is the inventor, or to show, in the particular case, that the article is made according to his invention (*h*).

Part of mark common to the trade.

Where a mark consists in part of distinctive matter and in part of matter which is common to the trade, the latter part cannot be registered without a disclaimer. Thus, in *Baker* v. *Rairson* (*i*), where a lighthouse, surrounded by two concentric circles, with initials and a date between

(*b*) *Exp. Stephens*, 3 C. D. 659 (1876), Jessel, M.R. (*Aeilyton*).

(*c*) *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C., application to register A, as an old mark for pens, refused.

(*d*) *Rotherham's Tm.*, 11 C. D. 250; 14 C. D. 585 (1878), Bacon, V.-C., and C. A., *Tod* in Arabic. Cf. *Gout* v. *Aleploglu*, 6 Beav. 69 n. (1833), *Pessendede* (*i. e.*) *warranted* in Turkish.

(*e*) *Hanson's Tm.*, 37 C. D. 112; 6 R. P. C. 130 (1887), Kay, J., *red, white, and blue* label. Sect. 67, below, p. 162.

(*f*) 26 C. D. 409, Chitty, J., and on appeal, 54 L. J. Ch. 1084 (1885), see *Liebig, &c. Co.* v. *Anderson*, 55 L. T. 206, Chitty, J.

(*g*) So held in *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. (N. S.) 298 (1867).

(*h*) 26 C. D. p. 415.

(*i*) 45 C. D. p. 533; 8 R. P. C. 89 (1890); see also *Kuhn's Tm.*, 53 L. J. Ch. 238 n. (1878), Jessel, M.R., where registration with a disclaimer was approved under the Act of 1875. See now, sect. 74, Chap. IX., p. 169.

them, had been registered in 1877 as a new mark, although the circles were in fact common to the trade, an application was made to remove the mark from the register. North, J., held that the circles ought not to have been registered, but as the whole mark had been used for a number of years, instead of ordering its removal, he directed a note, stating that the circles were common to the trade, to be put upon the register. The common matter can, however, be registered, with a disclaimer as an addition, under sect. 74, if the whole mark was used as a trade-mark before 13th August, 1875. In the case of marks not so used additions are restricted to words and combinations of words (*k*).

Combination device.

A combination of devices which are common to the trade may form a new and distinctive device (*l*). The test by which any such combination must be tried is, it is submitted, correctly stated in the following passage from the report of Lord Herschell's Committee (*m*). The Committee say: "In this connection we may refer to a point which has been the subject of considerable controversy, namely, how far registered or common marks when combined together are to be regarded as a new mark. We think that the juxtaposition of two or more such marks is not, if there be nothing more than this, a combination constituting a new mark. An important test appears to be whether the existing marks are so combined as to suggest a new idea. For instance, assuming a cat and a fiddle to be each an old mark, we do not think that the mere representation of a cat and a fiddle together would be a new mark, but the representation of a cat playing upon a fiddle, the idea conveyed by which would be neither the cat nor the fiddle, but a cat playing upon a fiddle, would be a good combination, and might properly be registered. We think that

(*k*) Chap. IX., p. 164; Additions and Disclaimers.

(*l*) The mark must be looked on as a whole, see Chap. X., p. 192; and below, p. 137, "Label," for instance where a number of common and some distinctive elements combined together did not form, as wholes, distinctive combinations, see *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. 479; and Lord Cairns' judgment, p. 484.

(*m*) Report of 1888, p. ix. The passage follows that upon the "idea of a trade-mark," cited at p. 189.

"this view differs somewhat from that which has been at times, at all events, entertained by the Board of Trade, but it appears to us to be the sound one."

Devices descriptive of the goods.

It has been held, in the case of word-marks, that descriptiveness is inconsistent with distinctiveness, and it would seem to follow, that marks which are descriptive of the goods to which they are to be applied are not within the Acts. In the opinion of Lord Herschell's Committee (*n*), such marks are not legitimate, and since the committee's report the comptroller has refused to accept them. This opinion is in accordance with the judgment of Pearson, J., in *James' Case* (*o*), holding that a representation of the goods on which the mark was to be used was not a good mark. In that case the mark in question was a sketch of a cylinder with a dome top, which had been registered in 1861, as a design, and as a trade-mark in 1877. It was used as a trade-mark for black-lead, which was generally, but not exclusively, sold in blocks of the shape shown by the sketch, and upon which the words "registered shape" were stamped. The Court of Appeal reversed the decision of Pearson, J., but Cotton and Lindley, L.JJ., apparently differed from the learned judge in their view of the facts only. They held that the mark was not a mere representation of the goods, and they laid stress on the circumstance that it might be used, and it had occasionally been used, on blocks of shapes other than that shown by the sketch (*p*). Lindley, L.J., said: "I cannot see why, according to English law, a fish may not be a distinctive mark for a fishing-line, though I can understand that a picture of a fish may not be a distinctive mark of that particular kind of fish. Why

James' Case.

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

(*o*) 31 C. D. 340 (1885). It also accords with a number of American decisions; see Sebastian, 3rd ed., p. 42. The Court of Appeal, however, thought that little assistance was to be obtained from the American cases; 33 C. D. 392; 3 R. P. C. 340.

(*p*) 33 C. D. 392; 3 R. P. C. 340. The appeal was heard *ex parte*, the respondents not appearing.

"a pig should not be, according to English law, a distinctive mark for lard, or something made out of a pig, I do not know. Supposing you tanned a pigskin into leather, I do not know why a pig should not be a good trade-mark for tanned pig's hide." Lopes, L.J., took the same view of the facts; but in the course of his judgment he asked: "Why is it (the mark) the less a distinctive device or mark because it represents the thing upon which it appears?" The suggestion of this question is not only at variance with the opinion cited above, but also with the statement of Lindley, L.J., that a fish would not be a good trade-mark for fish of the same kind (*q*).

Devices comprising pictures of the goods.

But although descriptive devices, including mere representations of the goods upon which the mark is to be used are objectionable, there seems to be no reason why pictures of the goods, worked up into a characteristic and uncommon design, should be refused. Thus a drawing of a mere ordinary coil of wire for wire, of a barrel for beer, a cricket-bat for cricketing materials, would be bad as trade-marks; but not a drawing of the wire woven up into a knot of new and striking design, or of several barrels or bats arranged in a particular and original manner (*r*).

It is somewhat difficult to define what degree of descriptiveness will make a mark objectionable, but the test is, it is submitted, to be found in the rule that, assuming the mark to be distinctive having regard to the marks already in use in the trade, as already defined, it must not be such as to restrict the liberty of any trader to use any drawing, picture, or device, which he may fairly require to enable him to describe his goods to any class of his customers in the ordinary manner.

Mark.

This word is sufficiently wide in its meaning, if it stood alone, to cover not only all the other symbols specified in

(*q*) See *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893), Kekewich, J.

(*r*) The question was discussed, but not decided, in *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893).

the section, but any kind of mark whatever. The insertion of the other words must therefore be taken in some way to limit its meaning; but it is not easy to see what kind of symbol, not registerable under the other words of the clause, could be used as a trade-mark.

Brand.

This word was introduced by the Act of 1883, in consequence of the ruling of Jessel, M.R., that cigar marks burnt into the ends of the boxes could not be registered under the Act of 1875, and in order to allow such marks to be registered (*s*); but it has not been restricted in practice to marks burnt into the goods or their envelope. Thus, a number of word-marks were at one time accepted and registered in the tin-plate trade as brands, which would not have been accepted under any of the other heads (*t*), because the words were geographical words.

Brand.

Lord Herschell's Committee said, in their report (*u*): "Some controversy has arisen with reference to the meaning of the word *brand* as distinguished from the other words employed. There can be no doubt that the term derives its origin from the practice of producing some mark by means of burning, but it appears now to be in use in certain trades for the purpose of describing trade-marks no longer produced in this way, and differing in no respect from the labels and tickets mentioned in the section; nevertheless a distinction has been made in the practice of the Office, and trade-marks have been allowed registration in certain trades as brands when they would not have been accepted in other classes as labels or tickets. We see no reason for this distinction. It does not appear to us to receive support from the language of the Act, and we

(*s*) See the evidence of the comptroller before Lord Herschell's Committee, Q. 2993. The comptroller stated that he did not see any reason for keeping up the distinction between brand and design or mark. Q. 3295.

(*t*) *Ibid.*, Q. 3294.

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

"think that, in future, brands should be dealt with in precisely the same way as labels or tickets."

Pirie v. *Goodall.*

This opinion corresponds with that expressed in the judgments delivered in *Pirie* v. *Goodall* (*x*). There the plaintiffs had, in 1885, registered the words *Pirie's Parchment Bank* for paper, disclaiming the exclusive use of both *parchment* and *bank*, which were words in common use in the trade. The defendants in an action for infringement moved to remove the mark from the register, and the plaintiffs tried to support it (*inter alia*) as a brand. Vaughan Williams, J., held, that the word brand must be limited in some way; it could not include all words, whether, for instance, they were *fancy words* (now *invented words*) or not. "I think," he said, "that before you can register anything as a brand, there must be evidence that, in point of fact, it is as a brand, and as a brand only, that it is used." The use of the words as a watermark on paper was not, the learned judge thought, user as a brand; but, he added, "I see no reason why a brand should not be woven into the goods just as much as stamped on to them or burnt into them." He ordered the trade-mark in question to be removed from the register. This decision was affirmed on appeal, and Lindley, L.J., who delivered the judgment of the Court, said he did not see why *mark* did not include *brand*, and he held that word-marks (*y*) could only be registered when they came within those parts of the section (64) which expressly relate to words, and consequently could not be registered as *brands* (*z*).

In *Paine's Case* (*a*), the words *John Bull Brand*, registered in 1885 as a trade-mark for beer, were ordered to be

(*x*) (1892) 1 Ch. 35; 9 R. P. C. 17.

(*y*) That is, marks consisting of a word or words, not headings, labels, or tickets, which comprise words.

(*z*) Cf. Lord Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. p. 295.

(*a*) (1892) W. N. p. 56, and 9 R. P. C. 130, Kekewich, J. The action in which the question arose is further reported, *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217.

removed. An attempt was made to support the mark as a brand, but Kekewich, J., pointed out that the mark claimed was the three words, not the first two, and that, consequently, the addition of the last word did not make the whole a brand. Some question was raised in the cases cited above as to whether a brand-mark must not be registered as a brand, but there is no machinery for such registration, as no distinction is made between the different heads referred to in the section upon the register.

The term *brand* was sometimes applied, before the Acts, to trade-marks branded on metal goods, or on wine casks, or corks (*b*), and its use to denote a class of some kinds of goods, as cigars, for instance, is very common; but these uses seem to have nothing to do with its meaning in the Act.

Heading.

The meaning of this term is not at all clear. The word is ordinarily used of a sentence or words placed at the top of a document as a title or to describe the matter contained in it; and it has been held that the words *Family Sauce*, printed thus, *Reinhardt's Celebrated Family Sauce*, at the top of a wrapper used for patent medicine bottles, formed a distinctive heading (*c*). But it has been held also, under the Act of 1875, which did not provide for the registration of words, that the single word *Valvoline* did not (*d*) form a heading, on the ground that word-marks were specially provided for in the Act. If the first decision can be relied on, and if it indicates the whole significance of the word in the section, the operation of the section under this head is very limited, for documents attached to

(*b*) Sebastian, 3rd ed. p. 39; *Millington* v. *Fox*, 3 My. & Cr. 338; *Seixo* v. *Provezende*, L. R. 1 Ch. 192.

(*c*) *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. The mark had been registered in 1876 as an old mark. It would, under the later decisions, have been refused as descriptive, and also because it was not the whole mark used before the Act.

(*d*) *Leonard & Ellis's Tm.*, 26 C. D. p. 295 (1884), C. A.: see the judgment of Selborne, L.C.

the goods or their envelope can themselves be registered as labels.

Line headings for cotton goods.

In the cotton trades a line heading means the pattern or marking woven at the end of a piece of cloth (*e*); and in *The Great Tower Street Tea Co.* v. *Smith* (*f*), North, J., said that this was what he understood by *heading* as used in this section. These line headings are of great importance in the Manchester trade, but are not registerable under the present Acts, since they are essentially colour-marks (*g*). A great deal of evidence as to the practicability of providing for their registration and protection was taken by Lord Herschell's Committee, and the most opposite opinions were expressed by the witnesses upon the subject. In the result, the committee reported (*h*) that they were disposed to think the registration was not practicable, and that they did not recommend that it should be allowed.

Label.

A label consists of a number of words, or of a word or words combined with a device or devices, or of a device or devices alone, printed on paper or other substance, in order to be stuck upon or attached to the goods or their envelope.

A single word or several words, not registerable alone, and not forming any sentence, will not become registerable by being printed on a plain piece of paper. Thus, in a recent case (*i*), North, J., said: "The plaintiffs would not be in any better position at all if they had put the words *Tower Tea* upon a piece of paper, otherwise blank, and fixed it on to their packages, than if they had, as they

(*e*) *Harter* v. *Souvazoglu* (1875), W. N. 11, 101; *Carver* v. *Bowker*, Seb. Dig. p. 350 (1877); *Robinson* v. *Finlay*, 9 C. D. 487 (1877).

(*f*) 6 R. P. C. p. 168 (1889).

(*g*) See above, p. 129.

(*h*) Report of 1888, p. ix, because the headings are essentially colour-marks.

(*i*) *The Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. p. 170 (1889). Cf. Lord Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884). So a black label, bearing the descriptive word *Monobrut* in its centre, was removed from the register in *Vignier's Tm.*, 6 R. P. C. 490 (1889), Kay, J.

"have done, impressed the words *Tower Tea* upon the packages themselves." And it would make no difference that the paper was surrounded by a conventional border, or was occupied by other indistinctive matter, not altogether forming a distinctive combination (*k*). So that the name of a firm printed in common letters on an ordinary label does not make a distinctive label (*l*).

Phrases and proverbs.

Lord Herschell's Committee reported (*m*) that "it is said that there is often a desire to register short phrases, such as proverbs, &c., and that owing to the difficulty of finding new marks, it is expedient that they should be allowed. We see," they added, "no objection to this, provided they be in no way descriptive of the character or quality of the goods, or of their place of origin, sale, or manufacture."

If such phrases are registerable under the present Acts, it can be only when printed and used as labels. And although a single word or two or three words, not forming a sentence and not themselves registerable, do not make an ordinary label distinctive, it may well be held that a phrase, such as is suggested in the passage cited, if printed prominently on the label, would do so.

Ordinary arrangement of common parts.

An ordinary arrangement of parts which are in common use, each part remaining as a distinct feature of the combination, does not form a distinctive label (*n*). So a label for match-boxes, bearing representations of a prize medal, with the words *Bryant and May's Royal Wax Vestas* printed in ordinary type, medals being common marks in the trade, was held not to be distinctive (*o*); and so also was a label

(*k*) See above, p. 129.

(*l*) *Price's Patent Candle Co.*, 27 C. D. p. 686 (1884), Pearson, J.; and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J., *Worth's Corsets*, between co-axial ovals. In *The Birmingham Vinegar Co.'s Tm.*, 11 R. P. C. 195 (1894), Kekewich, J., a label comprising a large H, some common words, and a small device, was held not to be, as a whole, a distinctive label.

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

(*n*) Cf. combination of devices, above, p. 130; and the passage from the Report there cited.

(*o*) *Bryant & May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.

bearing two co-axial ovals, with the words *Worth's Corsets* in ordinary type, and four dots arranged as a star at each end printed between them, ovals being common marks in the trade (*p*). In the last case, Chitty, J., held that the addition of the trade-name of the owner of the mark made it neither better nor worse, and he approved and followed *Price's Case* (*q*).

No disclaimer of common parts of label.

Common words, that is, words which any one is at liberty to use, which appear in a label, need not be disclaimed, for they are not essential parts of the label, and sect. 74, which provides for disclaimers, applies only to additions to the trade-mark, and the whole label is itself the trade-mark (*r*). So, in *The Apollinaris Case*, it was held, by the Court of Appeal, that the name *Friedrichshall* occurring on a label need not be disclaimed (*s*), and this was followed by Chitty, J., in the case of the *Smokeless Powder Co.'s* trade-marks, where he refused to order the words *Smokeless Powder* to be disclaimed on the application of rival makers of similar powder (*t*). A dictum of Cotton, L.J., in an earlier case (*u*), decided under the Act of 1875, that such words ought to be disclaimed, was cited in the last-mentioned case; but Chitty, J., declined to follow it. The decision of Stirling, J., in *Edge's Case* (*x*), that the words *Filtered Blue*, which he held to be bad as a separate trade-mark, must be disclaimed when registered on a label, is also in conflict with the rule stated above. None of the above-mentioned cases were, however, cited in *Edge's Case*, and it was not cited in the *Smokeless Powder Case*. A dis-

(*p*) *Bradley's Tm.*, 9 R. P. C. 205 (1892).

(*q*) 27 C. D. 686; cited p. 137.

(*r*) *Pinto* v. *Badman*, 8 R. P. C. pp. 188, 191 (1891). As to the registration of common marks as additions, see above, p. 108, and Chap. IX., p. 170.

(*s*) (1891) 2 Ch. 433; 8 R. P. C. 137; see also *Atkins' Tm.*, 3 R. P. C. 164 (1886), C. A.; and *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217.

(*t*) (1892) 1 Ch. 595; 9 R. P. C. 109.

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

(*x*) 8 R. P. C. 207 (1891).

tinctive label may accordingly be properly registered, although it contains words or names to the exclusive use of which no claim could be maintained (*y*).

Similar common words in another registered label is no objection to registration.

The presence of common words in a registered label does not prevent any trader registering a different label with the same or similar words. Thus *Valvoleum* printed across a label with a particular device was allowed, although *Valvoline* was already registered upon a label with a different device (*z*), Jessel, M.R., holding that each word was merely equivalent to *valve oil*.

Blanks in registered labels.

It is a common practice to register labels with blank spaces which in use are filled up by matter which is either not capable of registration, or which for some other reason it is not convenient to register, because, for example, it is changed from time to time (*a*). The practice is unobjectionable, and the use of the added matter, which forms, of course, no part of the trade-mark protected by registration, does not interfere with the protection of the label as registered (*a*). But in considering whether a mark is a proper mark to register regard must be had to the appearance it will present in actual use (*b*).

Ticket.

The only difference between a label and a ticket seems to be that a label is attached by sticking it on to the goods or their envelope, and a ticket by tying (*c*).

(*y*) *Hudson's Tm.*, *Atkins' Tm.*, and *Paine & Co.* v. *Daniells & Sons' Breweries*, *supra*.

(*z*) *Re Horsburgh & Co.'s Application*, 53 L. J. Ch. 237 (1878); see *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884), C. A.; *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29; North, J. (*unco' guid whisky*).

(*a*) *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892); *Melachrino & Co.* v. *Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), both Chitty, J.; and see Chap. X., p. 195.

(*b*) *Christiansen's Tm.*, 3 R. P. C. 51 (1886), C. A., the *Taendstikker Match Case*. And see Chap. X., p. 192.

(*c*) The words are used alternatively in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. 479; and *Great Tower Tea Co.* v. *Smith*, 6 R. P. C. 165.

Word-Marks.

Words as trade-marks.

Words are highly valued as trade-marks, since when well chosen they combine the necessary quality of distinctiveness with a capacity for being remembered and referred to, which is only equalled by such simple devices as from their resemblance to common objects, or to familiar geometrical figures, at once suggest appropriate names, and, while in many of the classes all, or almost all, the suitable devices are either already appropriated or have ceased to be distinctive, the number of new words which may be invented is practically unlimited.

Word-marks were common enough before the Registration Acts, and provision has been made in all of these for the registration of any special and distinctive word or words used as trade-marks before the 13th of August, 1875, when the Act of 1875 came into operation, and also, under sections already considered, for the registration of the name of an individual or firm printed, &c. in some particular and distinctive manner, and of a written signature or copy of a written signature. Except such old marks, names, and signatures, no other word-marks could be registered under the Act of 1875 (*d*). This was altered by the Act of 1883, which allowed the registration of "a fancy word or words not in common use." The expression "fancy word," however, gave rise to considerable differences of opinion as to its meaning, and after the report of Lord Herschell's Committee it was struck out of clause (c), and the two new clauses (d) and (e) were substituted for it. They allow the registration of: (d) "an invented word or invented words"; and (e) a "word or words having no reference to the character or quality of the goods, and not being a geographical name."

(*d*) *Exp. Stephens*, 3 C. D. 659 (1876), Jessel, M.R., (*Aeilyton*); *Rose* v. *Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C., (*Limetta*); see *per* Lindley, L.J., in *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887).

The report of Lord Herschell's Committee on word-marks.

The portion of the report above referred to, which relates to this subject, was as follows (*e*) :—"It will be convenient to consider first what words ought to be allowed as trade-marks. There can be no objection to permitting the registration of an invented word not to be found in the vocabulary of our own or any other country. It seems, further, that existing words may with advantage be permitted as trade-marks, subject to limitations which at once suggest themselves. It is manifest that no one ought to be granted the exclusive use of a word descriptive of the quality or character of any goods. Such words of description are the property of all mankind, and it would not be right to allow any individual to monopolise them and exclude others from their use. Again, geographical words, which can be regarded as descriptive of the place of manufacture or sale of the goods, are open to obvious objections. One manufacturer or merchant cannot properly be allowed to prevent all his competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first person who had manufactured or sold the goods in the place the name of which he seeks to appropriate as a trade-mark. But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to lead to difficulty and litigation (*f*). We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale. We would add upon this point that we think that where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. The question has been raised whether a word having the same sound as one entered on the register, though spelt differently and with a different meaning, should be registered. The question in such a case would seem to be whether the resemblance between the old mark

Geographical names.

Translated words.

Phonetic equivalents.

(*e*) Report of 1888, p. xi.

(*f*) See Chap. II. p. 44.

"and that applied for was such as to be calculated to deceive; if it were it ought, of course, to be rejected."

A Fancy Word or Words not in common use (*f*).

As already stated, the meaning of these expressions gave rise to considerable differences of opinion, and since the marks registered under the Act of 1883 are still governed by that Act, and the principles employed in the interpretation of these expressions will be employed also in construing the amending Act (*g*), it is necessary to consider the cases. A definition of *fancy word* was ultimately laid down by the Court of Appeal, which seems to be both clear and precise, and it is perhaps to be regretted, after this had been done, and as no great substantial change was desired to be made, that the expression, which was, no doubt, an ill-chosen one, should have been abandoned for another which will in all probability itself require and receive explanation.

Fancy words.

In the latest reported case on the subject (*h*), Chitty, J., summed up the result of the decisions in the following passage: "To be a fancy word, the word must be obviously meaningless as applied to the article in question. On that principle the Court has held that the term *Gem* (*i*), with reference to a gun, is not a registerable fancy word; with reference to hair restorer, that the word *Melrose* (*k*) is not a fancy word; with reference to velveteen, that the word *Electric* (*k*) is not a fancy word; and with reference to lace, the opinion of Lord Justice Cotton appears to have been that the term *Alpine* (*l*) was not a fancy word. These are some of the numerous illustrations that may be given of what may be thought by some to be the severe

(*f*) A fancy word was a good trade-mark before the Acts: "The more ridiculous it is, the better it is." Wood, V.-C., in *Young* v. *Macrae*, 9 Jur. N.S. 322 (1862).

(*g*) *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J., (*Satinine*).

(*h*) *Lloyd & Sons' Tm.*, 10 R. P. C. 281 (1893), *Carnival* not a fancy word.

(*i*) *Re Arbenz's Application*, *infra*.

(*k*) *Van Duzer's Tm.* and *Leaf's Tm.*, *infra*.

(*l*) 34 C. D. p. 639.

"and strict construction which the Courts put upon the 64th section. There is another case, which I may also usefully mention, which is the case of *Jubilee* with reference to note paper." The last-mentioned word was also held not to be a fancy word (*m*).

Van Duzer's Case.

The leading cases are the consolidated appeals of *Van Duzer's Trade-Mark* and *Leaf and Son's Trade-Mark* in the Court of Appeal (*n*). The former arose out of an application to register the words *Melrose Favorite Hair Restorer*, which had been adopted by the applicant in 1880, and which were identified by reputation with their goods, and with theirs, alone. They had been already registered by the applicants on a label. It was argued that, although *Melrose* happened to be the name of a place, it was registerable because of its secondary meaning, indicating the applicant's goods (*o*); that it was sufficient if the words were not "in common use" in connection with the goods in question; and that an earlier decision of Chitty, J., in *The Alpine Case* (*p*), holding that a word is a *fancy word* if fancifully used, was right. The Court of Appeal did not assent to any of these arguments.

The fancy word must be obviously meaningless.

To be a *fancy word*, Cotton, L.J., held, a word must be one "which obviously cannot have reference to any description or designation of where the article is made, or of what character it is." So that it is not enough that it should be shown by evidence that it, in fact, has no such reference, and the incorrect or inappropriate user of a word which is descriptive does not make it a fancy word. Lindley, L.J., said: "To be a fancy word I think the word must either have, to ordinary English people, to whom this Act of Parliament is addressed, no meaning,

(*m*) *Towgood Bros.* v. *Pirie & Sons*, 4 R. P. C. 67; 56 L. T. 394 (1887), Chitty, J.

(*n*) 34 C. D. 623; 4 R. P. C. 31 (1887), Cotton, Lindley and Lopes, L.JJ.

(*o*) This was sufficient to make the words a trade-mark under the law before the Acts. See Chap. II., pp. 36 *et seq.*

(*p*) 29 C. D. 877 (1885). The right of appeal in this case was lost by a slip as to time.

"like the word *Eureka* or the word *Aeilyton*, or if it has any meaning at all, it must be obviously non-descriptive (*q*) when used as a trade-mark"; and Lopes, L.J. (*r*), laid down the following conditions as necessary in order that a word should come within the term:—It must be obviously meaningless as applied to the article in question; it must be fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as to be neither deceptive nor descriptive, nor calculated to suggest deception or description; and, further, it must have "an innate and inherent character of fancifulness, which must not depend on evidence, and cannot be supported by evidence, to show that, in fact, it is neither deceptive nor descriptive, or calculated to be deceptive or descriptive." It must speak for itself.

In *Leaf and Son's Case* the Court, applying these criteria, held, that *Electric* for velveteens was not a fancy word.

The definitions given in these judgments have been cited and adopted in all the subsequent cases upon the meaning of the expression. Thus, in *Waterman* v. *Ayres* (*s*), the Court of Appeal held, that *Reversi* was not a fancy word for a game. Ordinary Englishmen, Cotton, L.J., said, would consider it was in some way connected with reversing, and Fry, L.J., said that, by its likeness to *reverse*, it was calculated and intended to convey to the minds of persons who read it a notion of the character of the game, and it was, therefore, not a fancy word (*t*).

A list of words which have been held not to be "fancy words not in common use" is given on a later page (*u*).

The decisions are only restrictive.

The propositions laid down by the Court of Appeal in the cases last cited do not amount to definitions from which

(*q*) 34 C. D., p. 642; "non-descriptive" was substituted for "meaningless" at the suggestion of Cotton, L.J., p. 645.

(*r*) Page 644.

(*s*) 39 C. D. 29; 5 R. P. C. 368 (1888).

(*t*) See also *Edge's Tm.*, 8 R. P. C. 207 (1891), (*Filtered Blue*); and *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), *Britannia*, for soap.

(*u*) Page 151, below.

tests to show affirmatively that any particular word is within the meaning of the Act can be drawn. They are negative propositions only. "To say that every word is a fancy word because it is unknown to an average Englishman, would be plainly to lay down a proposition which could not be for a moment maintained, (for) there are many good English words descriptive of articles which are unknown to an average Englishman, taking a rather high standard" (*x*).

Descriptive words.

It follows that a word descriptive of, or suggesting a description of the origin, qualities, or uses of the goods, is not a fancy word. The word *Gem*, therefore, having come into use to indicate excellence in the article to which it is applied, is not a fancy word (*y*). And on an application to register it as a trade-mark for air-guns, it was a further fatal objection that it had, by user, become descriptive of a particular class and make of gun (*y*).

Words in a foreign language.

The Acts are directed to ordinary Englishmen (*z*), and the question whether the words put forward are obviously meaningless and non-descriptive in regard to the goods for which the mark is to be used, is to be tried, therefore, in the light of such information as ordinary Englishmen may be supposed to possess. It has, however, been held that *monobrut*, which is a compound of *brut*, meaning "dry" as opposed to "sweet" in the French wine trade, and which itself means "very dry," is descriptive, and therefore not a fancy word (*a*).

(*x*) *Per* Chitty, J., in *Davis* v. *Stribolt*, 6 R. P. C. p. 211; 59 L. T. 854 (1888), *Bökol*, the name of a Norwegian beer, rejected as a trade-mark for the beer.

(*y*) *Arbenz' Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887). So held by the C. A., reversing Kay, J., whose judgment was delivered before that of the C. A. in *Van Duzer's Case*. *Reversi*, *Satinine*, and *Carnival* are other instances, below, p. 151.

(*z*) See the judgments of Lindley, L.J., in *Van Duzer's Case*, and Cotton, L.J., in *Waterman* v. *Ayres*, *supra*; *Lloyd & Sons' Tm.*, 10 R. P. C. 281 (1893), (*Carnival*); and *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39, *Ocmoo*, cited below. Cf. the Report of Lord Herschell's Committee, cited *ante*, p. 141.

(*a*) *Vignier's Tm.*, 6 R. P. C. 490 (1889), Kay, J.; cf. *Jackson*

Name of the goods in foreign language.

The name of the goods is not a good trade-mark apart from the Acts (*b*), and it cannot, of course, be registered under them (*c*). So that the introducers of a kind of beer, which was common in Sweden and Norway, were not allowed to retain on the register the names by which it was ordinarily known in those countries, and under which it had been sold in England (*d*). "For the sake of caution limiting my proposition to the European languages," Chitty, J., said, "I am of opinion that, in reference to an article produced in a foreign country and imported into England where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy word within the meaning of the Act."

And it is clear that a word which, though not English, carries a well understood descriptive meaning (*e*), such as *Sanitas* (*f*) or *Britannia* (*g*), is not a "fancy word."

This rule does not, however, extend to exclude words taken from a barbarous language. So that the word *Oomoo*, which was said to mean "choice" or "select" among some of the Aborigines of Australia, was held by Chitty, J., to be a fancy word notwithstanding. "If it does mean choice," the judge said, "or if it ever meant choice in the Aboriginal language of Australia, it does not mean choice to an ordinary Englishman, or to a sufficient

Co.'s Tm., 6 R. P. C. 80 (1888), where Kay, J., rejected the Chippeway Indian word *Kokoko* because it meant *Owl*, which was a common mark; and *Davis & Co.* v. *Stribolt & Co.*, *infra*.

(*b*) See Chap. II., pp. 35 *et seq.*, and the judgment of Chitty, J., in *Barlow* v. *Johnson*, 7 R. P. C. 395 (1890).

(*c*) *Per* Fry, J., in *Waterman* v. *Ayres*, *supra*.

(*d*) *Davis & Co.* v. *Stribolt & Co.*, 6 R. P. C. 207; 59 L. T. 864 (1888), Chitty, J., (*Bökol*).

(*e*) Lord Herschell's Committee reported that, in their opinion, "where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language," see the whole passage cited above, p. 141.

(*f*) *Sanitas Co. Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887), Kay, J.

(*g*) *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), Chitty, J.

"number of Englishmen in this country, to enable me to say it *has* a meaning" (*h*).

Names of common marks.

The name suggested by a mark which is common in the trade is not a fancy word, and this rule was held to apply where the word was the name in the unwritten language of an uncivilized tribe, the Chippeway Indians, to whom the trade in the goods in question was not shown to have extended (*i*). It is, however, difficult to reconcile this with the rule already referred to, that the Acts are directed to ordinary Englishmen, or to reconcile with it the decision last stated, which was decided a few months later.

Secondary distinctive meaning does not constitute a fancy word.

In *The Singer Cases*, and other cases coming under this head before the Acts, the contest was whether the name was that of the article merely, or whether it had acquired a secondary meaning identifying the article with the owners of the marks (*k*); but under the Acts such secondary meaning, so far as regards the right to registration (*l*), is immaterial in the case of marks not used as trade-marks before the 13th of August, 1875. It cannot make a word a fancy word (*m*) (or an invented word).

Geographical words.

In *Van Duzer's Case* both Cotton and Lindley, L.JJ., refused to hold that no geographical word could possibly be a fancy word. And Lindley, L.J., said (*n*): "If you pick out some name which no Englishman ever heard of, such as *Penj Deh*, to which our attention was called some years ago, I do not know that that would not do. It conveys *no meaning to* an Englishman, and such a geographical name, for all I know, may be a fair and proper fancy word." But, as was held in that case, a name which is known to be that of a place from which the goods

(*h*) *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39 (1889); but cf. the case next cited.

(*i*) *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), Kay, J., *Kokoko*, meaning owl.

(*k*) Chap. II., p. 38.

(*l*) It may have an important bearing upon a passing off case, *Slazenger* v. *Feltham*, 6 R. P. C. 531; *Barlow* v. *Johnson*, 7 R. P. C. 395; see Chap. XVI., p. 404.

(*m*) *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887), C. A.; *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887); and see above, p. 127.

(*n*) 34 C. D. p. 643.

might come is not registerable (*o*). So, in *The Apollinaris Case*, the Court decided that the names of the springs from which the mineral waters came, and which were not the property of, or wholly controlled by, the traders who sought to appropriate the names as trade-marks, could not be registered (*p*). The words *Britannia* (*q*), and *John Bull* (*r*) have also been held to be objectionable on the ground that they are geographical words.

On the other hand, it seems that the name of the factory from which the goods bearing the mark come is not a geographical word within the meaning intended (*s*).

"Geographical words, which can be regarded as descriptive of the place of manufacture or sale of the goods," Lord Herschell's Committee reported (*t*), "are open to obvious objections. One manufacturer or merchant cannot properly be allowed to prevent all competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first who had manufactured or sold goods in the place the name of which he seeks to appropriate as a trade-mark (*u*). But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to lead to difficulty and litigation. We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale."

And geographical names are accordingly not permitted to be registered by the present Act (*x*). It will be noticed

(*o*) See also *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J., *Brymbo*, for steel.

(*p*) (1891) 2 Ch. pp. 203, 221; 8 R. P. C. 137, C. A.

(*q*) *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1891), Chitty, J.

(*r*) *Paine's Tm.*, 9 R. P. C. 130; 61 L. J. Ch. 365 (1892), Kekewich, J.

(*s*) *Finto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.; and see *Hall* v. *Barrows*, 4 De G. J. & S. 150; 32 L. J. Ch. 548; 33 L. J. Ch. 204 (1863), Romilly, M.R., and Westbury, L.C.

(*t*) The whole passage is cited above, p. 141.

(*u*) See Chap. II., p. 44; and *Seixo* v. *Provezende*, and *Wotherspoon* v. *Currie* there cited.

(*x*) Sect. 64 (1) (e).

that the recommendation of the committee does not apply to words which "clearly could not be regarded as indicative of the place of manufacture or sale," but the Act contains no such limitation; but it may well be imported upon the construction of the words.

The name of a person, even though the person be a mythical person, is not a fancy word (*y*). Name of a person.

A combination of words, each of which is common to the trade, is not a "fancy word" (*z*). Combination of words.

Not in common use.

In order to come within sect. 64 (c) of the Act of 1883 the word or words must not only be a fancy word or fancy words, but must not be in common use.

In *The Alpine Case* (*a*) Chitty, J., took the view that the use referred to is to be understood to be use in the trade, and this view has been adopted also in a Scotch case, in which Lord Craighill said that the term "common use," as employed in the statute, does not necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. "What is enough, in my opinion," he added, "to establish common use, in the sense of the statute, is this: if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less directly with the use of the commodity to which the term has been applied" (*b*). But it is submitted that the condition suggested by the last

(*y*) *Ralgson* v. *Sinclair*, 9 R. P. C. 22 (1891), *Britannia*, Chitty, J. The C. A., by consent, reversed the order to expunge this mark. The early case in which *The Lawford* was allowed to be registered seems to be clearly in conflict with the later decisions; (1885) W. N. 124, Pearson, J.

(*z*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A.; *Pirie's Parchment Bank*; and see *Perry, Davis & Son* v. *Harbard*, 15 App. Cas. 316; 7 R. P. C. 336 (1890), (*Perry-Davis' Vegetable Pain Killer*); cf. p. 152, n.

(*a*) 29 C. D. 877 (1885).

(*b*) *Stuart & Co.* v. *Scottish Val de Travers Paving Co.*, 13 Sess. Cas. 4 Ser. 1 (1885), *Granolithic* stone. The word was held to be in common use.

phrase is not in accordance with the later decisions as to what are fancy words cited above (*b*), and that the construction adopted by Kekewich, J., in the recent case of *Paine's Trade-Mark* (*c*) gives the correct meaning of the Act. "I cannot think," the learned judge said, "it means simply the use applied to this trade only. It cannot mean, I think, that words are not in common use if they are not used in the trade. It must mean something wider and larger than that, and seeing that *John Bull* are two words, or a combination of words, which are in common use wherever the English language is known, I think that I must hold them to be in common use within the meaning of the Act."

Common use, whether in the trade or popularly.

The extent of user which amounts to "common use" has not been defined, but it has been held that the words *Tower Tea*, which were used by the plaintiff and the defendant in the case in question, and by three other persons in the tea trade, and of which the word Tower was used by several traders in other trades, were words in common use (*d*). On the other hand, the mere use by a single person, other than the applicant for registration, at an exhibition in this country of a word which is not known in the trade concerned, does not amount to common use within the clause (*e*). The phrase may be compared with "common to the trade" in sect. 74 (*f*).

"The" prefixed to word.

Words which are not entitled to registration as fancy words do not become so entitled by having the definite article prefixed to them (*g*). This is clear from the definitions cited above, but a different view was taken by the comptroller (*h*) when first the Act of 1883 came into operation, and before the decision of *Van Duzer's Case*.

Examples

The following words have been held not to be fancy

(*b*) Pages 143 *et seq.*

(*c*) 9 R. P. C. p. 133; 61 L. J. Ch. 365, (1892), (*John Bull* beer).

(*d*) *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165 (1889), North, J.

(*e*) *Burgoyne's Tm.*, 6 R. P. C. pp. 230, 232; 61 L. T. 39 (1889), Chitty, J., (*Oomoo*).

(*f*) See Chap. IX., p. 169.

(*g*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A., (*The Self-washer*).

(*h*) See the *Alpine Tm.*, 29 C. D. 877 (1885).

words not in common use (*i*): ALPINE embroidery, p. 149; APOLLINARIS water, *Apollinaris Co.'s Tm.*, (1891) 2 Ch. pp. 202, 221; 8 R. P. C. 137; BEATRICE shoes, *Harris' Tm.*, 9 R. P. C. 492; BEN LEDI whiskey, *Ainslie & Co.'s Tm.*, 4 R. P. C. 212; BÖKOL beer, p. 146; BRITANNIA soap, p. 149; BRYMBO iron (Brymbo being a place in Wales), p. 148; CARNIVAL cigarettes, p. 142; ELECTRIC velveteen, p. 144; ELECTROID anti-fouling composition, *Hannay's Tm.*, 7 R. P. C. 46; EMOLLIO cream, *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612; EMOLLIORUM dubbing, *Talbot's Tm.*, 11 R. P. C. 77; (1894) W. N., 12; FRIEDRICHSHALL water, *Apollinaris Co.'s Tm., supra;* GEM air-guns, p. 145; GRANOLITHIC stone, *Stuart* v. *Scottish Val de Travers Paving Co.*, 13 Sess. Cas., 4 Ser. 1; HAND GRENADE FIRE EXTINGUISHER, *Harden Star, &c. Co.'s Tm.*, 3 R. P. C. 132; 55 L. J. Ch. 596; HERBALIN (a medicine), *Humphries* v. *Taylor's Drug Co.*, 59 L. T. 820; HUNYADI JANOS water, *Apollinaris Co.'s Tm., supra;* JOHN BULL and JOHN BULL BRAND beer, p. 150; JUBILEE note paper, p. 143; KOKOKO cotton goods, p. 147; MANOR tin-plates, *Thompson's Tm.*, 6 R. P. C. 213; MELROSE hair restorer, p. 143; MONOBRUT champagne, p. 145; RED, WHITE AND BLUE coffee, *Hanson's Tm.*, 37 C. D. 112; 3 R. P. C. 130; REVERSI (for a card game), p. 144; SANITAS (for a disinfectant), *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166; SELF-WASHER and THE SELF-WASHER soap, *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492; TOWER tea, *Great Tower Tea Co.* v. *Smith*, 6 R. P. C. 165; WASHERINE soap, *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482; ZEPHYR ASIATIC WALNUT PIPE, *Friedlander's Tm.*, (1885) W. N., 85. from decided cases.

The only reported instances of words decided to be within the clause are the words *Oomoo*, for wine (*k*), *Alpine*, for embroidery, and *The Lawford*, for tennis racquets (*l*). The decision in the second case was subse-

(*i*) The pages referred to are those of this book. Most of the words are collected in Sebastian, 3rd ed. p. 46, and in the index to Mr. Austen-Cartmell's Digest.

(*k*) *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39 (1889), Chitty, J.

(*l*) (1885) W. N. 124, Pearson, J.

quently disapproved by the Court of Appeal (*m*), and that in the third is certainly not in accord with the interpretation subsequently put upon the clause under which the registration was allowed (*n*). Great numbers of words have, however, been registered by the comptroller as fancy words without objection.

Invented words.

"(d) *An invented word or invented words.*"

This clause and the following clause (e) were substituted for "fancy word or words not in common use" by the Act of 1888, upon the recommendation of Lord Herschell's Committee, which has been already quoted (*o*). It seems clear that the alteration was not intended to affect the principles laid down to determine what words might be registered in the leading cases decided upon the earlier Act (*p*), but only to give authoritative expression to them, and to avoid any further difficulty which might arise upon the expression "fancy word." And these principles will be employed in the application of the new Act, so that, for instance, a word which is descriptive (*q*), or a geographical (*r*) word cannot be registered as an invented word.

The leading case on the present clause is *The Somatose Case* (*rr*), in which the Court of Appeal decided in accordance with the earlier judgment of Kay, J. (*q*), that the two clauses (d) and (e) must be read conjunctively, and not, as

(*m*) *Alpine Tm.*, 29 C. D. 877 (1885), Chitty, J.; see above, p. 143.

(*n*) See above, p. 149.

(*o*) Above, p. 141.

(*p*) *Van Duzer's Tm.*, *Leaf & Co.'s Tm.*, and *Waterman* v. *Ayres*, above, pp. 143 *et seq.* Mr. Sebastian is, however, of a different opinion, he says: "The introduction of this expression into the Act appears to be intended to bring within its scope such words as *Washerine* and *Monobrut* (see above, p. 151), which were rejected as fancy words," 3rd ed. p. 48.

(*q*) *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J., (*Satinine*); *Talbot's Tm.*, (1894) W. N., 12; 11 R. P. C. 77, Stirling, J., (*Emolliorum*).

(*r*) *Apollinaris Co.'s Tm.* (1891), 2 Ch. pp. 203, 221; 8 R. P. C. 137, Kekewich, J., and C. A., (*Apollinaris*, *Hunyadi Janos*, and *Friedrichshall*).

(*rr*) *Farbenfabriken Co.'s Tm.*, (1894) 1 Ch. 645; 11 R. P. C. 84; 10 Times L. R. 260, North, J., and Kay and A. L. Smith, L.JJ.; Lindley, L.J., dissenting. Lindley, L.J., thought the word allowable as a new compound of well-known elements. A. L. Smith, L.J., thought it too near the dictionary words Soma and Somatic.

they are printed in the Act, as alternatives, and that the word *Somatose*, a compound of the Greek σωμα (body) with the common affix *ose*, could not be registered as a trade-mark for a chemical food described by the applicants as "a preparation . . . . which can easily be absorbed and taken up into the human body."

Words having no reference to character or quality of goods.

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

The question under this clause is not whether the word which it is sought to place or retain on the register has in fact any reference to the character or quality of the goods, but whether it has it in appearance. For if it have, it must be either descriptive or deceptive, and in either case it is not entitled to be on the register (*t*). The clause seems to be equivalent to the phrase "obviously meaningless" in the decisions on the earlier Act (*u*), but apparently its explicit statement as to what is necessary gets rid of the requirement of an "innate and inherent character of fancifulness" (*x*), which, after those decisions, was the most indefinite branch of the exposition of the expression "fancy word" (*y*).

Old Marks.

Old marks.

By sect. 64 (3) (ii.) (*z*):

"Any special and distinctive word or words, letter, figure (*a*), or combination of letters or figures, or of letters and figures, used as a trade-mark before the

(*s*) See clause (d) above; and, as to geographical names, see above, pp. 147 to 149.

(*t*) *Edge's Tm.*, 8 R. P. C. 207 (1891), *Filtered Blue*, Stirling, J.

(*u*) See the Report of Lord Herschell's Committee upon which the amendment was made, above, p. 141.

(*x*) See the judgment of Lopes, L.J., in *Van Duzer's Tm.*, 34 C. D., p. 644, cited above, p. 143.

(*y*) Mr. Sebastian says: "This seems designed to include such terms as *Pharaoh's Serpents* toys, *United Service* soap, and *Charter Oak* stoves," 3rd ed. p. 48. In my opinion, the second of these examples, and probably the first also, is descriptive.

(*z*) Act of 1888, sect. 10.

(*a*) *Figure* means *numeral*, per Jessel, M.R., in *Exp. Stephens*, 3 C. D. 659 (1876).

"13th day of August, 1875 (*b*), may be registered as a trade-mark under this part of this Act."

This clause is co-ordinate with the clauses (a) to (e) of sub-section (1). It is taken verbatim from the Act of 1883. Provision was made in the original Act for the registration of old marks. The clause corresponding to the present clause in that Act was as follows:

Special and distinctive.

"Any special and distinctive word or words, or combination of figures or letters used as a trade-mark before the passing of this Act may be registered as such under this Act" (*c*).

The amendment (letter, figure) was made in consequence of the decision that, under the sub-section as it originally stood, a single letter, although an old mark, could not be registered (*d*). It was the intention of the Act to allow to be registered anything which was protected as a trade-mark under the old law, and could not be registered under the other clauses of the section (*e*).

The requirement that the mark shall be "special and distinctive" only embodies the old law (*f*). *Special* means of such a character that the mark "separates the article to which it is applied from all others of the same class or character; something which points out the article as standing alone, which makes the man who sees or reads the word understand that the article has a special standing, a special existence, and is not one of the general class, for instance, of pianos, but belongs to a class of a particular character" (*f*). *Distinctive* means that the mark is a distinctive thing which points out that the goods are the goods of A. B. (*g*). Thus, in *The Eton Cigarette Case*, Fry, L.J., said: "It appears to me, that to satisfy the requirement of

(*b*) Date of commencement of the Act of 1875.

(*c*) Act of 1875, sect. 10.

(*d*) *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C., *A*, for steel pens.

(*e*) *Barrows' Tm.*, 5 C. D. 353 (1877), per Malins, V.-C.; *Bodega Co.* v. *Owens*, 6 R. P. C. 241, Chatterton, V.-C., (1888), in Ireland.

(*f*) *Re Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.; see as to this, *ante*, p. 119.

(*g*) *Richards* v. *Butcher*, (1891) 2 Ch. p. 536; 8 R. P. C. 249, Kay, J.; and *per* Halsbury, L.C., in *Perry, Davis & Son* v. *Harbord*, 16 App. Cas. p. 320; 7 R. P. C. 336 (1890).

"(this) definition the word or words must be distinctive in this sense, that they distinguish the manufacture of the person who has registered the trade-mark from the manufacture of all other persons" (*h*).

The decisions on the word distinctive, where it occurs in the earlier part of the section, have been already considered (*i*).

Deceptive mark not distinctive.

Where, therefore, a cigarette manufacturer had registered the word *Eton* as an old mark, but had sold the cigarettes in boxes bearing the words *St. Petersburg—P. Mavrogordato & Co.*, as well as *Eton*, thereby suggesting to purchasers that the goods were not of his manufacture, but were made in Russia, although the mark was known in the trade as, in fact, indicating his manufacture, it was held that he was not entitled to have it registered, and it was accordingly ordered to be removed (*h*).

Descriptive words.

It follows that words which were merely descriptive of the goods to which they are applied cannot be registered as old trade-marks under the clause, for, in fact, they could not be trade-marks at all (*k*). So, where fusees were manufactured under a patent which expired in 1881, and were called *braided fixed stars*, *fixed stars* being a common name for fusees, and *braided* descriptive of the process by which the particular goods were manufactured, and the words were registered as an old mark in 1877, they were ordered to be removed from the register, on this as well as on other grounds (*l*).

Words with a secondary distinctive meaning.

Before the Acts words which were *primâ facie* descriptive might be acquired as trade-marks, if, by use as such, in connection with the goods of a particular trader, they, in fact, acquired a secondary distinctive meaning distinguishing the goods as his (*m*); and such words may still be so acquired as a "common law trade-mark" apart from

(*h*) *Wood* v. *Lambert*, 32 C. D. p. 262; 3 R. P. C. 81 (1886).

(*i*) Above, pp. 119 *et seq.*

(*k*) See Chap. II., pp. 35 *et seq.*, and pp. 127, 131.

(*l*) *Palmer's Tm.*, 24 C. D. 504 (1882), C. A.; and see the cases cited below.

(*m*) See Chap. II., p. 36.

registration (*n*). And it is submitted that wherever such words have been used and acquired as trade-marks before the 13th of August, 1875, they are "special and distinctive," and therefore capable of registration within the clause.

This was directly decided by Kekewich, J., in a recent case (*o*), where he held the words *J. & J. Hopkinson*, printed in ordinary type, to be "special and distinctive," and to be properly registered as an old mark. "In order to protect a trade-mark before the Act," he said, "you were obliged to prove by evidence and satisfy the Court that the words used as a trade-mark were known in the market, and, to use Lord Westbury's expression in *Leather Cloth Co.* v. *American Leather Cloth Co.* (*p*), gave a 'vendible' character to the articles to which they were attached, made those articles recognized as coming from a particular manufactory, and so gave them a character different from that of every other article in the trade. Therefore, it seems to me, that the Legislature in the Act of 1875 did no more than adopt the language of the cases, by reducing them into a compressed form, and say really that what the Court would have held to be a trade-mark independently of the Act should now be capable of registration as a trade-mark under the Act, provided only that the mark had been used as a trade-mark before the passing of the Act." And this accords with the opinions expressed by several other judges (*q*). The *Monopole* case was discussed (*r*), on the assumption that the word, though in

(*n*) *Reddaway* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A., (*Camel Hair Belting*).

(*o*) (1892) 2 Ch. 116; 9 R. P. C. 102.

(*p*) Above, p. 47.

(*q*) Malins, V.-C., in *Barrow's Tm.*, 5 C. D. 353 (1877); and Porter, M.R., in *Watt* v. *O'Hanlon*, 4 R. P. C. p. 15 (1887); and Chatterton, V.-C., in *Bodega Co.* v. *Owens*, 6 R. P. C. 241 (1888), both Irish cases. In *Leonard & Ellis's Tm.*, 26 C. D. p. 205 (1884), Lord Selborne said: "As to the word *Valvoline*, I, for my part, am not disposed to doubt that, if that word had been used in the United Kingdom as a trade-mark before the passing of the Act it might have been registered under the Act." See also p. 158, note (*y*).

(*r*) Fry, L.J., expressly reserved

itself descriptive, could be registered if it were shown to have been used before the Act of 1875 as a trade-mark; and in the *Stone Ales* (*s*) case, the only ground upon which the Court of Appeal proceeded in removing the mark *Stone Ale* was the want of proof of such user.

On the other hand, in *Perry, Davis and Son* v. *Harbord* (*t*), the question was treated as an open one by two of the Lords Justices, for Fry, L.J., said: "It is not necessary now to inquire whether the words must be special and distinctive from their own proper nature and internal force *ex vi terminorum*, or whether they may acquire a distinctive character by user as applied to the goods"; and Lopes, L.J., made use of similar language, and added: "Speaking for myself, I should be inclined to think (the word tendered for registration as an old mark) must be inherently special and distinctive" (*u*). And on the further appeal, Halsbury, L.C., and Lord Morris held that the words in question in the case, *Pain Killer* for a medicine, were not special and descriptive; the Lord Chancellor, on the ground that they were descriptive of a quality attributed to the goods to which they were applied (*x*). This decision is not in conflict with the conclusion stated above, for there was no finding or evidence that the medicine of the plaintiffs was distinguished from the same medicine made by others by the use of the words *Pain Killer;* on the contrary, it appeared that there was no competition in its manufacture. It seems, therefore, that the present state of the law is that laid down by Kekewich, J., in the case cited above, and this is, it is submitted, the proper construction of the Act.

So a geographical word may be registered if it was used

this question, *Richards* v. *Butcher*, (1891) 2 Ch. p. 547; 8 R. P. C. 249, Kay, J., & C. A.

(*s*) Page 159, note (*b*).

(*t*) 5 R. P. C. 333, Kay, J., & C. A. (1888); and 15 App. Cas. 316; 7 R. P. C. 336, H. L.

(*u*) The question was also referred to by Kay, J., in *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889), (*Emollio Cream*).

(*x*) Cf. the *Nourishing Stout Case*, *Raggett* v. *Findlater*, L. R. 17 Eq. 29 (1873), Malins, V.-C.

as a trade-mark and had acquired a secondary distinctive meaning before the 13th of August, 1875 (*y*).

Examples of old word-marks.

The following words have been held not to be special and distinctive words: ENOLLIO cold cream, *Grocsmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612; BAFFLE safes, *Talbot* v. *Webley*, 3 R. P. C. 276; PERRY-DAVIS' VEGETABLE PAIN KILLER, *Perry, Davis* v. *Harbord*, 15 App. Cas. 316; 7 R. P. C. 336.

And the following have been admitted to registration as such: FRIGIDOMC, for a hot-house plant wrap, *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323; FAMILY SALVE, *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57; EXCELSIOR SPRING MATTRESS, *Chorlton and Dugdale's Tm.*, 53 L. T. 337; J. & J. HOPKINSON (for pianos), *Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102.

Used as a trade-mark.

Used as a trade-mark.

What is use as a trade-mark has already been considered in Chapter II. The following paraphrase by Lord Esher (*z*) of the judgment of the Court of Appeal in *Palmer's Case* (*a*) sums up the rules there stated: "Let us see what was used in the trade, and let us see whether any article was ever in the market made by these people with these words only on them. If we find these words on goods in the market, which are said to be distinguishing marks on the goods, and on the same goods other marks, and never on any goods these words alone, then the conclusion of fact is that what was used upon the goods to distinguish them was all that was on the goods; and we are not going to enquire whether part of what was put on all the goods to distinguish them was at one end of the goods or at the other end of the goods, or whether they were an inch or half an inch apart, or even whether part was at the top

(*y*) See the judgments of Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 635; 4 R. P. C. 31 (1887); and of Kay, J., in *Compagnia General de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), (*Cavité*).

(*z*) *Spencer's Tm.*, 3 R. P. C. p. 74; 54 L. T. 659 (1886).

(*a*) 24 C. D. 504 (1883), (*Braided Fixed Stars*).

"and lapping over the side, or whether part was on one side and part on the other. If you find that they are on goods for the purpose of distinguishing the goods, that makes the user one user."

In accordance with these principles, it has been held that words used only as a description of the goods (*b*), for instance, in ordering them from the applicant, are not used as trade-marks, and that a device employed as a pattern or design mark (*c*) is not so used either.

Use on bottles or boxes only.

So also it has been considered that the use of words upon rough packing-cases containing bottles of wine (*d*), or sauce (*e*), or upon the side of a wine cork where they cannot be seen (*ee*), is not a use of them as a trade-mark, since it does not "sell the goods" (*f*), although in some cases, for example, where the goods are cigars, soap, or the better classes of candles, the trade-mark may be, and almost invariably is, put not upon the goods themselves, but on the boxes which contain them (*e*). But in such cases the boxes go into market and are bought with their contents by the purchasers, to whose attention the marks are directed.

Where the applicant has another trade-mark.

The use by the applicant of a trade-mark other than and distinct from the marks which he is seeking to place or maintain on the register as an old mark is a circumstance to be considered in determining whether he used the mark in question as a trade-mark, but it is not conclusive that he did not, for traders often have numerous trade-marks and they not infrequently use two or more of them on the same goods at once (*g*).

(*b*) *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J., (*Coker Canvas*); *Talbot* v. *Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C., (*Baffle Safes*); *Montgomery* v. *Thompson*, 41 C. D. 35; 6 R. P. C. 404 (1889), C. A., (*Stone Ale*); *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 195 (*Yorkshire Relish*), Chitty, J., and C. A., aff. by H. L. (1894), A. C. 8.

(*c*) *Harrison's Tm.*, 42 C. D. 601; 7 R. P. C. 25 (1889), Kekewich, J., (*Albion*).

(*d*) *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A.

(*e*) *Powell's Tm.*, *supra*.

(*ee*) *Kinahan's Tm.*, 10 R. P. C. 393, above, p. 30.

(*f*) Chap. II., p. 30.

(*g*) *Powell's Tm.*, (1893) 2 Ch. pp. 394, 406, 411; 10 R. P. C. 63

Old mark must have been used as registered, and alone.

And, as stated in the passage quoted above (*k*), the mark sought to be registered must have been used, in the form in which it is offered for registration (*i*), and alone (*k*), as a trade-mark before the 13th of August, 1875. So that words taken out of a label which was an old trade-mark (*l*), and words which had been used as a trade-mark when combined with a device (*m*), or with the name of the proprietor (*n*), or with other words (*o*), and which were not shown to have been separately used as trade-marks, apart from the other matter, have been refused registration or removed from the register.

Use for the same goods.

The mark must, moreover, have been used as a trade-mark for the class of goods in respect of which it is to be registered (*p*), for it is only an old mark in respect of them; and if registration is applied for in other classes the application, so far as regards such other classes, must be treated on the footing that the mark was not used before the 13th of August, 1875 (*q*). But use on goods essentially the same as those in the class to which the

& 195; (1894) A. C. 8, Chitty, J., C. A. & H. L., (*Yorkshire Relish*); *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., & C. A., (*Monopole*); *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523; 35 L. J. Ch. 53 (1865).

(*h*) Page 158.

(*i*) *Meeus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J., (*Key Brand Geneva*); *Fuente's Tm.*, (1891) 2 Ch. 166; 8 R. P. C. 214, Romer, J., both combination marks. As to the alteration of an old mark under sect. 92, see Chap. XI., p. 248.

(*k*) *Spencer's Tm.*, 3 R. P. C. 73; 54 L. T. 659 (1886), Chitty, J., & C. A., and the cases next cited.

(*l*) *Palmer's Tm.*, 24 C. D. 504 (1883), C. A., (*Braided Fixed Stars*); and see *The Stone Ale* and *Yorkshire Relish Cases*, *supra*.

(*m*) *Spencer's Tm.*, *supra.*, *Diamond Cast Steel* combined with a cutler's mark; *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), Pearson, J., & C. A., (*Valvoline*).

(*n*) *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 37, 249 (1891), Kay, J., & C. A., *Monopole*, with *Heidsieck & Co.*

(*o*) *Perry, Davis* v. *Harbord*, 15 App. Cas. 316; 5 R. P. C. 333; 7 R. P. C. 336 (1888), Kay, J., C. A. & H. L., (*Perry-Davis Vegetable Pain Killer*).

(*p*) Chap. V., p. 87.

(*q*) *Jelley, Son & Jones' Application*, 51 L. J. Ch. 639 n.; 46 L. T. 381 n. (1878), Jessel, M.R.; and see *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884), C. A., cited p. 139; *Harrison* v. *Woodroffe*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J.

application relates, although they pass under a different name, owing to slight variations in size or shape, is sufficient to qualify a mark as an old mark. Thus a mark used on hatchets and augers has been admitted as an old mark for axes and gimlets (*r*).

Use in the United Kingdom.

The use must have been use as a trade-mark in the United Kingdom (*s*), and mere importation into a British port for the purpose of reshipment and transportation is not sufficient (*s*).

Fraudulent user.

User which was commenced and continued in fraud of the rights of the owner of another trade-mark cannot qualify a mark for registration (*t*). The registration of the mark in such case would, besides, almost necessarily be within the prohibition of sect. 72 or sect. 73, as calculated to deceive.

Temporary cessation of user.

The owner of an old trade-mark does not lose his title to register by merely ceasing to use it for a time (*u*), provided that the cessation of user does not amount to abandonment (*v*), or because other traders have infringed his right (*x*), unless the infringements have been so extensive as to make the mark common (*v*).

Slight evidence of user sufficient.

Slight evidence of user as an old mark will be accepted, it is said, even the production of a single label (*y*), at any rate after the mark has been registered and used for a long

(*r*) *Jackson & Co.* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

(*s*) *Meeus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Monck's Application*, 50 L. T. 12 (1884), Chitty, J. In *Jackson & Co.* v. *Napper*, 35 C. D. p. 177; 4 R. P. C. 162, Stirling, J., said: "You must make out user *in England*"; but the learned judge probably used the name of the only part of the United Kingdom in which user had been suggested, without intending to exclude user in Scotland or Ireland. The question whether foreign user was sufficient was raised as early as *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884), C. A.

(*t*) *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J., (*Hoop L. Iron*); *Monck's Application*, note (*s*).

(*u*) *Monson* v. *Boehm*, 26 C. D. 398 (1884), Chitty, J., cited p. 325.

(*v*) Chap. XIV., p. 283.

(*x*) See *Heaton's Tm.*, *supra*.

(*y*) *Chorlton & Dugdale's Tm.*, 53 L. T. 337 (1888), Pearson, J.; *Palmer's Tm.*, 21 C. D. 47; 24 C. D. 504 (1882), Chitty, J., & C. A. The usual evidence is the production of old prints and dies or blocks for printing.

time. And where a mark has stood upon the register unchallenged for years, and important witnesses have died who might have given evidence of qualifying user before 1875, the Court accepts evidence of non-user put forward by any one who seeks to procure the removal of the mark from the register, with considerable hesitation (z).

Colour.

By sect. 67—

Trade-marks may be registered in any colour.

"A trade-mark may be registered in any colour [or colours] (*a*), 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*).

This provision was introduced by the Act of 1883, and the words "or colours" were added in 1888. Under the Act of 1875 colours could not be registered (*b*).

Registration in colours.

A trade-mark propounded for registration in colours must, however, be distinctive within the meaning of sect. 64, independently of the colours (*c*). An oblong label divided into three sections, which were respectively printed in red, white, and blue, was accordingly held not to be distinctive (*d*). Colour, said Kay, J., is treated as an accident, and if the mark were registered the applicant might use it in any colours he chose. "You may register a mark, which is otherwise distinctive, in colour, and that gives you the right to use it in any colour you like; but

(z) *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(*a*) Act of 1888, sect. 11.

(*b*) See *Robinson's Tm.*, 29 W. R. 31 (1880), Jessel, M.R. The decision that a gold coin mark could not too nearly resemble a silver coin mark in this case, is inconsistent with the later authorities cited below.

(*c*) See above, p. 129.

(*d*) *Hanson's Tm.*, 37 C. D. 312; 5 R. P. C. 130 (1887), Kay, J. But the same mark, registered without colours, *i.e.*, as a label with three parallel stripes and the words *red, white and blue*, had been protected from infringement by the use of a similar coloured label comprising the same words, *Hanson* v. *British Tea, &c. Association* (1884), Bacon, V.-C., & C. A.; Sebastian, 3rd ed. p. 368.

"you cannot register a mark of which the only distinction is the use of a colour, because, practically, under the terms of the Act, that would give you a monopoly of all the colours of the rainbow."

The difficulties of registration in connection with mere colour marks, such as the line headings for cotton piece goods are referred to in the earlier part of the chapter (*e*).

Bearing of colour upon the resemblance of marks.

The colours in which a mark is actually used, or is likely to be used, have often a material bearing upon questions of alleged resemblance calculated to deceive, or of infringement (*f*); for instance, a design similar in outline to that of the device in another mark, but filled up in a totally different manner, may have the distinctive filling up observed by the use of a deep colour in printing (*g*). And in a recent case the words *red star brand* were directed to be removed from the register on the ground that they constituted a mark having such resemblance to a star device mark, which was coloured red in actual use, as to be calculated to deceive (*h*).

In some cases marks have been allowed to be entered or retained on the register upon the proprietors undertaking to use them in particular colours only, a note of the undertaking being placed on the register (*i*).

(*e*) Above, p. 130.

(*f*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Turney and Sons' Tm.*, 11 R. P. C. 37 (1893), North, J.

(*g*) *Worthington's Tm.*, 14 C. D. 8 (1880), C. A.; *Biegel's Tm.*, 4 R. P. C. 525; 67 L. T. 247 (1887), Chitty, J., *Turney and Sons' Tm.*, *supra*.

(*h*) *Société, &c. de l'Etoile's Tm.*, (1894) 1 Ch. 61; (1894) W. N. 42; 10 R. P. C. 436; 11 R. P. C. 142; Stirling, J., and C. A.

(*i*) *Re Jeffrey & Co.*, 18 May, 1888, Stirling, J., registration allowed with note binding applicants not to use mark in black, or any colour so dark as to resemble black; *Re Johnson, Philpott & Co.*, 21 Feb. 1888, North, J., register rectified by consent, by adding note that the proprietor was only to use his mark in blue and white. Both cases are cited Sebastian, 3rd ed. p. 368.

CHAPTER IX.

ADDITIONS AND DISCLAIMERS.

	PAGE
Additions	165
Lord Herschell's Committee on additions and disclaimers	165
Disclaimers to be included in the applications to register	166
What are essential particulars of a registered mark	166
The proprietor need not disclaim his own name	167
Trade-name	168
Additions which are common to the trade	169
Section 74	169
The registration of common words in a trade-mark confers no monopoly	170
Distinctive means *primâ facie* distinctive	171
Common to the trade	171
Use by one trader only	171
The three mark rule	172
Common words in a distinctive label need not be disclaimed	172
Common additions are not part of the trade-mark	173
Effect of registration of additions with a disclaimer	173
The advantages of it	174

It is provided by sect. 64 of the Act (*a*) that a trade-mark for registration under the Act must consist of, or contain, one at least of the essential particulars enumerated in that section. It is not, however, necessarily confined to such essential particulars, but it may comprise other matter also, as, for instance, statements of quality or price (*b*), or descriptive or ornamental matter, and most trade-marks do, in fact, comprise some such additions to the parts of the marks which are claimed and protected as their essential particulars. All the Acts have provided for such

(*a*) Chap. VIII., p. 106.

(*b*) Cf. sect. 66, series of marks, above, p. 90.

additions; the provision in the present Act (*c*), which, with immaterial verbal changes, is the same as the corresponding sections of the Acts of 1875 (*d*) and 1883 (*e*), being in the following terms:—

Additions.

"There may be added to any one or more of *these* [the essential] particulars [mentioned in this section] any letters, words, or figures (*ee*), or combination of letters, words, or figures, or any of them" (*f*).

Lord Herschell's Committee on additions and disclaimers.

Remarking upon this provision, Lord Herschell's Committee reported as follows (*g*):—"It is said, and we think truly, that it is not easy to understand what is the exact status of the added matter provided for by sect. 64. Where the added words are not common to the trade in the goods with respect to which the application is desired, the right of exclusive user need not be disclaimed (*h*), yet it is presumed that the proprietor of the trade-mark could not object to their use by any other person except in connection with the essential particular of his trade-marks. What purpose then do they serve? Perhaps they may be useful in the case of a colourable imitation of the essential particular. If, with such an imitation, the added words were used, it would assist the proprietor in establishing that his trade-mark had been infringed. But the added matter may, it is assumed, be of so distinctive a character as to form an essential part of the trade-mark so that its use might be an infringement. We think it would clearly be desirable that the added matter, which the proprietor does not claim the exclusive use of, should be disclaimed, so that the public may know exactly what is the trade-mark registered. We think, too, that all disclaimers should appear in connection with the mark in the official journal."

(*c*) Sect. 64 (2), Act of 1888, s. 10.

(*d*) Sect. 10.

(*e*) Sect. 64 (2).

(*ee*) "Figures" here means numerals, *Exp. Stephens*, 3 C. D. 659 (1876); Jessel, M.R.

(*f*) The word in italics was repealed, and the words in brackets were added by the Act of 1888, which added also to the sub-section the provision for identification of essential particulars and disclaimer of additions referred to below.

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

(*h*) That is, of course, under the Act of 1883, as unamended.

In consequence of this recommendation, what is now the latter part of sect. 64 (2), and also sect. 64 (3) (i) were added by the Act of 1888. The former provides that—

Disclaimers to be included in the application to register.

["The applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register."]

Disclaimers in respect of additions which are *primâ facie* distinctive, but are in fact common to the trade in question, were already required by the Act of 1883, and they are dealt with by a separate section of the Act, sect. 74, which is set out below.

The reason for requiring the essential particulars of a mark tendered for registration to be identified, and the remaining matter contained in it to be disclaimed is, then, that the exact status of the latter may be defined. It is an advantage to traders to have the whole trade-mark, with all the common marks and words, the descriptive additions and the other added matter, if any, all reproduced upon the register as it is printed when the trade-mark is in actual use (*k*); and, on the other hand, it is material that the public should know what parts of the mark as registered may be lawfully used by others than the proprietor. The statement and disclaimer are also of service to enable the comptroller and the Court to more readily determine whether a mark which it is sought to place upon, or to remove from, the register does or does not comply with the requirements of sect. 64.

The "essential particulars" of a registered trade-mark are not necessarily all its distinctive parts.

It is necessary to guard against a possible confusion which may arise from the use of the words "essential particulars" with somewhat different meanings in connection with trade-marks. All the material and distinctive parts of a trade-mark, and all its prominent features are sometimes spoken of as its essential particulars, and these may include items which do not fall within the list

(*k*) See *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n. (1878), Jessel, M.R.

of symbols in sect. 64 (1); for instance, they may comprise words which, although distinctive, are not capable of registration under sect. 64 (1) (d), or sect. 64 (1) (e). It follows, however, from the sub-section set out above, that *all the items of a composite* trade-mark which are not referable to any of the classes enumerated in the list contained in the Act, are to be treated as "added matter," and that no exclusive rights in regard to such items are conferred by the registration. Of course, the trade-mark may, as a whole, fall into one of the classes—for example, as a distinctive label or an old mark.

Disclaimer on appeal.

The provision that the statement and disclaimer shall be contained in the application is not merely directory. It cannot be waived by the Court on an appeal from the comptroller (*l*). The cases cited were both decided on sect. 74, and in respect of applications made before the Act of 1888 came into operation; but the terms of sect. 74 and sect. 64 (2), as amended by the last-mentioned Act, correspond, and the same construction will, no doubt, be put upon them in the latter section as in the former.

It is further provided by sect. 64 (3) (i) that—

The proprietor need not disclaim his own name.

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

Trade-name.

This provision was also added by the Act of 1888. A trader has, as is shown elsewhere (*n*), a right to the exclusive use of his own name, limited by the rights of other traders to honestly use their own names, or the names which they honestly adopt. This exists independently of the law of trade-marks, and the report of Lord Herschell's Committee

(*l*) *Goodall's Tm.*, 42 C. D. 566 (1889), North, J.; *Re Meeus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J. As to the comptroller's power of amendment, see Chap. IV., pp. 70 and 76.

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

(*n*) See Chap. XVI., p. 392.

in reference to the present clause, shows that it was intended to leave such right unaffected. The Committee say, "Some misapprehension might perhaps arise if the person registering the mark were compelled to disclaim his own name, or the foreign equivalent of it. We think, therefore, this might be excluded from the necessity of disclaimer; but it should be provided that the proprietor of the mark should not thereby acquire the right to prevent any other person *bonâ fide* using his own name in connection with his goods." It will be observed that the restriction arising out of the saving clause is more limited than the restriction which a disclaimer, if registered, would create. At common law, as already stated, a trader can only be prevented from using a name similar to that of another trader if he uses it so that his business would in the ordinary course of human affairs be likely to be confounded with that of the other (*o*); and if he is honestly using his own name, he cannot be interfered with at all. Under the Act, however, if the name or the description of the place of business registered as parts of the trade-mark are material parts, it is presumed that section 76 would confer on the proprietor exclusive rights to the use of the name and description under all circumstances, save only as against an owner of the same name, and, of course, only for use in connection with the goods for which the mark is registered (*p*).

Effect of the registration of a trade-name as part of a trade-mark.

Descriptive trade-name.

It has been held under this proviso that a company need not disclaim common words which describe the article it deals in, and which appear upon its trade-mark, if they form part of its name and appear on the mark as such (*q*). And that the applicant's name in the possessive case occurring in a label need not be disclaimed either (*qq*).

Name in possessive case.

(*o*) *Hendriks* v. *Montagu*, 17 Ch. D. 638 (1881) C. A.; and see *Tussaud* v. *Tussaud*, 44 C. D. 678 (1890), Stirling, J., and the cases there cited. See also Chap. XVI., p. 392.

(*p*) See Chap. XII., p. 255.

(*q*) *The Smokeless Powder Co.'s Tm.*, (1892) 1 Ch. 590; 9 R. P. C. 109, Chitty, J.

(*qq*) *Colman's Tm.*, (1894) W. N.

Additions are further provided for by sect. 74 of the Act of 1883, which deals with additions "common to the trade" in the goods with respect to which the registration is made.

Additions which are common to the trade.

The section is in the following terms:

Saving for power to provide for entry on register of common marks as additions to trade-marks.

"74. (1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade-mark—

"(a) In the case of an application for registration of a trade-mark used before the 13th day of August, 1875—

Common addition to old mark;

"Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure (*r*), or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

to new mark.

"(b) In the case of an application for registration of a trade-mark not used before the 13th day of August, 1875—

"Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

"(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*

Disclaimer.

"[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars (*rr*) of the trade-mark, and must disclaim in his application any right to the exclusive

30; 11 R. P. C. 129, Stirling, J., (*Colman's* mustard), cf. clause 64 (l) (a), above, p. 115. As to common words in a distinctive label, see p. 172, below.

(*r*) *i.e.*, numeral, p. 165, n.

(*rr*) See p. 166, above.

" use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.]

"[Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.] (*s*)

The three mark rule.

" (3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the 13th day of August, 1875, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods."

Sub-sect. (2) of the original section was replaced by the present sub-sect. (2) in order to bring the requirements of this section into accord with the corresponding provisions of sect. 64 as amended, which are in the same words.

The registration of common words in a trade-mark confers no monopoly.

Under the Act of 1875, the disclaimer of common additions could not be forced upon an applicant who refused to consent to it as a condition of registration (*t*), although the fact of registration gave him no right to the exclusive use of them (*u*), and the present section was, no doubt, introduced in order that the register might be made to show that the additions were not appropriated by the registration.

Common additions to old and to new marks.

It will be seen that the section distinguishes between old marks used before the 13th of August, 1875, and new marks first used since that date. As to the former, the policy of the Act is to put them upon the register exactly as they were used (*x*); and accordingly, while the addition

(*s*) Act of 1888, s. 16, above, p. 167.

(*t*) The register might have been rectified by placing a disclaimer upon it. See *Re Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.

(*u*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886) C. A., decided upon the Act of 1875, though after that of 1883 was passed.

(*x*) *Phillip's Tm.*, (1891) 3 Ch.

authorized for new marks by the section is confined to "any distinctive word or combination of words," that authorized for old marks is "any distinctive device, mark, brand, heading, label, ticket, word, or figure, or combination of letters, words, or figures." So that while, apparently, the section adds nothing to what is allowed to be registered by sect. 64 (2) as an addition, namely, "any letters, words, or figures, or combination of letters, words, or figures, or of any of them," in the case of new marks, it considerably increases the list in the case of old marks.

Distinctive means *primâ facie* distinctive.

The section is expressed to apply only to additions which are distinctive, but as those which are really distinctive (*y*) cannot be at the same time "common to the trade," distinctive must here mean *primâ facie* distinctive (*z*), that is to say, the section applies to additions which would be distinctive if they were not common to the trade.

Common to the trade.

"Common to the trade" does not mean merely "commonly used in the trade," but "open to the trade to use," so that a word which has been once largely used in the trade, but has subsequently fallen out of use by all but one or two persons (*a*), or a word which is descriptive of the goods to which the mark is to be applied (*b*), if *primâ facie* distinctive, must be disclaimed under the section. Of course, any word may lawfully be used by any trader until it has been appropriated by use or registration as a trade-mark, so that the statements in the cases just cited must be taken to mean that words, &c., which might lawfully be, and have been, used by traders other than the applicant for registration, or his predecessors in title, or which are incapable of appropriation—as descriptive words are—

Words used by one trader only.

139; 8 R. P. C. 469, Chitty, J.; *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J. Under the Act of 1875, the descriptive words *Filtre Rapide* were allowed to be registered, with a signature; *Maignen's Tm.*, 28 W. R. 759 (1880), Jessel, M.R.

(*y*) See Chap. VIII., p. 122. The word refers back to sect. 64, see the next case.

(*z*) *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J., (*Washerine*).

(*a*) *Burland* v. *Broxburn Oil Co.*, *supra*.

(*b*) *Humphries* v. *The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J., (*Herbalin*).

are "common to the trade." And this accords with the view expressed in the Court of Appeal in *Thompson* v. *Montgomery*, that the words *Stone Ale* having never been used by any trader other than the trader who claimed them as a trade-mark, were not common to the trade (*c*). Lindley, L.J., said in that case: "Nothing, I apprehend, can be common to the trade, which is only used by one person in the trade."

The three mark rule.

It was held also in *The Washerine Case* that the phrase in question is not limited by the three mark rule of sub-sect. (3). That sub-section contains a rule for the particular case to which it refers, not a definition. "It might have been a question whether user by three or four, or five or six persons would have made a word or combination of words common to the trade, and the proviso is introduced merely for the purpose of settling that question, which might have been a difficult one of fact, and saying that where you have user in the trade by more than three persons, then the name so used shall be deemed to be common to the trade" (*d*). The three mark rule was originally introduced by the Commissioners of Patents, but it was repeatedly recognized by the Courts before the present Act was passed (*e*). It applies whether the marks used by the three persons are precisely, or only substantially, similar, and whether they have been used as trade-marks or otherwise, provided that they have been used on the same or a similar description of goods (*e*). But use abroad does not fall within the rule (*f*).

Common words in a distinctive label need not be disclaimed.

Words comprised in a distinctive label, which are common to the trade within the meaning of the section, need not be disclaimed (*g*), although Cotton, L.J., seems to have

(*c*) 41 C. D. 35; 6 R. P. C. 404 (1889).

(*d*) *Per* Chitty, J., 42 C. D. p. 280, 6 R. P. C. 482 (1889).

(*e*) See *Jelley's Application*, 51 L. J. Ch. 639 n. (1878); *The Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394 n., both Jessel, M.R.; and *Wragg's Tms.*, 29 C. D. 551 (1885), Pearson, J.

(*f*) See *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.

(*g*) *Smokeless Powder Co.'s Tms.*, (1892) 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 233; 8 R. P. C. 137, C. A.

expressed a contrary opinion in *Hudson's Case* (*h*), for the label does not consist of each particular part of it, but consists of the combination of all the parts (*i*). This rule may probably be regarded as settled by the cases cited, but in the earlier case of *Burland* v. *The Broxburn Oil Co.* (*k*), an order was made that the descriptive word *Washerine*, appearing in a registered label, should be disclaimed.

Common additions are not part of the trade-mark.

In the last-mentioned case, Chitty, J., expressed an opinion that additions registered under sect. 74, are not part of the trade-mark to which they are attached (*l*), and the wording of the section obviously suggests the same view. If this is the correct construction of the Act, it it would seem that no exclusive rights in the additions are conferred by registration, since sect. 76 grants such rights in the trade-mark only, and consequently the provision for the disclaimers required by the section was unnecessary, except for the purpose of showing that the registered proprietor has no such rights upon the face of the register. The additions allowed to the essential particulars enumerated in sect. 64, are referred to in the section in different language, and they are clearly part of the trade-mark itself where they are distinctive.

Effect of registration with disclaimer.

The effect of a disclaimer is that the proprietor of the registered trade-mark cannot claim any trade-mark rights under the Acts, in respect of the parts of the mark to which the disclaimer relates (*m*), so that, for instance, no action for infringement lies in respect of the use or imitation of the disclaimed particulars (*n*), and the mere presence of

(*h*) 32 C. D. 311; 3 R. P. C. 155 (1886); see above, p. 138.

(*i*) *Per* Lord Esher, M.R., in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), see Chap. X., p. 191.

(*k*) 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. A similar order was made in *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J., (*Filtered Blue*).

(*l*) So, *per* North, J., in *Rosenthal* v. *Reynolds*, *infra*.

(*m*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A., *Pirie's Parchment Bank*, the plaintiffs disclaimed *parchment* and *bank*, but sought to set up some right to the combination; *Baker* v. *Rawson*, 45 C. D. 529; 8 R. P. C. 89 (1890), North, J.

(*n*) *Rosenthal* v. *Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J.

the disclaimed words in a second mark tendered for registration does not make it resemble an earlier registered mark within the meaning of sect. 72 (2) (*nn*).

Advantages of registration with additions.

In comparing two marks which are alleged to too closely resemble each other, some account must be taken of elements common to the trade which are included in both (*o*); and on this ground the registration of a trade-mark, with the common words or other particulars which are actually used with it, may secure it a more efficient protection under sect. 72 against the subsequent registration of similar marks in the same class, than would be obtained by the registration of its distinctive elements only (*p*). Beyond this, it is difficult to see what substantial bearing upon the proprietor's rights the registration of disclaimed additions

Registration with blanks.

with a trade-mark can have; for if the places occupied by the matter which would have to be disclaimed are left blank upon the register, the proprietor forfeits none of his exclusive rights to the use of the registered and distinctive parts of the mark by filling up the blanks, in actual use, in any manner he pleases (*q*).

As already stated, traders prefer to register their marks as they are actually used (*r*), both because it saves the expense and trouble of preparing special prints for registration only, and for convenience of reference. On the latter ground, there seems to be good reason for making the registration of trade-marks as they are actually used compulsory in all cases.

(*nn*) *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29; North, J. *Unco Guid* in each of two quite distinct labels; and the cases in note (*m*).

(*o*) See Chap. X., p. 193.

(*p*) And see the passage from the Committee's report above, p. 165.

(*q*) *Melachrino & Co.* v. *The Melachrino Egyptian, &c. Co.*, 4 R. P. C. 215 (1887); *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), both Chitty, J.; and see Chap. XV., p. 331.

(*r*) See above, p. 166.

CHAPTER X.

RESTRICTIONS ON REGISTRATION.

PAGE
The comptroller's discretion not limited by the express restrictions .. 176

I. Duplicate marks for the same goods. Sects. 71 and 72 (1) .. 176
The three mark rule 177
rule does not apply to new marks 179
application of the rule 179
The same goods or description of goods 180
Section 72 is not limited by the register classes 180
use or registration for part of a class 181
Registration of a second mark by agreement 182

II. Mark resembling a registered mark. Sect. 72 (2) 182
The section extends beyond infringing marks 183
Where the marks are used in different markets 184
Deceptive resemblance calculated to deceive 186
A. WHAT PERSONS ARE TO BE CONSIDERED 186
ultimate purchasers 187
foreigners 187
ordinary persons 187
B. RULES OF COMPARISON 188
what amount of resemblance is calculated to deceive .. 188
1. The "idea of the mark" to be regarded 188
the *Two Elephant Case* 190
the *Taenstikker Case* 191
marks to be compared as wholes 192
general resemblance with differences in details 192
included common marks not to be disregarded 192
2. The marks are to be compared as fairly used in practice .. 193
alterations of the marks from their registered forms .. 195
3. The essential particulars are to be specially attended to .. 196
4. All the circumstances of the trade to be considered .. 197
numerous marks of the same description 197
distinction may be of a well-known kind 198
bearing of common marks on the comparison 199
5. Where the opponent's goods are known by a name suggested by the mark 199
answers to this objection 201
(a) the name is descriptive of the goods 201
(b) it is suggested by included matter common to the trade 202
or by disclaimed matter 203
or it is a common name 203
(c) it gives a practical monopoly 204
EVIDENCE 205
evidence of actual deception 206
examples and illustrations 207
contrasted devices and contrasted words 207

III. Deceptive marks. Sect. 73 (*see next page*).

PAGE
III. Deceptive marks. Sect. 73 209
The section extends beyond infringing marks 210
Doubtful new marks to be rejected, *Eno* v. *Dunn* 211
Mark containing name of the opponents' goods 212
Device suggesting the name 213
Trade-mark attached to part of the mark 214
Threats of prosecution in trade-mark 215
Registered, &c. 216
False representation as to origin of goods 216
Mark originally used fraudulently 216

The comptroller's discretion is not limited by the express restrictions.

NOTHING can be entered upon the register which is not authorized by the sections set out and commented on in Chapter VIII. (*a*), and, as stated in the chapter referred to, the comptroller has a discretion, subject to appeal, to refuse to register marks which he thinks ought not to be accepted, although they comply with the provisions of the enabling sections. This discretion is, as has been shown, general, and it extends beyond the letter of the restrictions imposed by other sections of the Acts which are the subject of the present chapter.

The most important sections to be considered in this chapter, sects. 71, 72, and 73, are substantially the same as the corresponding sections of the Act of 1875, sects. 5 and 6.

I. Duplicate Marks for the same Goods.

It is provided by sect. 71 that—

Sect. 71. Conflicting claims to registration.

"Where each of several persons claims to be registered as proprietor of the same trade-mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court."

And by sect. 72. (1) that—

Sect. 72 (1). Identical marks not to be registered without leave.

"Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade-mark, the comptroller shall not .. ..

(*a*) Page 106, sects. 64 and 74, see "reasons for refusal," p. 63.

"register in respect of the same goods or description of goods a trade-mark identical with one already on the register with respect to such goods or description of goods."

It will be observed that, while the former section gives the comptroller a discretion, the latter is imperative.

Duplicate claims to the same mark.

Where several applicants claim to be proprietors of the same mark the comptroller may require them to state their cases in writing, and to appear before him and give oral explanations with respect to such matters as he may require (*b*). And if the dispute is submitted to the Court under sect. 71, it is provided by the rules that the procedure to be adopted, unless the Court shall otherwise order, shall be that of a special case (*c*), which may be settled if need be by the comptroller (*d*); but in practice the application is always made by summons or motion, the summons or notice of motion asking for leave to have the question determined in that way (*e*).

The three mark rule.

Before the introduction of registration, when trade-mark rights could, except in a few special trades and in particular places (*f*), be acquired only by user, the duplication of marks for use in connection with the same description of goods, by use in different districts, was very common, and many duplicate old marks were admitted on to the register. A limit to the number of such duplicates which would be accepted was put by the adoption of the three mark rule which has been already referred to (*g*).

This rule was introduced by the Commissioners of Patents, under the Act of 1875, and it was repeatedly recognized by Jessel, M.R., and other judges (*h*), and its

(*b*) Rule 43, p. 602.

(*c*) Rule 44.

(*d*) Rule 45.

(*e*) See Sebastian, 3rd ed. p. 374, and *Simpson, Davies & Son's Tm.*, 15 C. D. at p. 527 (1880), Jessel, M.R.

(*f*) *e.g.*, the cutlery trade in Sheffield.

(*g*) Chap. IX. p. 172; Act of 1883, sect. 74 (3).

(*h*) *Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394 n. (1877), Jessel, M.R.; *Jelley's Application*, 51 L. J. Ch. 639 n. (1878), Jessel, M.R.; and *Wragg's Tm.*, 29 C. D. 551 (1885), Pearson, J.; *Benbow* v. *Low*, 44 L.T. 875 (1881), Bacon, V.-C.

test is adopted, with respect to additions common to the trade, by sect. 74 (3). According to the rule, three, but not more than three, identical or substantially identical (*i*) old marks may be registered for use upon the same, or substantially the same, class or description of goods, provided that the marks have been honestly and lawfully acquired and used. So that a mark which was originally unlawfully copied from another cannot claim registration along with the other under cover of the rule (*k*). If more than three such marks had been so acquired and used before the 13th of August, 1875, they were all treated as common to the trade (*l*); but the use of a mark abroad did not fall within the rule (*m*).

Lord Herschell's Committee on the three mark rule.

"Prior to the passing of the Act of 1883," say Lord Herschell's Committee (*n*), "the late Master of the Rolls had laid down the rule that the comptroller might register three old marks, *i. e.*, marks in use prior to August, 1875, without the necessity of the parties resorting to the Court. It is suggested," they add, "that this worked well; and although there is not complete unanimity of opinion on the point, we think the preponderance of reasons is in favour of reviving the practice as regards old marks." The committee seem to have been in error as to the power of the comptroller to register a second mark without the leave of the Court under the old Act, for sect. 6 of that Act laid down substantially the same rule as sect. 72 (1) set out above. The rule was that, upon proof of the title of a second or of a third trader to the mark, leave to register it was granted notwithstanding the presence of a first or second prior registration of the same mark for the goods in question (*o*), and no alteration has been made in

(*i*) *White Rose Tm.*, 30 C. D. 505 (1885), Kay, J.

(*k*) *Jelley's Application*, p. 179.

(*l*) See *Burland* v. *Broxburn Oil Co.*, 42 C. D. at p. 280; 6 R. P. C. 274 (1889), Chitty, J.

(*m*) *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.; and see *Jackson & Co.* v. *Napper*, 35 C. D. at p. 178; 4 R. P. C. 45 (1886), Stirling, J.

(*n*) Page xiii.

(*o*) See *per* Jessel, M.R., *Jelley's Application*, 51 L. J. Ch. at p. 640n. (1878).

regard to this by the present Acts. There cannot, one may suppose, be now remaining and unregistered any very large number of marks used before the 13th of August, 1875, which are likely to be put on the register under cover of the three mark rule; but the rule is still important, since questions as to the propriety of existing registrations are continually arising under sect. 90.

The rule does not apply to new marks.

The rule has never been applied to marks first invented or used since the 13th of August, 1875 (*p*), for the Registration Acts make proper registration itself equivalent to public user, and evidence of the registered proprietor's right to the exclusive use of the mark (*q*). Title to a mark can still, however, be acquired by user, although registration is a condition precedent to any action by the proprietor in respect of its infringement (*r*). It is quite possible, therefore, that the circumstances which led to the adoption of the rule might arise in connection with new marks. If, for instance, the same mark is adopted by two traders for use upon the same class of goods, but in different districts, and there is no proof as to which first adopted it, then, according to the present practice, if one gets registered the other cannot do so. It was suggested to Lord Herschell's Committee that this should be altered (*s*), but no change has been made.

Application of the rule.

Leave to register a second old mark is granted as of course, if an independent and honestly acquired title to the mark as a trade-mark is shown. In *Jelley's Case* (*t*), Jessel, M.R., said: "I have often had the case of a man in one town not knowing that another man in another town has the same mark, and he has got his trade-mark registered. The second applicant must prove his title, that

(*p*) *Jackson & Co.* v. *Napper*, 35 C. D. p. 169; 4 R. P. C. 45 (1886), Stirling, J.

(*q*) Act of 1883, sects. 75 and 76; Act of 1875, sects. 2 and 3.

(*r*) Act of 1883, sect. 77; and p. 260, below.

(*s*) See the evidence of the comptroller, Sir H. Reader Lack, Q. 3161.

(*t*) 51 L. J. Ch. 639 n. (1878).

"is all. The leave of the Court mentioned in sect. 6 (*u*) is not a capricious leave. The rule of the Court which I have just stated is always followed, and it merely means that the second man must show his title. You cannot deprive him of his trade-mark. Look at the monstrous injustice that would be done if a man who had a trade-mark for, perhaps, forty years, should lose it, because another man who had it for four years had happened to register it first."

After five years' registration of opponent's mark.

Registration of an old mark may be allowed although a similar mark has been on the register for more than five years (*x*).

The same goods or description of goods.

Sect. 72 is not limited by the register classes.

The operation of sect. 72 is not limited by the classes into which goods are divided for the purposes of registration. And in this respect the wording of the present Act is wider than that of the corresponding section of the Act of 1875, for that section contained the words "the same goods or classes of goods" in place of the words "the same goods or description of goods." Thus, in *The Australian Wine Importers' Case*, the question arose whether an application to register a label containing a device and the words "Golden Fleece" for wine, could be opposed on the ground of the prior registration of what were held to be similar labels for spirits, both wine and spirits being in the same register class (42), and Kay, J., held that, whether sect. 72 applied or not, the use of the mark tendered, having regard to the presence on the register of the other marks, would be calculated to deceive within the meaning of the next section, and that it ought not to be registered. The Court of Appeal affirmed the decision, and Lindley, L.J., said (*y*), "For the purpose of deciding whether two sets of goods are of the same description, we must not, it appears to me, lay too much stress on the classification in the schedule to the rules. You find there goods of the same description in

(*u*) *i.e.*, of the Act of 1875, now sect. 72 (1).

(*x*) *Jackson & Co.* v. *Napper*, 35 C. D. 162; 4 R. P. C. 45; *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1888), both Stirling, J. See further, as to the registration of old marks, Chap. VIII. pp. 154 *et seq.*

(*y*) 41 C. D. p. 291; 6 R. P. C. 311 (1889).

"different classes, and goods of different descriptions in the same class. For example, if you turn to classes 26—29, you will find that flax and hemp are in one class, and jute in another, though all of them are fibrous, and more or less of the same description for trade purposes. Then, if you turn to class 22, you will find bicycles and railway carriages in the same class. Now, for trade purposes, can you have any goods more different than bicycles and railway carriages? Of course, they are utterly different things, and yet they are put by the framers of these rules into the same class, so that we cannot be guided by their classification in construing the words 'same goods or description of goods,' which are the words used in sect. 72." And the judges were all inclined to think that wines and spirits were of the same description of goods, although they did not decide the point. It has since been held that beer and rum are the same description of goods within the meaning of the section (*yy*). So, on the other hand, in *Brady & Co.'s* applications, North, J., allowed a new mark to be registered for galvanized iron sheets, although a similar mark was already registered and used for bar iron and wire, which goods were within the same register class as the iron sheets (*z*). The true test would seem to be supplied by the question—are the two sets of goods so commonly dealt in by the same trader, that his customers, knowing his mark in connection with one set, and seeing it upon the other would be likely to suppose that it was used upon them also to indicate that they were his goods (*a*). It has already been stated that the proprietor of a mark used for only part of a register class, even though it be registered for the whole, and *à fortiori* if the registration as well as the user is limited within the class, cannot prevent the use of the mark by other traders upon other descriptions of goods, although they may be

Use or registration for part of a register class.

(*yy*) *Turney & Sons' Tm.*, 11 R. P. C. 37; 10 Times L. R. 175 (1893), North, J.

(*z*) 21 C. D. 223 (1882); and see *Jelley's Application*, 51 L. J. Ch. 639 n. (1878), Jessel, M.R.

(*a*) See *per* Kay, J., 41 C. D. at p. 281.

included in the same register class (*b*). But the fact that an opponent of an application for registration could not get an injunction to restrain the use which the registration sought is intended to cover, is by no means conclusive upon the question of the registration (*c*).

Registration of a second mark by agreement.

A second mark is often admitted to registration by agreement with the proprietor of a mark already registered, who might otherwise oppose it under sects. 72 or 73, on the terms that it shall be limited to part only of the register class. The limitation is effected by placing a note on the register (*d*). And in the same way marks are allowed to be registered on the terms of being used in a particular manner, so as not to be confused with a mark already registered (*e*), or for use in a particular district (*f*). And the comptroller may be directed to put a note, in accordance with the agreement, upon the register (*f*). Where identical or similar marks are registered for different goods in the same register class, it is an infringement for the proprietor of either to use his mark upon the goods for which the other is registered (*g*).

Note on the register.

II. Mark resembling a Registered Mark.

Sect. 72 (2), mark resembling a registered mark.

It is further provided by sect. 72 (2) that—

> "[Except as aforesaid] (*h*) the comptroller shall not register with respect to the same goods or description of goods (*h*) a trade-mark *so nearly resembling* [having such resemblance to] (*i*) a trade-mark already on the register with respect to such goods, or description of goods, as to be calculated to deceive."

(*b*) See p. 88, sect. 65; and see *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

(*c*) See *The Australian Wine Importers' Case*, *supra*, and p. 183, below.

(*d*) See *Re Rabone Bros. & Co.*, Seb. Dig. p. 395 (1879), Jessel, M.R.

(*e*) *Whiteley's Tm.*, 43 L. T. 627 n. (1879), Jessel, M.R.; *Sykes & Co.'s Tms.*, *ibid.* p. 626 (1880), Hall, V.-C. For restrictions as to colour, see Chap. VIII. p. 163.

(*f*) *Keep's Tm.*, 26 C. D. 187 (1884), Pearson, J.; *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1884), Chitty, J.; *Whiteley's Tm.*, 43 L. T. 627.

(*g*) *Upper Assam Tea Co.* v. *Herbert*, 7 R. P. C. 183 (1890), C. A.

(*h*) See above, p. 176.

(*i*) Act of 1888, sect. 14.

The sub-section corresponds to a part of sect. 6 of the Act of 1875. The words "except as aforesaid" refer back to sect. 72 (1) (*k*), and the exception is where the Court has decided that two or more persons are entitled to have identical, or substantially identical, marks registered, for instance, on the ground that trade-mark rights in them have been independently acquired. The words were added by the Act of 1888. The Act just cited also substituted "having such resemblance" for the words "so nearly resembling," which occurred in the Acts of 1875 and 1883. The change was in each instance made upon the recommendation of Lord Herschell's Committee, and in the latter was supported by the reasons stated in the extract from the report set out below (*l*). It is difficult, however, to see in what way the effect of the sub-section has been altered by the amendments.

What is meant by the same goods or description of goods has already been considered (*m*).

The provision of the sub-section embodies the old rule, that a mark which from its resemblance to an existing trade-mark is calculated to deceive cannot be protected as a trade-mark, for its use is an infringement of the other mark, which would be restrained by the Court (*n*). But the restriction extends beyond the rule, and it does not follow that because an opponent could not obtain an injunction against the use by the applicant of the mark he tenders for registration, that the latter is not calculated to deceive within this sub-section. Thus, in *Speer's Case* (*o*), Kay, J., said: "I could quite conceive a case

The section extends beyond infringing marks.

(*k*) Page 176.

(*l*) Page 188.

(*m*) Page 180, above.

(*n*) *Seixo* v. *Provezende*, 1 Ch. 192 (1865), Cranworth, L.-C.; and see *Cope* v. *Evans*, L. R. 18 Eq. 158 (1874), Hall, V.-C., and the cases there cited. Deceptive trade-marks are not protected, see Chap. XV. p. 336.

(*o*) 4 R. P. C. at p. 524; 55 L. T. 880 (1887); and see *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.

"in which the similarity would not be such as would induce the Court, on that fact alone, to grant an injunction, but in which the comptroller would still be entirely within his duty in saying that these marks are so nearly resembling one another, at any rate, that I will not, by allowing the registration, encourage the use of a mark which may lead to litigation hereafter. It seems to me that is a matter which the comptroller ought to consider." And this is fully in accord with the judgments of the law lords in *The Fruit Salt Case* (*p*)..

Marks used in different Markets.

Limitation to particular market.

The question has been raised whether a mark which is sufficiently distinguishable from an opponent's mark everywhere except in a particular country or market, but has there such resemblance to it as to be calculated to deceive, on account of the local circumstances of the trade, for instance, because goods bearing the latter mark have locally acquired a particular name (*q*), falls within the section, and ought, therefore, to be refused registration (*r*). The question has not been directly decided, but it is submitted that the objection would be sufficient to justify the rejection of the mark unless the parties came to an arrangement for the limitation of the area of user of the applicant's mark (*s*). The authorities cited below (*t*) show that probability of deception in England only is not all that is to be con-

(*p*) *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890).

(*q*) See p. 199, below.

(*r*) In *The Société Anonyme des Verreries de l'Etoile*, (1894) 1 Ch. 61; 10 R. P. C. 436, the trades of the applicant for rectification and of the respondent were in fact competing in the colonies, and Stirling, J., held that the use of the applicants' mark on goods shipped in English ports for the colonies was use in England, where the respondents' main trade was. Aff. by C. A., W. N. (1894) 42; 11 R. P. C. 142.

(*s*) As in *Keep's Tm.*, 26 C. D. 187 (1884). In *Re Rabone*, Seb. Dig. p. 396 (1879), upon simultaneous applications for the registration of similar old marks, Jessel, M.R., appears to have ordered the registration of both, subject to undertakings for specified local user only.

(*t*) Page 187.

sidered in cases of infringement, and it cannot be supposed that a mark would be admitted on to the register if it were shown that the proprietor would forthwith, upon the application of the opponent, be restrained from using it. It is true that, where old marks have been in use simultaneously for years in different markets, the injunctions granted in infringement cases have occasionally been locally limited (*u*), and such limitations have the support of a dictum of Cotton, L.J., in *Johnston* v. *Orr-Ewing* (*x*); but in that case, on appeal, Lord Cairns expressed a doubt whether the rightful and *bonâ fide* trade-mark of the trader using it could be excluded by injunction from particular markets (though unimpeachable everywhere else), merely because in those markets it might be liable to be called by a name which the mark of another had already acquired there (*y*). And it seems clear that the principle upon which the limitation of the injunctions in the cases referred to was based cannot avail to enable a new mark, which is deceptive in any market, to be registered without the consent of the owner of the mark with which it might there be confused, for the registration confers rights unlimited as to locality; and, although the owner of the previously registered mark may not yet have extended his trade to the particular market in question, it is open to him to do so. Thus, in *The John Bull Beer Cases*, where the two marks concerned were used by the plaintiffs and the defendants respectively in different districts of England, the more lately adopted mark was refused registration, and subsequently an injunction was granted to restrain the use of it (*z*). So, too, in *The Jackson Co.'s Case* (*a*), registration of a word was refused because it was the name of a common mark in the

(*u*) *Carver* v. *Bowker*, Sob. Dig. p. 350 (1877), Little, V.-C.; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.

(*x*) 13 C. D. p. 464.

(*y*) 7 App. Cas. p. 227. To that proposition, he said, he could not assent.

(*z*) *Paine & Co.* v. *Daniells & Son's Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217.

(*a*) 6 R. P. C. 80 (1888), Kay, J., (*Kokoko*).

cotton trade among the Chippeway Indians, to whom the English cotton trade had not then extended.

Deceptive Resemblance.

Calculated to deceive.

"Calculated to deceive" may mean either "intended to deceive" or "likely to deceive," and the prohibition applies where the case falls within either meaning (*b*), although the latter, which is, of course, the more inclusive meaning, is sufficient to dispose of most, if not all, of the questions that arise under the section. The words are not equivalent to "capable of being used to deceive" (*c*), for it must be assumed, until the contrary is shown, that the applicant will make an honest use of his marks (*b*). A trade-mark is calculated, by its resemblance to another already on the register, to deceive, if in the course of its legitimate use in the trade it is likely to do so.

Two important questions are suggested by the section: A. Who are the persons whom the resemblance must be calculated to deceive? and, B. What rules of comparison are to be adopted in judging whether such resemblance exists?

A. What Persons are to be considered.

Whom the mark must be calculated to deceive.

In accordance with the cases decided in suits and actions for the infringements of trade-marks before the Registration Acts, it is held that the persons to be considered in estimating whether the resemblance between the marks in question is calculated to deceive are all of those who are likely to become purchasers of the goods upon which the marks are used. So that, if such persons, using ordinary care (*d*) and intelligence, are likely to be deceived, then the comptroller ought not to accept the mark.

(*b*) *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J., (*Carlsbad Salts*); and see the next case.

(*c*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

(*d*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886). See *per* Esher, M.R., p. 62, quoted below, p. 191.

The ultimate purchasers.

It is clearly not enough for the applicant to show that retail dealers buying his goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade-mark to deceive their customers, the ultimate purchasers (*e*). In fact, dealers who buy from the manufacturers in order to sell by retail are generally aware of attempted infringements, and are parties to the fraud (*f*).

Foreigners.

Nor is the inquiry to be confined to England, or to persons acquainted with the English language, where the goods in question have a foreign market (*g*).

Persons of ordinary ability and carefulness.

And it must not be assumed that a very careful or intelligent examination of the mark will be made (*h*); but, on the other hand, it can hardly be a bar to the admission of a mark that unusually stupid people, fools or idiots, may be deceived (*i*). The cases cited are nearly all cases of infringement, and, as already said, a weaker case than would entitle a plaintiff to succeed in an action for infringement, will enable an

(*e*) *Wilkinson* v. *Griffith*, 8 R. P. C. at p. 374 (1891), Romer, J. See the judgment of Mellish, L.J., in *Ford* v. *Foster*, 7 Ch. 616 (1872); and the judgment of Lord Selborne, in *The Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 15 (1882).

(*f*) *Anglo-Swiss, &c. Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.; *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A. "In my opinion, the whole gist of the complaint against the defendants is, 'You have sold a weapon calculated to be used fraudulently by the middlemen,'" Cotton, L.J.

(*g*) *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219 (1882); *Wilkinson* v. *Griffith*, *supra*.

(*h*) "Unwary purchasers." *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508 (1872), Lord Chelmsford; *The Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 15 (1882), Lord Selborne. "Ordinary purchasers purchasing with ordinary caution," *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L.C.

(*i*) "Whatever be the class of persons who buy these things (sewing machines), we must at all events assume that they are persons capable of reading and writing, or of reading, at all events," *per* James, L.J., 18 C. D. p. 413. "The possibility of such a mistake is not a cause of action (for passing off). The same thing might happen if the defendant issued circulars that his were *not* Singer sewing machines. For however large he printed the *not* some one might not see it," *per* Lord Bramwell, 8 App. Cas. p. 42.

opponent to successfully object to the registration of a new mark.

B. Rules of Comparison.

What amount of resemblance is calculated to deceive.

It is impossible to discover from the decided cases any criterion as to the amount of resemblance which will suffice to cause the rejection of a mark more definite than that expressed in the section itself, and probably no test could usefully be stated (*k*); but a perusal of the reported cases shows that the comptroller and the Court now apply the restriction much more strictly against new marks than formerly, and, as already shown, it is settled that the onus of showing that there is no reasonable probability of deception is cast on the applicant (*l*). In comparing the marks, the comptroller must, as is shown by the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's. The report of Lord Herschell's Committee on this point admirably states what are conceived to be the critical tests, and it shows also what the amendment of the Act (*m*) was intended to effect. It will be useful to set out the whole passage.

1. The "Idea of the Mark" is to be regarded.

Lord Herschell's Committee on the principle of comparison.

"We have given very careful consideration to the evidence which has been laid before us by those interested in the trade of Lancashire. The number of marks registered in classes 23, 24, and 25, which are commonly described as the Cotton Classes, is very large; and the administration of the Act (*n*) in relation to these classes is of great

(*k*) "What degree of resemblance is necessary (to constitute an infringement) is, from the nature of things, a matter incapable of definition, *à priori*," *per* Cranworth, L.C., in *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866).

(*l*) *Eno* v. *Dunn*, 16 App. Cas. 252; 7 R. P. C. 311 (1890).

(*m*) Substituting "having such resemblance" for "so nearly resembling."

(*n*) *i.e.*, the Act of 1883.

"importance to the trade. There can be no doubt that the working of the Trade-Marks Act has not given satisfaction in Lancashire. Even if at times there may have been a disposition to expect too much, we think there have been substantial grounds for the dissatisfaction which has prevailed. The great bulk of the goods manufactured in Lancashire, in respect of which trade-marks are used, is exported to other countries, and there can be no doubt that these marks fulfil important functions in the trade between Lancashire and India and other countries. One chief complaint has been that the usages of the trade and the character of the markets where the marks are intended to serve their purpose have not been sufficiently kept in view by the Patent Office. By sect. 72, sub-s. (2), the comptroller is directed not to register, with respect to the same description of goods, a trade-mark so nearly resembling a trade-mark already on the register with respect to such description of goods as to be calculated to deceive. It is on the question whether marks do so nearly resemble one another as to be calculated to deceive, and what extent of resemblance to an old mark ought to cause the rejection of an application, that the chief difference has arisen between the trade and those to whom the administration of the Act has been entrusted. The tendency of the office has been to construe the words of the Act more favourably towards applicants for new marks than the trade have thought right. We think the difference has arisen in part from the wording of the Act. The comptroller has felt unable to say that two marks 'so nearly' resemble each other as to be calculated to deceive. He has thus not considered himself at liberty to take into consideration to the extent he otherwise might, the character of the market in which the mark is to serve its purpose. Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if the goods were

The idea of each mark to be considered.

"allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football (*o*). It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

"In order to avoid misapprehension in the future, we recommend, even though it may not be absolutely necessary, a slight amendment of the Act, substituting for the words 'so nearly resembling' the words 'having such resemblance to'; and further, we would suggest that when the question arises whether a mark applied for bears such resemblance to one on the register as to be calculated to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different; whilst, on the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same."

The principle is adopted by the Court.

It is conceived that the principles which should guide the comptroller, and the Court on appeal from him, and also on applications under sect. 90, to remove a trade-mark from the register as offending against this sub-section, are here stated in accordance with the leading cases on the subject.

The Two Elephant Case.

Thus, in *Johnson* v. *Orr-Ewing* (*p*), where both plaintiff's and the defendant's marks consisted of tickets bearing

(*o*) Cf. *Barker's Tm.*, 53 L. T. 23 (1885), Kay, J. (*Huntsman*, or *Sportsman's* cherry brandy).

(*p*) 7 App. Cas. 219 (1882).

pictures of two elephants with a banner between them, the figures being differently arranged, Lord Selborne said (*q*): "Although the mere appearance of these two tickets could not lead anyone to mistake one of them for the other, it might easily happen that they might both be taken by natives of Aden or of India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods. To such persons, or at least to many of them, even if they took notice of the differences between the two labels, it might probably appear that they were only differences of ornamentation, posture, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged. Such variations might not unreasonably be supposed to have been made by the owners of the plaintiff's trade-mark themselves for reasons of their own."

The Taenstikker Case.

And in *The Taenstikker Case* (*r*), where the Court of Appeal, reversing the decision of Chitty, J., held that a label for match-boxes so nearly resembled an older label registered for the same goods as to be calculated to deceive, the judgment of the Court proceeded on the ground that the net impression produced by both labels was the same. The appellant's label as registered consisted of a black oblong, bearing the word *taenstikker* printed at the bottom, and the word *nitedals* at the top, and a small geometrical device having two overlapping medals on each side of it in the middle. The respondent's label as registered showed the same elements, with the word *medals* instead of *nitedals*, two blank spaces having the same outline as the medals, and a cross instead of the device, the blanks and cross corresponding in size and shape with the medals and device. It was shown that in practice the respondents printed representations of medals over the blanks.

(*q*) Page 225. See also *Baschiera's Tm.*, 33 Sol. J. 460; 5 Times L. R. 480 (1889), Chitty, J., where the ground of rejection was that "the dominating portion of each mark was a lion, and the goods were designated by the prevailing feature, according to the custom of the trade."

(*r*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886).

Lord Esher's judgment.

The marks to be compared as wholes.

"The trade-mark," said Lord Esher, "is the whole thing—the whole picture on each. You have, therefore, to consider the whole. Mr. Justice Chitty has looked at the distinguishing features. He, I think, only looked at it to see whether, with that distinction, the whole was like or unlike. That is what he did, but the argument raised by Mr. Romer, and which was not only shadowed but plainly put forward by his skilful cross-examination, was this: the moment there is any distinction in any part the things are at once unlike. That is his point. Therefore he cross-examined the people thus:—The lamps (*s*) or the medals are alike, and they are common?—Yes. The two things in the middle are unlike?—Yes. The word at the bottom is common to the trade, and it is the same in both?—Yes; but it is common to the trade. Therefore, he says, everything but the words *medals* and *nitedals* is common, and those two are different, and therefore the whole is different. It seems to me he has fallen into this fallacy—he takes each thing by itself, and says either it is common or it is the same, and leaves out altogether the mode in which the things are put together in the two pictures."

There may be general resemblance with many differences in details.

And Lindley, L.J., said: "The difference here, looking at the boxes, is simply this, that the word *medals* is used instead of the word *nitedals*, all the rest being, according to the evidence, common. Now I do not think that is a dissimilarity which is sufficient in this case, because, although I rather agree with the view taken by Chitty, J., that the leading feature is the name at the top or bottom of the label, one must not be misled by that. The question is, notwithstanding that, what is the effect of the use or introduction of that distinguishing character on the whole? When you look at the wholes, then it appears to me, I confess, that the dissimilarity is not enough to make the wholes dissimilar" (*t*).

Included

So that, where common marks are included in the trade-

(*s*) *i.e.*, the blank spaces.

(*t*) "Though no one particular mark was exactly imitated, the combination was very similar and likely to deceive," Hatherley, L.C., in *Abbott* v. *The Bakers', &c. Association, Ld.*, W. N. (1872) 31.

marks to be compared, or in one of them, it appears, from the judgments just quoted (*u*), that the proper course is to look at the marks as wholes, and not to disregard the parts which are common, although Cairns, L.C., in the *Orr-Ewing Case*, expressed a different opinion (*x*).

common marks are not to be disregarded.

Farrow's Case (*y*) is a good illustration of Lord Esher's rule (*z*). There both the applicant and the opponent were mustard merchants, and both used square boxes covered with yellow labels printed in black and red, for these boxes were common to the trade. The applicant placed upon his labels a picture of a charging buffalo, and the opponent a picture of a bull's head; both pictures were contained within silver rings, and these rings were also common to the trade. Stirling, J., said that the buffalo and the bull's head, as printed in the Trade-Marks Journal, were very different, but when they were placed upon the coloured labels, the applicant's label too closely resembled that of the opponent to be admitted to the register.

Parts of the contrasted marks common to the trade not to be disregarded.

2. The Marks are to be compared as fairly used in Practice.

It is also clear that the comptroller or the Court ought not merely to look at the marks as they stand side by side, for, from the nature of the case, they will not be so put before any customer whom it is sought to deceive by means of either of them. He can only contrast the mark upon the goods offered to him with his recollection of the mark used upon those he is seeking to buy, and allowance must be made for this in estimating the probability of deception. Any other rule would be of no practical use (*a*). Moreover, variations in details might well be supposed by customers

Marks not to be merely compared side by side on a view;

(*u*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886), above, p. 191; and see *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 39 (1890), North, J.

(*x*) 4 App. Cas. 479 (1879).

(*y*) 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

(*z*) Page 191, above.

(*a*) *Seixo* v. *Provezende*, 1 Ch. 192 (1866), Cranworth, L. C.; *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J.

to have been made by the owners of the trade-mark they are already acquainted with for reasons of their own (*b*).

but as seen and remembered in actual use.

In comparing the marks, therefore, regard must be had not only to their form as they appear on the register (*c*), but also to the appearance they would present in actual use when fairly and honestly used; to the nature of the goods upon which they are to be employed; to the character and size of the marks themselves, and to the probability of their becoming partially or wholly blurred or modified as ordinarily stamped or printed, or by ordinary wear and tear (*d*).

For instance, a mark which is used for hardware goods, and is stamped upon them with a die, is not likely to appear so definitely or to be so readily distinguishable from a similar mark as one which is engraved or printed upon a paper label, and so attached to the goods (*e*). In the former case, too, the mark will necessarily be used in

Size of mark.

a small size only (*e*). As regards size, however, even under circumstances in which, from the nature of the goods, large sizes showing the design distinctly can be, and generally are used,—since it is open to a registered proprietor to use his mark in any size,—size would not seem to be a material element in the comparison (*f*). It must not be assumed against the applicant or registered proprietor that he is going to use his mark unfairly, in the sense that he is

(*b*) *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219 (1882), Lord Selborne, *ante*, p. 191.

(*c*) Jessel, M.R., held, in several cases, that the register only should be looked at. *Re Jelley*, 51 L. J. Ch. N. S. 639 n. (1878); *Robinson's Tm.*, 29 W. R. 31 (1880); *Mitchell* v. *Henry*, 15 C. D. 181 (1880); but in the latter case the C. A. dissented from his opinion and overruled his decision; *Christianeen's Tm.*, 3 R. P. C. 54 (1886), Chitty, J.

(*d*) *Rosing's Application*, 54 L. J. Ch. 975 n. (1878), C. A.; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102, (1885), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138 (1889), C. A.

(*e*) See the two cases last cited, in which, however, the opposition failed; and see *Re Jelley*, 51 L. J. N. S. 639 n. (1878), Jessel, M.R.

(*f*) *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J.

going to use something different (*g*), by leaving out or obliterating any parts of the mark, for instance, so as to make it more like that of the opponent (*h*), for the Court presumes that a trade-mark will be fairly used and without fraud (*i*). But the comptroller or the Court must consider any alterations which the applicant lawfully might make, without altering the essential features of his mark or losing the protection which would be conferred by registration (*k*). Thus he may use the mark in any colour, and in *Worthington's Case* (*l*) a triangular frame with the picture of a church inside was rejected on the ground that it would, if the whole were coloured red, too nearly resemble Bass' well-known solid red triangle. And if it is shown that the applicant does actually use, or intend to use, his mark so altered as more nearly to resemble that of the opponent, as, for example, in *The Tuenstikker Case* (*m*), by filling up blanks left in the mark as registered, the mark so altered will, as against the applicant, be treated as the mark to be considered (*n*). On the other hand, such alteration of the opponent's mark, being something other than the ordinary effects of its lawful user in the registered form, is immaterial as against the applicant (*n*), for no one can extend the protection given to his registered mark by departing from the registered form. It is, however, no answer to an objection that the objector uses his mark in a form different to that in which it appears on the register, if the mark in question so nearly resembles the

Alteration of mark as used, from mark as registered, to be considered.

Variation in the use of the opponent's mark.

(*g*) *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.

(*h*) *Lyndon's Tm*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

(*i*) *Lambert's Tm.*, 6 R. P. C. 344; 61 L. T. 138 (1889), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad salts*).

(*k*) *i. e.*, making his mark so different as to be practically an unregistered mark.

(*l*) 14 C. D. 8 (1879), Jessel, M. R., and C. A.; and see *Hanson's Tm.*, 37 C. D. 112 (1887), Kay, J.; see "colour," p. 163.

(*m*) *Christiansen's Tm.*, cited above, p. 191.

(*n*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

objector's mark, as it there appears, as to be calculated to deceive (*o*), for such use is legal, although, so far as the mark used is substantially different from the mark registered, it is not protected. Even if the user were illegal, it could hardly act as an estoppel (*p*); and if the opponent were using his mark improperly, for instance, in aid of a fraudulent or illegal trade, or if his mark as used by him were calculated to deceive (*q*), the applicant's proper course would be to remove the mark out of the way by an application to rectify the register under sect. 90.

Alteration of the opponent's registered mark in use cannot increase the objection.

3. The Essential Particulars are to be specially attended to.

Regard must, however, be specially directed to the essential particulars of the marks to be compared, for the remaining matter in any of them might, subsequently to registration, be changed on an application under sect. 92. On this ground, Stirling, J., refused, in *Murphy's Trade-Mark* (*r*), to allow a mark consisting of a lion carrying a sheaf, together with other matter, to be registered, there being already on the register another mark comprising a lion bearing a crown, although each mark had additional matter also, and the general appearances of the two were different, because the lions were the sole essential particulars of both. The applicants in this case offered an undertaking that they would use their mark only in the form tendered for registration, but this was not deemed sufficient by the proprietors of the opposing mark, and, as the mark was a new one, the judge refused to accept the offer as an answer to the difficulty raised by the resemblance of the essential particulars.

Undertaking not to vary registered mark in use.

(*o*) *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301 (1892), Chitty, J., both cases of infringement.

(*p*) See *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

(*q*) See *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.

(*r*) 7 R. P. C. 163 (1890).

4. All the Circumstances of the Trade to be considered.

Further, the Court must have regard to all the circumstances of the trade in which the marks in question are employed, or are to be employed, and in particular to the nature of the market, whether a home or a foreign one; to the number of other trade-marks similar to the contrasted marks already circulating in connection with the same description of goods; to the common marks which are or may be combined with the contrasted marks or either of them; and, generally, to the customs and usages of the trade.

It is obvious that marks which are readily distinguishable by Englishmen, or persons who can read English, may so resemble each other as to be calculated to deceive foreigners whose language is not only different to English, but written in different characters and in a different manner (*s*). For them, if they are ignorant of English, the words upon a mark are only subordinate devices not readily distinguishable from other words occupying corresponding positions in any contrasted mark, and being of about the same length.

Numerous marks of the same kind on the register.

And in cases where there are a large number of marks similar to the mark propounded on the register, the Court may think that, though the applicant's mark might be fairly distinguishable from the opponent's if there were no other, and perhaps also from each of the others taken alone, yet the extension of the number of such marks may lead to deception. Thus, in *Hargreaves' Case* (*t*), there being four anchor marks already on the register in the same class, Hall, V.-C., refused to allow another anchor mark to be added to them, notwithstanding that the new

(*s*) *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219 (1882); *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J.

(*t*) 11 C. D. 669 (1879); *Thewlis and Blakey's Tm.*, and *Hughes and Young's Tm.*, 10 R. P. C. 369 (1893), North, J.; and see *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. 479 (1879).

mark was sought to be registered for bacon and hams, while those already registered were used for different articles of food, such as biscuits, potted meat, &c., and that it was said to be distinguishable from them all. But the registration of other marks belonging to the applicant himself would not be material to defeat his application, since a trader often desires to register slightly differing marks to distinguish goods which are of different qualities or prices (*u*). Of course, the objection referred to in the present paragraph is much more material in the case of a new trade-mark than in that of an old one (*x*).

Similar marks belonging to the applicant.

The distinction between the marks may be of a well-known kind.

In some cases, on the other hand, the existence of a number of marks, either as common marks or as trade-marks, may operate to render a finer distinction allowable than would otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter. Thus, in *Mitchell* v. *Henry*, an action for infringement, the reasoning which led Jessel, M.R., to dismiss an application by the plaintiffs for an interlocutory injunction, was summed up by Cotton, L.J., as follows: "What is claimed by the plaintiffs is a double thread on a white selvage; if that is distinctive, then what the defendants are using, namely, a triple thread upon a white selvage, must be a distinctive trade-mark, and therefore I cannot restrain the defendants" (*y*).

Line headings.

The case just referred to forcibly illustrates the difficulties which led Lord Herschell's Committee to recommend that the line headings woven at the ends of lengths of piece goods should not be admitted as trade-marks upon the

(*u*) See "series," sect. 66, Chap. V., p. 90; and *per* Cotton, L.J., in *Mitchell* v. *Henry*, 15 C. D. at p. 193 (1880).

(*x*) See Lord Blackburn's judgment in *The Orr-Ewing Case*, 4 App. Cas. 499; and that of Stirling, J., in *Murphy's Tm.*, 7 R. P. C. p. 166.

(*y*) 15 C. D. at p. 194 (1880). The application of this reasoning to the particular case was disapproved by the C. A.

register (*z*). As they are all constructed by weaving coloured threads into a narrow strip at the end of the piece, the range of possible variation is very closely limited, while the number of existing headings is extremely great, so that it was considered practically impossible to maintain effective distinctions between them, or to sufficiently identify and describe them on the register.

Marks common to the trade may be material in estimating resemblance.

The bearing of marks common to the trade upon the distinctiveness of a mark propounded for registration has been already discussed (*a*); but besides affecting the right to registration in that way, the nature and number of the common marks with which it will be associated or contrasted may cause the mark propounded to be more or to be less distinguishable from a particular mark than if they did not exist. It is clear, therefore, that the comptroller or the Court must have regard to the marks common to the trade in applying sub-sect. 72 (2) (*b*).

5. Where the Opponent's Goods are known by a Name suggested by the Mark.

Where the goods of a particular trader have become known by a name derived from his trade-mark, any other mark which would be likely to suggest the use of the same name for the goods on which it is used, so resembles the former as to be calculated to deceive.

Seixo v. *Provezende.*

Thus, where the trade-mark of the plaintiff was a crown and the word *Seixo*, and his goods had in consequence come to be known in the market as *Crown-Seixo* wine, the defendants were restrained from using marks which led their wine to be described by the same name (*c*), although evidence was given that *Seixo* was a common word in Portuguese. "The plaintiff," said Lord Cranworth, "had adopted a device or trade-mark which had caused his wines

(*z*) Report of 1883, p. ix.; see Chap. VIII., p. 136.

(*a*) Page 122, above.

(*b*) *Per* Cotton, L.J., in *Mitchell* v. *Henry*, 15 C. D. 193 (1880).

(*c*) *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (1866).

" to obtain celebrity under a name descriptive of that trade-mark. The defendants have adopted a trade-mark which could not fail to lead purchasers to attribute to the wines so marked the same name as that under which the plaintiff's wines were known, and so to believe that in purchasing them they would be purchasing the wines of the plaintiff. Against the use of such a trade-mark the plaintiff has, I think, a right to have the injunction of this Court." So where a trade-mark consisted of the full-length figure of a milkmaid carrying two pails, one on her head and one in her right hand, with the words *milkmaid brand* above it, was registered for condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee, and the goods upon which it was used were known as the *milkmaid* or *dairy-maid* brand, and subsequently another trade-mark consisting of a half-length figure of a woman carrying a pail under her right arm, with the words *dairy-maid* at the side of the figure, was registered for butterine and other fatty substances used as food or as ingredients in food, an order was made to rectify the register by confining the second registration to goods other than those included in the first, and to restrain the use of the second mark upon any of the goods for which the first was registered (*d*).

The Dairy-maid Milk Case.

The objection is equally strong if the word suggested by the new trade-marks, although not the same as a word suggested by the older mark, yet so nearly resembles it, as to be calculated to deceive (*e*).

(*d*) *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.; *Orr-Ewing* v. *Johnston*, 13 C. D. 434; 7 App. Cas. 219 (1879), Fry, J., C. A., and H. L., (*Two Elephant Yarn*); *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J., (*Dog, Tower, and Harp Linen*); *Read* v. *Richardson*, 45 L. T. 54 (1881), C. A., (*Dog Head Beer*); *Baschiera's Tm.*, 33 S. J. 469; 5 T. L. R. 480 (1889), Chitty, J., (*Lion Matches*); *La Société Anonyme des Verreries de l'Etoile*, 10 R. P. C. 436; (1894) 1 Ch. 61; 11 R. P. C. 142; W. N. (1894) 42, Stirling, J., and C. A., (*Star Glass*); *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J., (*Red Medal Polish*); are to the same effect.

(*e*) *e. g.*, *Ancross* for umbrellas

The cases just cited are cases where the name applied to the goods was taken from the device used as a trade-mark. The rule applies also to cases where the name is taken from some word or words appearing upon the mark. *The Osman Towel Case* (*f*) is an illustration of this, and *The Milkmaid Case* (*g*), already cited, and *Meeus' Application* (*h*), are instances belonging to both classes.

Answers to objections founded upon names derived from marks.

Where the alleged resemblance is put upon the probability of the application of the same name to the goods of both the applicant and the opponent, it is often contended in reply, (a) that the name is in fact the name or description of the goods themselves; (b) that it is suggested by words, or devices, comprised in the marks, which are common to the trade, or is itself a word or the name of a mark which is common to the trade; or (c) that the proprietor of the opposing mark is seeking to secure a monopoly in the word under cover of his mark.

(a) Where the name is descriptive of the goods.

(a) The first objection is really included in the second, but it is convenient to state it separately. It is a question of fact whether the name concerned is the name of the goods or of some quality (*i*) attributed to them, having no reference to the traders by whom they are made or dealt in, or whether it conveys a representation that the goods are made or dealt in by the proprietors of the opposing mark. The question has already been discussed (*k*). All the authorities relevant to it before 1890 were discussed and commented on in *The Osman Towel Case* (*l*) by Chitty, J., and the Court of Appeal. As has been shown elsewhere (*m*), where a name was first given by a trader to

Where the opponent has

in a new mark, was rejected because there were several old anchor marks; *Thewlis and Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J.

(*f*) *Barlow* v. *Johnson*, 7 R. P. C. 395 (1890), C. A.

(*g*) *Supra.*

(*h*) (1891) 1 Ch. 41; 8 R. P. C. 25 (1890), Chitty, J., (*Key Brand Geneva*).

(*i*) *e. g.*, excellence: *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1886), C. A., (*Gem Air-guns*); or size: *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A., (*Eton cigarettes*).

(*k*) Chap. II., p. 36; see *per* Lord Selborne, in *Singer* v. *Wilson*, 3 App. Cas. p. 376 (1878).

(*l*) *Barlow* v. *Johnson*, 7 R. P. C. 395.

(*m*) Chap. II., pp. 36 *et seq.*

had a monopoly in the goods.

goods in the manufacture or sale of which he had a monopoly, whether as of right under a patent (*n*), or in fact because he was the first inventor or introducer of the goods (*o*), the Court will more readily infer that the name is the name of the goods merely, and that it connotes no connection between them and the trader, and the probability that this is the case, is nearly, although not quite, as strong, where, in similar circumstances, the public themselves have taken the name from the trader's marks and applied it to the goods. Of course, it is much more difficult to make out that the name has no such connotation if it is not the sole name applied to the goods in the market.

If the fact is made out that the name suggested by the marks is merely descriptive, and there is no other resemblance which is calculated to deceive, the second mark is entitled to registration. Thus, in *Horsburgh & Co.'s* application, Messrs. Leonard and Ellis, in 1873, adopted, and subsequently registered, a trade-mark comprising the word *valvoline;* four years later the applicants sought to register a different mark comprising the word *valvoleum.* The words were held to be substantially the same, and each of them to be descriptive of the valve oil in connection with which both marks were to be used, and Jessel, M.R., allowed the second mark to be registered (*p*).

(b) Where the name is suggested by matter in the mark common to the trade.

(b) Where the name is suggested by words or devices which are common to the trade and which form part of the trade-mark offered for registration, the words or devices

(*n*) *Wheeler & Wilson Co.* v. *Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C.; *Linoleum Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J.; and *Palmer's Tm.*, 24 C. D. 504 (1882), Chitty, J., and C. A.; *Slazenger* v. *Feltham*, 6 R. P. C. 531 (1889), C. A., (*Demon Raquets*), is a case of an invalid patent.

(*o*) *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A., (*Valvoline*); *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A., (*Gem Air-guns*); *Waterman* v. *Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888), C. A., (*Reversi*).

(*p*) 53 L. J. Ch. 237 n. (1878). The opponents had also registered *Valvoline* alone as a trade-mark. It was subsequently removed from the register; *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Blair* v. *Stock*, 52 L. T. 123 (*Strathmore Blend Whisky*); *Loftus' Tm.*, above, p. 174, note (*nn*).

must be disclaimed in the application (*q*), and if they form part of the opponent's mark also, a disclaimer should be registered in connection with that mark, and the matter disclaimed cannot be, by itself, relied on to support the opposition (*r*). But the presence of the common elements in both may be an element in creating a general resemblance between the marks looked at as wholes. It seems that where there is no disclaimer on the register, and no application to rectify, the Court will not pay attention to evidence that any part of the opponent's mark is common to the trade (*s*).

The opponent cannot rely on disclaimed matter or words in his mark.

The Star Tobacco Mark Case (*t*) is an authority to show that the suggestion both by the mark of the applicant and by that of the opponent of a word which is common to the trade because it is a name or description for the goods in connection with which both marks are used, is not a sufficient reason for refusing the application to register. There the opponents had registered as an old mark a characteristic eight-pointed star, and also, as a new mark, a label with the star, another device and the word *star*, and they asserted that their goods were frequently sold and ordered as star goods. The applicant's mark consisted of a sea picture within a ring, having a small six-pointed star in the clouds at the top, and a conspicuously drawn anchor in the lower part of the picture, and the words *star of hope*. The judge found that the device of a star, although not the particular star of the opponent's old mark, was common to the trade, and he allowed the registration. "I think," he said, "that

Where the name is common to the trade.

(*q*) Sect. 74. Chap. IX., p. 164; Porter, M.R., an Irish case, *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29, North, J., (*Uneo Gaid Whisky*). *Meeus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J., (*Key Brand Genera*); *i.e.*, unless they are parts of a distinctive label, p. 172.

(*r*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, C. A., (*parchment bank paper*); *Rosenthal* v. *Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J., (*W. R. corsets*); *Watt* v. *O'Hanlon*, 4 R. P. C. 1 (1886),

(*s*) *Goodall s Tm.*, 42 C. D. 566 (1889), North, J., (*parchment bank paper*); cf the rule that an application to rectify cannot be made by counterclaim, Chap. XI., p. 238.

(*t*) *Re Dexter's Application*, *Re Wills' Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J.

"the use of the word *star* and the use of the figure of a star are matters *publici juris*, and have been *publici juris* at all material times, except so far as some particular trader may have appropriated a particular phrase in which *star* is used in some special manner, or may have appropriated a particular design in which the figure of a star has assumed a special form, or has been so combined with other matters as to produce a specific thing different from what may be called the ordinary image of a star."

(c) Where the name is said to give a practical monopoly.

(c) The third ground of reply has been also dealt with in several cases, and it is settled that a trader will not be allowed to acquire or use a mark which will probably lead to his goods being mistaken for those of another, even though this may make it difficult for him to truly describe the place of origin of his goods, or to present them to purchasers in the form in which they expect to receive goods of the class (*u*). Thus, in *Wilkinson* v. *Griffith* (*x*), an infringement case, Romer, J., in restraining the defendants from using their label, relied upon evidence that the plaintiff's goods were known as red stamp polish from the figures upon his labels, although it was urged on the defendant's behalf that the plaintiff's claim practically involved a claim to a monopoly in red labelled goods. The judge, however, expressly stated that the plaintiff was not entitled to any such monopoly. "I by no means hold, nor do I think, the evidence as a whole can fairly be said to establish," he said, "that any red mark on a label of the defendant would render that label deceptive. I can imagine many red marks, or even red medals, being so used as to prevent deception." But it is for the applicant for registration of the mark which is alleged to be deceptive to make it clear that it is not.

The Red Medal Polish Case.

(*u*) *Wotherspoon* v. *Currie*, 5 L. R. H. L. 508 (1872), (*Glenfield Starch*); *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361, (*Stone Ales.*) It is to be noted, however, that these were both cases of attempted frauds. *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219 (1882) H. L., (*Two Elephant Yarns*).

(*x*) 8 R. P. C. 370 (1891), Romer, J., (*Red Stamp Polish*).

Evidence (*y*).

Evidence material to the question of resemblance.

It follows that upon any question with respect to the registration of a mark which arises under sub-sect. 72 (2) it is material for the comptroller or the Court to be furnished with evidence of the matters of fact involved in the propositions stated above wherever it is alleged that they tend to increase or diminish the resemblance referred to in the sub-section.

Expert evidence as to probability of deception.

Besides this evidence, the evidence of persons who are well acquainted with the trade concerned is constantly tendered by the parties to show that in the opinion of such persons, as experts, the alleged resemblance between the contrasted marks is, or is not, calculated to deceive. Judges have often expressed much impatience of evidence of this class (*z*), and certainly it frequently presents in an eminent degree the characteristic vices of expert testimony. It consists in general of opinions formed after the dispute has arisen; not upon any judicial balance of the opposing contentions, but upon a scrutiny of the subject directed to discover what can be said in favour of one side only. And where the question is as to the degree of a resemblance between two words or designs, or as to whether a difference in particular parts of two contrasted labels is substantial or immaterial, reasons can rarely be found by the witnesses to recommend an opinion to anyone who has not conceived it for himself without their assistance.

The judge must in the end act upon his own view upon a comparison of the marks, having regard to the matters of fact referred to above (*a*); but it is settled that the expert evidence is admissible, and in particular cases it

(*y*) As to the evidence upon applications to register generally, see Chap. IV., pp. 73, 74 and 83. Where the appeal to the Court is by summons the evidence should be completed before the adjournment into Court, *per* Stirling, J., in *Jackson & Co.* v. *Napper*, 35 C. D. p. 166; 4 R. P. C. 45.

(*z*) *Re Jelley*, 51 L. J. Ch. 639, n., Jessel, M.R. (1878); *Pinto* v. *Badman*, 8 R. P. C. 181 (1891) C. A.

(*a*) The question is to be decided partly by the judge's eyesight, and partly by his view of the evidence. *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

may be of importance, for evidence of what are the surroundings of the marks and the circumstances of the trade concerned may not suffice to enable the Court to judge sufficiently of the influence which a practical acquaintance with such matters would have upon the impression made by the marks on the minds of persons engaged in the trade. Thus, in *Mitchell* v. *Henry*, the case of the coloured thread marks woven into the selvages of cloth, Cotton, L.J., considered the probability of deception essentially a question for experts (*b*).

Direct evidence of probability of deception.

Evidence of ordinary members of the public who are not acquainted with the usages of the trade involved, or even of experts, that they think they would, or would not be deceived by the resemblance of one mark to another, is of little assistance in the determination of questions of alleged deceptive similarity (*c*).

Evidence of actual deception.

If one or more cases of actual deception are made out to the satisfaction of the Court, this will, of course, afford very strong evidence that the resemblance of the marks in question is so close as to be calculated to deceive. But the absence of evidence of actual deception is a circumstance which varies greatly in weight according to the nature of the case. It is conceived that it can never be conclusive by itself (*d*); but where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material (*e*), unless the absence of evidence is ex-

(*b*) 15 C. D. p. 195 (1880); and see *Christiansen's Tm.*, 3 R. P. C. 54 (1885), Chitty, J., and C. A.

(*c*) See *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J., (*Carlsbad salts*). In the *Apollinaris Case*, Fry, L.J., compared this evidence to the oaths of compurgators in a mediæval trial. (1891) 2 Ch. 186; 8 R. P. C. 137.

(*d*) *Edelsten* v. *Edelsten*, 1 D. G. J. & S. 185 (1863), Westbury, L.C.; *Compania Général de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), Kay, J.; *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Pinet & Co.* v. *Daniell & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, C. A.

(*e*) *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Rodgers* v. *Rodgers*, 31 L. T. 285 (1874), Mellish, L.J.; *Estcourt* v. *The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276 (1875), C. A.; *Lambert's Tm.*, 5 R. P. C. 556; 61 L. T. 138

plained by the difficulty of procuring witnesses from a distant foreign market (*f*), or otherwise, satisfactorily. On the other hand, if one or both of the marks is new or nearly new there can have been no opportunity, or little opportunity, for deception to occur.

Examples and illustrations.

The cases following, of marks held to have, or not to have, such resemblance to each other as to be calculated to deceive, illustrate the principles referred to above. Many of them have been cited already.

Contrasted Devices.

A pointer eating out of a pot, too near for registration to a similar dog standing by a pail with STANCH beneath it; *Jelley's Application*, 51 L. J. Ch. 639, n. A twisted curved horn, with a twig bearing two roses, too near a similar untwisted horn with a cord having two loops in the same place as the roses in the twig; *Roxing's Application*, 54 L. J. Ch. 975, n. A triangular frame with words upon it and a church inside, too near Bass's solid triangle; *Worthington's Tm.*, 14 C. D. 8; so also a red diamond within a blue diamond; *Turney and Sons' Tm.*, 10 Times L. R. 175. A half-length figure of a milkmaid, with the word *Dairy-maid*, too near a full length figure of a milkmaid carrying two pails; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28. A woman's head wearing a helmet with ATHENA beneath, not too near a man's head with WAY beneath; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102. A tower in an oval border, with a dog and harp, too near a tower, dog, and harp without any border; *Speer's Tm.*, 4 R. P. C. 521. An oval label containing interlaced triangular frames with a stag's head within them, too near an oval label with three superimposed solid triangles, although the lettering on the marks was conspicuously different; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247. A sheep suspended by its middle, with the words GOLDEN FLEECE, too near a somewhat different

(1888), North, J.; and *Baker* v. *Rowson*, 45 C. D. 519; 8 R. P. C. at p. 107 (1889), North, J.; *Talbot's Tm.*, *infra*, p. 229.

(*f*) *Wilkinson* v. *Griffith*, 9 R. P. C. 370 (1891), ROMER, J.

sheep with the same words; *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311. A pig in outline, and H. B. & Co., not too near shaded pointer dog, and STANCH; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669. A tobacco pipe and dart, not too near a tobacco pipe alone; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138. A charging buffalo, too near a bull's head, both being placed in silver rings on similar yellow wrappers; *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233. A mark having as its sole essential particular a lion bearing a sheaf, too near a mark having as an essential particular a lion with a crown; *Murphy's Tm.*, 7 R. P. C. 163. An elephant in a border with lettering round it, an infringement of a somewhat different elephant alone; *Upper Assam Tea Co.* v. *Herbert & Co.*, 7 R. P. C. 183. A label bearing a winged cross surrounded by two circles in its upper third, not an infringement of a similar label, being a lighthouse similarly surrounded and placed; *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89. A label with two red medals and a balloon, an infringement of a similar label with two red medals only, both labels being used for polish known in India, from the latter label, as red metal polish; *Wilkinson* v. *Griffith*, 8 R. P. C. 370.

Contrasted Words.

WHITE ROSE, too near ROSALINE; *White Rose Tm.*, 30 C. D. 505. CONDI-SANITAS and SANITANT infringements of SANITAS; *Sanitas Co.* v. *Condy*, 4 R. P. C. 195 and 530; 56 L. T. 621. BOYD'S UNRIVALLED HARNESS COMPOSITION, in a label with the Arms of the City of Dublin, not an infringement of PROPERT'S IMPROVED HARNESS COMPOSITION in a label, with a fox's head, the labels being similarly got up; *Beddow* v. *Boyd*, 4 R. P. C. 310. APOLLINIS an infringement of APOLLINARIS; *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478. STEINBERG, an infringement of STEINWAY, the words being used with devices showing a general similarity; *Steinway* v. *Henkaic*, 5 R. P. C. 77. EMOLLIO too near EMOLLINE; *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612. SWIFT'S SPECIFIC

occurring in a trade-mark not calculated to deceive, merely because the words were descriptive of the opponent's drug; *Swift Specific Co.'s Tm.*, 6 R. P. C. 352. OOMOO, not too near EMU; *Burgoyne's Tm.*, 6 R. P. C. 229; 61 L. T. 39. KOKOKO, too near the common word COCO; *Jackson Co.'s Tm.*, 6 R. P. C. 80. DEMOTIC, an infringement of DEMON; *Slazenger* v. *Feltham*, 6 R. P. C. 531. DUNN'S FRUIT SALT BAKING POWDER, too near ENO'S FRUIT SALT; *Eno* v. *Dunn*, 41 C. D. 439; 15 App. Cas. 252; 7 R. P. C. 311; subsequently held to be an infringement, 10 R. P. C. 261. EL DEVINO, an infringement of EL DESTINO; *Pinto* v. *Trott*, 8 R. P. C. 173. Label with EL DESTINACION, an infringement of a similar label with EL DESTINO; *Pinto* v. *Badman*, 8 R. P. C. 181. Label with LONDON PICKLES, an infringement of similar label with LONDON PICKLE CO.; *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301.

III. Deceptive Marks.

It is provided by sect. 73 that—

Sect. 73. Deceptive marks.

> "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 (*g*), be deemed disentitled to protection in a court of justice, or any scandalous design."

This is taken from sect. 6 of the Act of 1875, except that in the last line "justice" is substituted for "equity," and the word "exclusive" which qualified "use," both in the old Act and in the Act of 1883, was removed, upon the suggestion of Lord Herschell's Committee, by the Act of 1888. The Committee say: "Words might be offered for registration in conjunction with a trade-mark for which the applicant did not claim, and of which he would not be entitled to the exclusive use, but the use of which might

"Exclusive use."

(*g*) See p. 217, below.

"nevertheless be calculated to deceive, and so be disentitled to the protection of a court of justice."

The restriction of the section would not seem to be carried any further by sect. 86, which authorizes the comptroller to refuse to register a trade-mark of which the use would, in his opinion, be contrary to law or morality.

The section extends beyond the old rule of estoppel by misrepresentation.

The provisions of the section were, no doubt, intended to embody the old rule of the Court of Chancery, which refused protection to the owner of a deceptive trade-mark (*h*); and it was held, by Jessel, M.R., that their operation was confined to cases where the marks were in themselves inherently deceptive (*i*); but the Courts have held that the restriction is of wider scope than the old rule, or than this construction would suggest (*k*). The leading case in point is *Eno* v. *Dunn* (*l*), in which the House of Lords (Lord Halsbury and Lord Morris dissenting) overruled the judgment of the Court of Appeal (Lindley and Fry, L.JJ., Cotton, L.J., dissenting), and restored that of Kay, J. The question in that case was whether the words *fruit salt* occurring in a mark consisting of the words *Dunn's Fruit Salt Trade-Mark Baking Powder*, and in a mark consisting of a distinctive label, quite different in character from the device used by the opponent, Eno, and bearing the words *Dunn's Fruit Salt Baking Powder*, were calculated to deceive, having regard to the well-known use of the words as the name of Eno's Fruit Salt. Eno, in the first instance, based his opposition to Dunn's application to register his marks partially upon his title as the owner of the mark "Fruit Salt," registered as

The Fruit Salt Case.

(*h*) See Chap. XV., p. 336; and Lord Macnaghten's judgment in *Eno* v. *Dunn*, *infra*.

(*i*) *Horsburgh's Application*, 53 L. J. Ch. 237 n. (1878), (*Valvoleum*).

(*k*) See the judgment of Cotton, L.J., in which the majority of the law lords concurred, in *Eno* v. *Dunn*, 41 C. D. p. 448.

(*l*) 15 App. Cas. 252; 7 R. P. C. 311; *Dunn's Tm.* (1889), subsequently an injunction was granted to restrain Dunn & Co. using the words *Fruit Salt*; *Eno* v. *Dunn*, 10 R. P. C. 261 (1893), Kekewich, J.

"a proprietary medicine for human use," and also as a "dry preparation for making a non-intoxicating beverage"; but finding that he could not prove user of that mark before 1875, and the words were consequently not capable of registration, he was driven to consent to its removal from the register, and to rely wholly upon the alleged deceptiveness of the marks propounded by Dunn. The marks were normally used for different goods. Dunn's preparation was a baking powder, and Eno's an aperient effervescing powder; but evidence was given that, in a very few instances, Eno's salt had been used as a baking powder, although it was shown to be very unsuitable for the purpose. The majority of the law lords held that Dunn's marks were deceptive, and the application to register was dismissed. Lord Herschell and Lord Macnaghten based their judgments upon the discretion conferred on the comptroller—apart from the sections considered in this chapter—to refuse marks from which it is not clear that deception might not result. Lord Herschell said: "I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived. The case was argued on behalf of the respondent, as if he had an absolute right to have any trade-mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. I do not so read the statute. Those sections prohibit the registration of a trade-mark in certain specified cases; but there is no duty cast upon the comptroller of registering every other trade-mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases fairly conferred." And Lord Macnaghten said of the marks: "They are calculated, and I think designed, to create a confusion in the minds of those persons to whom Mr. Dunn's advertisements are addressed, and to lead the ordinary run of such persons to suppose that his baking powder is in some way or other

Doubtful new marks to be rejected.

Lord Herschell's judgment.

Lord Macnaghten's judgment.

"connected with Mr. Eno's preparation"; and he held, therefore, that the marks ought to be rejected, for the "comptroller ought to reject words which involve a misleading allusion or a suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood."

Lord Watson's judgment.

Lord Watson, on the other hand, treated the case as one falling within the 73rd section. "These prohibitory clauses," he said, referring to sects. 73 and 72 (2), "cast upon the applicant the duty of satisfying the comptroller, or the Court, that the trade-mark which he proposes to register does not come within their scope. In an inquiry like the present, (the applicant) does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There, the onus of showing that his trade-mark was calculated to mislead rests, not on him, but upon the party alleging infringement; here, he is *in petitorio*, and must justify the registration of his trade-mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed." And upon the question of fact, he said: "There would be a supposed connection in the minds of many persons, who would naturally assume that the baking powder had been manufactured with the appellant's fruit salt, and purchase it in that belief; so that a batch of badly made baking powder might seriously injure the credit of the effervescing powder" (*l*).

Mark containing name of the opponent's goods not necessarily deceptive.

But a mark is not calculated to deceive merely because it contains an ordinary description of an article of commerce which is occasionally used to describe a rival trader's goods (*m*). To hold otherwise would certainly be, as Fry, L.J., said, in *The Fruit Salt Case*, to allow the objector "to enclose and appropriate as private property

(*l*) See above, p. 64, "the Comptroller's discretion."

(*m*) See *Dexter's Application*, (1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J., (*Star Tobacco*), above, p. 203.

"certain little strips of the great open common of the English language" (*n*). Thus, where *The Smokeless Powder Co., Ld.*, had registered a label bearing a target, with their name printed prominently upon it, supported on one side by the figure of a sportsman, and on the other by that of a rifleman, an unsuccessful attempt was made by a rival powder making company to have the mark removed from the register, or to have a disclaimer of the words *Smokeless Powder* added to the registration. The application failed as to the disclaimer, because the words were not distinctive, and also because they were not additions within the meaning of sect. 74, and were part of the name of the proprietors of the mark. It was argued that the presence of the words in the label was in effect a claim of a monopoly of the words, although the manager of the respondent company stated that the company made no such claim; but Chitty, J., decided against the objection (*o*), and held that the use of the words in the mark was not calculated to deceive. No such identification of the words in question with the applicant's goods was proved in this case, as was shown in *The Fruit Salt Case* of the words *Fruit Salt* with Eno's powder, and in *The Stone Ales Case* (*p*) of the words *Stone Ales* with Joule and Sons' beer; but, apart from this, the case seems readily distinguishable, on the ground already mentioned, that the words here concerned were the ordinary words which any one would choose to describe the goods both of the applicants and of the respondents, and words which, apart from the Acts, could never have become, for such goods, the subject of exclusive rights (*q*).

The Smokeless Powder Co. Case.

And as the presence of a common word in a label does not make the label deceptive, although the word is used of the opponent's goods (*r*), so neither does the presence of a device which suggests such a word. Thus, in *Kutnow's*

Device suggesting the name of the opponent's goods.

(*n*) 41 C. D. at p. 455.

(*o*) See Chap. VIII., p. 138, "Label."

(*p*) (1891) App. Cas. 218; 8 R. P. C. 361.

(*q*) Chap. II., pp. 35 *et seq.*

(*r*) See above, p. 201.

Case (*s*), a label, in which a picture of the Deer-leap rock at Carlsbad, a well-known and remarkable object in the environs of the town, was allowed to be registered for use with Carlsbad Salts, the name of the salts being common property, and applicable both to the natural product of the springs at Carlsbad and to artificial imitations of it. The opponents in the case were the Municipality of Carlsbad,—who own both the springs and the rock in question,—and their lessees of the springs. They sought to show that the use of the picture by the applicant would be calculated to lead purchasers to believe that the goods upon which it appeared were their goods; but the judge held that it would only suggest that the goods were Carlsbad Salts. And this would be true if, as he was bound to anticipate, the applicant used his mark honestly. The opponents had no monopoly in Carlsbad Salts.

Trade-mark attached to part of the mark only may be deceptive.

In *The Apollinaris Case*, Fry, L.J., in delivering the judgment of the Court of Appeal, expressed an opinion that a label which bears the word trade-mark so printed upon it as apparently to refer only to a device which forms part of the label, the whole label being, in fact, the trade-mark, is calculated to deceive (*t*), notwithstanding that the objection might have been, but was not, taken in the earlier case of *Hudson's Trade-Marks* (*u*), where the Court of Appeal decided in favour of the mark propounded; and in *Re Wills' Trade-Marks*, Wright, J., subsequently ordered a mark to be removed from the register on this ground (*x*). This objection has caused considerable uneasiness to proprietors of trade-marks, and has led to several applications to the Court, under sect. 92, for leave to amend registered marks, for the word trade-mark is often printed upon labels and other trade-marks; but it is to be observed that it is only objectionable where its presence apparently implies that part of the actual mark is the whole trade-

(*s*) 10 R. P. C. 401 (1893), North, J.

(*t*) (1891) 2 Ch. at p. 233; 4 R. P. C. 478.

(*u*) 32 C. D. 311 (1886).

(*x*) (1893) 2 Ch. 262; 10 R. P. C. 269.

mark. In the mark to which Fry, L.J., was directly referring, the word was placed immediately under a red disc, which was the most prominent feature in the label. "It is a question of fact in every case where a man puts the term 'trade-mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade-mark only" (*y*). In *Colman's Trade-Marks* (*z*), Kekewich, J., allowed "trade-mark" to be struck out of a number of labels, on condition that the proprietors should state what were and what were not the essential particulars of the marks (*a*). But in a later case (*b*), Chitty, J., refused to allow a similar alteration to be made in an old mark on the ground that, in accordance with the decisions of the Court, an old mark ought to be registered and kept registered, in all essential particulars, as it was used before the 13th of August, 1875. In the earlier case, two of the marks allowed to be altered had, in fact, been old marks, but in that case the comptroller had raised no objection on this ground, as he did in the later case (*b*).

Alterations of marks to remove *trade-mark*.

Fry, L.J., also suggested, in *The Apollinaris Case* (*c*), that the indorsement, "imitations of this water will be prosecuted," upon a label registered for use in connection with a natural mineral water, *Hunyadi Janos*, caused the mark to be calculated to deceive, because it probably meant all imitations of the water, whether fraudulent or not, and was therefore addressed to artificial *Hunyadi Janos* waters which might have been legitimately made and legitimately sold under the name, provided that it was made clear that they were artificial waters (*c*). It may be noted that the comptroller refuses to register the words "registered,"

Threats of prosecution in the mark may be deceptive.

The comptroller refuses

(*y*) *Per* Chitty, J., in *Hammond & Co.* v. *Malcolm, Brunker & Co.*, 9 R. P. C. p. 307.

(*z*) (1891) 2 Ch. 402; 8 R. P. C. 209.

(*a*) Cf. sect. 64 (2), and see Chap. IX., p. 166.

(*b*) *Phillips' Tm.* (1891) 3 Ch. 139; 8 R. P. C. 469; and see *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

(*c*) *Supra*; (1891) 2 Ch. p. 226.

registered, copyright, &c.

"registered design," "copyright," "entered at Stationers' Hall," or "to counterfeit this is a forgery" (*d*). And in the case of the word "registered" this refusal has been supported by the Court (*e*).

Mark referring to particular goods.

And when there appears on the face of a trade-mark an indication of the goods to which the mark is to be applied, the claim for its registration must be in respect of those goods only (*f*).

Deceptive representation as to origin of goods.

The questions—Who can register a trade-mark? (*g*), and, What is the implication of a trade-mark with regard to the origin of the goods? (*h*), are dealt with elsewhere. It has been held, that a mark comprising the consignees' names, and a representation of their house, which is used by the consignor, is calculated to deceive (*i*).

The recent case of *Hill's Trade-Mark* (*k*) furnishes a good illustration of a deceptive mark. The mark consisted of a fir tree, with the words *Forrest* above and *London* below it in large letters, and it was registered and used by a Coventry watch-maker, who had no connection with the business formerly carried on by Forrest in London. He alleged, in answer to an application to remove the mark, that the words in question were commonly used by the trade in Coventry, although, in a correspondence with the applicant, he had previously claimed an exclusive right to them. The judge held that the mark was calculated and intended to deceive (*l*).

A mark which has been used fraudulently, or for the purposes of a fraudulent trade, if offered for registration, is open to the objection that its further use will tend to

(*d*) Instructions, 29, p. 631.

(*e*) *Meikle's Tms.*, 46 L. J. Ch. 17 (1876), Hall, V.-C.

(*f*) Instructions, 31; see *ante*, p. 89.

(*g*) Chap. IV., p. 58.

(*h*) Chap. II., pp. 49 *et seq.*; see also Chap. XV., p. 301, "joint trade-marks."

(*i*) *Jones' Tm.*, 53 L. T. 1 (1885), C. A.

(*k*) 10 R. P. C. 113 (1893), Chitty, J.

(*l*) Its use was unquestionably an offence under the M. M. A., 1887; see Book II., Chap. I., p. 491.

continue the old deceptions, and it is therefore a deceptive mark, and registration of it should be refused (*m*).

"Or otherwise."

The words "or otherwise" in the section, having regard to sect. 86, referred to above, and other parts of the Acts, seem to be merely redundant. They have, however, been held to be sufficient to exclude the registration, as part of a trade-mark, of words which are merely descriptive of the article upon which the mark is to be used, whether they are merely descriptive from their nature, or whether they have become descriptive by the course of the trade and in the market (*n*). But the decision in the case referred to rested upon the opinion of the learned judge that, if he allowed the words in question to be registered as part of the applicant's mark, he would be giving him a monopoly in the words, to which he was not entitled.

(*m*) *Fuente's Tm.* (1891) 2 Ch. 166; 8 R. P. C. 214, Romer, J.; see further, as to trade-marks vitiated by misrepresentation, Chap. XV., pp. 336 *et seq.*

(*n*) *Anderson's Tm.*, 26 C. D. at p. 415 (1884), Chitty, J., (*Brand Baron Liebig*).

CHAPTER XI.

RECTIFICATION OF THE REGISTER.

	PAGE
1. Rectification under sect. 90	220
Section 90	220
"PERSONS AGGRIEVED"	221
all persons substantially inconvenienced if the registration is wrong	221
the question is one of *locus standi* only	221
The Apollinaris Case	221
any person harassed or intimidated by the registration	222
Powell's Case	222
defendant in a passing off action	223
where the respondent offers to disclaim	223
exporter aggrieved by the registration of a mark for the home trade	223
foreigner	223
wider view now taken than in the earlier cases	224
THE EXERCISE OF THE JURISDICTION	225
where the mark was incapable of registration it must be removed..	225
and the conduct of the applicant is immaterial	225
where it was capable of registration, but might have been opposed, the Court has a discretion..	226
Paine v. Daniells	226
independent title by registration and user	228
mark allowed to remain in pursuance of a compromise ..	228
the comptroller's decision is no bar to rectification	229
nor is five years' registration	229
nor, generally, delay on the part of the applicant	229
but delay may have a bearing on the evidence	229
entry to be vacated or rectified if originally wrongly made ..	230
but not on account of subsequent events	231
THE ORDERS MADE	231
(1) new entries	231
new marks cannot be registered under sect. 90	231
(2) total removal	232
reasons for removal	232
alteration of circumstances, abandonment, misuser	233
(3) partial removal	233
deceptive marks wholly removed	234
(4) registration of a disclaimer	234
(5) limitation of the registration	235
to particular goods or particular markets	235
(6) variation of the mark	235
(7) ,, of the date of entry	235
(8) ,, of the name of the proprietor	236
registration in the wrong name	236

1. Rectification under sect. 90—*continued.* PAGE
PROCEDURE 237
the Court 237
summons or motion, not counterclaim 238
notice to the comptroller 239
service on the registered proprietor 239
where the proprietor is resident abroad 240
notice of motion not served out of the jurisdiction 240
notice by letter 240
foreigner appearing, liable for costs 240
but not ordered to give security 241
EVIDENCE 241
declarations of proprietor 242
discovery and particulars 242
Order to be served on the comptroller 243
Damages 243
Costs 244
Appeal 245

2. Correction and cancellation at the proprietor's request .. 246
Section 91 246
Alteration of address 246

3. Alterations in non-essential particulars 247
Section 92 247
essential particulars 248
old marks not to be altered 248
alterations of new marks 249
procedure 250
costs 251

PROVISION is made for the rectification of the register by three sections of the Act. Sect. 90 provides for cases where any person is aggrieved by the omission from, or by the entry upon, the register of any particulars without sufficient cause, and enables the Court to direct the necessary rectification to be made; sect. 91 authorizes the comptroller to correct clerical errors in the registration, and, at the request of the proprietor, to cancel the entry, or part of the entry, of a trade-mark on the register; and sect. 92 enables the Court, upon application, to permit an addition to, or alteration of, a registered mark to be made in any non-essential particular. The Act also directs that after fourteen years from its registration a mark shall be removed from the register unless the prescribed fee be paid. This provision is considered in another chapter (*a*).

(*a*) Sect. 79; see Chap. XIII., p. 291.

1. Rectification under Sect. 90.

Sect. 90 (*b*) is in the following terms:—

Section 90.

"(1) The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person [or of any other particulars] (*c*) from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

"(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

"(3) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller."

Decisions on the Act of 1875.

This section corresponds to parts of sect. 5 of the Act of 1875 (*d*), and is to the same effect, but is expressed in more general terms. No distinction between the construction of the two enactments appears to have been taken (*e*), but, on the contrary, decisions under the former are constantly cited and applied in cases falling under the present section (*f*).

"Any other particulars."

The amendment "or of any other particulars" was made upon the recommendation of Lord Herschell's Committee (*g*), so as to make the jurisdiction of the Court

(*b*) Cf. Companies Act, 1862, sect. 35.

(*c*) Act of 1888, sect. 23.

(*d*) Appendix, p. 588.

(*e*) Except that appeals from the comptroller on applications to register are now governed by a separate section, sect. 62; see *Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. C. 123 (1886), Chitty, J., and C. A.

(*f*) See *Baker* v. *Rawson*, 45 C. D. at p. 531; 8 R. P. C. 89, (1890), North, J.

(*g*) Report of 1888, p. xiv.

to rectify applicable to every particular which ought to be entered upon the register.

Who are persons aggrieved.

All persons substantially inconvenienced if the registration is wrong.

The application to rectify the register must be made by a person who is aggrieved by the entry or omission complained of if it is made without sufficient cause. In recent judgments, the phrase in the section has been very liberally construed, and it would be difficult to find any person engaged in the trade concerned, or any allied or connected trade, who was prevented by the qualification which it requires from moving to rectify the register. The persons who are aggrieved are, it is held, all persons who are in some way or other substantially interested in having the mark removed—where it is a question of removal—from the register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that (*h*).

The Apollinaris Case.

The leading case on the subject is that of *The Apollinaris Co.'s Trade-Marks*. In that case, Fry, L.J., in delivering the judgment of the Court of Appeal, said: "We approach this question (Are the applicants persons aggrieved?) on the assumption, which is necessary, of course, to answer this question, that the trade-mark was wrongly on the register; and, further, with these two observations: in the first place, that the question is merely one of *locus standi*; and in the second, that the words 'person aggrieved' appear to us to have been introduced into the statute to prevent the action of common informers, or of persons interfering from merely sentimental motives (*i*); but that they must not be so read as to make evidence of great and serious damage a condition precedent to a right to apply. Further, we are of opinion that, wherever one trader, by means of his wrongly

The question is one of *locus standi* only.

(*h*) *Per* Bowen, L.J., in *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 195.

(*i*) See Lord Selborne's judgment, in *Rivière's Tm.*, 29 C. D. at p. 54 (1884), and the judgments of Lindley and Fry, L.JJ., on the subsequent hearing of the same case, 5[illegible] J. Ch. 545.

"registered trade-mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is an 'aggrieved person'" (*k*). And in the same case the Court of Appeal held, that the fact that the applicants for registration of certain new marks had attempted to support their application by reference to other marks already registered by them, and notwithstanding that they subsequently abandoned the attempt, made the opponents to the registration of the former marks persons aggrieved by the registration of the marks already registered, and therefore persons entitled to apply for the removal of them from the register (*l*); and, further, that an alleged infringer of a mark is always a person aggrieved by its registration (*m*). "The practical conclusion of this view," Fry, L.J., said, "is, we think, a sound one. It will stop the practice, of which we have seen instances in this case, of a trader registering his mark without justification, using it as a means to intimidate or coerce other traders, and then, at the bar, alleging that the threat was idle, and the persons against whom it was used are not aggrieved thereby" (*n*).

Any person intimidated or harassed by the registration.

Powell's Case.

The words in question have received their most liberal interpretation in the recent case of *Powell's Trade-Mark* (*o*). In that case the applicants were being sued to restrain them from passing off a sauce called *London Relish* as the goods of the registered proprietor of a mark consisting of the words *Yorkshire Relish* by means of a label said to resemble one of his trade labels. They moved to expunge the mark *Yorkshire Relish*, and they were held to be "persons aggrieved" notwithstanding that they did not trade in Yorkshire Relish Sauce, and had not even considered the question of trading in it, and that the Court thought it

(*k*) (1891) 2 Ch. p. 224; 8 R. P. C. 137.

(*l*) *Ibid.*, p. 228.

(*m*) See also *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

(*n*) (1891) 2 Ch. p. 229.

(*o*) (1893) 2 Ch. 388; (1894) A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4, Chitty, J., C. A., and H. L.

probable that they could not trade in it under the same name, without wrongfully causing their goods to be taken for those of the respondent, the registered proprietor of the mark.

Defendant in a passing off action.

It has been held that a defendant charged in an action with passing off his goods as those of the plaintiff (*p*), is aggrieved by the registration of a trade-mark referred to in the plaintiff's pleadings, although no case of infringement is set up (*q*); and so also a trader who wishes to use the registered mark, not as a trade-mark, but as a description of his goods (*r*). And the applicant does not cease to be a person aggrieved because the registered proprietor offers to register a disclaimer, or to confine the use of the mark to particular goods in such manner that if the disclaimer or limitation were actually registered the applicant's grievance would be removed (*s*); for, as was pointed out by Fry, L.J., in the passage quoted above, the grievance is only necessary to give a *locus standi*, and it exists if at the time when the application is launched the registration is such as to occasion it.

Offer of a disclaimer is no answer to an application to rectify.

Exporter aggrieved by mark for home trade.

The exporter of goods made abroad, which are brought to England and then shipped to the Colonies, is a person aggrieved by the registration of a mark having such a resemblance to the mark which he has registered, and which he uses in his trade, as is calculated to deceive, although the mark objected to is employed in a trade confined wholly or almost wholly to England, and not extending to the Colonies (*t*).

Foreigner.

And a foreigner may be a "person aggrieved" by the registration of a mark. This was decided by the Court of Appeal, overruling the judgment of Pearson, J., in *Rivière's*

(*p*) See Chap. XVI., p. 295.

(*q*) *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

(*r*) *Ralph's Tm.*, 25 C. D. 194 (1883), Pearson, J., (*Homewasher*); *Rose* v. *Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C., (*Limetta*).

(*s*) *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J.; *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

(*t*) *The Société Anonyme des Verreries de l'Etoile*, (1894) 1 Ch. 61; W. N. (1894) 42; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

Case (*u*), where the applicants, who carried on business in India, but did not trade or intend to trade in England, alleged that on their request to register the mark in question for them, the registered proprietors had wrongfully registered it in their own names, and the Court, in holding that the applicants were aggrieved, assumed, but did not decide (*x*), that, as foreign traders, the applicants could not themselves have registered the mark.

Wider view now taken than in the earlier cases.

On the further hearing of the case just cited (*y*), it was shown that the registered mark was an old mark belonging to the respondents, Rivière & Co., but that they had for many years allowed it to be used upon labels bearing the name of the applicants, McDowell & Co., for brandy manufactured by Rivière & Co., and shipped by them to McDowell & Co. for sale in India. The labels were used by McDowell & Co. upon brandy not made by or purchased from Rivière & Co., after the rupture of business relations between the parties, and Rivière & Co. had commenced proceedings in India for infringement in respect of this user. Under these circumstances, Pearson, J., and the Court of Appeal held that the applicants were not in fact aggrieved by the registration, but that it was rightly made, and they refused to annul it. Lindley, L.J., said: "Aggrieved in the sense of being annoyed (McDowell & Co.) certainly were, and, I think, not without cause; but aggrieved in the sense in which it is necessary they should be aggrieved—in the sense of sustaining legal damage either immediate or prospective—they have not shown that they were"; and Fry, L.J., said it was possible that they might be injured, but there was no reason to suppose that they would be, and therefore they were not within the section (*z*). In subsequent cases the section, and the phrase "person aggrieved," has been more stringently

(*u*) 26 C. D. 48 (1884), decided on the Act of 1875.

(*x*) It is clear that the present Act contemplates registrations by foreign traders; see sects. 103 and 104, and sect. 8 of the Act of 1888.

(*y*) 55 L. J. Ch. 545; 53 L. T. 237 (1885).

(*z*) *i. e.*, sect. 5 of the Act of 1875.

construed against the registered proprietor, and although there is no conflict between this decision (*a*) and the decisions cited above, it is plain that a different view was taken of the section in them to that acted upon in it.

The Exercise of the Jurisdiction under the Section.

Where the mark was incapable of registration it must be removed.

The question of the grievance of the applicant being merely one of *locus standi*, if on the face of the proceedings the applicant is enabled, as a person aggrieved, to bring his application before the Court, the Court has jurisdiction to rectify the register, which, in the case of a mark not belonging to the class of marks admitted to registration under the Acts (*b*), it ought to exercise, even under circumstances in which the applicant is estopped from exercising the right with which the registration interferes. Thus, in *The Stone Ales Case* (*c*), the Court of Appeal removed the plaintiffs' mark, *Stone Ale*, from the register on the application of the defendant, although they maintained the injunction granted by Chitty, J., restraining the defendant from selling goods not of the plaintiffs' manufacture under the name in question.

The conduct of the applicant is irrelevant.

And the demerits of applicant in any such case are irrelevant to the question whether rectification should be ordered or not, for the question is not between the applicant on the one hand and the respondent on the other, but between the public and the respondent. Where, therefore, a mark on the register bearing the words *Forrest London* was shown to be deceptive, because it was used by a Coventry watch-maker who had no connection with the business of Forrest once carried on in London, Mr. Justice Chitty refused to enter upon an inquiry

(*a*) Because the Court held that the mark was properly registered.

(*b*) See Chap. VIII., p. 106.

(*c*) *Thompson* v. *Montgomery*, 45 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal to the H. L. against this order. The words had not been used as a trade-mark before 13th August, 1875, and were not fancy words. See *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 195; (1894) A. C. 8; 11 R. P. C. 4; Chitty, J., C. A. and H. L. (*Yorkshire Relish*), above, p. 222.

whether the conduct and the trade of the applicant were tainted with fraud, as the respondent alleged. "I state my opinion," he said, "that directly it is apparent that any part of the trade-mark is calculated to deceive, it is the duty of the Court to order it to be removed" (*d*).

So an agreement by which the respondents, the registered proprietors of a mark, appointed the applicants sole agents for the goods they sold under the mark, and the applicants agreed to sell no goods but those of the respondents under the mark, was held to furnish no answer to an application to remove the mark from the register, and Chitty, J., said: "This is not a question of equity; this is a question of right under the statute; and the defence, which I find really a difficulty in appreciating, appears to me to fail altogether. I am at a loss to discover how any such agreement as this can displace the applicants' right to have the register of trade-marks disencumbered of that which is not a trade-mark at all" (*e*).

Where the mark was capable of registration but might have been opposed. *Paine* v. *Daniells.*

But in cases where the mark attacked belongs to the class of symbols which are capable of registration, the Court has a discretion, under the Acts, whether to expunge or vary the registration or to refuse the application. This was decided by the Court of Appeal in the recent case of *Paine & Co.* v. *Daniells & Sons' Breweries* (*f*), where the matter was fully considered. In that case the defendants, in an action for infringement and passing off, applied to remove the words *John Bull* and *John Bull Brand* from the plaintiffs' registered labels. It appeared that at the time of the registration of the labels certain third persons, unknown to the plaintiffs, were using *John Bull* as a trade description of their goods in a district, in and around Sheffield, to which the plaintiffs' trade did not extend, but such user had wholly ceased before the date

(*d*) *Hill's Tm.*, 10 R. P. C. 113 (1893); see also *Eno* v. *Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890).

(*e*) *Ainslie & Co.'s Tm.*, 4 R. P. C. 212 (1887).

(*f*) (1893) 2 Ch. 567; 10 R. P. C. 71, 217.

of the application to rectify. And it was assumed by the Court that these persons might have successfully opposed the registrations had they known of them, and thought fit to do so. In the view the Court of Appeal took, the defendants had been guilty for years of deliberate infringement of the plaintiffs' trade-mark. The Court refused to direct the marks to be removed, and the following passage from the judgment of Bowen, L.J., fully explains the grounds of their decision :—

The Court has a discretion.

"The purity of the register of trade-marks—if one may use the expression—is of much importance to trade in general, quite apart from the merits or demerits of particular litigants. If on a motion like the present the attention of the Court is called to the entry on the register of a trade-mark which cannot in law be justified as a trade-mark, it seems to me that the Court's duty may well be, whatever are the demerits of the applicant, to purify the register and to expunge the illegal entry in the interests of trade, as was done in *The Stone Ales Case* (*g*). As a rule, the Court, on being seised of the matter, would doubtless put an end to the existence of a trade which could not possibly be justified by law. But the matter is wholly different when the trade-mark complained of is one which is not in itself illegal or improper, although at the date of registration its registration might have been, perhaps, successfully opposed by some third party who did not in fact oppose it. In such a case, the defect in the register is not a defect of which the law is bound to take cognizance at the instance of every complainant. Consent by the *Sheffield* company would, in the present case, have removed all difficulty in the registration of the plaintiff's trade-mark. The defendants have no right, as it appears to me, to take the point that such consent was not in fact shown to have been given by the *Sheffield* firm, in order to displace a trade-mark which they have been meanwhile dishonestly infringing. I am of opinion that the Court is

(*g*) *Supra*, p. 225.

"not bound under sect. 90 of the Act of 1883, on the application of an unmeritorious applicant, to displace an entry on the register, which, on the face of it, is not illegal, because the original registration might have been opposed on the ground of prior user by a third person who never opposed it on any such ground, and who, at the time of the motion to rectify, has discontinued his user."

The construction of sect. 90, here adopted, is certainly in accordance with the apparent meaning of the section, for its terms empower the Court to make "such order . . . as the Court thinks fit," or to refuse the application.

Independent title acquired by registration and user.

So, in a case where the registered proprietor of a mark had adopted and registered it in ignorance of the rights of the applicant, who previously possessed, but had temporarily ceased to use, a similar mark, and the proprietor had largely used his mark for two years, an application to remove it from the register was refused. The applicant, however, was allowed to register his mark also (*h*).

There are, however, some reported cases which can hardly be reconciled with the view taken by the Court of Appeal in *The Stone Ales Case* by the distinction suggested in the judgments in *Paine* v. *Daniells* between marks which are good marks under the Acts upon the face of them, although the registration of them might, for some extrinsic reason, have been opposed, and marks which are bad in themselves.

Mark allowed to remain in pursuance of a compromise.

Thus, in a case where Chitty, J., had ordered a mark to be removed from the register, on the ground that it did not comply with sect. 64 of the Act, the Court of Appeal expressed a strong opinion that the applicant (the defendant) had made a binding agreement with the registered proprietor (the plaintiff) not to use the mark, and, the applicant consenting, they set aside the order for removal (*i*). And, in an earlier case (*k*), Kekewich, J.,

(*h*) *Mouson & Co.* v. *Boehm*, 26 C. D. 398 (1884), Chitty, J.

(*i*) *Hodgson* v. *Sinclair*, 9 R. P. C. 22 (1892).

(*k*) *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), (*Albion*). The variation is not stated in the Law Reports.

allowed an order expunging a mark from the register to be varied (subject to any objection being made by the comptroller) by the consent of the applicant, although he held that, having been used to indicate a design, and not as a trade-mark, it ought not to have been registered.

The comptroller's decision is no bar to rectification;

The fact that the comptroller has exercised his discretion in favour of the registration of a mark, and has allowed it to be registered, does not prevent the Court from ordering its removal if the registration was made without sufficient cause (*l*).

nor is five years' registration;

And it is elsewhere shown that sect. 90 is not limited by sect. 76, so that a mark registered without sufficient cause can be removed, notwithstanding the fact that it has been five years upon the register (*m*).

, generally, is delay in making the application to rectify;

but delay may have a bearing on the evidence.

The delay of the applicant in coming to the Court to ask for rectification of the register is not of itself any bar to his application (*n*), and marks have been removed or varied after being registered for long periods to the knowledge of the applicant (*o*). But where the objection alleged to a mark is that it is the same as that of the applicant, or that it has such resemblance to his as to be calculated to deceive, it will be some evidence against the applicant, on whom the burden of showing that the registration was made without sufficient cause lies, if he has stood by and allowed the registered proprietor to use the mark objected to for a length of time. And if the objection depends upon proof of a state of facts at a given time, for instance, upon the question whether an old mark was used before the 13th of August, 1875, in the form registered, after a long lapse of time, and especially if important witnesses

(*l*) *Arbenz's Application*, 35 C. D. p. 260; 4 R. P. C. 143 (1887), C. A., (*Gem*).

(*m*) Chap. XII., p. 258.

(*n*) *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165 (1889), North, J. *Société, &c., de l'Etoile's Tm.*, *ante*, p. 223; *Talbot's Tm.*, (1894) W. N. 12; 11 R. P. C. 77, Stirling, J.

(*o*) For instance, in *The Apollinaris Case*, some of the marks removed had been registered for fourteen years; (1891) 2 Ch. p. 186; 8 R. P. C. 137, C. A. See also *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

have died, the Court will receive the evidence of the applicant upon the point with hesitation (*p*).

Entry to be vacated or rectified if originally wrongly made.

An entry which has been made without sufficient cause ought to be expunged, even though, so far as appears at the hearing of the application to rectify, an application to re-register could be successfully made at once, for there ought to be fresh advertisements and a fresh opportunity for objectors to oppose the registration (*q*). So where a misstatement as to the length of time during which the mark had been used was made, not fraudulently, but through carelessness, in the application for registration, North, J., directed the registration to be vacated (*r*). And in *The Apollinaris Case*, in dealing with the objection that the company, when only importers, had registered marks belonging to the producers of the goods as their own,

Judgment of Fry, L.J., in *The Apollinaris Case*.

Fry, L.J., said (*s*): "On behalf of the Apollinaris Co. an argument was addressed to us to this effect, that as they had, in the year 1881, become the sole owners of the produce of the spring, they could now get these marks on the register, and that we ought not to remove marks which, as soon as we have taken them off, can be put on again. But even assuming that the respondents are *prima facie* entitled now to be placed on the register, as to which we say nothing, we are of opinion that the course suggested is rendered impossible by the statutory provision for advertisements. To allow a mark which ought not to have been on the register to remain on by reason of some intervening event, would be to preclude the public from challenging the new title of the applicant for registration."

(*p*) *Benjamin Edgington; Ld.* v. *John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(*q*) In *Hayward's Tm.*, however, where the objection was that the application on which the mark was registered ought to have been treated as abandoned, Kay, J., allowed the mark to stand, with a note limiting the date from which the five years should run before the registered proprietor acquired an absolute title, to the date of actual registration; 54 L. J. Ch. 1003 (1885).

(*r*) *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 39 (1890).

(*s*) (1891) 2 Ch. p. 230; 8 R. P. C. 137.

But the rule here laid down does not compel the Court to order the removal of a mark if the registration of a note, partial removal, or other variation meets the justice of the case (*t*).

Entry, if originally rightly made, not to be varied.

Conversely, an alteration in the circumstances connected with the mark after its registration, cannot cause the entry on the register to have been "made without sufficient cause." So, where after an application for the registration of a mark belonging to a firm had been made, a change in the constitution of the firm took place, the Court refused to order the register to be rectified by the entry upon it of the name of the new proprietors in place of that of the old (*u*). The proper course to be adopted was the registration of a transmission of title (*u*).

What Orders may be made under the Section.

The section empowers the Court to make "such order for making, expunging, or varying the entry" of the omission or registration of which complaint is made as the Court thinks fit. The Court may therefore (1) direct an entry to be made on the register; (2) order an entry already appearing thereon to be wholly removed; or (3) to be partially removed; or (4) to be modified by a disclaimer; or (5) by limiting it to particular goods; or (6) to be varied as to its form; or (7) date; or (8) the name of its registered proprietor.

New entries.

(1.) The jurisdiction to order a new entry to be made seems to be specially referable to the preceding words of the section "aggrieved by the omission without sufficient cause of the name of any person or of any other particulars" from the register; but the Court is not empowered by the section to order to be entered upon the register a mark which the comptroller has refused,

New marks cannot be registered under the section.

(*t*) See note (*q*) and the instances cited below, pp. 234 *et seq.*

(*u*) *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 347 (1881), Hall, V.-C., and see below, p. 236.

although, under the corresponding section of the earlier Act, it might have done so, for a special mode of appeal from the comptroller's decision to the Board of Trade, and to the Court only by reference from them, is provided by sect. 62, and consequently, no other appeal is permitted (*x*). And it cannot direct a new mark to be registered with regard to which the proper procedure by application and advertisement has not been resorted to (*y*). The reference to entries to be made upon the register must therefore, notwithstanding the words quoted above, be taken to refer only to the variation by addition of marks already registered.

Total removal.

(2.) Orders for total removal of entries from the register have been made in a great number of cases, and many examples have been given already in this and the two preceding chapters. The entry is to be expunged if made without sufficient cause. What is a sufficient cause for refusing an application to register is considered in Chapter IV. (*z*), and generally the same reasons will afford grounds for removing an entry inadvertently made. But the Court has a discretion to refuse to vacate the registration of a mark, independently adopted and extensively used by the proprietor, if it falls within the class of symbols which may be registered as trade-marks, and the only objection is that it had been previously used or acquired as his trade-mark by another person (*a*). The proprietor of a registered mark stands, however, in a better position

Reasons for removal.

(*x*) *The Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. C. 123 (1886), Chitty, J., and C. A.

(*y*) *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1885), C. A.; and as to transfers from one name to another, see below, p. 236, and cf. p. 230. In *Jackson v. Napper* there was an application for registration, and the summons was not, as stated in 4 R. P. C. 45, an application to rectify under sect. 90, but to proceed under sect. 62. It seems to have been irregular in any case, as there was no appeal from the comptroller to the Board of Trade, so far as the report shows; 35 C. D. 162 (1886), Stirling, J.

(*z*) Page 63.

(*a*) *Mouson v. Boehm*, 26 C. D. 398; *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, above, p. 226.

than an applicant for registration, since the comptroller's discretion (*b*) has been exercised in his favour, and the onus of showing that the registration was made without sufficient cause is cast upon the person applying to vary it (*c*).

The reasons for removing a mark may be classified as follows: the registered proprietor is not the person entitled to use it (*d*); the mark was not capable of registration (*e*), or it fell within the restrictions forbidding registration contained in the Acts (*f*); the registration was procured by a material misstatement (*g*).

Alteration of circumstances subsequent to registration.

There does not appear to be any jurisdiction under the section to remove a mark because the registration, rightly made at its date, has by subsequent events become a cause of grievance to the applicant. If, for instance, the registered proprietor ceases to carry on business (*h*), agrees with another trader not to use his mark or to have it removed from the register, or uses it fraudulently or deceptively, it would seem that no redress can be had under the section. For the words "made without sufficient cause" are in the past tense, and they relate to the date of registration (*i*), and the term rectification is only applicable where there has been some mistake or error in the original registration (*i*). And this construction accords with the decisions that no events subsequent to the time of registration can be appealed to by the registered proprietor to defend his mark (*k*).

Abandonment or misuser of mark.

Partial removal.

(3.) If part only of a composite mark is objectionable, that part may be removed. This course was adopted in

(*b*) Chap. IV., p. 64; but see above, p. 229.

(*c*) See *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Benjamin Edgington, Ld.* v. *John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(*d*) Chap. IV., p. 60.

(*e*) Chap. VIII., p. 136.

(*f*) Chap. X., p. 175.

(*g*) *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

(*h*) As regards the removal of an abandoned mark, see below, p. 291.

(*i*) *Ward, Sturt, and Sharp's Tms.* 50 L. J. Ch. 347 (1881), Hall, V.-C.

(*k*) Above, p. 230.

Biegel's Trade-Mark (*l*), where the applicants, Younger & Co., complained that the use of three interlaced triangles in the respondent's label caused it to resemble too closely their own label, which contained three superimposed solid triangles similarly placed. The remainder of the label was distinctive, and the applicants did not complain of it. The order made was to strike out the triangular device. Where, however, the registered mark consisted of a fir tree, with the words Forrest above and London below printed in large letters, and the proprietor, being a Coventry watch-maker, having no connection with the business formerly carried on by Forrest in London, the mark was deceptive, Chitty, J., directed the whole mark to be struck out, but without prejudice to any application the respondent might make to register the fir tree alone (*m*).

Deceptive mark wholly removed.

In the case last cited it was argued on behalf of the comptroller that sect. 90 does not authorize the alteration of a registered mark, and that any application to vary must be made under sect. 92; but this contention is opposed to the express words of the first mentioned section, and it would leave unprovided for the large number of cases which do not fall within sect. 92, and among others all those arising on hostile applications.

Registration of a disclaimer.

(4) Registration with a disclaimer has already been discussed (*n*). *Edge's Trade-Mark* (*o*) is an example of the compulsory registration of a disclaimer. The respondent had registered the words *Edge's Filtered Blue*, and a label containing these words with certain devices. The judge held that the word *filtered* was either descriptive or deceptive, and therefore the respondent could have no exclusive right to use it. He accordingly directed the first mark to

(*l*) 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.; *Blair* v. *Stock*, 52 L. T. 123 (1884), Kay, J.; *Strathmore* struck out of mark.

(*m*) *Hill's Tm.*, 10 R. P. C. 113 (1893).

(*n*) Chap. IX., p. 164.

(*o*) 8 R. P. C. 207 (1891), Stirling, J. (see above, p. 138); *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J., (*Washerine*); *Haywards Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J., are other instances.

be removed from the register, and the exclusive right to the use of *filtered* in the other to be disclaimed.

(5) A limitation restricting the registration of a trade-mark to those goods for which the registered proprietor actually used the mark, and to which alone the goodwill of the business transferred to him with the mark by the former proprietor extended, was adjudged to be notified upon the register in *Edwards* v. *Dennis* (*p*). And in *The Milkmaid Brand Case* (*q*), where the defendant's mark too nearly resembled the previously registered mark of the plaintiffs, it was ordered that the registration of the former should be confined to goods for which the plaintiffs' mark was not registered.

Limitation of the registration—*to particular goods;*

So the Court may under the section order a note of an undertaking by the registered proprietor restricting the use of the mark, in accordance with an agreement between the proprietor and the applicant, to be entered on the register (*r*).

to particular market.

(6) The only variation in the form of a registered mark ordered under sect. 90, which occurs in any reported case is variation by striking out part of the mark (*s*). Any alteration which substantially changed the mark would be open to the objection that it would cause a new mark to be entered on the register, the application for which had not been advertised (*t*), and which had not been approved by the comptroller.

Variation in form of mark.

(7) A variation of the date of registration was directed in *Hayward's Case* (*u*). There a mark was registered in 1885 on an application made in 1879, and it was held that the registration not having been completed within one year ought to have been treated as abandoned, under sect. 63 of the Act of 1883. Kay, J., however, refused to expunge the registration, but ordered that the five years

Variation of date of entry.

(*p*) 30 C. D. 454 (1885), C. A.

(*q*) *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.

(*r*) *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1885), Chitty, J.; cross undertakings for local user.

(*s*) See above, p. 233.

(*t*) See above, pp. 230 and 232.

(*u*) 54 L. J. Ch. 1003 (1885), Kay, J.

which make registration conclusive evidence of exclusive right of user should run from the date of the actual registration instead of from the date of the application to register.

Variation of name of propriet

(8) The register cannot be rectified under sect. 90, where a mark has been wrongfully registered in the name of someone other than the proprietor, by expunging the name and substituting that of the person entitled to the mark. The whole entry may be expunged, but the true proprietor must be left to make a fresh application for registration, which will be advertised in the ordinary course, and may lead to opposition (*x*). So where an agent wrongfully registered his principal's trade-mark in his own name, Jessel, M.R., refused to order the name to be changed (*y*).

Registration in the wrong name.

And the same rule is applied where the entry is innocently made in the wrong name by mistake, as by a partner in his own name instead of his firm's (*z*), or by an agent acting for two principals, in the name of the wrong principal (*a*). In the former case the proper course is for the registered owner to assign, and for the assignee's name to be registered under sect. 87 (*b*). But in a case where a partner registered the mark in his own name thus—"Arthur Rust, trading as T. W. Rust & Co."—Jessel, M.R., allowed the names of all the partners to be substituted for "Arthur Rust" (*c*); and this case was distinguished in the later judgment, on the ground that the true proprietors, the firm, were there expressly mentioned on the register. And where the owners of the mark changed the name under which they were carrying on

(*x*) *Rivière's Tm.*, 55 L. J. Ch. 545, cited above, p. 224.

(*y*) *Marler's Tm.*, 44 L. T. 98 n. (1878).

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

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

(*b*) *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; and *Farina's Tm., supra.* Sect. 70 (trade-mark to be assigned only with goodwill) is not an obstacle to such assignment, *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.

(*c*) *Rust's Tm.*, 44 L. T. 98 n. (1880).

business, Stirling, J., on an application under the section, allowed the new name to be entered, with a note that the firm formerly traded under the old name (*d*). In *Re The Australian Wine Co.* (*e*) a mark had been registered in his own name by the sole consignee of wines from a particular vineyard, the consignee intending to use the registration solely for the protection of such wines, and so long only as he should remain consignee. The mark was transferred by his trustee in bankruptcy, with the consignee's business, to a purchaser who procured the entry on the register of his own name as proprietor. Subsequently, upon the application, under sect. 90, of the then owners of the vineyard, Chitty, J., directed their names to be entered as proprietors of the mark in lieu of that of the purchaser of the consignee's business, on the ground that the mark was registered in the first instance for the benefit of the owner of the vineyard, not for that of the owner of the business.

And in a case where the registered proprietor of a mark had assigned her business and the use of the mark for six years to the respondents, and they had procured the registration of their own names as assignees, upon their application it was ordered that the register was rectified by removing their names and restoring that of the original proprietor (*f*).

Procedure on an Application under sect. 90.

"The Court" in England is Her Majesty's High Court of Justice (*g*), or, with reference to marks of which the registration was applied for in the Manchester Trade-Marks Office (*h*), the Palatine Court of Chancery (*i*); and those Courts have jurisdiction to rectify a registered mark, "The Court."

(*d*) *The Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890); cf. applications under sect. 92, below, p. 248.

(*e*) 61 L. T. 427 n. (1886).

(*f*) *Re Avril*, 20th April, 1888, Stirling, J.; Sebastian, 3rd ed. p. 404.

(*g*) Sect. 117.

(*h*) Chap. VII., p. 103.

(*i*) Sect. 112a, Act of 1888, sect. 26.

whether the registered proprietor is domiciled or resident in England, or in Scotland, or Ireland, or elsewhere (*k*), although it is probable that where he is domiciled or resident in Scotland or Ireland, the Scotch or Irish Courts have a concurrent jurisdiction (*l*).

In practice, proceedings to rectify are almost always taken in the Chancery Division, except where they occur in the course of an action for infringement or passing off, commenced against the applicant in the Queen's Bench Division (*m*), and unless disputed questions of fact are involved which it is desirable to try by the aid of a jury, the Chancery Division will almost always be found to provide the more satisfactory tribunals for the trial of trade-mark questions.

Procedure by action.

Neither the Acts nor the Rules contain any regulations as to the manner in which the application to the Court must be made; and it follows the applicant must approach it by one of those means by which the High Court is usually approached, that is, either by writ or by summons, or by notice of motion (*n*). There is no reported case where the application has been made by action; and in *Pinto* v. *Badman* (*m*), Bowen, L.J., suggested that to proceed in that way would be an abuse of the process of the Court. It may be assumed, at any rate, that the plaintiff in an action, unless he could show some good ground for adopting a course which is both unusual and, in general, unnecessarily expensive, would have to pay the extra costs incurred, even though he were successful.

Not by counterclaim.

In the case last cited, it was held that the application could not be made by counterclaim, apparently on the ground that it did not fall within sect. 24 (3) of the Judicature Act of 1873.

(*k*) *Re King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350, Kekewich, J., and C. A. As to notice of motion in such cases, see below, p. 240.

(*l*) See the case last cited, and sect. 111 (2).

(*m*) As in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891).

(*n*) *Per* Kay, L.J., in *King & Co.'s Tm.*, (1892) 2 Ch. p. 488; 10 R. P. C. 350.

By summons or motion.

Applications under the section are frequently made both by summons and by motion. Each mode of proceeding offers some advantages peculiar to it. A simple case, where there is no very determined contest between the parties, might be dealt with inexpensively and quickly in chambers, and, on the other hand, if the case is certain to be adjourned into Court, it can usually be brought to a hearing more rapidly on an application by motion. If an action is pending in the matter, however, the summons or motion will almost always be adjourned to the hearing of the action, and a summons will then be the cheaper course. And where there is no action in question, some judges object to dispose finally of an application affecting important property rights on motion day, and, if the application is by motion, and is to be decided on affidavit evidence, direct it to be placed in the non-witness list.

The summons, unless taken out in a pending action, will be an originating summons (*o*). The notice of motion must, as the summons must, if issued in the Chancery Division, be marked with the name of a judge (*p*), and the notice must, unless special leave for short notice is given by the Court or a judge, be served two days before the motion is made (*q*).

Notice to the comptroller.

In any case, by Rule 49 of the Trade-Mark Rules, four clear days' notice of every application to the Court under sect. 90 for the rectification of the register must be given to the comptroller, but it does not seem to be necessary to make him a respondent to the motion or summons (*r*), and he frequently does not appear on the hearing.

Service on the registered proprietor.

It is proper, when the registered proprietor of the trade-mark in question is resident within the jurisdiction, to serve him with the notice of motion or the summons (*r*); but if he is resident abroad, under the existing rule of Court this cannot be done, and it is not necessary to enable the Court to

(*o*) Ord. 5, r. 9 (b); Rules of 1893, Ord. 54, rr. 4 (b) to (e).

(*p*) Ord. 5, r. 9 (b) (c); *King & Co.'s Tms.*, (1892) 2 Ch. 469; 10 R. P. C. 350. Ferm, p. 642.

(*q*) Ord. 52, r. 5.

(*r*) See *King & Co.'s Tms.*, *supra*.

Where the proprietor is resident abroad.

entertain the application in question (*r*). In the case of *La Cie. Générale d'Eaux Minérales, &c.*, notice of motion to remove a mark belonging to a foreign company not carrying on business in England was served upon the company in Paris, and Stirling, J., upon their application, set aside the service, because it would have founded a jurisdiction to give costs and damages against the company, and there is, he held, nothing in the Acts to warrant this in the case of such a respondent. The notice of motion had been served abroad without the leave of a judge, but that was really immaterial, as there is no jurisdiction under Ord. XI. or otherwise to grant leave in respect of the application in question. On a subsequent application the learned judge directed that the name of the company should be struck out of the notice of motion, leaving the comptroller as the sole respondent, but that information of the application should be given to the company (*s*). This course was adopted and approved in *King & Co.'s Case* (*t*), where the registered proprietors of the mark in question were a company having its registered office and carrying on business in Ireland. In that case the Court of Appeal held that service of the formal notice of motion was not required to enable the Court to deal with the application, and that, as the Acts and rules were silent on the subject, all that was required by natural justice, and therefore all that the Court would insist on, was that the persons interested in the mark should have actual notice of the application to be made respecting it (*u*). If they should take advantage of the notice to appear and oppose the application it was, the Court held, open to them to do so, but in that event they would be liable, if they failed, to be ordered to pay costs. Lindley, L.J., expressed a doubt whether it was necessary, in the case before Stirling, J., to strike out the name of the foreign respondents from the notice (*x*). He said: "If you go down to the root of the

Notice of motion not to be served out of the jurisdiction.

Notice by letter only.

Foreigner appearing on the application may be made liable for costs.

(*r*) See *King & Co.'s Tms.*, *supra*.
(*s*) (1891) 3 Ch. 451; 8 R. P. C. 446.
(*t*) *Supra*.
(*u*) Cf. Ord. 52, r. 3.
(*x*) (1893) 2 Ch. p. 482.

"argument there is nothing in it except a false analogy based on the supposition that, because the notice of motion is marked by an English judge, the parties interested must be technically named at the foot of it as respondents, and you must get leave to serve them if they are to be affected by it. It appears to me that all that they want for the purposes of this Act is notice, and that they have had" (*y*).

Security for costs by foreigner.

It has been held that a foreigner who is the registered proprietor of a mark which it is sought to remove from the register, is entitled, on receipt of information as to the intended application to rectify, to appear upon the application without giving security for costs, on submitting to the jurisdiction (*z*).

Action for infringement in Scotland or Ireland.

The Court has in several cases refused to allow actions for infringement to be brought or proceeded with in England where it has considered the Scotch or Irish Courts to be more convenient, notwithstanding that motions to rectify were pending in it with regard to the same matters (*a*).

Evidence on the Application.

The evidence is, in accordance with the usual rule, generally given in the first instance by affidavit, subject to cross-examination of the deponents if ordered by the Court or a judge (*b*). But applications under the section are very frequently heard upon *viva voce* evidence given in Court. And the Court has, by the terms of the section (*c*), power to direct an issue to be tried for the determination of any fact arising upon the application, but this is rarely, if ever, done.

(*y*) Cf. *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1888), and *Robertson, Sanderson & Co.'s Tm.*, (1892) 2 Ch. 245; 9 R. P. C. 213, where notices of appeals from the comptroller were sent to persons out of the jurisdiction, but the notices of motion were not served on them.

(*z*) *La Société, &c. de l'Etoile's Tm.*, 10 R. P. C. 290 (1893), Stirling, J.; *Miller's Patent*, W. N. (1894) 4; 11 R. P. C. 55, Kekewich, J.

(*a*) *Kinahan* v. *Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1890), Kekewich, J.; *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

(*b*) Ord. 38, r. 1.

(*c*) Sect. 90 (2).

Declarations of the proprietor.

Statutory declarations, or certified copies of declarations made on the application for registration of the mark sought to be removed or varied, and on the occasion of transfers of the mark by predecessors in title of the owner of the mark may be put in evidence by the applicants, but not declarations made by persons who are neither parties to the application nor predecessors in title of the respondents (*d*).

Evidence to be completed before the summons comes into Court.

Where the application is made by summons the evidence on each side should be completed before the matter is adjourned into Court, and Stirling, J., has announced that he will not in future allow the rule to be departed from by permitting evidence to be filed subsequently (*e*).

Discovery.

In a proper case discovery of documents may be ordered to be made by either party to the application (*f*). In *Wills' Trade-Marks* (*g*), on an application by notice of motion to remove certain marks from the register, and after the evidence had been completed (except as to the cross-examination of two witnesses, which was to be taken in Court), the applicants took out a summons for an order for discovery of documents by the respondents, the proprietors of the marks, and Kekewich, J., required the applicants to make a statement in writing of the grounds upon which they sought to have the marks removed, and upon it formulated six questions relative to the use of the marks by the respondents, and ordered that a member of the respondents' firm should make discovery of the documents relating to the several questions, not disclosing all the documents, but only specimens representative of each class of them. The Court of Appeal held that this order, carefully limited as it was, was oppressive at the then stage of the proceedings, and upon the respondents undertaking to deliver to the applicants a statement of the labels on which they intended to rely, and to have the relevant

(*d*) *Thwaite & Blakey's Tm.*, 10 R. P. C. p. 373 (1893), North, J.

(*e*) *Jackson & Co.* v. *Napper*, 35 C. D. p. 166 (1886).

(*f*) Ord. 31, r. 12; see *Re Norwich Town Close Estate Charity*, 46 C. D. 310.

(*g*) (1892) 3 Ch. 301; 9 R. P. C. 346.

documents in Court at the hearing, and not to object to produce them, the Court set aside the order, without prejudice to any order the judge at the trial might think fit to make as to discovery of documents.

Particulars.

If the case set up is that the mark objected to is deceptive, and it is alleged that it has in fact deceived certain persons, particulars as to the persons deceived may be ordered to be given (*h*).

Order to be served on the comptroller.

An office copy of any order to rectify must be left forthwith at the Trade-Marks Branch of the Patent Office, and the register is to be thereupon rectified or altered, or the purport of the order to be otherwise duly entered on the register, as the case may be (*i*). The comptroller is directed, if he thinks that the rectification or variation should be made public, to publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register at the expense of the person applying for it (*k*).

Damages under section 90.

It is difficult to see what damages can be given under the section. In several of the older cases under sect. 35 of the Companies Act of 1862, upon which sect. 90 is founded, the difference between costs as between solicitor and client and as between party and party were given as damages (*l*); but these cases were overruled (*m*), and, though it has since been held (*n*) that solicitor and client costs may be given in the Chancery Division under the jurisdiction inherited from the old Court of Chancery in any proper case, there is no reason to suppose that the cases first referred to would now be followed.

(*h*) *Humphries* v. *The Taylor Drug Co.*, 39 C. D. 693; 5 R. P. C. 687 (1868), Kekewich, J. An action for infringement.

(*i*) Rule 46.

(*k*) Rule 50.

(*l*) *e.g.*, *Anderson's Case*, 17 C. D. 373.

(*m*) *Cockburn* v. *Edwards*, 18 C. D. 449; Buckley on the Companies Acts, 6th ed. p. 140.

(*n*) *Andrews* v. *Barnes*, 39 C. D. 133, Kay, J., and C. A.

Possibly in a case where the presence of the wrongly registered mark of the respondent upon the register has caused the applicant to fail in proceedings taken to register a mark which he was otherwise entitled to register, the costs of these abortive proceedings might be given as damages under the section. There is no reported case in which damages have been given under the section.

In any event, it seems that damages could only be granted where an order for rectification is made (*o*).

Costs (*p*).

The ordinary rule that the unsuccessful party must pay the costs of the proceedings is rarely departed from (*q*), and these costs include the comptroller's costs, if he think fit to appear. The comptroller is never directed to pay costs.

The Court has, however, a discretion whether to give costs or not, and, in the exercise of this discretion, Kekewich, J., refused to give costs to a successful applicant who could not have been interfered with in the slightest degree in his business had he allowed the mark to remain unaltered (*r*); and in a case where the defendant in an action for passing off his goods as those of the plaintiff, successfully applied to expunge the plaintiff's registered mark, North, J., reserved the costs of the application till after the hearing of the action (*s*). And where in a similar case the plaintiff obtained an injunction against the defendant, on the ground of the fraudulent passing off of the latter's goods as his, and the defendant's motion to rectify failed, and was dismissed with costs at the trial, but, when urged on other grounds, succeeded in the Court of Appeal, no costs of the appeal on that point were given,

(*o*) *Ottos Kopje Diamond Mines, Ltd.*, (1893) 1 Ch. 618, a company case.

(*p*) See also Chap. IV., p. 85; and Chap. XV., p. 364.

(*q*) *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878); *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n. (1878), both Jessel, M.R.

(*r*) *Humphries v. Taylor Drug Co.*, 53 L. T. 820 (1888), Kekewich, J., (*Herbalin*); see also *Perry Davis' Tm.*, 5 R. P. C. 337, Kay, J.

(*s*) *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889).

because the objection was not urged in the Court below, and the rest of the appeal was dismissed with costs (*t*).

In *Hill's Trade-Mark* the application to rectify was proceeded with at the applicant's instance, without waiting for the further investigation of charges of improper trading brought against him by the respondent, upon his undertaking not to ask for costs in any event (*u*).

In *Talbot's Trade-Mark* (*v*), where the application to rectify succeeded, no costs were given, because the applicant failed in regard to one of the grounds relied on, and he had delayed to move for three years.

As regards security for costs where the respondent is resident abroad, see above, p. 241.

Appeal.

An order made on an application under sect. 90 is a final order, and an appeal to the Court of Appeal against it must consequently be heard by not less than three judges (*x*). The appeal must be brought within fourteen days, and must be by a fourteen days' notice of motion (*y*).

Stay of execution.

The Court may stay execution of its order to rectify pending an appeal, and it will sometimes do so (*z*), but the appeal itself does not act as a stay (*a*). In *Re Palmer's Application* (*b*) the Court of Appeal, having reversed the decision of the judge of first instance on a preliminary

(*t*) *Thompson* v. *Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1888), Chitty, J., and C. A., (*Stone Ale*).

(*u*) 10 R. P. C. 113 (1893), Chitty, J.

(*v*) W. N. (1894) 12; 11 R. P. C. 77, Stirling, J., (*Emolliorum*).

(*x*) *Rivière's Tm.*, 26 C. D. 48 (1884), C. A.; Judicature Act, 1875, sect. 12; see the notes to Ord. 58, rr. 3 and 15, in the Annual Practice.

(*y*) Ord. 58, rr. 3, 9 and 15; see *Re Blyth and Young*, 13 C. D. 416; and *Onslow* v. *The Commissioners of the Inland Revenue*, 25 Q. B. D. 465; and cf. *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A., where it was held that an appeal on an application to proceed must be brought within twenty-one days (now changed to fourteen days, Orders of 1893).

(*z*) *Harrison* v. *Woodroffe*, 7 R. P. C. 25; 42 C. D. 691, Kekewich, J.

(*a*) Ord. 58, r. 16.

(*b*) 22 C. D. 88 (1882).

objection, refused to stay the proceedings on the merits before the judge pending an appeal to the House of Lords against their decision.

2. Correction and Cancellation of Entries at the Proprietor's Request.

By sect. 91 (b) and (c) (*a*) the comptroller is empowered to correct any clerical error in the name, style, or address of the registered proprietor, and to cancel the entry of a trade-mark on the register, wholly or in part.

The sub-sections provide that—

Sect. 91.

"The comptroller may, on request in writing accompanied by the prescribed fee (*b*)—

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

"(c) Cancel the entry or part of the entry of a trade-mark on the register: provided that the applicant accompanies his request by a statutory declaration (*c*) made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade-mark."

Alteration of address.

Rule 48 directs the comptroller to enter any alteration of the address of the registered proprietor on application (*d*) and payment of the prescribed fee (*d*).

Amendment or cancellation only at the proprietor's request.

It is not expressly stated in sub-sect. (b) by whom the request is to be made, but obviously it is intended to be made by the registered proprietor only, and the forms attached to the rules and referred to above are drafted on the assumption that this is so. It is suggested that the proviso printed in the Act as part of sub-sect. (c) is to be construed as applicable to the whole section. A similar

(*a*) Sub-sects. (a) and (d) deal with the correction of errors in or in connection with an application to register, and the omission of any of the goods referred to in it.

(*b*) 5*s*.

(*c*) Rule 61. Forms O. and P., Appendix, p. 612.

(*d*) 5*s*. Form M., Appendix, p. 612.

error in printing to that suggested is to be found in sect. 64 (3) (ii.).

Cancellation of an entry.

Sub-sect. (c) providing for cancellation of an entry at the proprietor's request, corresponds to the rule of February, 1878, made under the old Act. A registered proprietor may wish to cancel the whole or part of a trade-mark registered in his name, because he has ascertained that it ought not to have been registered, and so to avoid the costs of any application under sect. 90 to expunge it which might be made by a person aggrieved, or because it stands in the way of some other registration he desires to be effected, or in pursuance of an arrangement with other traders, or to cancel part of a mark in order to more readily support the registration of the remainder.

Sub-sect. (b) only relates to the correction of clerical errors. Any other alteration of the register must be effected under sect. 90, already discussed, or under sect. 92.

3. Alterations in Non-Essential Particulars.

Sect. 92 provides that—

Sect. 92.

"(1) The registered proprietor of any registered trade-mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

"(2) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant; and the comptroller shall be entitled to be heard on the application.

"(3) If the Court grants leave, the comptroller shall, on proof thereof, and on payment of the prescribed fee (*e*), cause the register to be altered in conformity with the order of leave."

This section corresponds to the rule 35 of the old code under the Act of 1875.

(*e*) Ten shillings.

What is an essential particular

The alteration can only be permitted in any particular which is not an essential particular within the meaning of the Act. Reference is obviously intended to be made to the essential particulars enumerated in sect. 64 (*f*), which must, under the Act of 1888, be stated in the application for the registration of any mark made subsequently to the 1st of January, 1889 (*g*).

Alteration of old marks.

As regards an old mark, however, that is, a mark registered under sect. 64 (3) (ii.), no part of the mark is specified as an essential particular, and "essential" must therefore be read as equivalent to "substantial" (*h*) or "material."

The section has accordingly a much more restricted operation in regard to old marks than in regard to marks first used since 13th August, 1875, and registered under the provisions applying to new marks. The policy of the Acts is that old marks should be registered and kept registered substantially as they were used before the date mentioned (*i*). In the absence of special circumstances, therefore, no alteration at all should be permitted (*k*). But the section allows some alterations to be made in old marks. For instance, the Court has authorized the addition of the word *limited* to a mark where the proprietors had assigned their rights to a company bearing their old firm name with that addition (*l*), and has permitted the name of certain works abandoned by the proprietors to be struck out, and the name of other works retained by them to be printed in a different position in the registered mark (*m*).

(*f*) The proviso in the old rule ran, "so that he do not alter any one or more of the particulars in such mark which are declared by sect. 10 of the Act (of 1875) to be the essential particulars of a trade-mark." A signature mark, therefore, cannot be altered, above, p. 118.

(*g*) Chap. VIII., p. 112.

(*h*) *Adams' Tms.*, 9 R. P. C. 174; 66 L. T. 610 (1892), Kekewich, J.; cf. *per* Lord Cairns in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. p. 484 (1879).

(*i*) *Phillips' Tms.*, (1891) 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Adams' Tms.*, *supra*. And see Chap. VIII., p. 160.

(*k*) *Re Henry Clay*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

(*l*) *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.

(*m*) *Burham Brick, &c. Co.'s Tm.*, 9 R. P. C. 422 (1892), Stirling, J.

"Trade-mark." "Patent."

But it has refused to expunge *trade-mark* so printed upon a label as to suggest that part only of the matter of the label was the trade-mark (*n*), in a case where the mark had stood for twelve years on the register (*o*); to strike out *patent* printed as part of the name of the goods upon a label, there being in fact no letters patent (*p*), and to substitute the name of one former proprietor of a mark for that of another in the mark (*q*).

Alterations allowed in new marks.

In the case of new marks, alterations in matters other than the essential particulars are more readily permitted, and in estimating the resemblance referred to in sect. 72 (2), it is proper to have regard to the possibility of such alteration (*r*).

None allowed to the prejudice of other persons.

But no alteration to the prejudice of other registered proprietors, or such as to cause the altered entry to infringe the restrictions of the Acts can be allowed. Thus, in *Reiss' Trade-Mark* (*s*), the applicant, having a registered combination device trade-mark bearing the words *Grass Bleach, Best Quality*, and having ceased to use the method of grass bleaching, desired to substitute for *Grass* their own trade name, *Reiss*. The comptroller required (*t*) them to inform the Court that there were certain other trade-marks containing the name *Reiss*, and North, J., refused to grant the application until he was satisfied that the altered mark would bear no resemblance to any of the marks referred to.

Instances of alterations.

Amongst the alterations allowed in reported cases are the addition of *limited* to a name (*u*); the correction of an

(*n*) See Chap. X., p. 214.

(*o*) *Phillips' Tm.*, *supra*. This alteration was allowed in the case of a new mark in *Colman's Tms.*, (1892) 2 Ch. 402; 8 R. P. C. 209, by Kekewich, J., the proprietors of the mark undertaking to register a statement of the essential particulars of their marks and to disclaim the remainder of them.

(*p*) *Adams' Tm.*, *supra*.

(*q*) *Re Henry Clay*, *supra*.

(*r*) *Murphy's Tm.*, 7 R. P. C. 163 (1890), Stirling, J.

(*s*) 5 R. P. C. 291 (1888), North, J.

(*t*) He consented not to appear on their undertaking to read his letters in the matter to the Court.

(*u*) *Bryant & May's Tm.*, 4 T. L. R. 675 (1887), Stirling, J.; *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.; *Burke's Tms.*, W. N. (1891) 2, North, J.

English letter printed by mistake for a Russian letter (*x*); the omission of certain words (*y*); and the alteration of the name of the proprietor's works (*z*).

Procedure on an Application under Section 92.

The procedure to be adopted is generally the same as that on an application under sect. 90 (*a*), with such differences as are occasioned by the fact that on applications under that section the registered proprietor is usually a respondent to the application, while on applications under sect. 92 he is himself the applicant, and there is usually no respondent other than the comptroller.

Notice of the application and order to the comptroller.

Fourteen days' notice of the intended application must be given to the comptroller (*b*), and if leave is granted the applicant is directed to forthwith supply to the comptroller such a number of representations of the trade-mark, as altered, as the comptroller may deem sufficient (*c*). The person in whose favour the order is made, or such one of them if more than one, as the comptroller may direct, must forthwith leave at the Patent Office, Trade-Marks Branch, an office copy of the order. The register is thereupon to be rectified or altered, or the purport of the order to be otherwise duly entered on the register, as the case may be (*d*).

Advertisement by the comptroller.

The comptroller must, if he thinks the rectification or variation should be made public, at the expense of the applicant, publish by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation of the register (*e*).

The comptroller may

The comptroller is entitled to appear and to be heard

(*x*) *Ermen & Roby's Tm.*, 4 R. P. C. 70; 56 L. J. 177 (1886), Chitty, J.

(*y*) *Burke's Tm.*, *supra*.

(*z*) *Burham Brick, &c. Co.'s Tm.*, 9 R. P. C. 422 (1892), Stirling, J. For other orders, see Sebastian, 3rd ed. p. 406.

(*a*) See above, p. 237.

(*b*) Sect. 92 (2), r. 51, p. 603.

(*c*) Rule 51.

(*d*) Rule 46.

(*e*) Rule 50.

on the application. If he thinks there is no objection to the alteration sought to be made, or that it is sufficient to see that the facts are brought before the Court (*f*), he does not usually appear. He frequently signifies to the applicant that he has no objection to the proposal, and his acquiescence is, of course, of material importance in inclining the Court to accede to the application.

appear on the application.

The applicant is always directed to pay the costs of the comptroller, if the comptroller appears (*g*).

The applicant must pay his costs.

(*f*) See *Reiss' Tm.*, 5 R. P. C. 291, *supra*, p. 249, n.

(*g*) Further as to costs, see above, p. 244.

CHAPTER XII.

EFFECT OF REGISTRATION.

PAGE
Object of the Acts 252
1. Title to new trade-marks conferred by registration 253
sect. 75. Registration equivalent to user 254
new and unused marks may be registered 254
2. Registration as evidence of title 255
sect. 76. Registered proprietor entitled to exclusive use of mark 255
comparison with earlier Acts 255
"subject to the provisions of this Act" 256
right limited to goods for which the mark is registered .. 256
and actually used 256
certificate of registration evidence of title *primâ facie* or conclusive 257
the register may be rectified at any time 258
examples of rectification after five years 259
sect. 76 is subordinate to sect. 90 260
registration is conclusive if there is no application under sect. 90 260
3. Registration is a condition precedent to an action for infringement 260
sect. 77 260
corresponding sections of the earlier Acts 261
Act of 1888 262
(a) new marks incapable of registration are within the prohibition 262
(b) old marks refused registration are not 263
certificate of refusal 264
the section applies to foreigners 264
section is a condition precedent to an action, but not to the acquisition of a trade-mark 264
only the registered proprietor or his assignee can sue .. 265
the assignee can sue before registration 265
THE PROHIBITION DOES NOT AFFECT PASSING OFF ACTIONS 265
distinction between infringement and passing off actions 265
unregistered trade-marks are practically protected 266
the operation of sect. 77 268
proof of fraud is not necessary to escape the prohibition .. 269
failure to register only deprives the proprietor of the assistance of the Acts 269
and of the protection of the Merchandise Marks Act 270

Object of the Acts.

THE general object of the Registration Acts was not to create new rights, but to regulate the use of, and the means of, protecting trade-marks (*a*). Their main effect,

(*a*) *London Tm.*, 32 C. D. p. 117; 3 R. P. C. 102 (1886), *per* Cotton, L.J.

however, has been (1) to provide a new way in which title to a trade-mark may be acquired, namely, by registration; (2) to simplify infringement actions, by making registration evidence, and, under certain circumstances, conclusive proof of title; and (3) to constitute registration, in general, a condition precedent to an action for infringement. The first of these changes was a substantive alteration of the old law.

The Acts have also defined and limited the classes of symbols which can be registered as trade-marks (*b*), and thereby, as a consequence of the third alteration just referred to, have restricted the number of marks in which trade-mark rights can, as such, be effectively protected (*c*).

1. Title to New Trade-Mark conferred by Registration.

Title to new mark.

Registration, if properly made in accordance with the Acts in force at the date of the application to register (*d*), confers upon the registered proprietor trade-mark rights in the registered mark in respect of the goods for which it is registered and upon which it is used, subject to the rights appearing from the register to be vested in any other person (*e*), and subject, for five years from the date of the application to register, to the conflicting rights existing at that date of any other person in the same mark (*f*). And the rights so acquired date back to the date of the application to register.

Trade-mark acquired by user before registration.

As registration gives an independent title, the owner of trade-mark rights acquired by user, when he has registered his mark, will only need to avail himself of his earlier title if the propriety of the registration is questioned, or if, within the five years, conflicting rights to the mark are set up.

(*b*) Chap. IV., p. 53.
(*c*) As to this, see below, p. 266.
(*d*) Chap. VIII., p. 106.
(*e*) Sect. 87; see *Mitchell's Tm.*, 28 C. D. 666 (1885), Chitty, J., and p. 255.
(*f*) Sect. 76, p. 255.

Before the Acts (except in the case of Sheffield cutlers' marks) user of the mark was the only way in which trade-mark rights in it could be acquired (*g*). It was of the very essence of such rights (*h*), and it is provided, by sect. 75, that—

Sect. 75. Registration equivalent to user.

"[Application for] (*i*) registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark, [and the date of the application shall, for the purposes of this Act (*k*), be deemed to be, and as from the 1st of January, 1876, to have been, the date of registration]" (*i*).

The amendment of this section was effected upon the recommendation of Lord Herschell's Committee (*l*). The alteration was merely directed to give legislative authority to the rule already in force.

New and unused trade-marks may be registered.

A serious question arose on the construction of the original Act, of 1875, which contained no provision equivalent to sect. 75, as to whether new marks which had never been used could be registered under it (*m*); but the view expressed above, that the Act created a new mode of acquiring trade-mark rights, which had been acted upon from the first, was finally affirmed in *Hudson's Trade-Marks* (*n*). "In my opinion," Cotton, L.J., said, in that case, "the language (of the Act), though not appropriate, means this, that a man who designs one of those special things pointed out in sect. 10 (*o*) is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled, within the

Hudson's Case.

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

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

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

(*k*) *i. e.*, the principal Act, the Act of 1883; see Act of 1888, s. 27.

(*l*) Report of 1888, p. 13.

(*m*) See *Edwards* v. *Dennis*, 30 C. D. 454 (1885); *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1885), both C. A.

(*n*) 32 C. D. 311; 3 R. P. C. 155 (1886), C. A. The application was made, and the case was decided, under the Act of 1875.

(*o*) *i. e.*, of the Act of 1875.

"meaning of the Act, to the exclusive use of that which, in fact, has never been in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it, as that his user would be interfered with by the registration" (*p*). And new marks have since been constantly registered. Any other construction of the Acts would have led to very strange results, for no length of user was required to be shown in the actions or suits for infringement before the Acts (*q*). In any case, sect. 75 makes the matter absolutely clear, for, having regard to sect. 76 of the Act of 1883, quoted below, and the corresponding section of the earlier Act, it is difficult to see what operation it could have except in regard to new marks.

Applicant for registration must intend to use the mark.

But although actual use of the mark is not a condition precedent to registration, the applicant must intend to use it, so that the registration of a mark merely for the purpose of preventing other traders from using it will not confer upon the proprietor any title to it, and, if registered for such a purpose only, it ought to be removed from the register (*r*).

2. Registration as Evidence of Title.

Sect. 76 provides that:

Sect. 76. Registered proprietor of mark to have right to exclusive use of it.

"The registration of a person as proprietor of a trade-mark shall be primâ facie evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act."

Comparison with the earlier Act.

Registration being declared by the preceding section of the Act to be equivalent to public user, the section is in

(*p*) See *per* Chitty, J., in *Barlow* v. *Johnson*, 7 R. P. C. at p. 404 (1890).

(*q*) See Chap. II., p. 34.

(*r*) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. p. 234; 8 R. P. C. 137, Fry, L.J.

accordance with the old law. It is identical in terms with sect. 3 of the Act of 1875, except that by a verbal amendment "proprietor" has been substituted for "first proprietor," and the proviso of the last clause is now general, whereas in the earlier Act it stood "subject to the provisions of this Act as to its connection with the goodwill of a business."

"Subject to the provisions of this Act."

The most important of the provisions of the Act referred to are the sections which enable a second person who has an independent title to an old mark identical with or similar to a mark already registered, to be registered as proprietor of it (*s*); the provision of sect. 65 that a trade-mark must be registered for particular goods; the provision of sect. 70 for the assignment of registered marks in connection with the goodwill of the business to which they belong; and the provision of sect. 90 for the rectification of the register. It will be seen that the operation of the last-mentioned section is to very considerably diminish the value of five years' registration as conclusive evidence of title (*t*).

Right limited to goods for which the mark is registered.

The registration confers no rights except in regard to the goods for which the mark is registered, whether that be the whole or only part of a register class (*u*), and if the registration is limited by a note entered on the register to some only of the goods which would be otherwise included under it, the rights conferred are limited also in the same way (*x*).

Registration restricted to goods for which the mark is used.

Further, if the mark is actually used for certain goods only, although registered for others also, the exclusive rights conferred by the section do not extend to the latter.

(*s*) Sects. 62, 71, and 72 (1); *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. p. 65 (1886), Stirling, J.; and see *Mouson* v. *Boehm*, 26 C. D. 398, cited below, p. 290, and the "three mark rule," Chap. X., p. 177.

(*t*) See p. 258.

(*u*) *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*x*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J. In this case, besides the ordinary injunction to restrain infringement on the goods for which the mark was registered, the plaintiff obtained an injunction to restrain the defendant from using the plaintiff's trade-mark, on other goods, so as to deceive. The head-note is too loosely stated.

Edwards v. *Dennis.*

Thus, where the plaintiff in an action was the assignee of a mark registered for "unwrought and partly wrought metals used in manufacture," and, in fact, he only used it upon sheet iron goods, his business being confined to such goods, and the defendant was the agent of the proprietors of a similar mark subsequently registered for steel and iron wire, and he had sold wire with the latter mark upon it, it was held that the plaintiff had no cause of action, and an order was made that the registration of the plaintiff's mark should be rectified by confining it to sheet iron (*y*).

In the case just cited the plaintiff was assignee of the registered mark, and the decision turned to some extent upon the rule that a registered mark can only be assigned in connection with the business to which it belongs (*x*), the plaintiff's business being confined, as already stated, to sheet iron goods; but all the judges in the Court of Appeal indicated an opinion that the rights of the original registered proprietor would in any case have been limited by his actual user of the mark (*a*), and this opinion has since been adopted and followed by Chitty, J., in the recent case of *Hargreaves* v. *Freeman* (*b*).

Certificate of registration is evidence of title; *prima facie* or conclusive.

The main purpose of sect. 76 is to facilitate the proof of title by a plaintiff suing for an alleged infringement of his mark; in place of the evidence of user and reputation, by which he would have had to show his right to the mark before the Acts, he has only to produce the certificate (*c*) of registration of his mark, and that will be *primâ facie* evidence of his title (*d*).

Evidence rebutted by the plaintiff's own case.

The evidence afforded by the registration may be rebutted, if the registration is less than five years old, at the date when the fact of registration is put in evidence (*e*).

(*y*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

(*x*) Sect. 70.

(*a*) And see *Hudson's Tm.*, 32 C. D. at p. 319 (1886).

(*b*) (1891) 3 Ch. 39; 8 R. P. C. 237.

(*c*) Sect. 96, rule 60.

(*d*) *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

(*e*) Thus, in *Lever* v. *Goodwin*, 4 R. P. C. 492 (1886), Chitty, J.,

Thus, in the case last cited (*i*), the plaintiffs were not content to rest their title, as in the first instance they might have, merely upon the registration, but they set out in their pleadings the steps by which they alleged that the trade-mark in question had been transferred to them, and thereby showed that the original proprietors of the mark, and of the cigar factory and business in connection with which it had been acquired, had purported to assign the trade-mark without assigning the goodwill of the business. It followed, therefore, that the assignment was a nullity (*f*), and, as the registration was less than five years old, the *primâ facie* title conferred by it was consequently rebutted by the evidence furnished by the plaintiff's own case.

Five years' registration.

If the register shows that the registration was five years old at the date when it is put in evidence (*g*), it will be conclusive evidence of the title of the registered proprietor, or, subject to sect. 70, of his assignee, so long as the registration stands; but it is open to the defendant, as a person aggrieved by the registration, if it has been made without sufficient cause (*h*), to apply by motion or summons, under sect. 90, to have it expunged or restricted. The application cannot be made by counterclaim in the action (*i*).

Register may be rectified at any time.

The words of sect. 76 appear to make that section subject to sect. 90, and, therefore, to make the rights conferred by it subject to the rectification of the register, even though the mark in question has been registered for five years, and this has been held to be the case. The same result was arrived at upon the construction of sect. 3

held that the words *Self Washer*, although they had been two years on the register, were not a trade-mark. The case, nevertheless, succeeded on the ground of passing off; see further, p. 304, note (*t*).

(*f*) Sect. 70, and Chap. XIII., p. 272.

(*g*) See *Hayward's Tms.*, 54 L. J. Ch. 1003 (1885), Kay, J., where a note post-dating the registration was inserted on the register, cited above, p. 235.

(*h*) Chap. XI., p. 220.

(*i*) *Pinto* v. *Badman*, *supra*, note (*d*).

of the Act of 1875, notwithstanding the dictum to the contrary of Jessel, M.R., in *Hyde's Trade-Mark* (*k*), although the saving in that section applied in express terms only to a particular provision of the Act, namely, that relating to assignment. The following are cases in which marks were removed or varied on the grounds stated, after being upon the register for five years or more. As the cases are constantly referred to, it will be convenient to tabulate them.

Examples of trade-marks removed or varied after five years' registration.

The words BRAIDED FIXED STARS, removed, because they were descriptive and common to the trade. and because, though registered as an old mark, they had not been used alone before the Act of 1875, *Palmer's Tm.*, 21 C. D. 47 (1882), C. A.; 24 C. D. 504, C. A.; VALVOLINE, removed on similar grounds, *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; LA MINERVA-HABANA, removed, because the words were common to the trade, *Lloyd and Sons' Tm.*, 27 C. D. 646 (1884), Chitty, J.; a syphon-bottle device, removed, because used by more than three persons before the registration, *Wragg's Tm.*, 29 C. D. 551 (1885), Pearson. J.; a Neptune and trident device, restricted to the goods over which the proprietor's rights extended, *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.; the word ETON, registered as an old mark, removed, because, as used by the proprietor, it was not "special and distinctive," *Wood's Tm.*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; the word ALBION, registered as an old mark, removed on the ground that it was descriptive of a particular pattern, and not used as a trade-mark, *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J.; a device, removed because its registration was procured by material misrepresentation as to user before 1875, *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1889), North, J.; deceptive trade-marks, *Hill's Tm.* (*ante*, p. 216), and *Wills' Tm.* (*ante*, p. 214).

(*k*) 7 C. D. 724 (1878).

Sect. 76 is subordinate to sect. 90.

In most of the cases just cited, it was urged, but unsuccessfully, that five years' registration constitutes, under sect. 76 of the Act of 1883, or sect. 3 of the Act of 1875, an indefeasible title; and, in *Baker* v. *Rawson*, it was contended that the previous decisions only applied where the mark sought to be removed was common to the trade, or otherwise incapable of registration, that they were all cases on the older Act (*l*), and that the present Act must be construed differently; but North, J., overruled all the objections, and held that the earlier decisions had finally concluded the question. It may, consequently, be considered as settled law, that the conclusive evidence of title furnished by five years' registration, is no answer to an application to rectify the register, by removing or varying the mark under sect. 90.

Registration conclusive if no application under sect. 90.

In the absence of an application to rectify, the five years' registration is conclusive evidence of title in an action for infringement, so that the defendant cannot allege that the mark in question ought not to have been registered (*m*).

3. Registration is a Condition precedent to an Action for Infringement.

It is provided by sect. 77 that:—

Sect. 77.

"A person shall not be entitled to institute any proceedings to prevent or to recover damages for the infringement of a trade-mark unless, in the case of a trade-mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade-mark in use before the 13th of August, 1875, registration thereof under this part of this Act, or (of) (*n*) an enactment repealed by this Act, has been refused. The comptroller may, on

(*l*) *Wragg's Case*, *ante*, p. 259, was decided under the Act of 1883.

(*m*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 476 (1887), C. A.; see also *Leahy, Kelly, and Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.

(*n*) *Sic*, without the brackets.

"request, and on payment of the prescribed fee, grant a certificate (*o*) that such registration has been refused."

The corresponding section of the Act of 1875 was part of sect. 1. It was in the following terms: "From and after the 1st day of July, 1876, a person shall not be entitled *to institute any proceeding* to prevent the infringement of any trade-mark, as defined by this Act, until and unless such trade-mark is registered in pursuance of this Act." The corresponding sections of earlier Acts.

It was found that the time allowed between the commencement of the Act of 1875—namely, the 13th of August, 1875, and the 1st of July, 1876—was insufficient for the registration of the very numerous trade-marks already in use (*p*); and by the Act of 1876 (*q*), the period allowed for registration was extended, and, at the same time, the terms of the enactment were amended, so as, on the one hand, to make the prohibition extend to an action for damages, as well as to an action for an injunction, in respect of an infringement of a trade-mark, as defined by the Act of 1875, and, on the other hand, to exempt from its scope any trade-mark in use before that Act which had been refused registration under it. This amendment was in accord with the policy of the Acts to preserve old trade-mark rights substantially without alteration (*r*).

By the Act of 1877 (*s*), and an Order in Council made thereunder, the time for registration, in the case of trade-marks used in the textile industries, was further extended to the 30th of June, 1878.

There does not seem to be any material difference between the amended section of the Act of 1876 and sect. 77 of the present Act.

(*o*) See p. 264.

(*p*) In 1879 there were still 44,000 applications to register pending and undisposed of in the Trade-Marks Office at Manchester; *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819.

(*q*) 39 & 40 Vict. c. 33, s. 1.

(*r*) See *per* Lord Blackburn, *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. p. 498 (1879); see Chap. XI., p. 248.

(*s*) 40 & 41 Vict. c. 37.

Act of 1888.

The only Act, making provision as to what may be registered, repealed by the Act of 1883, is the Act of 1875. By the Act of 1888, the Act of 1883 is, as from the 1st of January, 1889, to take effect subject to the additions, omissions, and substitutions required by the later Act; but nothing in the later Act is to affect the validity of any act done, right acquired, or liability incurred before the date mentioned (*t*). So that the marks capable of registration under the present Act, within the meaning of sect. 77, are those described in sect. 10 of the Act of 1888.

The prohibition of the section does not in terms extend to (a) any new (*u*) mark incapable of registration under the present Act, whether it was or was not capable of registration under a repealed Act, and whether it has been refused or never tendered for registration under any of the Acts; or to (b) any old mark which was incapable of, and was refused, registration under a repealed Act, but is capable of registration under the present Act.

New marks incapable of registration

(a.) Although the section does not expressly enact that a new mark, incapable of registration under the Act, that is, not falling within any of the classes of marks enumerated in sect. 64 (*x*), shall not be the subject of trade-mark rights, yet the saving contained in it, with regard to old marks which have been refused registration (*y*), plainly shows that this was the result contemplated by the draftsman. And the Acts have always been regarded as limiting the classes of symbols in which trade-mark rights can be, or, since they came into operation, can have been, acquired by the descriptions comprised in their several definition clauses (*z*).

(*t*) Act of 1888, ss. 27 and 28.

(*u*) *i. e.*, not used as a trade-mark before 13th August, 1875.

(*x*) Chap. IV., p. 58.

(*y*) But see next page, note (*e*).

(*z*) In *The Normal Co.'s Tm.*, 35 C. D. p. 235; 3 R. P. C. 269 (1886), Chitty, J., said: "The result (of sect. 77) is that a person, who, I will assume, is entitled to be, but by some error has not been, put on the register by the comptroller or by the Board of Trade, loses his right, because it is useless

Thus, Cotton, L.J., said, in *Van Duzer's Case* (*a*), "The Act was also intended to protect the public, by having a register of marks, so that they might know what it was that was protected by the trade-marks adopted, and also by cutting down the numerous forms of words and other things, by the use of which traders tried to secure themselves exclusive rights." are within the prohibition.

And applications to expunge the plaintiffs' trade-marks from the register have been constantly made in actions for infringement of the trade-marks, and have been treated as effectual defences if successful, unless in any case the plaintiff could make out a case of "passing off" (*b*) by the use of his trade-mark (*c*). The question has, however, so far as I am aware, never been directly raised and decided by the Court, and the term "common law trade-mark" has been judicially applied to marks which, being incapable of registration, have been protected in passing off actions (*d*).

(b.) There is no ground, apparently, for a suggestion that an old mark once refused registration need be tendered again in order to escape the prohibition of the section, because it might possibly be accepted under an Act subsequently passed. There is, in fact, little probability of the question arising, although letters and figures excluded by the Act of 1875, as old marks, are now admitted to registration (*e*). Old marks refused registration.

to have a trade-mark which you cannot protect in case of infringement; as to old marks, however, a distinction is drawn. And where there has been a refusal, there is a right to institute proceedings to prevent infringement. . . . So that the validity of the old trade-marks does not depend on the (non-)registration."

(*a*) 34 C. D. p. 634; 4 R. P. C. 31 (1887); cf. *Apollinaris Co.'s Tms.*, (1891) 2 Ch. at p. 235; 8 R. P. C. 137, *per* Fry, L.J.

(*b*) See below, p. 265.

(*c*) Chap. XVI., p. 379.

(*d*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, Lindley, L.J.

(*e*) Lord Blackburn, in his judgment in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. pp. 498 and 499 (1879), seems to have regarded the Act of 1876 as barring all actions in respect of old marks which were incapable of registration, and the permission to sue if a certificate of refusal to register

Certificate of refusal.

Lord Herschell's Committee advised that the certificate of refusal should be altered to a certificate that the trade-mark is incapable of being registered under the Act, on the ground that the former tends to prejudice the proprietor of the mark, especially in proceedings abroad (*f*); but the suggestion was not adopted. The fees payable for the certificate of refusal are 1*l.* for one mark, and 10*s.* in addition for each mark beyond the first. The form of application is Form L. (*g*).

It was suggested by Malins, V.-C., in *The Twentsche Stoom Bleekery Goor* v. *Ellinger & Co.* (*h*), that the prohibition of sect. 77 does not apply to foreign owners of trade-marks; but it is submitted that the suggestion is ill-founded, and that no distinction can be drawn between trade-marks owned by subjects, and those owned by aliens (*hh*).

Registration a condition precedent to action;

The section makes registration, in the cases falling within it, a condition precedent (*i*) to an action for infringement. Where, therefore, the sole consignee of goods for which his consignors had a label registered as a trade-mark in France, sought to restrain the use of a name which formed a material feature in the label, it was held that the action was in substance an action to restrain an infringement of the label, and, as that might have been registered in England as a trade-mark under sect. 103 of the Act, it fell within the prohibition (*k*). An action to restrain the use of a registered mark on goods for which the registration does not avail is also within the prohibition, for it is in effect an action in respect of an unregistered mark (*l*).

were given, as only intended to meet cases where the mark ought to have been registered, pending an appeal to the Court. He says the owner of the trade-mark "may seek for more speedy redress" by bringing his action for infringement instead of appealing against the registrar's decision. It is submitted, however, that this view is inconsistent with the express words of that Act and of sect. 77.

(*f*) Report of 1888, p. xiii.

(*g*) Appendix, p. 611.

(*h*) 26 W. R. 70 (1877).

(*hh*) See *Goodfellow* v. *Prince*, note (*k*); and Chap. XV., p. 300.

(*i*) *Per* Lord Blackburn in *Orr-Ewing's Case*, note (*e*).

(*k*) *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

(*l*) *Hargreaves* v. *Freeman*, (1891)

It is not an enactment that a man shall not have a trade-mark until he registers (*m*), and it has been compared (*m*) to sect. 24 of the Copyright Act (*n*), which is satisfied by a registration made subsequently to the wrongful act complained of, but before the commencement of the action. It is sufficient if the registration is effected before the hearing (*o*). not to acquisition of a trade-mark.

Only the registered owners, or the assignees of the registered owners, of the trade-mark can sue in respect of an infringement of it (*p*), but it is not necessary that an assignee should have registered the assignment before commencing his action (*q*). Only the registered proprietor or his assignee can sue.

The Prohibition does not affect Passing Off Actions.

Sect. 77 has no application to actions to restrain a trader passing off his goods, or doing what is calculated to pass off his goods, as the goods of another. Two questions arise in trade-mark actions and in allied actions: first, is the defendant using a mark which is the same as, or which is a colourable imitation of, the plaintiff's registered trade-mark; and secondly, is the defendant selling goods so marked as to be designed, or calculated to lead purchasers to believe that they are the plaintiff's goods (*r*). The two questions are distinct, and the injunctions granted by the Court to meet the wrongs complained of are different in the two cases. Thus, in *Jay* v. *Ladler* (*s*), the defendant Distinction between trade-mark and passing off cases.

3 Ch. 39; 8 R. P. C. 237, Chitty, J.; cf. *Jay* v. *Ladler* and *Hart* v. *Colley*, cited below, p. 267. That the registration is blocked by delay at the office was considered to be no excuse; *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.

(*m*) *Per* Chitty, J., in *Barlow* v. *Johnson*, 7 R. P. C. at p. 405 (1890).

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

(*o*) *Hazzopulo* v. *Kaufmann*, *supra*.

(*p*) *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J. Action by sole purchasers from registered proprietors. Leave to add the proprietors.

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

(*r*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), Thesiger, L.J.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Fry, L.J.; see Chap. I., p. 12, and Chap. XVI., p. 382.

(*s*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

was restrained "from infringing the plaintiff's said trade-mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade-mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats (the only goods for which the trade-mark was registered), or otherwise using the said trade-mark in that connection," and he was also restrained "from using the device of a lady and bear (the trade-mark in question), so as to deceive the public," that was, so as to lead the public to believe that the goods of the defendant were the goods of the plaintiff.

The jurisdiction to grant the last-mentioned injunction is part of the general jurisdiction of the Courts to prevent and to give compensation for frauds which cause injury to the person who comes to complain of them (*t*), and this jurisdiction, which was well established before the Trade-Marks Registration Acts, has not been taken away or altered by anything contained in them (*u*).

Unregistered trade-marks practically protected.

It is no defence, therefore, to an action for passing off the defendant's goods as those of the plaintiff, that the grant of an injunction would practically confer on the plaintiff trade-mark rights in an unregistered trade-mark.

The Stone Ales Case.

This is well shown by *The Stone Ales Case*. There the plaintiffs had registered the words *Stone Ale* as a trade-mark, and they had other registered marks which comprised the same words. An application was made by the defendant to vary the registration of the first-mentioned mark, by adding a disclaimer of the right to the exclusive use of the word *Stone*, and this application Chitty, J., refused. The Court of Appeal, however, ordered the mark *Stone Ale* to be removed from the register altogether, on

(*t*) See Chap. I., p. 1.

(*u*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Singer, &c. Co.* v. *Loog*, 8 App. Cas. at p. 32 (1882), *per* Lord Blackburn; *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.; *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361, (*Stone Ale*).

the ground that it was not shown to have been used separately as a trade-mark before the 13th of August, 1875, but they, and subsequently the House of Lords, nevertheless, maintained the injunction granted by Chitty, J. The injunction (*x*) restrained the defendant from "carrying on the business of a brewer at Stone, under the title of 'Stone Brewery,' or 'Montgomery's Stone Brewery,' or under any other title, so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling, or causing to be sold, any ale or beer not of the plaintiffs' manufacture, under the term 'Stone Ales,' or 'Stone Ale,' or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture, and from infringing the plaintiffs' registered trade-marks, or any of them."

Lord Herschell's judgment.

"The respondents," Lord Herschell said (*y*), "are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so, because the practical effect of such restraint may be much the same as if persons seeking the injunction had a right of property in the particular name."

Passing off by the imitation of an unregistered trade-mark.

In the case just quoted the deception was practised by the use of the plaintiffs' trade name upon the defendant's goods. The jurisdiction existing, apart from the Acts, extends equally to cases where it is practised by the adoption of the plaintiff's trade-mark, or of the "get up" of his goods, and it affords no ground of defence that the trade-mark (*z*), or an essential part of the get up (*a*), might have been, but is not, registered under the Acts.

(*x*) (1891) A. C. p. 218.

(*y*) (1891) A. C. p. 220.

(*z*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*a*) *Great Tower Street Tea Co.* v. *Langford*, 5 R. P. C. 66 (1887), Stirling, J.

Pinto v. *Badman.*

In the case of *Pinto* v. *Badman* (*b*), the jury found, as a fact, that the defendant had fraudulently sold his cigars as those of the plaintiffs, and also that he had infringed the plaintiffs' trade-mark, and Day, J., gave judgment in the plaintiffs' favour. The Court of Appeal reversed the decision, and gave judgment for the defendant, on the ground that the trade-mark on which the plaintiffs relied had been assigned to them without the goodwill of the business in the goods to which it belonged. The question whether the plaintiffs were not, notwithstanding, entitled to retain their judgment on the ground of the finding of the jury, first stated above, does not seem to have been argued, and the plaintiffs' case appears to have been substantially based upon their assumed trade-mark right. The decision, therefore, cannot be regarded as conflicting with the proposition that passing off cases lie outside the Acts.

The operation of sect. 77.

The cases cited above have considerably limited the operation of the prohibition contained in sect. 77. Trade-mark rights, as was shown in the introductory chapter of this book (*c*), grew out of the right of a trader to prevent, and to obtain compensation for deceptions practised upon the public, which caused, or were likely to cause, damage to him as an individual, and, long after property in a trade-mark had been practically recognized by the judgment of Lord Cottenham in *Millington* v. *Fox* (*d*), Lord Westbury held, that imposition on the public was the test of the property in a trade-mark having been invaded or injured, although it was not the ground on which the Court rested its jurisdiction (*e*).

The Registration Acts have altered the old law to this extent that, after five years' registration, they give the

(*b*) 8 R. P. C. 181 (1891), C. A.

(*c*) Page 5.

(*d*) 3 My. & Cr. 338 (1838); Chap. I., p. 4.

(*e*) *Hall* v. *Barrows, Leather Cloth Co.* v. *American Leather Cloth Co.*, cited below, p. 314; and see Lord Blackburn's judgment in *Orr-Ewing* v. *The Registrar of Tms.*, 4 App. Cas. at p. 494 (1879).

registered proprietor of a mark, so long as he remains registered, the exclusive right to the use of the mark on the goods for which it is registered, so that if it, or an essential part of it, is appropriated by another trader the proprietor can interfere to restrain the appropriation (*f*). But where the complaint is not the appropriation but the colourable imitation of his mark, the test to be applied is still—Is the defendant's mark calculated to pass off his goods as the goods of the plaintiff? (*f*)

The alteration is not, however, of substantial importance, for it was settled law, apart from the Acts, that, if a trader has taken a substantial part of the trade-mark of another, the onus of showing that he is not using it in a manner calculated to deceive is cast upon him (*g*), and this onus he could hardly discharge if the mark had, in fact, become identified by use with the other trader. So that the change is, in effect, no more than the natural consequence of treating registration as equivalent to public use of the registered mark (*h*).

Proof of fraud is not necessary to escape the prohibition.

In most of the cases where the Court has interfered to prevent the passing off of the defendant's goods as those of the plaintiff, the deception has been found to have been deliberately practised; but fraud is not necessary to enable the Court to act (*i*); accordingly, its presence does not constitute a material distinction between cases where actions in respect of the unlawful imitations of trade-marks do or do not fall within the prohibition of sect. 77.

Failure to register only deprives the proprietor of

It can rarely happen, therefore, that the prohibition of sect. 77 will prevent the owner of an unregistered mark, which has, in fact, become known to the public, or to a

(*f*) Sect. 76; see *per* Cotton, L.J., in *Mitchell* v. *Henry*, 15 C. D. at p. 193 (1880); in *Edwards* v. *Dennis*, 30 C. D. at p. 471 (1885); and in *Lyndon's Tm.*, 32 C. D. at p. 117 (1886); and Chap. XV., p. 314.

(*g*) *Orr-Ewing* v. *Johnston*, 13 C. D. 434, C. A.; 7 App. Cas. 219 (1882). This case was begun in 1877, before sect. 1 of the Act of 1876 came into operation; it was therefore decided under the old law; see 7 App. Cas. p. 228.

(*h*) Sect. 75.

(*i*) Chap. I., p. 14.

the advantages of the Acts.

considerable, although indefinite, number of purchasers, as indicating that the goods upon which it appears are his goods, from protecting it against infringement, for the adoption of the mark, or of a substantial part, or a colourable imitation of it, can hardly fail to be calculated to pass off the goods of others as those of the owner; but the want of registration will cast upon the plaintiff in any action the necessity of proving that goods bearing the mark are known as his, and that goods bearing the mark complained of are likely, by reason of the resemblance between the marks, to be mistaken for his. And where an injunction is granted to restrain the use of a mark calculated to pass off the defendant's goods as those of the plaintiff, by reason of its resemblance to his unregistered mark, it should be so limited as to leave it open for the defendant to use any part, or the whole, of the plaintiff's unregistered mark, if he can do so, in any manner which is not calculated to lead to deception (*k*).

Goodfellow v. *Prince*.

The case of *Goodfellow* v. *Prince* (*l*), which is the only reported case in which sect. 77 has proved fatal to a plaintiff where he sought relief on the ground of passing off, as well as in respect of an infringement of his trade-mark, turned upon the view taken by the Court of Appeal that, as both plaintiff and defendant were importers, not producers, of the goods in question, the mark complained of was not calculated to suggest that the goods sold by the defendant were those of the plaintiff, but only that they were those of the producer from whom he bought.

Unregistered trade-marks and the Merchandise Marks Act, 1887.

Failure to register a trade-mark, whether it be occasioned by the incapability of registration of the mark, having regard to the definition clauses, or be due to any other reason, is material on other grounds than those depending upon sect. 77, for the definition of a trade-mark contained in the Merchandise Marks Act, 1887, is, as regards Great

(*k*) See the judgments in *Montgomery* v. *Thompson*, (1891), A. C. 217; 8 R. P. C. 361; and above, p. 266.

(*l*) 35 C. D. 9 (1887), C. A.

Britain and Ireland, restricted to trade-marks registered under the Act of 1883, and an unregistered mark is consequently deprived of the very valuable protection, under the criminal law, constituted by the penalties and punishments provided by the former statute for forging trade-marks, falsely applying trade-marks to goods, or selling, exposing, or having in possession for sale, or for any purpose of trade or manufacture, any goods or things to which a forged trade-mark is applied. The provisions of the statute as to applying a false trade description do, however, extend to unregistered trade-marks (*m*).

(*m*) Sect. 3 (2); see Book II., Chap. I., p. 492.

CHAPTER XIII.

ASSIGNMENT AND DEVOLUTION OF TRADE-MARKS.

	PAGE
A trade-mark is assignable only with the goodwill, sect. 70	272
And passes with the goodwill by implication	273
Hall v. *Barrows*	273
Trade-mark comprising the name of the original proprietor ..	274
The Leather Cloth Case	275
No assignment if the use of the assigned mark by the assignee would be deceptive	275
Lord Kingsdown's judgment	275
The mark used by the assignee must indicate what it indicated when used by the assignor	276
A mark comprising a trader's name is assignable	276
Assignment with the goodwill of part of the business	277
Transfer of goodwill and trade-mark not necessarily contemporaneous	277
Dissolution of partnership, and bankruptcy	278
Registration of assignments, sect. 87	278
Procedure and rules	279
Refusal to register an assignment	280
Action by assignee before registration	280
Alteration of registered mark in consequence of an assignment ..	280
Licence to use a trade-mark	281
Lease of goodwill	282
Action by licensee	282

A trade-mark is assignable only with the goodwill.

TITLE to a trade-mark cannot be assigned, and cannot devolve in gross, but, unless the mark connotes a personal connection between its original owner and the goods in connection with which it is used, it may be assigned and transmitted, together with the goodwill of the business in such goods.

This proposition was fully established before the first Registration Act was passed, and, as regards registered trade-marks, it was, in part, embodied in that Act. The section in question, sect. 2, so far as it related to

assignment and transmission, was identical in terms with the corresponding section of the present Act here set out.

By sect. 70—

Sect. 70.

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

Until it was established that there could be property in a trade-mark, there could, of course, be no question of the assignment of trade-mark rights (*b*), although the successors of the original founders of a business no doubt took over and continued to use the old trade-marks employed in it, and were protected when other traders sought to pass off their goods as the goods of the lawful users of the marks (*c*). But as soon as trade-marks were recognized as the subjects of property, the alienation of them, as of any other property rights, was permitted, subject only to such limitations as were necessary to prevent the use of the marks becoming deceptive.

Transfer by implication with goodwill.

And, conversely, it was held, that the sale and transfer of the goodwill of a business assigned the trade-marks used in the business to the purchaser and transferee by implication, and without any express grant being needed (*d*).

Hall v. *Barrows.*

The leading cases on the subject are, *Hall* v. *Barrows* (*e*), and *The Leather Cloth Co.* v. *The American Leather Cloth Co.* (*f*). They were decided at the same time, in 1863,

(*a*) The last clause of the section adds, "and shall be determinable with that goodwill," see the next chapter.

(*b*) See *per* Fry, L.J., in *Pinto* v. *Badman*, 8 R. P. C. at p. 194 (1891).

(*c*) See, for instance, *Webster* v. *Webster*, 3 Swan. 490 (1791), Thurlow, L.C.; and *Motley* v. *Downman*, 3 My. & Cr. 1 (1837), Cottenham, L.C.

(*d*) *Shipright* v. *Clements*, 19 W. R. 599 (1871), Malins, V.-C.

(*e*) 32 L. J. Ch. 548; 33 L. J. Ch. 204; 4 De G. J. & S. 150, Romilly, M.R., and Westbury, L.C.

(*f*) 1 H. & M. 271; 32 L. J. Ch. 721; 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53, Wood, V.-C.,

by Lord Westbury, and his judgment in the latter case was affirmed by the House of Lords; in the first case, the question at issue was, whether, in determining the sum to be paid by the surviving partner of a firm who took over the partnership assets, at a valuation, under the articles of partnership, the value of the trade-mark used by the business ought to be taken into account, and the Lord Chancellor, reversing the decision of Romilly, M.R., held that it ought to be so taken, the valuation being made, however, on the footing that the surviving partner was entitled to carry on a similar business and to use the trade-mark in it without payment. The trade-mark was the letters B. B. H. (the initials of the partners composing the original firm), surmounted by a crown, and the Master of the Rolls had held that it could not be sold, because it designated the firm which manufactured the particular goods. "It would," he said, "obviously be a fraud on the public if the Court of Chancery were to attempt to sell to another person the right of holding out to the public that the goods manufactured by him were, in fact, goods manufactured by another and distinct firm." And he distinguished the mark in question from marks indicating the manufacture of a particular factory, which might rightly be transferred with the factory. Lord Westbury dissented from the view that the trade-mark was a personal mark. "It must be borne in mind," he said, "that a name, although originally the name of the first maker, may in time become a mere trade-mark or sign of quality, and cease to denote or be current as indicating that any particular person is the maker." And he held, as a fact, that the connection represented by the mark was a connection with the business and the factory at which it was carried on, not a connection with the persons who were the owners of these, and that, accordingly, the trade-mark

Trade-mark comprising the name of the original proprietor.

Lord Westbury's judgment.

Westbury, L.C., and H. L. See also *Bury* v. *Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465 (1863), Romilly, M.R. and L.JJ.

belonged to the partnership as part of its property, and might be sold with the business and works.

The Leather Cloth Case.

In *The Leather Cloth Case* (*g*), the plaintiffs sued the defendants for an alleged infringement of their trade-mark, and Lord Westbury, reversing the decision of Wood, V.C., dismissed the suit on the ground that the trade-mark of the plaintiffs contained material misrepresentations. The plaintiffs had purchased the marks from an American company—the Crockett International Leather Cloth Co.,—who were the successors of Crocketts & Co., and the marks contained the names both of the company and the firm, as well as an American address which was not the address of the plaintiffs. The presence of the names and address amounted, in Lord Westbury's opinion, to a representation that the goods on which the mark was used were the goods of the original firm or of the American company, and the marks, therefore, could not be properly used by the plaintiffs, and consequently could not be validly assigned to them. And this judgment was fully indorsed by the House of Lords, although Lord Cranworth and Lord Kingsdown, on the appeal, based their judgments chiefly on the ground that there was in fact no infringement, and Lord Westbury placed his upon wider grounds than those he had adopted on the appeal from the Vice-Chancellor, namely, that the alleged trade-marks were in fact only advertisements and not trade-marks at all.

The mark is unassignable if deceptive when used by an assignee.

Lord Kingsdown's judgment in *The Leather Cloth Case.*

The following passage from Lord Kingsdown's judgment in the House of Lords (*h*) shows the principle upon which the assignment of trade-marks and trade-names, as well as the limitations restricting such assignment, are based:—"By the usage of trade, the name of a firm is understood not to be confined to those who first adopted it, but to extend to and include persons who had afterwards been introduced as partners, or persons to whom the

(*g*) Note (*f*). The case is further stated at p. 47, above.

(*h*) 35 L. J. Ch. p. 64; 11 H. L. C. 523

"original partners have transferred their business. The name of a firm continues to be used in many cases long after all the original traders have died, or have ceased to have any interest in the concern—as in the great banking houses of Child and Coutts, and many other mercantile houses. If a manufacturing company uses the name of the firm, and stamps the name of its firm upon its goods, though the name of the firm no longer represents the same persons as at first, it is no fraud upon the public for the reasons I have already mentioned. For the same reason, the use of the old trade-mark of the firm by the new partners or their successors (if the term 'trade-mark' be understood in what I have already said is its proper sense (*i*)), is no fraud upon the public; it is only a statement that the goods are the goods of the firm whose trade-mark they bear." And Lord Cranworth said, "The right to a trade-mark may, in general, treating it as property, or as an accessory to property, be sold or transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser (*k*).

The mark used by the assignee must indicate what it indicated when used by the assignor.

In the recent case of *Pinto* v. *Badman* (*l*), Fry, L.J., stated the rule governing the assignment of a trade-mark in concise and definite terms: "It may be assigned," he said, "if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when, in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor."

A mark comprising the trader's name is assignable.

And as the judgments quoted above show, a trade-mark is not deceptive in the hands of an assignee of the business of the original proprietor, and consequently unassignable, merely because it comprises the name or initials of the

(*i*) *i.e.*, a symbol or emblem, come by use to be recognised in the trade as the mark of the goods of a particular person (above, p. 25).

(*k*) 35 L. J. Ch. p. 61.

(*l*) 8 R. P. C. 181 (1891), C. A.

original proprietor, or of any of the former owners of the business (*m*).

So, the right to use a trade-mark for a sauce cannot be sold without the business in the sauce, or the secret of its manufacture (*n*), or the right to the use of a brand for cigars, without the factory and business of the manufacturer who first acquired it (*o*).

Sale of trade-marks with the goodwill of part of the business.

But the trade-marks used in a part of a business may be sold with the goodwill of that part only, and if the goodwill sold is restricted to some only of the goods in which the vendor dealt, the purchaser will only obtain the right to use the trade-marks assigned to him upon the goods in question, even though they be registered for other goods. Thus a mark was registered for "unwrought and partly wrought metals used in manufacture," and the proprietors assigned it together with their goodwill "in the trade or business of galvanized iron merchants and manufacturers," but the business, in fact, being entirely confined to sheet iron, the assignor's rights were held to be restricted to that description of goods only (*p*).

Transfer of goodwill and trade-mark not necessarily contemporaneous.

It is not essential that the assignments of the trade-mark and the transfer of the goodwill should be exactly contemporaneous (*q*), or even that there should be any legal conveyance of the latter, if the assignee is equitably entitled to it. An assignment to the owner of the business in connection with which the trade-mark is used or intended to be used has, consequently, been permitted in some cases where it has been registered by mistake or accident in the name of a person other than that owner (*r*).

(*m*) *Hall* v. *Barrows*; *Bury* v. *Bedford*, above, p. 274. See also *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

(*n*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90 (1874), Jessel, M.R.

(*o*) *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

(*p*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

(*q*) *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.; *Hammond* v. *Malcolm, Brunker & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

(*r*) See Chap. XI. p. 236; *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; *Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.; and see last note.

Trade-marks on bankruptcy and dissolution of partnership.

Upon the dissolution of a partnership in the absence of special agreement (*s*), the trade-marks of the firm are part of its assets, and are saleable as such with the goodwill (*t*); but it seems that each of the partners is at liberty to make use of the trade-name of the firm, and of its trade-marks, provided he can and does do so in such a way as to avoid deceiving the public, or casting any risk or liability upon his late partners (*u*). Similarly, upon the death or bankruptcy (*x*) of a trader, his trade-marks may be sold with the goodwill of his business by his executors or trustees.

The register of trade-marks comprises notifications of assignments, and of transmissions of trade-marks (*y*), and it is provided by sect. 87 that:—

Sect. 87. Registration of assignments.

"Where a person becomes entitled by assignment, transmission, or other operation of law (to a patent, or to the copyright in a registered design, or) to a registered trade-mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of (the patent, copyright in the design, or) trade-mark, in the register of (patents, designs, or) trade-marks (as the case may be). The person for the time being entered in the register of (patents, designs, or) trade-marks as proprietor of a (patent, copyright in a design, or) trade-mark (as the case may be) shall, subject to [the provisions of this Act, and to] (*z*) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with the same, and to give effectual receipts for any consideration

(*s*) For instances of this, see *Bury* v. *Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465; and *Hanson* v. *Game, Harrison and Larner, Ltd.*, 9 R. P. C. 186 (1892).

(*t*) *Hall* v. *Barrows*, above, p. 274.

(*u*) See the last case; *Hookham* v. *Pottage*, 8 Ch. 91 (1872), C. A.; and *Thynne* v. *Shove*, 45 C. D. 577 (1890), Stirling, J.

(*x*) *Hammond* v. *Malcolm, Brunt & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

(*y*) Sect. 78.

(*z*) Act of 1888, sect. 21, see below, p. 280.

"for such assignment, licence, or dealing. Provided that any equities, in respect of such (patent, design, or) trade-mark may be enforced in like manner as in respect of any other personal property."

No notice of any trust is to be entered on the register, or to be receivable by the comptroller (*a*).

Procedure.

The procedure by which the registration of assignments and transmissions of title to trade-marks is governed, is laid down in the following rules (*b*).

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 (*c*) for the entry of his name in the register as proprietor of the trade-mark shall be addressed to the comptroller, and left at the Patent Office, Trade-Marks Branch.

Signature of request.

"**37.** Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively duly authorized to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorized in like manner.

Contents of request.

"**38.** Every such request shall state the name, address, and description of the person claiming to be entitled to the trade-mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade-mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted

(*a*) Sect. 85, Chap. III. p. 54.

(*b*) The old rules were 23 to 29 of the former code. The more important provisions of these have been incorporated in the Act.

(*c*) Form K. Appendix, p. 611.

"in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade-mark has been registered.

Declaration to accompany request.

"**39.** Every such request shall be accompanied by a statutory declaration (*d*) to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade-mark as claimed by such request.

Further proof of title if required.

"**40.** The claimant shall furnish to the comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction."

"Subject to the provisions of this Act."

The amendment "subject to the provisions of this Act" in sect. 87 means, subject to the rule of sect. 70, that a trade-mark shall not be assigned or transmitted without the goodwill of the business in the goods for which it has been registered (*dd*).

Refusal to register an assignment.

If the comptroller refuses to enter an assignment upon the register, the assignee can apply to the Court under sect. 78, and also under sect. 90, as a person aggrieved by the omission of his name without sufficient cause from the register, for an order directing the registration. He must in any such case satisfy the Court that the goodwill of the business has been transferred to him (*e*), and that he is otherwise entitled to use the mark.

Action before registration.

Registration of the assignment is not, as registration of the mark itself is, a condition precedent to any action for infringement by the assignee (*f*).

Alteration of registered mark in consequence of assignment.

In some cases the assignment of a trade-mark to new proprietors makes an alteration in its form necessary or advisable. In the case of registered marks, such alteration

(*d*) See Rule 61, Appendix, p. 605. And as to the comptroller's power to dispense with evidence, Rule 53, p. 603.

(*dd*) Cf. sect. 76 above, p. 256.

(*e*) *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J.

(*f*) *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1884), North, J.; *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J.

may be allowed by leave of the Court obtained under sect. 92, provided that the mark is not altered in an essential particular (*g*). Thus in *Guinness and Co.'s Trade-mark* (*h*), Chitty, J., allowed the word *limited* to be added to the name upon the mark, the business and trade-marks of the old firm having been taken over by a company bearing the name of the firm with "limited" added to it. But in the case of an old mark the Court is very unwilling to allow any alteration to be made, although it has jurisdiction to do so if special circumstances render it necessary, for a mark registered as an old mark ought to be kept on the register as it was actually used before the 13th of August, 1875. So, in *Re Henry Clay, and Bock and Co.* (*i*), Kekewich, J., refused to allow an old mark to be altered by substituting, for the initials of one predecessor of the proprietors, the name of another and later predecessor, notwithstanding that the mark in its altered form had been registered for some years in Havanah, and had been extensively used by the applicants in England (*k*).

Licence to use a trade-mark.

The part of sect. 87 which relates to licences would seem to apply, not to trade-marks, but exclusively to patents and to copyright in designs, with which the section also deals, for a licence to use a trade-mark would be either unnecessary or illegal: unnecessary if the mark were to be put upon the goods made or dealt in in the business to the goodwill of which the trade-mark was attached, since any person may lawfully attach a trade-mark to the goods which are in fact the goods it indicates (*l*); illegal if it were to be put upon any other goods (*m*). This was the view of Lord Herschell's Committee, and they advised that the part of the section relating to trade-marks should be separated from the rest. The passage in their report is as follows. After

(*g*) *Murphy's Tm.*, 7 R. P. C. 163 (1890), W. N. 84.

(*h*) 5 R. P. C. 316 (1888); *Re Bryant & May, Ltd.*, 4 Times L. R. 675, Stirling, J.

(*i*) (1892) 3 Ch. 549; 9 R. P. C. 449.

(*k*) See further, Chap. XI. p. 248.

(*l*) See Chap. II. p. 32.

(*m*) *Oldham* v. *James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862).

quoting sections 70 and 87, they say (*n*), "It has been suggested that this (sect. 87) gives power to assign, or at all events to grant licences to use, a trade-mark apart from the goodwill of the business concerned in the goods for which it has been registered. Probably the two sections read together may receive a consistent construction; but in order to avoid doubt it would be well to amend sect. 87 by dealing specifically with trade-marks, omitting the words as to granting licences, and providing that assignments are to be subject to the provisions of the Act." But the only amendment made by the Act of 1888 was the interpolation of the words quoted above.

Lease of goodwill and trade-marks.

If the goodwill of a business be leased for a term, the right to use the trade-marks identified with it would during the term pass to the lessee, in the absence of special agreement; and if it were reserved on the principles stated above, the lessor could not rightly use the marks. It seems that the registration of the lessee as assignee of the marks without the consent of the lessor, would not, however, be rightly made (*o*).

Action by licence.

The only authorized dealer in goods bearing a particular trade-mark in the United Kingdom, who is in a sense a licensee of the trade-mark rights, cannot sue for infringement of the trade-mark (*p*). But a true licensee of the rights, if there can lawfully be such a person, could not sue either (*q*).

(*n*) Report of 1888, p. xiv.

(*o*) *Re Avril*, Stirling, J., 20th April, 1888; Sebastian, 3rd ed. p. 404, cited above, p. 237.

(*p*) *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J.

(*q*) *Heap* v. *Hartley*, 42 C. D. 461; 5 R. P. C. 603; a Patent Case; *Woolley* v. *Broad*, (1892) 1 Q. B. 805; 9 R. P. C. 208, 429; a Design Case.

CHAPTER XIV.

DETERMINATION OF TRADE-MARK RIGHTS.

PAGE

1. **Loss of distinctiveness** 284
   by the action of the proprietor 285
   by extensive piracy 286
   test whether the mark is *publici juris* 286
   mark *publici juris* for a particular class 287
2. **Separation of the mark from the goodwill** 287
   sect. 70 287
   removal of the mark 288
   temporary separation from goodwill, or disuse of mark, is immaterial 288
3. **Abandonment** 289
   agreement to abandon 290
   not mere disuse of mark 290
   adoption of a new mark 290
   use with the proprietor's name 290
   neglect to prosecute infringements 290
   Sheffield corporate mark by non-registration 291
4. **Forfeiture of right to protection** 291
5. **Removal of mark from the register** 291
   where it has determined 291
   for non-payment of fees, sect. 79 292
   new mark may be deceptive by resembling the removed mark .. 293
   cause of the removal to be registered 294
   fees and forms 294

Modes of determination.

THE right of the proprietor of a mark (subject to the rights of other proprietors, if any, of the same mark (*a*)) to the exclusive use of it upon the goods of the kind in respect of which the right existed is determined :—

(1) When the mark so used ceases to be distinctive ;

(2) When the proprietor is no longer able to use it in

(*a*) See the three mark rule, p. 177, and sect. 87, p. 278.

the business in connection with which the right was acquired;

(3) When he has abandoned it; and

(4) When he has fo. ited his claim to protection of his right by using the mark deceptively or in a fraudulent trade (*b*).

The proprietor may, in general, use the mark after his exclusive rights have determined.

In the first case the mark can no longer be the subject of trade-mark rights, and anyone may use it; but in the others, if there are any independent proprietors of the mark for the same class of goods, their rights will be unaffected by the determination; and in the third and fourth cases, their rights will continue to be qualified by his right to use the mark himself on the goods, so long as he uses it in the business in connection with which it was acquired.

1. Loss of Distinctiveness.

The first case follows immediately from the definition of a trade-mark given in Chapter II. It is there shown that the function of a trade-mark is to distinguish the goods, to which it is applied or attached, from similar goods, and to identify them with a particular trader and his successors in business. And distinctiveness is an essential condition of capacity for registration under the Acts (*c*). Further, the test of infringement is that the use of the mark, or of a similar mark, by others than the proprietor, is calculated to cause their goods to be bought as his (*d*). So that, apart from the Acts, a mark which has ceased to be distinctive is incapable of being the subject of trade-mark rights, and no action for infringement could be successfully brought to prevent any trader using it, and if not already registered, it would be incapable of registration under the Acts.

(*b*) See Chap. XV., "the action for infringement," defences, pp. 336 *et seq.*

(*c*) Chap. VIII. p. 106.

(*d*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), James, L.J.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Cotton, L.J.; see also *Ford* v. *Foster*, 7 C. D. 611, cited below, p. 286.

How distinctiveness may be lost.

The elements of distinctiveness have been considered at length elsewhere (*e*), and it will be sufficient here to refer to some of the modes in which a mark may cease to be distinctive, and to give a few examples of cases in which the question has arisen. Marks are not distinctive if they are descriptive (*f*), and, in particular, if they have been adopted in the trade concerned as the names of the goods for which they are claimed as trade-marks (*g*), or are common marks (*h*), or marks common to the trade (*i*), or if they connect the goods, not with their proprietor, but with some other trader (*k*).

By the action of the proprietor.

Distinctiveness may be lost through the action of the proprietor, or by reason of successful piracy.

Thus, if the proprietor abandons his mark (*l*), it will almost inevitably become a common mark, unless there are other persons who have trade-mark rights in it which they assert. So, if he uses it himself as the name of the goods he deals in, the trade will probably adopt the same course, especially if he is for a time the only dealer in the goods (*m*).

Before the Registration Acts a difficult question of fact was often raised in trade-mark cases where admittedly a name or other mark had been introduced by the plaintiff, but it was alleged that it had by repeated use on the goods of other traders lost its original significance indicating a connection with the plaintiff, and had become *publici juris* (*n*). As already pointed out, this difficulty is not likely to arise in the case of a registered mark, since the public advertisement of the registration, and the readiness with which the infringement of a properly registered mark

(*e*) Chap. II. p. 35; Chap. VIII. *Cigarettes*), p. 119.

(*f*) See above, descriptive marks, p. 36; devices, p. 131; words, p. 146.

(*g*) Page 36.

(*h*) Page 122; see also the "three mark rule," Chap. IX., p. 172.

(*i*) Page 171.

(*k*) *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 41 (1886), C. A., (*Eton*

(*l*) See below, p. 289.

(*m*) *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J.

(*n*) See *Ford* v. *Foster*, 7 Ch. 611 (1872); *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. 434; 3 App. Cas. 376 (1875).

can be prevented, under sect. 76, both tend to warn other traders against the use of the mark, and enable the proprietor to protect his rights.

By extensive piracy.

Extensive infringement by a single trader can hardly suffice to make a trade-mark common. "It has been said that one murder makes a villain, and millions a hero; but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasion of his neighbour's rights is to convert his piracy into a lawful trade (*o*)." Nor will a few unprosecuted scattered infringements by several traders (*p*).

The test whether a mark has become *publici juris*.

"There is no doubt, I think," Mellish, L.J., said, in *Ford* v. *Foster* (*q*), "that a word which was originally a trade-mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of *Harvey's Sauce* (*r*). I think the test must be whether the use of it by other persons is still calculated to deceive the public (*s*), whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trador from being cheated by other person's goods being sold as his goods through the fraudulent use of his trade-mark, the right to the trade-mark must be gone" (*t*).

(*o*) *Per* James, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 625.

(*p*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.

(*q*) L. R. 7 Ch. p. 628.

(*r*) *Lazenby* v. *White*, 41 L. J. Ch. 354 (1871).

(*s*) So the long duration of fraudulent user is immaterial if it is still calculated to deceive: *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J., (*Hoop* L *Iron*).

(*t*) See also *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n.; and *Hyde & Co.'s Tm.*, 7 C. D. 724, both (1878), Jessel, M.R.

Upon the facts of the case, the Lords Justices held that the name in question had become *publici juris* to this extent, "that by the use of it in trade circulars, which are issued only to retail dealers, or by shirts being invoiced by the wholesale dealers '*Eureka Shirts*,' no retail dealer would be likely to be deceived, or be led to buy shirts which were not made by Ford believing they were Ford's shirts," but that a considerable portion of the public who buy shirts for the purpose of wearing them would still be very liable to be deceived by the use of the word *Eureka* on the shirt itself. And the injunction granted by the Court accordingly left the defendants at liberty to advertise the name *Eureka* as between themselves and the trade (*u*).

A mark may be *publici juris* in a particular branch of the trade only.

2. Separation of the Mark from the Goodwill.

It has been shown in the last chapter that the trade-mark rights in a mark are inseparable from the goodwill of the business in the goods upon which the mark is used, for the function of the mark is to connect the goods with the trader who owns the business, and his successors (*x*). The indication of that connection is its original signification, and it cannot legally be used as a trade-mark with any other (*y*). It follows that if the goodwill is lost, or passes into other hands than those of the proprietor of the mark, the exclusive rights of the proprietor in respect of the use of the mark are determined, and this rule is recognized by the Acts in the case of registered marks. Sect. 2 of the Act of 1875, and sect. 70 of the present Act of 1883, enact that a trade-mark "shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods" for which it has been registered, and the latter

Sect. 70.

(*u*) L. R. 7 Ch. p. 634; cf. *Singer, &c. Co.* v. *Spence*, 10 R. P. C. 297 (1893), Romer, J.

(*x*) See the judgment of Mellish, L.J., in *Ford* v. *Foster*, cited above, and Chap. II., p. 24.

(*y*) See the judgment of Fry, L.J., in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), cited above, p. 276.

section expressly adds "and shall be determinable with such goodwill."

No exclusive right in a registered mark apart from the goodwill.

No question therefore arises as to whether the registered owner of a trade-mark which has determined by separation from the goodwill of the business can sue for infringement, for sect. 76, which grants the right of exclusive use to the proprietor of a registered mark, makes the grant "subject to the provisions of this Act," and consequently subject to sect. 70.

Removal of mark when the goodwill is determined (z).

It was provided by rule 34 of the Rules of 1876, for which the Rules of 1890 are now substituted, that—"The Court may, on the application of any person aggrieved, remove any trade-mark from the register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods within the same class as the goods with respect to which a trade-mark is registered." And in *Ralph's Case* (*a*), where the registered proprietor had not manufactured the machine, for which the mark was registered, for twenty-one months before the date of the application, Pearson, J., in accordance with the rule, directed the mark to be removed.

The rule has not been re-enacted, and there is now no provision enabling a properly registered mark to be removed except for non-payment of fees after fourteen years (*b*), or at the request of the proprietor (*c*).

Temporary separation from the goodwill or disuse of mark is immaterial.

A mere temporary cessation of business (*d*), or delay in the transfer of the goodwill (*c*), would not determine the trade-mark rights. The judgment of Pearson, J., in *Ralph's Case* (*f*), notwithstanding the repeal of the rule on which it was founded, may be useful to indicate what length of cessation of a business determines the goodwill, and there-

(*z*) See below, p. 291.

(*a*) 25 C. D. 194 (1883), cited *infra*.

(*b*) Sect. 79.

(*c*) Sect. 91.

(*d*) See the next page.

(*e*) *Welcome's Tm.*, 32 C. D. 76; 3 R. P. C. 213 (1886); *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), both Chitty, J.

(*f*) *Supra*.

fore also the trade-mark rights attached to it. "The only question I have to determine," he said, "is whether one year and nine months is sufficient cesser on the part of Mr. Ralph to show that he comes within the (34th) rule. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the Companies Act you may wind up a company if it has ceased to carry on business for a year. The legislature in that has shown by its enactment when a business is supposed to be carried on, and what amount of cesser shows that the business is not being carried on." And it made no difference, he held, that the cessation of business was due to the ill-health of the proprietor.

3. Abandonment.

A trade-mark right, as any other right, can, of course, be abandoned by the owner; but so long as he remained the regi·red proprietor of the mark and carried on the business to which the mark was attached, it would be difficult, if not impossible, to show abandonment, unless, either by repeated and undisturbed infringements, or by the use of the mark by the proprietor himself in some way inconsistent with the maintenance of its character as a trade-mark, it had become a common mark so as to fall under the first case (*g*), or a case could be made by any particular defendant sued by the owner for infringement to show that he had been led by the conduct of the plaintiff to believe that the mark was a common mark, and so to set up an estoppel (*h*).

(*g*) *Ante*, p. 284.

(*h*) See the next chapter: estoppel, p. 330; acquiescence, p. 332; and delay, p. 333. See also *Browne* v. *Freeman*, 12 W. R. 305; 4 New Rep. 476 (1864), Wood, V.-C., where the dismissal, at his own request, of a previous suit by the plaintiff against the defendant to restrain the use by the latter of *Chlorodyne*, was treated as conclusive against him that he had no exclusive right to use the word. He brought a third suit in 1873, W. N. 178.

Agreement to abandon trade-mark.

The possible case of an agreement by the proprietor to abandon his mark stands by itself. The other party to the agreement, if sued for infringement, could no doubt rely upon it as a defence, and might possibly, if the mark were registered, obtain an order, by way of specific performance of an implied term in the agreement, that the proprietor should apply under sect. 91 to cancel the registration.

Not mere disuse.

Mere disuse of the mark does not amount to abandonment of trade-mark rights in respect of it. For "A man who has a trade-mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade-mark by not putting more goods on the market when it was glutted"(*i*). Accordingly, in the case cited, a mark was directed to be registered concurrently with a similar mark in the same class which had been previously registered, and which the Court refused to expunge, although the proprietor of the former mark, having adopted it in 1874 and used it largely in the two years following, from 1876 to 1882 had used it less and less, and had in the last-mentioned year forgotten, and ceased to use it altogether. He had not, however, broken up the moulds he used for the marked goods, or erased the mark from his books or price lists.

Adoption of a new mark.

The adoption of a new mark may be evidence of the abandonment of an old one (*k*). But the fact of itself is not conclusive, for it is no justification for the defendant to say, "The plaintiff has two ways of identifying his goods, and I have only stolen one of them" (*l*). And the fact that the owner of a word-mark uses it always in connection with his own name, is not conclusive to show that the mark is not a trade-mark, or that he has waived his rights in it as such (*l*).

Use in connection with the proprietor's name.

Neglect to prosecute infringements.

Neglect to proceed in respect of infringements, which do not amount to user sufficient to affect the distinctiveness of

(*i*) *Per* Chitty, J., in *Mouson* v. *Boehm*, 26 C. D. 398 (1884).

(*k*) *Lea* v. *Miller*, Sob. Dig. p. 305 (1876), Jessel, M.R.

(*l*) *Per* Wood, V.-C., in *Braham* v. *Bustard*, 1 H. & M. 447 (1863), (*Excelsior White Soap*).

the mark, does not affect the proprietor's rights if he is aware of the infringements (*m*), still less if he is not (*n*).

Old corporate mark.

A corporate trade-mark, not re-registered in the Sheffield Register before the 1st of January, 1889, is to be deemed to have been abandoned (*nn*).

4. Forfeiture of Right to Protection.

The forfeiture of the right of the proprietor of a trade-mark to have his trade-mark protected by the Court, is discussed elsewhere, under the head of defences to an action for infringement (*o*).

5. Removal of Mark from the Register.

Where the trade-mark has determined.

No provision is made in the present Act or rules for the removal from the register of marks in which the trade-mark rights have determined, except for non-payment of fees. For sect. 90 only applies to entries on the register originally made without cause (*p*), and rule 34 of the Rules of 1876 has not been renewed (*q*). But it is submitted that the Court has jurisdiction to order the registration of a mark, which is no longer a trade-mark, to be expunged, on the ground that the register is intended by the Acts to be a register of trade-marks only (*r*). The Court is not, however, constituted the custodian of the register by any part of the Acts, but is expressly empowered by sections 90 and 92 to make orders affecting it in the cases included under the sections respectively. In *Welcome's Case* (*s*), Chitty, J., upon an application under sect. 78, directed an assignment to be registered, although that section contains no reference to the Court, or to rectification of the register; but the question of jurisdiction, so far as can be gathered from the report, was not argued.

(*m*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Ford* v. *Foster*, L.R. 7 Ch. 611 (1872), L.JJ.

(*n*) *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C. See the next chapter, p. 333.

(*nn*) Sect. 81 (9).

(*o*) Chap. XV., p. 336.

(*p*) Chap. XI., p. 220.

(*q*) Above, p. 288.

(*r*) See sect. 78.

(*s*) 32 C. D. 213; 3 R. P. C. 76 (1886).

Possibly, however, the intention of the legislature was to leave a registered mark in respect of which the trade-mark right had determined by abandonment, or otherwise, upon the register, as an obstacle to the registration of similar marks for the same goods or description of goods, until it should be removed under the provision next referred to.

It is provided by sect. 78, that :—

For non-payment of fees.

"(1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade-mark, the comptroller shall send notice to the registered proprietor that the trade-mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall, at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

"(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

Restoration of the mark.

"(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may without removing such trade-mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

"(4.) Where after the said three months a trade-mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade-mark to the register, on payment of the prescribed additional fee.

Removed mark an obstacle to later registrations.

"(5.) Where a trade-mark has been removed from the register for non-payment of the fee, or otherwise, such trade-mark shall nevertheless for the purpose of any application for registration during *the five years* [one year] (*t*) next after the date of such removal, be deemed to be a trade-mark which is already registered [unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under the proprietor or under his bankruptcy is using the trade-mark]" (*t*).

The section corresponds to rules 30 to 33 of the old rules of 1876.

Sub-sect. (5) refers to sect. 72 (*u*). It is directed to prevent the registration by another trader for the same goods or description of goods, of a mark the same as the removed mark, or having such resemblance to it as to be calculated to deceive, until such time after the removal of the other as is considered sufficient to allow the other to be forgotten, so that the new mark may not be taken for that of the proprietor of the old mark. The period provided for by the Act of 1883 was five years, but this was altered by the Act of 1888 to one year on the recommendation of Lord Herschell's Committee (*x*). With their approval also the proviso "unless, &c." was added at the end of the sub-section, it being considered unnecessary to refuse the re-registration of the mark for a year if the late proprietor were dead or bankrupt, and no one claiming under his bankruptcy were using the mark, and if any other successor to his business neglected to pay the fee.

A new mark may be deceptive by

Notwithstanding the amendments, it is assumed that so long as the recollection of the removed mark survives in

(*t*) Act of 1888, sect. 19.
(*u*) Chap. X. p. 175.
(*x*) Report of 1888, p. xiii.

resemblance to a removed mark.

the trade, the use of it, or a mark resembling it, might be calculated to deceive, and might therefore be properly refused by the comptroller under sect. 73, or in his discretion.

Cause of removal to be registered.

It is provided by rule 47 that: "Where a trade-mark has been removed from the register for non-payment of the prescribed fee or otherwise, under the provisions of sect. 79 of the said Act, the comptroller shall cause to be entered in the register a record of such removal and the cause thereof."

Fees.

The fee for continuance of a registered mark at the expiration of fourteen years is 1*l.* Where the fee is not paid within three months after the expiration of the fourteen years there is an additional fee of ten shillings. The additional fee for restoration of a trade-mark where it has been removed for non-payment of the fee is 1*l.* (*y*). The forms of applications for continuance and restoration are forms X, Y, and Z (*z*).

Forms.

(*y*) Appendix, p. 606.

(*z*) *Ibid.*, p. 616.

CHAPTER XV.

THE ACTION FOR INFRINGEMENT.

PAGE

Comparison with passing off action 296

1. Commencement of the action 298
in what court 298
service out of the jurisdiction 299
notice of action unnecessary 300

2. The plaintiff's title 301
joint trade-marks 301
contract for exclusive sale 302
one of several proprietors may sue 302
action by executors.. 303

3. Registration 303
registration of assignment 304
registration as evidence of title 304

4. What constitutes infringement 305
definition 305
isolated act of infringement 306
use on goods which are not the plaintiff's 308
(A) WHERE THE DEFENDANT COPIES THE PLAINTIFF'S MARK OR PRETENDS THAT IT IS HIS OWN 312
(B) WHERE HE COPIES AN ESSENTIAL FEATURE OF IT 313
(C) WHERE HIS MARK IS A COLOURABLE IMITATION OF IT 314
test of infringement 314
actual deception need not be proved 316
nor intention to deceive 316
what resemblance is calculated to deceive 318
principles of comparison summarised 318
what importance is to be attached to differences between the marks 322
inconspicuous additions or explanations: "late of," "from," "equal to" 322

5. Defences 323
ATTACK ON THE PLAINTIFF'S TITLE OR THE REGISTRATION OF HIS MARK 324
CONCURRENT OR INDEPENDENT RIGHT 325
registration of the defendant's mark 327
introduction into a new market 328
trade-marks on dissolution of partnership 329
or bankruptcy 329
honest use of defendant's own name 330
ESTOPPEL 330
(a) personal estoppel 330
agreement to condone infringement 330
uncandid conduct 331
use of mark in unregistered form 331
(b) acquiescence 332
licence 333

5. Defences—*continued.*
ESTOPPEL—*continued.* PAGE
(c) delay 333
delay may modify the relief, or amount to abandonment .. 334
it has a bearing on the evidence 335
(d) deceptive trade-mark or fraudulent trade 336
collateral misrepresentation 336
it is immaterial that the misrepresentation is too gross to deceive 339
false claim of patent rights 339
"trade-mark" affixed to part of mark only 343
false assertion of registration 345
other misleading statements 346
fraudulent trade 346
Havana cigars 347
misrepresentation after action commenced 347
6. The relief granted 348
I. INJUNCTION 348
form 350
restricted to future consignments or a particular market .. 351
refused because of delay 353
interim injunction 354
enforcement of the injunction 355
choice of a new mark by the defendant 356
delay in application to commit 356
II. DELIVERY UP OF THE MARKED ARTICLES 357
erasure of the spurious marks 357
bailee is not bound to deliver spuriously marked goods .. 358
III. DAMAGES 359
where the plaintiff is not solely entitled 360
IV. ACCOUNT OF PROFITS 360
refused or limited because of delay, &c. 362
form of order 362
costs of inquiry or account 363
7. Costs 364
infringer must offer complete redress 364
stay of action 366
not given in trivial cases 366
where the plaintiff claims too much 366
successful defendant may be refused costs 367
costs on appeal 368
higher scale 369
certificate under sect. 77a, solicitor and client costs 370
costs of motion to rectify 370
8. Appeal 371
9. Practice 372
pleadings 372
particulars 373
discovery 374
inspection 375
evidence 376

Actions for infringement of trade-mark and actions.

IT is convenient to deal with actions which are brought to prevent or to recover damages for the infringement of trade-marks, and with what are compendiously described

as "passing off actions," separately. In an action of the first class the plaintiff complains that the defendant has infringed his trade-mark by taking it in its entirety, or by taking a substantial portion of it, or colourably imitating it, and he relies on his title to the exclusive use of the mark in question for goods of a specified kind; in an action of the second class the plaintiff's case is less specialized, for he complains that the defendant is using means which are calculated to pass off, or to cause to be passed off, the goods of the defendant as and for those of the plaintiff, and the means may or may not comprise or consist of an infringement of a trade-mark to which the plaintiff has a title. The distinction between the two classes of actions has been accentuated by the provision, already discussed, which makes registration a condition precedent in general to the institution of actions ranking in the first class, that is, trade-mark actions proper (*a*). They are, however, closely connected, and in practice they are frequently combined, the statement of claim alleging both infringement and passing off. The first class is in reality a specialized variety of the second, having been divided off from other passing off actions when property in a trade-mark was first adopted as the ground of jurisdiction (*b*). And as the test of infringement is still whether, by reason of its resemblance to the plaintiff's mark, the defendant's mark is calculated to lead purchasers to believe that the goods on which it appears are those of the plaintiff, every case of infringement would be a case of passing off; but that where the actual mark is taken, or an obvious imitation is made, the Court does not trouble to inquire whether deception is likely to result, and, in the former case, it seems that it is precluded, by the provision that registration after five years shall give an exclusive title to the use of the registered mark, from doing so (*c*).

for passing off.

(*a*) Chap. XII., p. 260.
(*b*) Chap. I., pp. 4 and 13.
(*c*) Sect. 76, Chap. XII., p. 255; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

1. Commencement of the Action.

In what Court a trade-mark action should be commenced.

The great majority of actions in respect of the infringement of trade-marks are commenced in the Chancery Division of the High Court (*d*), but such actions are not specially assigned to that division, and they have been occasionally transferred from it to the Queen's Bench Division in order to be there tried by a jury (*e*). This

Jury.

was done by Kay, J., in a case where the defendant submitted to a perpetual injunction and the question of damages only remained, on the ground that in trade cases a jury is the best tribunal to assess damages (*f*); but in an earlier case, where the right to the injunction was contested, the defendants having given notice requiring the trial to be by a judge and a special jury, Bacon, V.-C., ordered that the action should be by a judge alone (*g*), and the last-named judge also refused to order the transfer of the complicated and difficult case of *The Singer Manufacturing Co.* v. *Loog* (*h*) to be transferred to the Common Law Division so that the issues involved might be there tried with a jury, on the ground that the questions to be determined involved matters of law as well as fact, and were unfit to be dealt with by a jury.

Jurisdiction of the County Court.

An action for damages not exceeding 50*l.* for infringement of a trade-mark, might probably be brought in the County Court, for it is a personal action, and does not fall within any of the exceptions of the County Courts Act, 1888, s. 56. In practice, however, such a course is rarely, if ever, adopted, and it was certainly not contemplated when the Trade-Mark Acts were passed; for the Court upon which jurisdiction is conferred to rectify the register, to

(*d*) Or the Court of Chancery of the County Palatine of Lancaster. This Court has jurisdiction under the Patents, &c. Acts, sect. 112a (Act of 1888, sect. 26).

(*e*) See *Re Martin*, *Hunt* v. *Chambers*, 20 C. D. 365 (1882); and Ord. 36, r. 6.

(*f*) *Fennessy* v. *Rabbits*, 56 L. T. 138 (1887).

(*g*) *Spratt's Patent* v. *Ward & Co.*, 11 C. D. 240 (1879).

(*h*) 11 C. D. 656 (1879). In *Fennessy* v. *Clark*, 37 C. D. 184 (1887), the issues of fact were ordered to be tried by a judge and special jury.

grant certificates to a successful litigant entitling him to solicitor and client costs (*i*) in future actions respecting the same mark, and for other purposes, is the High Court (*k*). It has been held that an action for the infringement of a patent, the validity of which is disputed, cannot be brought in the County Court, on the ground that a patent is a franchise within the section 56 above mentioned (*l*); and in the judgments in the case referred to, some stress is laid upon the fact that the Patents, Designs, and Trade-Marks Act of 1883 does not contemplate that patent actions should be brought in a County Court, but this was not, and, it is submitted, could not have been, the ground of decision; for if the jurisdiction to try either patent or trade-mark actions exists in the County Court it is much older than the Act of 1883, and as a trade-mark right is not a franchise, the decision does not modify the jurisdiction to determine trade-mark actions which is apparently conferred by the County Courts Act.

Service out of the jurisdiction.

Service of the writ out of the jurisdiction may be allowed if the case falls under any of the classes enumerated in Order 11, rule 1, for instance, if the plaintiff seeks an injunction to restrain infringements within the jurisdiction; but if the defendant carries on business in Ireland or Scotland, and not at all, or only to an inconsiderable extent, in England, leave to serve the writ upon him in either of the first-mentioned countries will be refused, and the plaintiff will be left to pursue his remedies in the local courts (*m*). On this ground leave to serve out of the jurisdiction has been refused even where an application to register the defendant's mark has been pending before the comptroller in London, on which the same witnesses would be required as in the action (*n*), and also where a motion

(*i*) Sect. 77a (Act of 1888, sect. 18).

(*k*) Sect. 117; or the Palatine Court, sect. 112a.

(*l*) *Queen* v. *County Court Judge of Halifax*, (1891) 2 Q. B. 263, C. A.

(*m*) *Kinahan* v. *Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1890), Kekewich, J. As to the rectification of the registrations of marks belonging to foreigners, see Chap. XI., p. 240.

(*n*) *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

to expunge the defendant's mark was pending in the English Courts (*l*). In the former case (*m*) the refusal was based partly on the fact that if an injunction were granted it could not be enforced against the defendant personally in England, but only against his agents. But where a Scotch manufacturing company had three branches, and an important business in England, leave was granted to sue them here (*n*).

Actions by foreigners.

An alien, not being a subject of a country actually at war with England, if he is the proprietor of a trade-mark which exists as such in this country, may sue in the English Courts in respect of infringements by English traders (*o*). But sect. 77, prohibiting actions in respect of the infringement of unregistered trade-marks applies to trade-marks belonging to foreigners (*p*).

Notice of action is unnecessary.

No notice need be given to the alleged infringer before the action is brought (*q*), and the plaintiff's right to bring the action is not affected by the ignorance of the defendant of the plaintiff's claim to the mark, or the readiness of the defendant to cease the infringement when called upon to do so (*r*). "A plaintiff in these cases," Chitty, J., said, in *Upmann* v. *Forester* (*s*), "is placed in circumstances of difficulty, because if he were to give notice there is great probability of the defendant at once getting rid of the spurious articles before the plaintiff could interfere; and the plaintiff therefore would in many instances be affording the defendant an opportunity of doing what the injunction would have prevented. I well remember that the late

(*l*) *Kinahan* v. *Kinahan*, *supra*; cf. *King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350.

(*m*) *Marshall* v. *Marshall*, 38 C. D. 330 (1888), C. A.

(*n*) *Burland* v. *Broxburn Oil Co.*, 41 C. D. 542; 6 R. P. C. 482 (1889), Chitty, J.

(*o*) *The Collins Co.* v. *Brown*, 3 K. & J. 423 (1857), Wood, V.-C.; *The Collins Co.* v. *Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

(*p*) See *Goodfellow* v. *Prince*, 35 C. D. 9 (1886), C. A.; and above, Chap. XII., p. 264; although Malins, V.-C., expressed a contrary opinion in *Twentsche, &c.* v. *Ellinger & Co.*, 26 W. R. 70 (1877).

(*q*) *Pierce* v. *Franks*, 15 L. J. Ch. 122 (1846), Knight-Bruce, V.-C.

(*r*) *Burgess* v. *Hately*, 26 Beav. 249 (1858), Romilly, M.R.

(*s*) 24 C. D. 231 (1883).

"Master of the Rolls, Sir G. Jessel, stated that he was, when at the Bar, accustomed in cases like this to advise his clients not to give any notice, but to move at once" (*t*). And consequently the omission to give notice before action does not disentitle the plaintiff to costs (*u*).

2. The Plaintiff's Title.

The plaintiff must be owner of the trade-mark (*v*) which is alleged to have been infringed, and the onus of proving that he is entitled to the exclusive use of the mark for the particular class of goods (subject, if the case is so, to the concurrent rights of persons, other than the defendant, who are also owners of the same or a similar trade-mark) is cast upon him (*x*). So where a manufacturer, a shipper and a foreign consignee, devised a trade-mark in concert, and used it for goods sent by the manufacturer through the shipper to the consignee, and afterwards the manufacturer began to use it for goods not sent through the shipper, and the shipper for goods not obtained from the manufacturer, and cross-actions for infringement were brought by the shipper and the manufacturer, it was held that neither of them could make out a title to exclusive use, and both actions were dismissed (*y*). Joint trade-marks.

In a case where Messrs. Harper and Moore, the plaintiffs, had been the lessees of certain brickworks, and had been accustomed to make bricks of the clay produced by mines of which they were lessees also, and after the expiration of their leases, the defendants, who had obtained a lease of the brickworks only, advertised themselves as "E. & J. "Pearson (late Harper and Moore)," thereby suggesting

(*t*) 24 C. D. 231 (1883).

(*u*) See below, p. 364.

(*v*) The questions, What is a Trade-Mark, and, What can be Registered as a Trade-Mark, are discussed in Chap. II., p. 24; and Chap. VIII., p. 103.

(*x*) *Robinson* v. *Finlay*, 9 C. D. 487 (1877), C. A.

(*y*) Last case. A custom in Manchester, by which the shipper, in the absence of agreement, was the owner of the trade-mark, was alleged but not proved. *Jones' Tm.*, 53 L. T. 1 (1885), C. A., is a similar case. See also *Rivière's Tm.*, 53 L. J. Ch. 545; 53 L. T. 237 (1884), Pearson, J., cited p. 224.

that they were successors to the old brick-making business, Wood, V.-C., granted an injunction to restrain the advertisements, and he said he would have granted it as a matter of course had the owner of the mines been plaintiff in the suit. The learned Vice-Chancellor seems, therefore, to have been of opinion that both he and the plaintiffs were interested in the old firm name (*z*).

A mere importer has no title to sue for infringement of the trade-marks of the consignor or producer (*a*).

Where the plaintiff is the sole purchaser from the proprietor.

The plaintiff does not become owner of the trade-mark, or acquire any interest in it sufficient to enable him to sue for infringement, by a contract with the proprietor for the exclusive purchase of the marked goods consigned to a particular district (*b*); but it is submitted that if the contract were for the exclusive purchase of all the marked goods manufactured by the proprietor, so that no goods could be rightly marked which did not pass through the plaintiff's hands (subject to any question of registration (*c*)), he might maintain the action against any person who used the mark, or a spurious mark infringing it, on goods which were not the goods of the manufacturer. The question whether a trader, exclusively entitled by contract with the proprietor to purchase his goods, could rightly register the proprietor's mark as his own, of course with the proprietor's assent, was discussed but left undetermined in the *Apollinaris Case* (*d*).

Action by one proprietor or by several.

One or more of several persons concurrently entitled

(*z*) *Harpers* v. *Pearson*, 3 L. T. N. S. 647 (1860); cf. *Motley* v. *Downman*, 3 My. & Cr. 1; 6 L. J. Ch. N. S. 308 (1837), Cottenham, L.C.

(*a*) *Hirsch* v. *Jonas*, 3 C. D. 584 (1876), Jessel, M.R.; see Chap. II., p. 49; and Chap. IV., p. 61; and *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

(*b*) *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J., leave to add the proprietor as plaintiff granted; cf. *Woolley* v. *Broad*, (1892) 1 Q. B. 806, exclusive licensee of registered design; and *Heap* v. *Hartley*, 42 C. D. 461 (1889), exclusive local licensee of a patent cannot sue.

(*c*) *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

(*d*) (1891) 2 Ch. p. 231; 8 R. P. C. 137, Fry, L.J.

may bring the action (*e*), and several plaintiffs so entitled may join together to sue although their interests are distinct and separate (*f*).

Plaintiff must use or intend to use the mark.

It would seem that the plaintiff must be using, or intending to use, the mark, for no damage would otherwise be occasioned to him by the infringement. It has been held that a mortgagee who does not intend to use the mark cannot bring an action in respect of its infringement (*g*), and intention to use is one of the conditions precedent to proper registration (*h*).

Action survives to executors, and they may sue.

Infringement of a trade-mark is an interference with a right of property injuring the personal estate of the owner, and consequently the right of action in respect of it is not determined by the death of the owner, and proceedings may be begun or continued (*i*) by his executors. Of course, if the executors have possession of the goodwill of their testator's business, and are carrying on his trade, they can themselves be registered, and can sue as owners of the trade-marks employed in the business and attached to the goodwill (*k*).

3. Registration.

Proof of registration of the trade-mark.

If the mark is capable of being registered, the plaintiff must, at the date of the hearing (*l*), be the registered proprietor, or be the successor in title of the registered proprietor, and if the mark is not capable of being registered, in the case of a mark in use before the 13th of August, 1875, the plaintiff must show that registration of it has been refused (*m*). In each case the registration and

(*e*) *Hine* v. *Larl*, 7 L. T. O. S. 41 (1846), Shadwell, V.-C.; *Southorn* v. *Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C.

(*f*) *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Southorn* v. *Reynolds*, 12 L. T., N. S. 75 (1865), Wood, V.-C.

(*g*) *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J., a Trade-Name Case.

(*h*) *The Apollinaris Co.'s Tms.*, (1891) 2 Ch. p. 233; 8 R. P. C. 137; see Chap. VIII., p. 110.

(*i*) *Oakey* v. *Dalton*, 35 C. D. 700; 4 R. P. C. 313 (1887), Chitty, J.

(*k*) See Chap. XIII., p. 272; and *Massam* v. *J. W. Thorley's Cattle Food Co.*, 6 C. D. 574; 14 C. D. 748 (1877), Malins, V.-C., and C. A.

(*l*) *Hazzopulo* v. *Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.

(*m*) Sect. 77; see Chap. XII., p. 261.

the name of the registered proprietor, or the refusal, must be shown by the certificate of the comptroller (*n*), and by sealed and certified copies of or extracts from the register (*o*).

Registration of assignment is unnecessary before action.

But the registration of the successor in title of the original proprietor—his assignee for instance—is not necessary to enable the successor to sue (*p*).

Registration is evidence of title.

The registration of a person as proprietor of a trade-mark is *primâ facie* evidence of his right to the exclusive use of his trade-mark, and is (in the absence of an application to rectify the register (*q*)), after five years from the date of the application for registration (*r*), conclusive evidence of such right (*s*).

So that after five years (*t*), the question whether the mark was capable of registration, and therefore the subject of trade-mark rights under the Acts, cannot be raised against the plaintiff (*u*), unless an application to rectify the register is before the Court. Other objections may, however, be taken; it may be shown, for instance, that the plaintiff does not possess the goodwill of the business to which the mark is attached (*x*).

And, it is submitted, the question whether the registered proprietor was entitled to the mark when he caused it to be registered, cannot be raised under such circumstances. The dictum of Fry, L.J., in *The Apollinaris Case*,

(*n*) Sects. 77 and 84.

(*o*) Sects. 88 and 89.

(*p*) *Ihlee* v. *Henshaw*, 31 C. D. 323 (1886), North, J.

(*q*) Chap. XII., p. 258.

(*r*) Sect. 75 (Act of 1888, s. 17).

(*s*) Sect. 76; Chap. XII., p. 255.

(*t*) In *The Apollinaris Co.* v. *Snook*, 7 R. P. C. 474 (1890), although the mark had not been registered for five years, Kekewich, J., refused to listen to an argument that it ought not to have been registered; but, apparently, his attention was not called to the point in question. And in *Compagnie Générale* v. *Rehder*, 5 R. P. C. 65 (1887), Kay, J., took a similar course upon an application for an interim injunction. In *Stuart* v. *Scottish Val de Travers Co.*, 13 Ct. of Sess. Ca. 1 (1885); and *Lever* v. *Goodwin*, 4 R. P. C. 492 (1886), Chitty, J., objections to marks registered for less than five years were allowed at the hearing, there being no application to rectify.

(*u*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

(*x*) *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

that "a man who puts another's trade-mark on the register cannot be a person entitled under the Act" (*y*), was made in a case founded on an application to rectify, and was not, therefore, directed to the operation of sect. 76.

Registration modified by a disclaimer or otherwise.

But the registration is, of course, evidence only of such title as it shows, and the plaintiff's right is, accordingly, subject to the modification imported by any note or limitation entered upon the register in connection with it. In particular, if there is a disclaimer of part of the registered mark, the registered proprietor has no title to sue in respect of an alleged infringement effected by the adoption of such part of the mark, for the disclaimer is an indication to all the world that he has no monopoly whatever in the use of that part (*z*).

By concurrent rights.

And the right to exclusive use, of which registration is evidence, is subject to the concurrent and independent rights, if any exist, of other persons to use the mark whether they have obtained registration or not (*a*).

Plaintiff's title determined or barred.

The five years' registration does not, it is submitted, prevent the defendant, although he has made no application to rectify, or although the Court has no jurisdiction to entertain any such application which he has made, from setting up as a defence that the plaintiff's right has determined by abandonment or otherwise, or has been wholly assigned to another (*b*). And it is, of course, no answer to a personal bar which disentitles the plaintiff to sue.

4. What constitutes Infringement.

Infringement is the use by the defendant, for trading purposes (*c*) in connection with goods of the kind for which

(*y*) (1891) 2 Ch. 186; 8 R. P. C. 137. The importers had registered the mark of the owners of the spring.

(*z*) *Rosenthal* v. *Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J.; *Pirie* v. *Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, C. A.; Chap. IX., p. 173.

(*a*) See below, p. 325.

(*b*) This follows from the fact that an unregistered assignee can sue, see p. 304.

(*c*) Page 307.

the plaintiff's right to exclusive use exists (*d*), (*i. e.*, for which his mark is registered and used), not being the goods of the plaintiff (*e*), of a mark identical with (*f*) the plaintiff's mark, or either comprising some of its essential features or colourably resembling it (*g*), so as to be calculated to cause the goods to be taken by ordinary purchasers (*h*) in any market where the marks circulate (*i*) for the goods of the plaintiff.

Inferiority of the defendant's goods.

It was originally an element of the right of action for infringement at common law, that the goods sold by the defendant as and for the goods of the plaintiff were inferior in quality to the genuine goods of the latter, but it has long been settled that the question of the relative qualities of the plaintiff's and the defendant's goods is not relevant to the title to maintain either action for infringement or "passing off" (*k*), and it has, accordingly, no place in the above definition. It may, however, affect the amount of the damages to be recovered by the plaintiff if he succeeds, for damages are sometimes claimed and allowed in respect of injury occasioned to the trade reputation of the plaintiff by the defendant's infringement or fraud; but if the defendant's goods are as excellent as his own, the reputation of the plaintiff cannot have been injured.

Single act of infringement.

The Court has refused to regard an isolated act, done at the request of the plaintiff's agent, who was laying a trap for the defendant, as an infringement (*l*). This must be

(*d*) Page 308.
(*e*) Page 309.
(*f*) It is usually so expressed. What is meant is, of course, "similar to"; but "similar to" and "resembling" are constantly used to convey the proper meaning of the latter word; see *Welch* v. *Knott*, 4 K. & J. 747 (1857), Wood, V.-C.
(*g*) Page 314.
(*h*) Page 318.
(*i*) Page 307.
(*k*) *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833); *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; and see *per* Lord Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 4 App. Cas. p. 20.
(*l*) *Hennessy* v. *Kennett*, Seb. Dig. p. 331 (1877), Malins, V.-C.; cf. *Leahy, Kelly & Leahy* v. *Glover*, 10 R. P. C. 141 (1893), where a single instance of the sale of goods

taken as a special case, however, for, in general, proof of a single act of infringement by the defendant is sufficient to justify the plaintiff in bringing his action, and the evidence relied on is frequently the sale by the defendant of the spurious goods to the plaintiff or his agent, who has bought them merely for the purpose of procuring evidence.

Defendant must use or intend to use the marked goods for trading purposes.

The defendant must be shown to have used or intended to use the goods marked with the spurious mark for trading purposes, whether for sale or as samples to enable him to sell similar goods,—and whether these are or are not themselves so marked,—for the essence of the wrong is that purchasers of the spuriously marked goods are defrauded, and the plaintiff incidentally suffers by the loss of their custom which would or might, but for the fraud, come to him (*m*). But the Court will not readily believe that the defendant does not intend to use vendible goods marked with the spurious mark for trading purposes if they are found in his possession, and either he is a trader in goods of the kind, or the quantity of the goods is considerable (*n*). So, where the defendant, a china manufacturer, had imported 5,000 spuriously marked cigars, he was held liable, although he did not know that the mark was spurious, and said that he intended the cigars "for family use."

Infringement must be in the plaintiff's market.

And the infringement must occur in a market where the plaintiff's mark circulates. But this condition is fulfilled if the areas of the trades of the plaintiff and defendant, although substantially local and distinct, are beginning to overlap (*o*), or if the spuriously marked goods are brought by the defendant's shopwoman, not shown to have been with his authority, was considered insufficient to support a case of passing off. In *Tonge* v. *Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.; and *Twentsche* v. *Ellinger*, 26 W. R. 70 (1877), Malins, V.-C., the defendants were held liable for infringements by their agents without their knowledge.

(*m*) *Levy* v. *Walker*, 10 C. D. 436 (1879), C. A.; *Richards* v. *Butcher*, 7 R. P. C. 288 (1890), Kay, J.

(*n*) *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.

(*o*) *Paine & Co.* v. *Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, (*John Bull Beer*). Chap. X., p. 184.

into this country for export to a country where the plaintiff's trade and marks are known (*p*).

Defendant must use the mark upon the goods for which the plaintiff's right exists,

The use must be in connection with the goods for which the plaintiff's right exists. "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract. Thus, an iron-founder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed on cotton or woollen goods; for a trade-mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity" (*q*). And the third essential ingredient for constituting an infringement, enumerated by the judge just quoted in *McAndrew* v. *Bassett* (*r*), is "that the defendants have imitated the mark for the purpose (*s*) of passing in the market other articles of a similar description."

The limits of the class of goods over which the right in respect of a registered mark extends have been discussed already (*t*), and the class has been shown to be not necessarily co-extensive with any register class (*u*), and it has also been shown that the registered proprietor's right ought to be limited, and the registration to be restricted to the kinds of goods upon which he actually uses or intends to use the mark, and in which he possesses the goodwill of the business to which the trade-mark is attached (*x*).

and is registered,

The plaintiff cannot sue for infringement in respect of

(*p*) *Joseph Rodgers & Sons* v. *Rottgen*, 5 Times L. R. 678 (1889), Kay, J.; *Tm. of the Société, &c. des Verreries de l'Etoile*, (1894) 1 Ch. 61; (1894) W. N. 42; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A., (*Red Star Glass*).

(*q*) *Per* Lord Westbury, in *Hall* v. *Barrows*, 4 De G. J. & S. 150 (1863).

(*r*) 4 De G. J. & S. 330 (1863).

(*s*) Fraudulent intent is not now essential, *post*, p. 316.

(*t*) Chap. V., p. 87, and Chap. XII., p. 256.

(*u*) Marks may be calculated to deceive, though in different register classes, p. 180; *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A., (wines and spirits); *Eno* v. *Dunn*, 10 R. P. C. 261 (1893), Kekewich, J., (an aperient drink and baking powder); *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J., (beer and rum).

(*x*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A., cited p. 88.

goods for which his mark is not registered (*y*), although, if he can make a case, he may sue to restrain passing off. And if his mark is registered generally for a register class which includes a kind of goods for which he does not use it, or for which it is unsuitable, it is not to be considered as registered for such goods. Thus, the proprietor of a mark registered for class 45, "tobacco whether manufactured or unmanufactured," used it only for cut tobacco, and the mark contained the words *Three Crowns Mixtu.* It was held that he could not sue to restrain an infringement in respect of cigars (*z*). and used.

Further, the use of the defendant's mark, which is relied on as an infringement, must be a use upon goods which are not those for which the plaintiff's mark is properly used, for anyone may use the plaintiff's mark on the plaintiff's goods, since that cannot cause the deception which is the test of infringement (*a*). So the retailer of goods obtained from the plaintiff may lawfully place or renew (*b*) the labels upon them, and have sufficient labels printed for the purpose (*c*). In the case last cited, the defendant failed to satisfy the jury, in an action at common law, that he had in fact printed the labels only for use on the genuine goods of the plaintiff; and the injunction, which had been granted in a suit in Chancery by Wood, V.-C., and dissolved on appeal by Cranworth, L.C., was accordingly restored (*d*). The rule just stated is well illustrated by *The Angostura Bitters Case*, where the injunction granted was so expressed as not to prevent the name being applied to an article identical with the plaintiff's, **The infringement must be in respect of spurious goods.**

(*y*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*z*) *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; and see *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J. A person who does not use the mark at all cannot sue; last case, and *Delondre* v. *Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.

(*a*) Chap. II., p. 32.

(*b*) *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*c*) *Farina* v. *Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855).

(*d*) 4 K. & J. 650 (1850).

should any other person discover the secret of manufacture and make the goods (*e*).

Adulterations, and goods comprising authentic parts.

But goods of the plaintiff, adulterated by some other person (*f*), are not goods on which the mark may lawfully be placed; nor is the manufacture by the defendant of an article made up of several parts the less an infringement because one genuine part of the plaintiff's manufacture, and bearing his mark, is included in it (*g*).

What connection with the spurious goods is sufficient.

It is not necessary that the spurious mark should be actually affixed to the goods, provided it is so used in connection with them as to be calculated to cause them to be taken for the plaintiff's goods (*h*). Use on the wrapper in which they are sold, or upon a slip placed in the package with them, or in circulars or advertisements offering them for sale is sufficient (*h*). So printing the plaintiff's trade-mark labels, without showing that they were for use on genuine goods only (*i*), or using the plaintiff's marked or stamped bottles (*k*), casks (*l*), or boxes (*m*) for goods other than his genuine goods, is an infringement, unless the Court is satisfied that the use under the circumstances is not calculated to deceive (*n*).

But the use of a descriptive word registered as an old trade-mark, not in connection with the goods, but in price lists referring to them only, has been held to be no infringement (*o*).

In a recent case Vaughan Williams, J., said: "I am,

(*e*) *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J.

(*f*) *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*g*) *Richards* v. *Williamson*, 30 L. T. N. S. 746 (1874), Bacon, V.-C., a gun with stamped lock.

(*h*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*i*) *Farina* v. *Silverlock*, note (*c*); *Guinness* v. *Ullmer*, 10 L. T. O. S. 127 (1847), Shadwell, V.-C.

(*k*) *Rose* v. *Henley*, 47 L. J. Ch. 577 (1877), Malins, V.-C.; *Rose* v. *Loftus*, *ibid.*

(*l*) *Hennessy* v. *Cooper*, Seb. Dig. p. 327 (1877), Malins, V.-C.

(*m*) *Barnett* v. *Leuchars*, 13 L. T. N. S. 405 (1865), Stuart, V.-C.

(*n*) As in *Welch* v. *Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

(*o*) *Talbot* v. *Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C., (*Baffle*, for safes); cf. "Singer system," in *Singer* v. *Loog*, 8 A. C. 15 (1882), H. L.; and above, p. 38.

"for my own part, not at all sure that you can prove an infringement of a trade-mark without proving that the defendants have imitated the plaintiffs' trade-mark upon something capable of receiving the impression of the mark. Either the material itself, or the paper which is used, or the sacks, or bags, or boxes, or whatever it is that the material is put into, I should have thought must have been imitated to constitute an infringement of a trade-mark" (*p*). The question actually decided in the case was that the sale of goods by the descriptive name *Rugby Cement* was not an infringement of a trade-mark comprising those words; and the decision was undoubtedly correct; but it is submitted, with great deference, that, had the words been distinctive and an essential feature of the mark, it would have been an infringement to use them to effect the sale of goods other than those of the plaintiffs. The distinction between cases where a name or device taken from a trade-mark is affixed to the goods, and cases where a name so taken is used in respect to them,—for instance, in advertisements to push their sale,—and the rule that fraud must be proved in cases of the second class, which were laid down by Jessel, M.R., and adopted by the Court of Appeal (*q*) in *The Singer Manufacturing Co.* v. *Wilson*, were not approved by the House of Lords (*r*). The abstract question is, however, of little or no importance, since, in the case put, the words would almost necessarily come by the legitimate user of the mark to denote the plaintiff's goods, and the use of them by the defendant, in any manner calculated to deceive, could be restrained in a "passing off" action. "It will be observed," Fry, J., said, in *The Linoleum Case* (*s*), "that the inquiry with regard to the use of the word *Linoleum* as a constituent element in the trade-mark,

(*p*) *Rugby Portland Cement Co. Ld.* v. *Rugby and Newbold Portland Cement Co., Ld.*, 8 R. P. C. 241; affirmed on appeal, 9 R. P. C. 46 (1891).

(*q*) 2 C. D. 434 (1874).

(*r*) 3 App. Cas. 376; see Lord Cairns' judgment, cited Chap. II., p. 14.

(*s*) *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. p. 836 (1878).

"and the inquiry as to the use of the word *Linoleum* as a misrepresentation, are one and the same inquiry, and I must consider what the word *Linoleum* meant as used at the time when the defendants intended to attribute it to their manufacture."

The infringing mark may either (a) be an actual or substantial copy of the plaintiff's mark; (b) consist of or comprise its essential features; or (c) be a colourable imitation of it.

Where the plaintiff's mark has been copied.

(a) The first case presents no difficulties. By sect. 76, the registration of the plaintiff as proprietor of the trade-mark is *primâ facie* evidence, and, after five years (in the absence of an application to rectify), is conclusive evidence of his right to the exclusive use of the trade-mark (*t*). The registered proprietor can therefore make a case in an action for the mere using of his mark in connection with goods of the class over which his right extends, without showing that the use is calculated to deceive (*u*). And this is not, substantially, an alteration of the law as it stood before the Acts (*x*), if registration be taken as equivalent to public user, although proof of the probability of deception was usually, but not invariably (*y*), mentioned as an element of right of action; for if the defendant had taken a "material and substantial" portion of the plaintiff's mark, and, *à fortiori*, if he had taken the whole, the onus of showing that his conduct was not calculated to deceive was cast upon him (*z*), and it was,

(*t*) Above, p. 304.

(*u*) See the judgment of Cotton, L.J., in *Edwards* v. *Dennis*, 30 C. D. 454 (1885).

(*x*) Cf., with the judgment last referred to, that of Hall, V.-C., in *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874).

(*y*) For instance, see the judgment of Jessel, M.R., in *The Singer Manufacturing Co.* v. *Wilson*, 2 C. D. p. 422 (1875). "The right which a manufacturer has in his trade-mark is the exclusive right to use it for the purpose of indicating where, by whom, or at what manufactory, the article to which it is affixed was manufactured," *per* Lord Cranworth, in *The Leather Cloth Case*, 11 H. L. C. p. 533; 35 L. J. Ch. 53 (1865).

(*z*) *Ford* v. *Foster*, 7 Ch. 611 (1872), James, L.J.; *Orr-Ewing* v. *Johnston*, 13 C. D. 434 (1879), Fry, J., and C. A.

practically, at any rate, impossible for him to support it. Moreover, unless he could give a reasonable explanation to show how he came to adopt a mark identical with that of the plaintiff, the Court would infer that he intended to deceive (*a*), and would not consider whether or not his attempt was likely to be successful (*b*).

False claim to the plaintiff's registered marks.

The infringement proved in *Paine & Co.* v. *Daniells & Sons' Breweries* (*c*) was effected in a very unusual way. The plaintiffs' marks consisted of labels bearing a figure of John Bull, and the words *John Bull* and *John Bull Brand*. The defendants used a label bearing a different figure of John Bull, with the words *John Bull, Registered*. Their label, though entered as their copyright at Stationers' Hall, had been, in 1885, refused registration as a trade-mark, on the ground of the plaintiffs' opposition, but they had, notwithstanding the refusal, continued to use it in their business. Although the labels had been in use so long, no evidence of actual deception was tendered, for the trades of the plaintiffs and defendants had been carried on in different districts, and were only beginning to overlap at one point at the date of the trial. There was no other evidence than that furnished by the labels themselves, that the defendants' label was calculated to deceive; but the Court of Appeal regarded the false claim of registration in their label as amounting in effect to a representation that the plaintiffs' marks—the only John Bull marks which really were registered—were their own, and this was held to be an undoubted infringement (*d*).

Where an essential feature has been copied.

(b) The right of the registered proprietor exists in regard to the whole mark, not in regard to any particular part of it (*e*), and an infringement must be an infringe-

(*a*) See the last case, in the H. L., 7 App. Cas. 219; *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.

(*b*) See *per* Lindley, L.J., in *Slazenger* v. *Feltham*, 6 R. P. C. p. 538 (1889).

(*c*) (1892) 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

(*d*) *Lawrie* v. *Baker*, 2 R. P. C. 213 (1885), Day, J., is a similar case. There the defendant described his goods as *patent cups*, the plaintiff having the only patent.

(*e*) *Hudson's Tm.*, 32 C. D. 311;

ment of the whole mark (*f*). But the adoption of a single characteristic distinctive particular from the plaintiffs' mark, and its use alone, or with other matter, may well be an infringement of the entire mark. At any rate, it throws upon the defendant the onus of proving the contrary (*g*). But it is not an infringement to take non-essential particulars from a mark: for instance, to take merely descriptive or other common words (*h*).

Colourable Imitation.

Where there is a colourable imitation.

(c) A colourable imitation is the most common case, for, if the resemblance is intended, the defendant will have tried to introduce apparent differences sufficient to prevent the Court from interfering, while preserving a likeness which is near enough to enable him to profit by the reputation of the plaintiff's mark. So far as the Court succeeds in carrying into effect the principles which govern its interference, the two ends are inconsistent with each other.

The test of infringement.

In both the second and third cases the test of infringement is the question whether or not the defendant's mark is calculated to cause his goods to be taken by ordinary purchasers for the goods of the plaintiff (*i*), and the Regis-

3 R. P. C. 155 (1886), Cotton, L.J.; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), C. A.

(*f*) *The Rugby Portland Cement Co., Ld.* v. *The Rugby and Newbold Portland Cement Co., Ld.*, 8 R. P. C. 241 (1891), V. Williams, J.

(*g*) *Ford* v. *Foster*, 7 Ch. 611 (1872), James, L.J.; *Johnston* v. *Orr-Ewing*, 13 C. D. 434 (1879), Fry, J., and C. A.

(*h*) *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J., (*Linoleum*); *Watt* v. *O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M.R., (*Old Innisho.en*); *Humphries* v. *Taylor's Drug Co.*, 59 L. T. 820 (1888), Kekewich, J., (*Herbalin*); *Native Guano Co.* v. *Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L., (*Native Guano*); *Rugby Portland Cement Co., Ld.* v *Rugby and Newbold Portland Cement Co., Ld.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A.; cf. Chap. X., p. 201; and *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.

(*i*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; *Leather Cloth Co., Ld.* v. *The American Leather Cloth Co., Ld.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury, L.C.; and 11 H. L. C. 523; 35 L. J. Ch. 53.

tration Acts have made no alteration of the law in this respect (*k*).

"It is not a question whether this (the use of the defendant's mark) necessarily is deceptive, but whether there is not a strong probability of its causing deception" (*l*). So that the imitation of the plaintiff's mark cannot be justified by showing either that the device or inscription on the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled (*m*).

There can be no infringement, therefore, in cases where the plaintiff's mark is not actually copied if there is no reasonable probability of deception (*n*). It was held by the Court of Common Pleas, as early as 1847, that the following questions were properly left to the jury by Williams, J., in *Rodgers* v. *Nowill* (*o*):—(1) Whether there was such a resemblance to the plaintiffs' marks, in the marks put on the knives made by the defendants, as was calculated to make an ordinary person believe that the marks were the marks of the plaintiffs, denoting that the knives were the knives of the plaintiffs? and (2) Did the defendants, with an intention to deceive, sell these knives representing them to be the manufacture of the plaintiffs? It will be shown immediately that if the plaintiffs' mark was their trade-mark, the second question has long been held to be imma-

Questions for the jury.

(*k*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Singer Manufacturing Co.* v. *Loog*, 18 C. D. 395, C. A.; and 8 App. Cas. 15 (1870); *Edwards* v. *Dennis*, 30 C. D. 454 (1885), Cotton, L.J.

(*l*) *Per* Cotton, L.J., in *The Upper Assam Tea Co.* v. *Herbert & Co.*, 7 R. P. C. p. 186 (1889).

(*m*) *Per* Lord Selborne, in *The Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. p. 18 (1882).

(*n*) *Cope* v. *Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Beddow & Sons* v. *Boyd*, 4 R. P. C. 31[illegible]987), Chatterton, V.-C.; see also *Woollam* v. *Radclif*[illegible] 1 H. & M. 259 (1863), Wood, V.-C.; *Bradbury* v. *Beeton*, 39 L. J. Ch. 57 (1869), Malins, V.-C.; *Civil Service Supply Association* v. *Dean*, 13 C. D. 512 (1879), Malins, V.-C.; and *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., in all of which an injunction was refused.

(*o*) 5 C. B. 109; 17 L. J. C. P. 52.

terial, except so far as it dealt with the mere fact of the sale of the knives.

Actual deception need not be proved;

Proof of actual deception, if the mark is, in the opinion of the Court, calculated to deceive, or if the plaintiff's registered mark has been substantially copied (*p*), is unnecessary, although the absence of it, where the plaintiff's and defendant's marks have circulated side by side for a considerable time, may go far to negative the probability of deception, unless it is explained, for instance, by the practical impossibility of calling evidence from a distant country to show that purchasers there have been deceived (*q*). The plaintiff is not bound to wait to see whether his customers will, in fact, be deceived, for "the very life of a trade-mark depends upon the promptitude with which it is vindicated" (*r*).

nor yet an intention to deceive.

Nor, where the defendant's mark has in fact deceived, or is, in the opinion of the Court, calculated to do so, is it necessary to show that the defendant intended to deceive. This was first decided by Lord Cottenham, in *Millington* v. *Fox* (*s*) as regards the relief by an injunction, and by Lord Westbury, in *Edelsten* v. *Edelsten* (*t*), as regards both injunction and account. It is now well-settled law (*u*). The dictum of Lord Chelmsford, in *The Glenfield Starch Case*, that where the trade-mark is not actually copied, fraud is a necessary element in the plaintiff's case—"that is, the party accused of piracy must be proved to have done the act complained of with the fraudulent design of passing off his own goods as those of the party exclusively entitled to the trade-mark" (*v*), and of Jessel, M.R., and the Court of Appeal, in *The Singer Manufacturing Co.* v.

(*p*) Above, p. 312; and see *Paine & Co.* v. *Daniells & Sons' Breweries*, cited *ante*, p. 313.

(*q*) Page 206.

(*r*) *Johnston* v. *Orr-Ewing*, *per* James, L.J., 13 C. D. p. 464; and Lord Blackburn, 7 App. Cas. p. 230 (1880).

(*s*) 3 My. & Cr. 338 (1338).

(*t*) 1 De G. J. & S. 185 (1863).

(*u*) *Reddaway* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219 (1882).

(*v*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. p. 519 (1872).

Wilson (*x*), that, where the defendant has not actually put the plaintiff's trade-mark, or a colourable imitation of it, on his goods, or on the bottles or boxes containing them, but has otherwise acted so as to represent his goods as those of the plaintiff (*y*), a fraudulent intent must be proved, cannot now be taken to be law. In the former case, Lord Hatherley said it had been pointed out that a *mala fides* towards the first purchaser was not the ground of the Court's interference; for it is sufficient if such purchaser is furnished by the defendant with goods bearing a label, of which the necessary consequence is that he is enabled to deceive others by means of them (*z*). And in *The Singer Case*, Lord Cairns said: "I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade-mark" (*a*); and in this Lord O'Hagan concurred (*b*). Lord Blackburn said: "I am not as yet prepared to assent either to the position that there is a right of property in a name, or, what seems to me nearly the same thing, to assent to its full extent to the proposition that it is not necessary" (in trade-name cases) "to prove fraud" (*c*). But the last-mentioned judge, in a subsequent case, stated that he thought it clear, at any rate, that if the defendant persevered in using a trade-mark calculated to deceive after notice of the facts, that would be evidence to support a claim for damages for knowingly selling his goods as and for those of the plaintiff (*d*). "However honest or inadvertent the original

(*x*) 2 C. D. 432 (1875).

(*y*) As already shown, these may be cases of infringement if the representation is effected by using a mark in connection with the defendant's goods (though not on them) which resembles the plaintiff's mark, or by using a distinctive name taken from the plaintiff's mark; above, p. 310.

(*z*) L. R. 5 H. L. p. 517.

(*a*) 3 App. Cas. p. 391, quoted and adopted in *The Bodega Co., Ld.* v. *Owens*, 7 R. P. C. 31 (1889), Chatterton, V.-C.

(*b*) 3 App. Cas. 396.

(*c*) Page 403.

(*d*) *Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 31 (1882).

"mistake may have been, the continuation of the use of it after that was pointed out is of itself evidence of a fraudulent intention" (*e*).

And it has already been shown that the proprietor of a trade-mark may obtain an injunction against an innocent consignee of spuriously marked goods, and an order for the spurious marks to be expunged from the goods, without having given the defendant any notice before the commencement of the action (*f*).

What resemblance is calculated to deceive.

It follows that the question to be answered when an infringement without taking the actual mark is alleged, is the same question as arises when a mark tendered for registration is objected to, or, having been registered, is sought to be removed from the register, on the ground that it has such resemblance to a trade-mark already on the register as to be calculated to deceive, within the restriction of sect. 72 (2); and the principles governing the comparison of the marks, and determining what amount of resemblance is calculated to deceive, are the same in both cases, although a higher standard of resemblance must be conformed to in an action for infringement than that set up in cases of the other class. These principles have been already discussed at length (*g*), and it will, therefore, be sufficient in this place to shortly summarise the conclusions to be deduced from an examination of the authorities.

The probable purchasers are to be considered.

(1) The persons to whom the test question—Is the spurious mark calculated to deceive them?—is to be referred, are the persons who are probable purchasers, whether they buy, or are likely to buy, directly from the plaintiff or defendant, or from, or through, intermediate purchasers from either of them, whether they are English or foreign,

(*e*) *Per* James, L.J., in *Orr-Ewing* v. *Johnston*, 13 C. D. p. 454 (1880); see also *Paine & Co.* v. *Daniells & Sons' Breweries*, (1892) 2 Ch. 567; 10 R. P. C. 217, C. A.

(*f*) *Ante*, p. 300; *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.; *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

(*g*) Chap. X., pp. 186 *et seq.*

and not merely very careful or intelligent persons, but ordinary unwary purchasers (*h*).

The net impressions left by the marks are to be contrasted.

(2) No definite rule as to the amount of resemblance required can be formulated *à priori*, but the net impression produced, and "the main idea left on the mind" by each mark must be compared, for marks may well be confused by purchasers, who see the defendant's mark when they have present in their memories only an indefinite recollection of the plaintiff's, in cases where the marks could not be mistaken for each other if they were seen side by side (*i*). So that the whole mark of the defendant may too nearly resemble that of the plaintiff, although all the essential particulars of the two are distinguishable (*k*); but special regard must, nevertheless, be paid to the essential features of the plaintiff's mark in considering whether the defendant has infringed it (*l*).

The marks are to be considered as seen in ordinary use.

(3) Further, the marks must be compared as they are seen in actual ordinary use (*m*) on the goods they are used for; remembering, however, that so far as the plaintiff's mark substantially differs from the mark on the register, it is an unregistered mark (*n*).

Regard is to be paid to all the circumstances surrounding the marks in use.

(4) The circumstances of the trade and market in which the marks are used must be considered also,—the language of the purchasers, for instance, and the number of analogous marks in use in connection with the same goods (*o*).

Colour.

But, since colour is not admitted to consideration in estimating the distinctiveness of a mark tendered for registration (*p*), and cannot, on account of the practical difficulties, be registered as an essential element of a trade-mark, similarity of colour is not to be greatly relied upon in deciding a question of infringement (*q*), although it is an element to be considered.

(*h*) Page 186; and *Shrimpton* v. *Laight*, 18 Beav. 164 (1854), Romilly, M.R.

(*i*) Page 188.

(*k*) Page 192.

(*l*) Page 196.

(*m*) Page 193.

(*n*) Page 196.

(*o*) Page 198.

(*p*) *Hanson's Tm.*, 37 C. D. 132; 5 R. P. C. 130 (1887), Kay, J., above, p. 162.

(*q*) *Nuthall* v. *Vining*, 28 W. R. 330 (1880), C. A.

And, in particular, to the adoption of a special name for goods bearing the plaintiff's mark.

If the plaintiff's mark, or some feature of it, has led to the application of a particular name to his goods, it is an infringement for the defendant to use a mark which is calculated to cause the same name to be applied to his (*r*), unless the name is applied, not merely to the plaintiff's goods, but to all goods of the kind (*s*), for instance, because it is suggested by matter in the mark which is common to the trade (*t*); and the defendant's use of his mark is none the less an infringement of the plaintiff's rights, because the exclusive use of the name may give the plaintiff a practical monopoly in certain goods in a particular market (*u*).

What importance is to be attached to differences between the marks.

Attention must be paid, of course, not only to the points of resemblance between the marks, but also to the points of difference. But it will not be sufficient for the defendant to show that the differences might prevent purchasers being deceived, the Court must hold that they are "such as to prevent its being likely that they would be deceived" (*x*).

Instances of infringements by marks which prominently displayed the defendant's name.

In the following cases it was held that the use of words taken from the plaintiff's mark by the defendant was an infringement, notwithstanding that he always added his own name:—*Perry* v. *Truefitt*, 6 Beav. 66, PERRY'S MEDICATED MEXICAN BALM, TRUEFITT'S MEDICATED MEXICAN BALM; *Braham* v. *Bustard*, 1 H. & M. 447, BUSTARD & Co.'s EXCELSIOR WHITE SOFT SOAP; *Kinahan* v. *Bolton*, 15 Ir. Ch. 75, KINAHAN'S LL WHISKY, BOLTON'S LL WHISKY; *Ford* v. *Foster* (*y*), L. R. 7 Ch. 611, FORD'S EUREKA SHIRTS, FOSTER, PORTER & Co.'s IMPROVED EUREKA SHIRTS; *Eno* v. *Stephens*, Seb. Dig. p. 372; *Eno* v. *Dunn*, 10 R. P. C. 261, ENO'S FRUIT SALT, STEPHENS & Co.'s EFFERVESCING VINOUS FRUIT SALTS; DUNN'S FRUIT SALT AND CHLORATE OF POTASH LOZENGES. In *The Glenfield*

(*r*) Pages 199 *et seq.*
(*s*) Page 201.
(*t*) Page 202.
(*u*) Page 204.
(*x*) *Per* Lord Blackburn, in *Johnston* v. *Orr-Ewing*, 7 App. Cas. p. 230 (1882), quoted and followed by the Privy Council in *Somerville* v. *Schembri*, 12 App. Cas. p. 458; 4 R. P. C. 179 (1887)
(*y*) Cited, p. 37.

Starch Case (*z*), *Wotherspoon* v. *Currie*, 5 L. R. H. L. 508, the defendant's own name appeared in bold letters upon the infringing labels, and this was also the case in *Johnston* v. *Orr-Ewing*, 13 C. D. 434, and 7 App. Cas. 219, but there the Indian customers of the plaintiff could not, it was assumed, read English (*a*). So, in *Rose* v. *Loftus*, 47 L. J. Ch. 576, the defendant washed the plaintiff's labels off the bottles, leaving only the moulded marks, and pasted his own labels upon the bottles in their place, but was, nevertheless, held to have committed an infringement. And in *Curtis and Harvey* v. *Pape*, 5 R. P. C. 146, an imitation of a diamond mark was held to be an infringement, although the defendant put a K in the middle of his diamond which did not appear in that of the plaintiffs.

Different get-up.

On similar grounds it is held to be no excuse for a clear infringement of a trade-mark that the infringing mark is used upon goods of which the get-up differs *in toto* from that of the plaintiff's goods (*b*).

But the use of the defendant's name as part of the mark complained of is an element to be considered, and in some cases it has turned the scale in his favour. Thus, in *Beard* v. *Turner*, 13 L. T. N. S. 746, KIRBY'S NE PLUS ULTRA NEEDLES, on a label, was held not to be infringed by TURNER'S NE PLUS ULTRA NEEDLES on a label generally resembling the plaintiff's, the words NE PLUS ULTRA being common to the trade; and in *Blackwell* v. *Crabb*, 36 L. J. Ch. 504, BLACKWELL'S PICKLES on a label, not to be infringed by CRABB'S PICKLES on a label resembling the plaintiffs', the name of the manufacturer, under the circumstances of the case, being the thing which a customer would rely on most to establish the identity of the goods he wanted. In each of these cases the elements of all the labels were for the most part common to the trade.

(*z*) Cited, p. 46.

(*a*) *Henderson* v. *Jorss*, Seb. Dig. p. 110 (1861), Wood, V.-C., is a similar case.

(*b*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A., (*Apollinis*).

Differences which may be removed by retailers are disregarded.

Where any such additions or precautions are relied on by the defendant to rebut an alleged infringement, it is necessary to inquire whether they may not be removed or obliterated by fraudulent retail dealers leaving the imitated marks to effect deception without any check. On this ground, in *Barlow* v. *Johnson* (*c*), the Court paid no regard to the tickets and labels attached by the defendant to the towels sold by him under the name, *Osman*, which he had taken from the plaintiff's trade-mark.

Decided cases do not assist in determining the question of fact.

Probability of deception is, of course, a question of fact, and, except so far as they lay down any general principle of comparison, the decided cases are of no assistance in the determination of new questions of fact raised upon other materials. "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?" Lord Watson asked, in *Johnston* v. *Orr-Ewing* (*d*), but the habit of referring to reported cases at the trial of such questions is inveterate, and it has been thought useful, therefore, to collect the cases just cited, and those cited at pp. 207 and 208, above.

Inconspicuous additions a badge of fraud.

The reported cases show that attempts are frequently made to prevent the interference of the Court by using along with the spurious or deceptive marks, words, descriptions, or other additions which, if carefully examined, would prevent the deception, and at the same time, by writing the additions in small letters, or otherwise causing them to be comparatively inconspicuous, to make the probability of careful examination as small as the infringer thinks he safely can. It is obvious that, so far from affording an answer to a charge of infringement, such colourable precautions are themselves a badge of fraud. The defendant is met at once with the questions, if the additions are necessary, why are they not made conspicuous? and, if they are superfluous, why are they used

(*c*) 7 R. P. C. 395 (1890), North, J., and C. A.

(*d*) 7 App. Cas. 219 (1882).

at all? In the following cases the several additions noted in small capitals were added in small letters to the plaintiff's name or trade-mark, or to an imitation of it: EQUAL TO Day & Martin's, injunction granted, *Day* v. *Binning*, C.P. Cooper, 489; LATE OF Lundy, Foot & Co., dismissed pending verdict at law, *Foot* v. *Lea*, 13 Ir. Eq. 484; FROM Thresher & Glenny, injunction granted, *Glenny* v. *Smith*, 2 Dr. & Sm. 476; FROM Hookham & Pottage, injunction granted, *Hookham* v. *Pottage*, L. R. 8 Ch. 91; AGENT FOR Mason & Brand's Essence of Beef, injunction granted, *Dence* v. *Mason*, W. N. (1877) 23; W. N. (1878) 42.

5. Defences.

The ordinary defences.

The defences commonly set up may be tabulated as follows, that:—

(1.) The plaintiff has no title to the trade-mark in question (*e*);

(2.) The defendant has an independent or a concurrent right to use the mark complained of;

(3.) The plaintiff has not complied with the provision of sect. 77 by obtaining the registration or refusal of the mark (*f*);

(4.) There is no infringement (*g*);

(5.) The plaintiff is barred from suing the defendant for all or part of the relief he seeks by (a) an agreement or some personal estoppel (other than those next alluded to); (b) acquiescence or licence; (c) delay; or (d) because the trade-mark is deceptive, or his trade is fraudulent (*gg*).

(1), (3), and (4) are traverses of parts of the plaintiff's case, but (1) may be something more.

(*e*) Pages 301, *et seq.* 324. The question whether the mark concerned is a trade-mark at all, as to which see Chap. II., p. 24, seldom arises in practice, except on an application to annul an entry on the register.

(*f*) Chap. XII., p. 260.

(*g*) Page 305.

(*gg*) Page 330.

Application to vary.

Attack on the plaintiff's title.

(1) If the plaintiff's mark has been registered for five years (*h*), whether in his name or in that of his predecessor in title (*i*), the registration is conclusive evidence of his right to the exclusive use of the mark, subject to the provisions of the Act—that is, subject to his possessing the goodwill in the business in the goods to which the trade-mark is attached (*k*); and the defendant can adduce evidence to show (*l*), or he may show from the plaintiff's own evidence (*m*), that this condition is not complied with; but he cannot attack the plaintiff's title generally, for instance, by showing that the mark is not a trade-mark (*n*), or is not within the classes of registerable symbols enumerated in sect. 64, except on an application under sect. 90 (*o*). The application cannot be made by counterclaim in the action (*p*).

Application to expunge or limit the plaintiff's registration.

It follows that the defendant in an infringement action, unless satisfied that the plaintiff's title cannot safely be attacked, generally moves to expunge the mark of the latter from the register, or to so limit it as to defeat the action, and, according to the usual practice, the application comes on for hearing with the trial of the action, or with the plaintiff's motion for an interlocutory injunction (*q*), if any. The Court will, in a proper case, adjourn the decision of the last-mentioned motion in order to enable the defendant to make his cross application to rectify or expunge (*r*).

Determination of the plaintiff's title.

In any case, it is submitted, and notwithstanding that there is no application to rectify, the defendant may show

(*h*) Sect. 70, *ante*, p. 304.

(*i*) Sect. 87.

(*k*) *Ante*, p. 287.

(*l*) *Edwards* v. *Dennis*, 30 C. D. 454 (1885), C. A.

(*m*) As in *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

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

(*o*) As to which see Chap. XI., p. 218.

(*p*) *Pinto* v. *Badman*, *supra*.

(*q*) On an interlocutory motion for an injunction to restrain infringement, registration, though for less than five years, is generally treated as sufficient evidence of title for the purposes of the motion. *Compania Général de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), Kay, J. See p. 304, note (*t*).

(*r*) Cf. *Edwards* v. *Elkan*, *infra*, note (*e*).

that the plaintiff's right has determined by abandonment or otherwise (*s*).

Concurrent Right.

Concurrent or independent right.

Where the Court has so decided, two or more persons may be registered as proprietors of the same mark for the same goods (*t*), and they will then have concurrent rights. But where more than three persons are independently entitled to use a mark for the same goods it is treated as common to the trade, so that if any of them has obtained registration, the entry ought to be expunged (*u*).

The defendant, if he have an independent right, can therefore apply for registration himself, and in a proper case the Court will order a motion for an interlocutory injunction to stand over until his application is disposed of (*v*); or, if he allege that the mark is common, he can apply to remove the plaintiff's mark from the register.

Mouson v. *Boehm*.

In *Mouson* v. *Boehm* (*x*), where the plaintiffs had independently adopted, and, in 1880, had registered, a mark closely resembling a mark which the defendant had previously acquired for the same goods, and which he had never abandoned, the plaintiffs brought their action to restrain the defendant from using the latter mark. The defendant applied to register the mark as his, and moved to have the entry of the plaintiff's mark expunged from the register. The application to register came before the Court on a summons to proceed, and was heard, together with the motion for an injunction, at the trial of the action. Chitty, J., allowed the defendant to be registered as a proprietor of the mark, but he refused to order the

(*s*) See Chap. XIV., p. 283.

(*t*) Sects. 71 and 72. It must be a right to use the mark as a trade-mark; not, for instance, as a family crest, *Standish* v. *Whitwell*, 14 W. R. 612; *Beard* v. *Turner*, 13 L. T. N. S. 746, both (1866) Wood, V.-C.

(*u*) Chap. X., p. 177.

(*v*) *Edwards* v. *Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

(*x*) 26 C. D. 398 (1884), Chitty, J. A similar case of an old mark is cited by Mr. Sebastian, *Re United Vineyards, &c. Co.* (1880), Stirling, J.; and *Re Bryant and May*, 4 Times L. R. 675 (1888), Stirling, J., is another.

registration of the plaintiff's mark to be expunged, and he dismissed the action.

Jackson v. *Napper*.

Jackson v. *Napper* (*y*) is a similar case. There the defendant, in 1876, applied through an agent to register a mark as his trade-mark, and he supposed that it was registered accordingly, but, in fact, the application was not proceeded with and was, as the Court held, abandoned. In the next year the plaintiffs registered a similar mark, and more than five years after their registration they brought the action to restrain the defendant from using his mark, and thereupon the defendant took out a summons for a direction to the comptroller to proceed with the registration of his mark. Stirling, J., found that the defendant had acquired and used his mark as a trade-mark before the 13th of August, 1875, in respect of the goods in question, except one particular class (sheep-shears), and he held that, notwithstanding that the five years' registration of the plaintiffs was conclusive evidence of their right to the "exclusive use" of their mark, he had jurisdiction to allow the defendant to be registered in respect of his own mark, upon the analogy of the rule that an entry on the register may be rectified, under sect. 90 (*z*), after five years' registration. He accordingly directed the defendant to be registered as proprietor of his mark for the goods in question, other than the sheep-shears, and dismissed the action, except so far as regarded the last-mentioned goods, in respect of which he granted the injunction the plaintiffs sought.

The defendant should apply to register his own mark or to expunge the plaintiff's.

It will have been observed that in both the cases last cited there was before the Court an application to register the defendant's mark, and, upon the analogy of the decisions cited above (*a*), that, in the absence of an application to rectify, the registration of the plaintiff's mark is, after five years, conclusive proof of his right, it would seem that where the plaintiff's mark has been registered

(*y*) 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

(*z*) Chap. XII., p. 258.

(*a*) Page 304.

for the period named, the defendant, if he wishes to plead an independent right, must apply either to register his own name, or to rectify the registration of that of the plaintiff.

Registration gives the defendant a right to use his mark *primâ facie* or conclusive.

It is assumed in the judgments delivered in the above-cited cases, and is besides clearly implied by the Act, that registration when properly made gives the defendant an equal title to use the mark with the plaintiff, but only, of course, according to the terms of the entry. It is just as much an infringement for the defendant to use a registered mark for goods (*b*), or in a market in respect of which it is not registered, and the plaintiff's mark is registered, as if the defendant's mark were not registered at all. If the plaintiff alleges that the use of the registered mark of the defendant for the goods in respect of which it is registered is an infringement of his mark, his proper course is to apply in the first place to remove the defendant's mark from the register before commencing, or concurrently with (*c*), the action for infringement.

If the defendant's mark has been registered for five years, on the principle referred to above (*d*), the plaintiff cannot question the right *primâ facie* conferred by the registration except upon an application to vary or expunge the entry; but, as in the corresponding case of the plaintiff's registered mark, where the registration is less than five years old, it appears to be open to the plaintiff to prove by evidence in the action that it does not, in fact, confer any right to the use of the mark (*e*).

Registration for copyright purposes of a mark at Registration

(*b*) *Upper Assam Tea Co.* v. *Herbert*, 7 R. P. C. 183 (1889), C. A.

(*c*) As in *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J., where the register was rectified by limiting the class of goods for which the defendant's mark was registered, and an injunction was granted in respect of goods excluded from the class.

(*d*) Page 304.

(*e*) *Read* v. *Richardson*, 45 L. T. 54 (1881), C. A., cited p. 345; *Goodwin* v. *Venning*, 24 Sol. J. 690 (1880), Jessel, M.R.

at Stationers' Hall.

Stationers' Hall confers no trade-mark rights, and constitutes no defence if the mark is an infringement of another person's trade-mark (*f*).

Is the introduction of the defendant's own mark into a new market an infringement?

If the plaintiff and defendant are severally entitled to, and are the registered proprietors of, two marks which are, in ordinary markets, distinct and unlikely to be confused, is it an infringement for the defendant to introduce his mark into a market where the plaintiff's is already known, if from the character of the customers there,—their ignorance of English, for instance,—its use is calculated to cause the defendant's goods to be taken for the goods of the plaintiff? It is submitted that it is an infringement, and that a note, limiting the use of the defendant's mark to markets other than the one in question, ought to be entered upon the register, for the case put falls within the principle that one trader must not do what is calculated to cause his goods to be taken for those of another, and the defendant's action is in this sense the cause of deception. The question was raised, but not determined, in *Johnston* v. *Orr-Ewing*, in the House of Lords, and the words of the order of Fry, J., having special reference to the Bombay trade were, with the assent of the respondents, directed to be omitted. There Lord Selborne said, in his judgment: "Your Lordships are not called upon to decide whether a ticket, which was a rightful and *bonâ fide* trade-mark of the trader using it, could be excluded by injunction from particular markets (though unimpeachable everywhere else) merely because in those markets it might be liable to be called by a name which the mark of another trader had already acquired there. . . . To that proposition I should not myself, as at present advised, be prepared to assent" (*g*).

(*f*) *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C., (*Family Salve*).

(*g*) 7 App. Cas. p. 227 (1882). See also *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J. An injunction limited to Ireland was granted in *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.

Where a partnership is dissolved without a sale of the goodwill, or any arrangement having been made for its disposal, or governing the use of the trade-marks of the firm, each of the late partners who carries on the business may use the trade-marks (*h*), for he is, as to a portion of the goodwill, a successor of the firm; but if the goodwill is sold as part of the assets of the firm, the exclusive right to use the trade-marks may be sold with it, and in that case the late partners cannot lawfully use the trade-marks, even though they set up a similar business in competition with the purchaser (*i*). Trade-mark rights on the dissolution of a partnership.

But a late partner cannot grant to others who are in no way successors to the firm's business, or any part of it, any right or licence to use the trade-marks, even though he be registered as proprietor of the marks under sect. 87, or otherwise. The case of *Hanson* v. *Game, Harrison and Larner, Limited* (*k*), was decided on the construction of a consent order under which the partnership in question had been dissolved, and which provided that the late partners "and any partners they may take respectively" were to have the common use of the trade-marks; but it is submitted that the decision might have been put on the general ground that the defendants—a limited company, of which one late partner was a shareholder and director—could not use the marks without infringing the rights of the plaintiffs, the other late partner and his partners, because they were not possessed of the goodwill of any part of the old business.

So if the trustee in bankruptcy of a trader sells the Sale of trade-

(*h*) *Banks* v. *Gibson*, 34 Beav. 566 (1865), Romilly, M.R.; *Condy* v. *Mitchell*, 37 L. T. N. S. 268 and 766 (1877), Bacon, V.-C., and C. A.; *Benbow* v. *Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C. See Chap. XIII., p. 278. As to cases where the severance of business relations determines a joint trade-mark, see *Robinson* v. *Finlay*, 9 C. D. 487; and *Jones' Tm.*, 53 L. T. N. S. 1, cited p. 50.

(*i*) See the last case, and *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.

(*k*) 9 R. P. C. 186 (1892), Stirling, J.

marks in bankruptcy.

goodwill and trade-marks of the latter's business, the trader has no right to continue to use the marks (*l*).

Honest use of the defendant's name is no infringement.

A trader who is honestly using his own name in his business will not be guilty of infringement because its similarity to the name of another, or to a name appearing in another's trade-mark, is calculated to lead to deception; but to support this defence the business must be his own, for a fraudulent attempt to cover an infringement by employing or taking into partnership a man who happens to bear the name which is to be used to effect the fraud, still less by buying from him the right to use his name, will not avail to protect the offender (*m*).

(3.) The necessity for registration of the plaintiff's marks, having regard to sect. 77, has already been discussed (*n*).

(4.) And so also has the question, What constitutes an infringement? (*o*).

Estoppel.

(a) Except with regard to the several defences which are considered under separate headings, there is nothing peculiar to the law of trade-marks to determine what agreements, or what circumstances constituting a personal estoppel, will prevent a plaintiff from suing a particular defendant for infringement. It is to be remembered, however, that an infringement is primarily a fraud on the public, in respect of which the plaintiff is allowed to sue, because its natural effect is to cause damage to him. An

Agreement to condone infringements.

agreement, therefore, not to prosecute future infringements would be an agreement to permit a fraud, and although, if established, it would undoubtedly prevent the Court from interfering in favour of any party to it, it could not be

(*l*) *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), Chitty, J.; *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

(*m*) See *Turton* v. *Turton*, 42 C. D. 128 (1889), C. A.; and *Tussaud* v. *Tussaud*, 44 C. D. 678 (1890), Stirling, J., and the earlier cases cited in these, and Chap. XVI., pp. 420 *et seq.*

(*n*) Above, p. 303; Chap. XII., p. 260.

(*o*) Above, p. 305.

specifically enforced, and, unless the intention were clearly indicated, the Court would presume that a lawful arrangement, for instance, a waiver of the remedy in respect of past infringements only, was intended (*p*).

Uncandid conduct.

As an instance of estoppel by conduct, the case of *Maxwell* v. *Hogg* (*q*) may be taken. There the defendants had received, and published for reward from the plaintiffs, advertisements of an intended new magazine, bearing the title of a magazine which they were themselves preparing to publish, without warning the plaintiffs of their own intention; and this uncandid conduct was held to be sufficient ground for dismissing the cross suit of the defendants for an injunction to prevent the plaintiffs using the name.

Failure to give warning.

And anything in the nature of a representation by the plaintiff to the defendant that his mark was not an infringement, or that it might be lawfully used, or of an encouragement to him to continue using it, would be an answer to a subsequent claim for damages for infringement, although a mere failure by the plaintiff as soon as he had knowledge of the infringement to warn the defendant, would be no bar (*r*).

The plaintiff is not barred because he uses his registered mark with additions.

It is sometimes urged as an objection to the plaintiff's case, on behalf of the defendant, that the plaintiff in actual practice uses his mark in a form different from that for which he has obtained registration; but the variation of his registered mark by the plaintiff, provided it is not an infringement of any other person's mark, or a breach of any agreement binding upon him, is perfectly lawful, although so far as the mark actually used by the plaintiff differs substantially from his registered mark, it is an unregistered mark, as has been already pointed out; and if

(*p*) *Oldham* v. *James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862), Brady, C., and Blackburne, L.J.

(*q*) L. R. 2 Ch. 307 (1867), Turner and Cairns, JJ., cited p. 33.

(*r*) See *Proctor* v. *Bennis*, 36 C. D. 740 (1887), C. A., a patent case; and the notes to *Savage* v. *Foster*, 2 White & Tudor's Leading Cases, 6th ed., 680. The rule is "*qui potest et debet vetare jubet*"; *Osborn* v. *Lees*, 9 Mod. 96; *Willmott* v. *Barber*, 15 C. D. 96; 17 C. D. 772.

the registered mark is in substance not used at all, that would be an independent objection to the plaintiff's action (*s*). It is well settled that the use of a varied mark by the plaintiff does not in any way estop him from proceeding against infringers. Thus, in *The Melachrino Case* (*t*), the plaintiffs had tried to register a label comprising three coats of arms, but the coats of arms had been rejected and the label registered without them. The plaintiffs, nevertheless, always used the labels with the arms in it, and the defendants, who had imitated the label, were enjoined from continuing the infringement. In a subsequent case (*u*), Chitty, J., said: "I adhere to what I said in *Melachrino's Case*, that the mere addition of something, as, in that case, a coat of arms, to the trade-marks, is not sufficient to disentitle a person who otherwise uses the whole of his trade-marks to sue for an injunction."

Similarly, it is no ground of estoppel that the plaintiff uses his mark for goods in respect of which it is not registered (*x*).

Acquiescence.

(b) Acquiescence in the infringement on the part of the plaintiff is a complete defence (*y*), but it can only be inferred where he is shown to have had knowledge of it (*z*). And, assuming that it is shown that the plaintiff knows of the infringement, the Court will not readily infer that he has assented to what is likely to be so detrimental to his property. It has been held that, where it is pleaded in answer to a motion to commit the defendant for the breach of an injunction restraining him from infringing, it must amount to a licence "sufficient to create a new right in him" (*a*).

(*s*) Above, p. 303.

(*t*) *Melachrino & Co.* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), Kekewich, J., and C. A.

(*u*) *Hammond* v. *Brunker*, 9 R. P. C. p. 307 (1892).

(*x*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*y*) *Per* Chitty, J., in *Mouson & Co.* v. *Boehm*, 26 C. D. p. 406 (1884).

(*z*) *Weldon* v. *Dicks*, 10 C. D. 247 (1878), Malins, V.-C.; *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C., and the last case.

(*a*) *Rodgers* v. *Nowill*, 3 De G. M.

A licence by the plaintiff to the defendant to use the mark would be proof of acquiescence in user falling within the terms of the licence, and would be a defence (*b*). Any registered proprietor can grant licences to use the mark, subject to any equities affecting it (*c*), unless, for instance, he has agreed with the plaintiff not to do so (*d*). But it is submitted that a licence by some registered proprietor, other than the plaintiff, would not be a defence unless the defendant were possessed of the goodwill of the business, or part of it, to which the trade-mark was attached (*e*). Licence.

(c.) Mere delay, after knowledge of the infringement, to take proceedings, not sufficient to call the Statutes of Limitation into operation, is no bar to the action. Before the Judicature Acts it might have furnished an answer to an application for an injunction (*f*), at least until the plaintiff had established his rights by recovering damages in an action at law, unless the deception resulting from the use of the defendant's mark were still continuing (*g*); but both branches of the Court now enforce legal and equitable rights together, and consequently, wherever an injunction could have been obtained after an action for damages, it can now be obtained at once or concurrently with the judgment for damages. The rule is not peculiar to trade-mark cases, but is part of the general law (*h*). Delay does not bar the right of action;

& G. 614; 22 L. J. Ch. 404 (1853), *per* Turner, L.J. As to what constitutes acquiescence, see *Proctor* v. *Bennis*, *ante*, p. 331; "delay," section (*c*); and *Hogg* v. *Scott*, L. R. 18 Eq. 444, Hall, V.-C., *Weldon* v. *Dicks*, 10 C. D. 247, Malins, V.-C. (copyright); and *Smith* v. *Smith*, L. R. 20 Eq. 500, Jessel, M.R. (ancient lights).

(*b*) *Kinahan* v. *Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.

(*c*) Sect. 87.

(*d*) *Hanson* v. *Game*, *Harrison and Larner*, *Ld.*, 9 R. P. C. 186 (1892), Stirling, J.

(*e*) See Chap. XIII., p. 281, and sect. 70.

(*f*) *Horenden* v. *Lloyd*, 18 W. R. 1132 (1870), Bacon, V.-C., fifteen months' delay; *Estcourt* v. *The Estcourt Hop Essence Co.*, 10 Ch. 276 (1875), Cairns, L.C. and L.JJ., seven months' delay.

(*g*) *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285 (1874), L.JJ.

(*h*) See *The Three Towns Banking Co.* v. *Maddever*, 27 C. D. 533 (1884), C.A.

It was stated by Fry, J., in the following terms, in *Fullwood* v. *Fullwood* (2) (*i*): "In my opinion that delay" (from early in 1875, when the plaintiff first knew of the infringement, till November, 1876, when he commenced his action) "—and it is simply delay—is not sufficient to deprive the plaintiff of his rights. The right asserted by the plaintiff in this action is a legal right. He is, in effect, asserting that the defendants are liable to an action for deceit. It is clear that such an action is subject to the Statute of Limitations, and it is also clear that the injunction is sought merely in aid of the plaintiff's legal right. In such a case the injunction is, in my opinion, a matter of course, if the legal right be proved to exist. In saying that I do not shut my eyes to the possible existence in other cases of a purely equitable defence, such as acquiescence or acknowledgment (*k*), and the various other equitable defences which may be imagined. But lapse of time, unaccompanied by anything else (and to that I confine my observations), has, in my judgment, just as much effect, and no more, in barring a suit for an injunction as it has in barring an action for deceit. In my judgment, the same rule applies since the Judicature Act as formerly applied in the Court of Chancery when the legal right had to be determined in an action at law" (*l*).

but may modify the relief granted;

But delay may affect the nature of the relief granted. It may cause the Court to refuse the ordinary interlocutory injunction, either on terms of the defendant keeping an account, or absolutely (*m*), or to refuse to give damages, or to direct an account of profits in lieu of damages, or to restrict such account to profits made since the beginning of the action (*n*).

And in a case where the plaintiffs took no action on hearing that the defendant had received a small consign-

(*i*) 9 C. D. p. 178 (1878).

(*k*) *Quære* abandonment.

(*l*) Cf. the judgment of Mellish, L.J., upon the defence of misrepresentation in *Ford* v. *Foster*, L. R. 7 Ch. p. 632.

(*m*) See below, "Interlocutory injunction," p. 353.

(*n*) See below, "Account," p. 360.

ment of spuriously marked goods, preferring to wait until he received a larger consignment, Malins, V.-C., ordered the injunction to be directed to future receipts by the defendant only (*o*). Unless, however, this case can be supported on the ground of acquiescence, it is submitted that it is inconsistent with the rule established by the cases cited above.

and may amount to abandonment.

But delay to pursue infringers, where the infringements are numerous and notorious, may amount to abandonment (*p*) of the trade-mark, and lead to its becoming *publici juris* (*q*).

It has a bearing on the weight of evidence.

And, as already pointed out, it may have an important bearing on the weight of the evidence in the case, for if, in spite of long user by the defendant of the alleged infringing mark, no case of actual deception is proved, and the absence of this evidence is not otherwise accounted for, it may be difficult for the Court to believe that the defendant's mark is calculated to deceive. It has been suggested that, where the infringement has lasted a number of years, it is necessary for the plaintiff to prove that some persons have actually been deceived (*r*), but this is not, it is submitted, a rule of law (*s*).

Moreover, lapse of time may prevent conduct which would at first be an infringement being calculated to deceive. Thus, in *The Marquis of Londonderry* v. *Russel* (*t*), an action against the defendant, for sending coals to the London market as "Londonderry Wallsend Coal," was dismissed because the defendant had used the name for twenty-five years, and the plaintiff had long known of his use of it.

(*o*) *The Anglo-Swiss Condensed Milk Co.* v. *The Swiss Condensed Milk Co.*, (1871) W. N. 163.

(*p*) Page 289.

(*q*) As in *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878), Jessel, M.R., (*Bank of England Sealing Wax*); Chap. XIV., p. 284.

(*r*) *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285 (1874), *per* Melliah, L.J.; *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

(*s*) See "Proof of Actual Deception," p. 206.

(*t*) 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.

Whatever might have been the result had the plaintiff applied in 1861 to restrain the defendant from selling his coals under the name, it was clear, the Court of Appeal held, that at the time of their judgment the defendant's conduct could not be taken to amount to any representation that his coals came from the plaintiff's Londonderry collieries.

Deceptive trade-mark and fraudulent trade.

(d.) The Court will not interfere to protect the use of a deceptive trade-mark, or to assist a trader who is using his mark for the purposes of a fraudulent trade. This principle was well established in the Court of Chancery, and, although no case seems to be reported upon the point, it would no doubt have been recognized also in the Courts of Common Law before the Judicature Acts, had any case arisen, for the maxim *ex turpi causa non oritur actio* is a rule of law (*u*).

The plaintiff, Lord Westbury said, in *The Leather Cloth Case* (*x*), "desires to restrain the defendant from selling his own goods as the goods of another person; but if, by the use of the trade-mark in question, the plaintiff himself is representing and selling his goods as the goods of another, or if his trade-mark gives a false description of the article, he is violating the rule upon which he seeks relief against the defendant."

Deceptive trade-marks are outlawed.

The deceptive mark, in Sir Roundell Palmer's phrase, adopted by James, V.-C., in *The Leather Cloth Co.* v. *Lorsont* (*y*), is "outlawed."

Collateral misrepresentation.

The earliest of the cases commonly cited, in which the Court of Chancery refused to interfere, on the ground of the plaintiff's own deceptive conduct, until the plaintiff had established his right by action at law, is *Pidding* v. *How* (*z*), and the leading authority on the subject is the judgment of Mellish, L.J., in *Ford* v. *Foster* (*a*). There it

Ford v. *Foster*.

(*u*) See *per* Mellish, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 631 (1872).

(*x*) 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863).

(*y*) L. R. 9 Eq. p. 352 (1869).

(*z*) 8 Sim. 477; 6 L. J. Ch. N. S. 345 (1837), Shadwell, V.-C. Lying advertisements as to the origin of tea (*Hoiqua's Mixture*).

(*a*) L. R. 7 Ch. 611 (1872), (*Eureka Shirts*).

was objected by the defendants that the plaintiff in certain invoices and advertisements had falsely described himself as a patentee; but as the false description was collateral and did not appear in the mark in question, and the plaintiff's trade was not shown to be fraudulent, the Court decided that the plaintiff's legal right of action in respect of the defendant's infringement was not barred, and that he was consequently entitled to an injunction, with an account from the filing of the bill, and costs. If the false representation had been in the trade-mark itself, the Lord Justice held, no Court of Equity, and, according to his opinion, no Court of law, would have entertained the plaintiff's action, and the same rule would apply if the trade were fraudulent; but, he said, "where the trade is, as in this case, a perfectly honest trade, and where the trade-mark is, as in this case, a perfectly honest trade-mark, I am clearly of opinion that there is no common law principle upon which it is possible to hold that the fact that the plaintiff has been guilty of some collateral fraud would be an answer to an action. It would be impossible to plead at law as a justification for the defendant's committing the fraud, that the plaintiff had committed a fraud on some one else." "It is true," he added, "that in this case the bills containing this false representation as to its being a patented article are proved to have been given to the defendants themselves; but there is not the slightest evidence, or the slightest reason for supposing, that the defendants were ever deceived by that representation, because they knew perfectly well that there was no patent for these shirts."

The judgment of Mellish, L.J.

The following are some miscellaneous examples of cases where objections to the plaintiff's case on the ground of collateral misrepresentation failed: title of a magazine protected, although the magazine purported to be written by someone other than the author, *Hogg* v. *Kirby*, 8 Ves. 215; similar cases with regard to songs, *Chappell* v. *Sheard*, 2 K. & J. 117; *Chappell* v. *Davidson*, 2 K. & J. 123; 8 De G. M. & G. 1. "Holloway's pills and ointment" protected,

Examples of collateral misrepresentations.

although the plaintiff called himself Professor Holloway without warrant, and published exaggerated commendations of his pills, *Holloway* v. *Holloway*, 13 Beav. 209; an objection on the ground that the plaintiffs retained a brass plate on the door of their business premises, bearing their predecessor's name, overruled, *Hudson* v. *Osborne*, 39 L. J. Ch. 79.

Sect. 73 provides that it shall not be lawful to register as part of, or in combination with, a trade-mark, any words the use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice (*b*).

Application to remove deceptive mark from the register.

It follows that a trade-mark which contains false statements or misrepresentations ought not to be entered or retained upon the register, and, in modern cases, if the defendant wishes to rely upon the defence now under consideration, and to allege that the plaintiff's trade-mark itself is deceptive, he commonly applies under sect. 90 to have it removed from the register (*c*). This is a convenient method of bringing the question to an issue, if the plaintiff is suing in respect of a registered mark, and it is the most advantageous course for the defendant; but there is no reason to suppose that the Court would be any more ready to interfere to protect a deceptive trade-mark because if was registered, or that it is not open to the defendant to give evidence in support of a plea of the defence in question without there being any application, under sect. 90, before the Court.

(i.) Where the trade-mark itself contains misrepresentations—

The Leather Cloth Case.

In *The Leather Cloth Case* (*d*), the plaintiffs' case failed

(*b*) Chap. X., p. 209.

(*c*) *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Dexter's Tm.*, (1893) 2 Ch. 202; 10 R. P. C. 269, Wright, J. See Chap. X., p. 209.

(*d*) 4 De G. J. & S. 137; 33 L. J. Ch. 199, Lord Westbury; and 11 H. L. C. 523; 35 L. J. Ch. 53; H. L. overruling 1 H. & M. 271; 32 L. J. Ch. 721, Wood, V.-C. (1863). See also *Newman* v. *Pinto*, 4 R. P. C. 503; 57 L. T. 31 (1887), C. A., mark representing German cigars as of Havana make, cited p. 347.

because, in the label in question, they had described their goods as "tanned leather cloth," "patented," and "J. R. and C. P. Crockett" as the manufacturers, adding an American address, whereas, in fact, much of the cloth for which the mark was used was not tanned, none of it was made under any patent, and the manufacturers were not J. R. and C. P. Crockett, but the plaintiffs themselves, who had no American address. It was urged on behalf of the plaintiffs that the misrepresentations, and in particular the representation that the goods were tanned, could not deceive any ordinary purchaser; but in answer to this Lord Westbury said: "I cannot receive it as a rule either of morality or equity that the plaintiffs are not responsible for a falsehood because it is so gross and palpable that no one is likely to be deceived by it. If there is a wilfully false statement, I will not stop to inquire whether it is too gross to mislead" (*e*).

It is immaterial that the misrepresentation does not deceive;

It is no answer to the objection that the trade, or any other given class of persons, know the actual facts and are not deceived (*f*); for, as in the case of the test of infringement, the question is—is the mark calculated to deceive any probable purchasers who buy from the plaintiff directly or indirectly through others to whom he sells?

or that the facts are known to the trade.

The employment of the word "patent" in a mark used for goods which are not manufactured under an existing patent right has given rise to much discussion (*g*); but the authorities do not seem to have established any more definite rule than that it is in each case a question whether or not the employment of the word makes a false and deceptive claim to a non-existent patent right for the goods. It is not necessarily deceptive to describe as "patent" goods which are made according to a process which once was patented, or even those made according to

False claim of patent right.

(*e*) 33 L. J. Ch. p. 203. So *per* Fry, L.J., in *Newman* v. *Pinto*, 4 R. P. C. p. 520 (1887).

(*f*) *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 31 (1886), C. A.; cf. *Eno* v. *Dunn*, 10 R. P. C. 261.

(*g*) Its use may amount to a criminal offence; sect. 105, and Merchandise Marks Act, 1887, s. 3 (1) (c); Book II., Chap. I., p. 483.

a process which is, or was when the epithet was first applied, different to the common process, though never protected by a patent, for ordinary usage and understanding have long sanctioned such descriptions, as the names patent leather, patent medicine, patent metal, patent yellow, and patent hoe, show (*h*).

Lord Kingsdown's judgment in *The Leather Cloth Case.*

The following passage from Lord Kingsdown's judgment, in *The Leather Cloth Case* (*i*), in reference to the subject under consideration, is very frequently cited in argument: "If a trade-mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *primâ facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade-mark to relief in a Court of Equity against anyone who pirated it. In *Flavel* v. *Harrison* (*k*), Wood, V.-C., intimated his opinion that this would be so when there never had been any patent at all. But in the subsequent case of *Edelsten* v. *Vick* (*l*), he seems to doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade-mark being true when first introduced, had been continued after it had ceased to be true. I confess that I should have had great difficulty in assenting to that distinction. If the word 'patent' be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that term (and this I collect to have been the main ground of his Honour's decision), then I quite agree with his view. In such case nobody is meant to be deceived, or is deceived.

(*h*) See *per* Wood, V.-C., in *Edelsten* v. *Vick*, 11 Hare, 78 (1853); *Morgan* v. *Meddam*, 36 L. J. Ch. 228 (1866), (*Patent Plumbago Crucibles*): and *Gridley* v. *Swinborne*, 5 Times L. R. 71; 52 J. P. 791 (1888), Coleridge, L.C.J., and Grantham, J., cited p. 485, (*Swinborne's Patent Refined Isinglass*). "The illustrious race whose drops and pills, have *patent powers* to vanquish human ills"—Crabbe, quoted in Ogilvie's Dictionary.

(*i*) 11 H. L. C. 523; 35 L. J. Ch. p. 64 (1865).

(*k*) 10 Hare, 467; 22 L. J. Ch. 866 (1853).

(*l*) 11 Hare, 78 (1853).

"A patent may have expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it. But if the trade-mark represents the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection has never existed or has ceased to exist."

Expired patent.

And in a later case, Jessel, M.R., said: "No doubt a man may use the word 'patent' so as to deceive no one. It may be so used as to mean that which was a patent but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade-mark. Protection only extends to the time allowed by statute for the patent, and if the Court were afterwards to protect the use of the word as a trade-mark, it would, in fact, be extending the time for protection given by the statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade-mark. But further, no man can claim a trade-mark in a falsehood. It is a falsehood to represent that the patent is still existing" (*m*).

Where "patent" is not deceptive.

From the principles stated in these judgments, and from the decided cases, it follows that the use of the word "patent" in a trade-mark for unpatented goods is not to be taken to be misleading where either it is shown that the market name of the goods comprises the word (*n*), or where the goods are made according to an expired patent, and the word is so used as to be understood to refer to this (*o*).

(*m*) *Cheavin* v. *Walker*, 5 C. D. p. 862 (1877), C. A.

(*n*) *Marshall* v. *Ross*, L. R. 8 Eq. 651, (*Patent Thread*); cf. *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 345, both (1869), James, V.-C.

(*o*) *Ransome* v. *Graham*, 51 L. J. Ch. 897 (1882), Bacon, V.-C. In *Morgan* v. *McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C., suggested that in these cases the date of the patent should be given.

Summary of cases where "patent" used.

The following is a summary of the reported cases on the subject (*p*):—

Action barred.

First, where the plaintiff's action was barred: FLAVEL'S PATENT KITCHENER, no patent, *Flavel* v. *Harrison*, 10 Ha. 467; 22 L. J. Ch. 866; PATENTED JAN. 24,'56, patent void, *Leather Cloth Co., Ld.* v. *American Leather Cloth Co., Ld.*, p. 339; *Leather Cloth Co., Ld.* v. *Lorsont*, L. R. 9 Eq. 345; PATENT PLUMBAGO CRUCIBLES, no patent, *Morgan* v. *McAdam*, p. 340; ROYAL LETTERS PATENT, no patent, but duty paid in respect of a patent medicine, *Lamplough* v. *Balmer*, W. N. (1867) 293; MANUFACTURER AND PATENTEE, no patent, *Nixey* v. *Roffey*, W. N. (1870) 227; G. CHEAVIN'S IMPROVED PATENT GOLD MEDAL SELF-CLEANING RAPID WATER FILTER, expired patent, *Cheavin* v. *Walker*, p. 341.

Action not barred.

Secondly, where the plaintiff's action was not barred: SYKES' PATENT, patent invalid, no plea having reference to the misrepresentation, *Sykes* v. *Sykes*, 3 B. & C. 541; TAYLOR'S PATENT SOLID-HEADED PINS, expired patent, labels printed from the old blocks in use while the patent existed, *Edelsten* v. *Vick*, 11 Hare, 78; PATENT THREAD, no patent, evidence that patent was understood in the market to denote the character of the goods, *Marshall* v. *Ross*, L. R. 8 Eq. 651. The case of *Ransome* v. *Graham*, 51 L. J. Ch. 897, must probably be explained as one of collateral misrepresentation, if it can be supported at all. There the trade-mark consisted of letters and numbers stamped upon the working parts of the plaintiff's ploughs, and "patent" was stamped also, although the only patent which had ever existed related to the plough-shares merely, and had expired in 1817. The plaintiff's advertisements and catalogues stated that the patent had expired, but this could hardly be an answer to the objection, as the notice would not, or might not, reach all the persons who saw the stamp.

(*p*) The pages given refer to this book. See also *Adams' Tm.*, 9 R. P. C. 174; 66 L. T. N. S. 610 (1892), where Kekewich, J., refused to allow "patent" to be struck out of an old mark for furniture polish.

"Trade-mark."

It is a misrepresentation which disentitles a label or other trade-mark to protection or to registration, to indorse upon it anything which is calculated to mislead the public as to what is the mark of which the proprietor claims the exclusive use. The matter was first brought forward in *The Apollinaris Case* (*q*), where some of the labels in question had the word *trade-mark* printed immediately under the red triangle or disc, which was their most prominent feature, although other parts of the labels, and, in particular, the words *Apollinaris* and *Friedrichshall*, were claimed as essential features of the trade-marks. The application before the Court was to remove the marks from the register on several grounds; and Fry, L.J., who delivered the judgment of the Court of Appeal, dealt with the present objection in the following passage (*r*):—

The Apollinaris Case.

"One (objection) was, that the mark was calculated to mislead, inasmuch as the whole label is registered as a trade-mark, and yet contains the assertion that the red disc, which is the most conspicuous part of the whole label, is 'the trade-mark'—not saying 'a trade-mark,' not saying part of 'the trade-mark'—but an assertion pointing to the conclusion that it, and it alone, is 'the trade-mark,' and therefore that the label, as a whole, is not the trade-mark. Such would have been the impression produced (I am speaking for myself) on my own mind, had I approached the reading of the label unbiassed by what I have learned while sitting in this seat, and such, we think, is the true result of this case. An owner of a registered trade-mark may put it on a registered label, but not so as to mislead a reader of that label, and induce him to believe the only thing registered is the distinctive mark." It is true, the learned Lord Justice added, that the objection might, apparently, have been taken in *Hudson's Case*, where the mark there in question was upheld by the Court of Appeal (*s*), but it was, in fact,

(*q*) (1891) 2 Ch. 186; 8 R. P. C. 137, C. A.

(*r*) (1891) 2 Ch. p. 233.

(*s*) 32 C. D. 311; 3 R. P. C. 155 (1886).

neither discussed in argument nor considered by the Court.

This judgment caused a number of applications, under sect. 92, for leave to remove "trade-mark" from registered marks to be made to the Court. The results of these are stated in Chapter X. (*t*).

It is to be observed that Fry, L.J., does not say that the use of the words trade-mark within a label is necessarily misleading; it may be, but it is a question of fact whether it is or not.

Hammond v. *Brunker.*

In *Hammond* v. *Brunker* (*u*), the registered label of the plaintiffs comprised a number of devices, and among them a small blank shield in the middle of the upper half. In use, the plaintiffs printed within the blank shield a hand and forearm holding a dart, and having the words "trade-mark" beneath it. Chitty, J., in rejecting an objection founded upon this, said (*x*): "It is a question of fact in every case where a man puts the term 'trade-mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade-mark only. In *The Apollinaris Case*, the Lord Justice's observations were addressed to a label which had been registered, and had the term *Friedrichshall* above a disc, with a quantity of printed matter; the disc was coloured red, and underneath the disc were the words 'trade-marks.' Without expressing a final opinion on the matter (*y*), the Lord Justice thought that there were grounds for saying, on that label, that the trade-mark referred to the disc, and if I may say so myself, with great respect, it seems to me that there were grounds. But, as I say, this is a question of fact, and I am satisfied that these words 'trade-mark' in the middle of this label do not indicate to the public that the shield only is the trade-mark. In *The Apollinaris*

(*t*) Page 215.
(*u*) 9 R. P. C. 301 (1892).
(*x*) Page 307.
(*y*) This is hardly borne out by the report of the judgment of Fry, L.J.

"*Case* there was no other device except the disc, which was coloured red, in use (x). That being so, I think that these two grounds of objection to the plaintiff's suing, namely, the addition of the arrow and the forearm, and the addition of the words 'trade-mark,' do not disentitle the plaintiff to ask for an injunction with regard to his trade-mark."

In the most recent reported case (*a*), on the other hand, Wright, J., held the objection to be fatal to one of the respondent's marks, a label, and ordered it to be removed from the register. There the main portion of the label was occupied by a picture of the head of a negro, inclosed by a circular band containing the words *W. D. & H. O. Wills, Bristol.* Underneath this picture was printed in very large letters the word *Star*. At the side of the label, on the right, was a representation of an eight-pointed star; and in immediate proximity to the star the words "trade-mark" occurred.

False assertion of registration.

It is a penal offence to describe a trade-mark as registered when it is not (*b*); but it is not clear that this misrepresentation is sufficient to deprive the proprietor of the mark of his right to protection against infringers, or against persons who pass off their goods as his under cover of the mark. In *The Melachrino Case* (*c*), Chitty, J., held, that the use of the word registered with a mark in which blanks appearing on the registered form were filled up by coats of arms in use, was not a bar to the plaintiff's case; and it has been held by the Court of Appeal that the use of the words "special registered trade-mark," before registration had been obtained, was not a sufficient objection to prevent the Court granting an interlocutory injunction (*d*). And the Court of Appeal has allowed a mark

(*x*) But there were the important words *Apollinaris* and *Friedrichshall.*

(*a*) *Dexter's Tm. and Wills' Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269.

(*b*) Act of 1883, s. 105, below, p. 540; Merchandise Marks Act, s. 3 (1) (e); see Book II., Chap. I., p. 476.

(*c*) 4 R. P. C. 215 (1887).

(*d*) *Read* v. *Richardson*, 45 L. T. 54 (1881), C. A. In *Lewis* v. *Goodbody*, 67 L. T. 194 (1892), Kekewich, J., refused an interlocutory injunction in a passing-off case, because the plaintiffs had represented that their mark was a registered trade-mark.

to be registered which had been used with the words "registered shape," both the mark, a dome-topped cylinder, and the words being impressed on the blocks of blacklead, which were the goods in question, although the registration of the shape as a design had expired in 1864; but the case was not argued on behalf of the respondents (*e*).

Other misleading statements.

It was further suggested, in *The Apollinaris Case*, and the Court of Appeal were inclined to hold, that the indorsement upon one of the labels used for natural mineral waters, and claimed as a trade-mark, "imitations of this water will be prosecuted," meant all imitations, whether fraudulent or not, of the water, and was addressed, therefore, to artificial waters which might lawfully be made and sold as imitations of the natural water, and that, if it bore this meaning, it was calculated to deceive (*f*).

And by the practice of the registry the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," will not be registered under the Acts, and should not, therefore, appear upon the representations of trade-marks forming part of an application (*g*).

The operation of a deceptive misstatement as to the origin of the goods in destroying the distinctive character of the mark, has been referred to in an earlier chapter (*h*). In *The Eton Cigarette Case* (*i*), it was held that an English tobacconist, who put a Russian name, as that of the maker, upon his goods, could not protect the mark which they also bore as his trade-mark against infringements.

Fraudulent trade.

(ii) Where the plaintiff uses the trade-mark in aid of a fraudulent trade, the rule which bars his action is so clear that it will be sufficient to summarise the few cases reported on the subject.

Summary of cases.

A plea that the plaintiff made a practice of selling by short weight, failed because it was not supported by the evidence, *The Guinea Coal Case*, *Lee* v. *Haley*, L. R. 5 Ch. 155;

(*e*) *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886).

(*f*) [illegible] 2 Ch. p. 226.

(*g*) Instructions 29, Appendix, p. 631.

(*h*) Chap. VIII., p. 155.

(*i*) *Wood* v. *Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.

Piano-forte Tutor, described as "600th edition, specially revised by Hemy," although the musician referred to had not revised the work for ten years, held not to be misleading, evidence being given that in the trade an issue of 250 was called an edition, *Metzler* v. *Wood*, 8 C. D. 606; trade in German cigars sold in boxes bearing a label with the words LA PUREZA (an old Havana brand), HABANA, RAMON ROMEDO, and additional labels with other words and a sham address in Spanish, held to be fraudulent, the whole get-up being described by Bowen, L.J., as "an elaborate concatenation of pictorial lies" intended to pass off the cigars as made in Havana, although evidence was given that the name *Havana* in the cigar trade indicates the shape of the cigars only, *Newman* v. *Pinto*, 4 R. P. C. 508; 57 L. T. 31 (*k*); but the sale of English cigars under a label bearing the word HABANA, but in boxes marked BRITISH MANUFACTURE, was held not to be fraudulent in the absence of evidence that the plaintiffs represented that their cigars were made in Havana, *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237.

Havana cigars.

A label containing misrepresentations adopted by the plaintiff after the commencement of his action against the defendant, cannot operate to bar the action. So Fry, J., stated in *Siegert* v. *Findlater* (*l*), for, he said, applying the test laid down by Mellish, L.J., in *Ford* v. *Foster* (*m*), its adoption could not, before Sir John Rolt's Act, have warranted the Court of Chancery in restraining the action, had it been previously commenced in a common law Court. The learned Judge held, however, that in the case before him there was in fact no fraudulent misrepresentation which ought, in any case, to debar the plaintiffs. It is submitted, with great deference, that on principle it can make no difference, supposing the plaintiff is seeking the aid of the Court for a fraudulent trade, or for a trade con-

Misrepresentation commencing after action brought.

(*k*) Cf. *Fuente's Tms.*, (1891) 2 Ch. 166; 8 R. P. C. 214; and *Dexter's Application*, (1893) 2 Ch. 262; 10 R. P. C. 269.

(*l*) 7 C. D. 801 (1878), (*Angostura Bitters*).

(*m*) L. R. 7 Ch. 611, cited p. 337.

ducted by fraudulent means, that the frauds commenced after the action was begun. The objection is not that the plaintiff's case is incomplete, or that the defendant has any answer as of right to oppose to it, but that the plaintiff and his business are, when the Court takes cognizance of the matter, unworthy of its protection or assistance.

6. The Relief granted.

If the plaintiff succeeds in an action for infringement, he may obtain an order for—(i.) an injunction restraining further infringements of his rights; (ii.) the delivery up for destruction, or for the erasure of the marks of any goods already marked with the spurious mark and in the possession or under the control of the defendant; (iii.) and damages in respect of the past infringement, or in lieu of damages; (iv.) an account of the profits made by the defendant by the sale of the spuriously marked goods, or for some one or more of these.

(i.) Injunction.

This was the characteristic remedy by which the Court of Chancery protected trade-marks, either after the plaintiff had recovered damages for past infringements at law (*n*), or where it had been appealed to in the first instance and no action had been brought. It is generally the most beneficial relief for the plaintiff, because it summarily stops the particular infringement which the defendant has practised, and makes it highly dangerous for him to commence any other, and it is operative against impecunious infringers who might care little for repeated judgments for damages against them. The Merchandise Marks Act of 1862 (*o*), empowered a court of law, in any action for fraudulent infringement, to grant an injunction to the successful plaintiff; and, since the Judicature Acts,

(*n*) See *Ford* v. *Foster*, L. R. 7 Ch. 616 (1872), L.JJ.

(*o*) 25 & 26 Vict. c. 88, s. 21, now repealed; see Chap. I., p. 18.

both divisions of the High Court have the same power as that formerly exercised by the Court of Chancery.

The grant of an injunction in trade-mark cases is governed by the general rules governing it where other rights are concerned. There must be some threat or probability that the infringement will be commenced, continued, or repeated, or the Court will not interfere (*p*); but if an actual infringement is shown to have occurred that is usually sufficient, and the plaintiff is not bound to wait until it has been frequently repeated, or until warning has been given and been disregarded (*q*), for "the life of a trade-mark depends upon the promptitude with which it is vindicated" (*r*). So an injunction has been granted where the defendant had altered the device and discontinued the use of the labels complained of, and offered to undertake not to use any more of them (*s*), although, in some instances, the undertaking of an innocent infringer has been accepted by the Court (*t*). Nor is it necessary that any actual infringement should have occurred if it is proved that the defendant contemplates committing or has threatened to commit one (*u*), and it is sufficient evidence of this that he is in possession of a considerable quantity of spuriously marked goods (*v*), even though it is only as a forwarding agent (*x*).

Further infringement must be threatened or be likely to occur.

It has already been shown that the fact that the infringement was not fraudulent (*y*), or even that it was

Proof of fraud not necessary.

(*p*) The Court will presume that a trader will use his mark so as not to be deceptive, if it is capable of being used without the probability of being deceptive, unless some reason to the contrary is shown; *Kutnow's Tm.*, 10 R. P. C. 401 (1893), cited p. 214.

(*q*) See *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J., see above, p. 300.

(*r*) *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219.

(*s*) By Malins, V.-C., in *Guinness* v. *Heap*, Seb. Dig. p. 377 (1878); cf. *Tonge* v. *Ward*, 21 L. T. N. S. 430 (1869), Romilly, M.R.

(*t*) *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

(*u*) See *The Emperor of Austria* v. *Day and Kossuth*, 3 De G. F. & J. 217; 30 L. J. Ch. 690 (1861), Campbell, C. and L.JJ.

(*x*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

(*y*) *Millington* v. *Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.

made in ignorance of the plaintiff's right (*z*), is no defence to the claim for an injunction.

Form of injunction (*c*).

The injunction is sometimes directed generally to restrain the infringement of the plaintiff's trade-marks to which his title is established in the case (*a*), but it is usually expressed with more particularity, to restrain the use by the defendant of such trade-marks, or of marks only colourably differing from them, in connection with goods of the kind for which they are registered, by selling or otherwise disposing of the goods marked with such marks. Sometimes the particular colourable infringement of which the defendant has been proved to have been guilty, is expressly referred to in the order, a general restraint being added. And, in some cases, the form of injunction which seems more appropriate to the unspecialized action for "passing off" is made use of also, the defendants being restrained from "in any other way passing off their goods as those of the plaintiff" (*b*). To avoid a discussion upon a motion to commit for an alleged breach of the injunction, it is obviously advantageous for the plaintiff to combine in the order a particular reference to the form of the infringement which has actually been committed or threatened, with general words, as wide as are obtainable, directed to prevent a colourable evasion of the decree (*c*).

As it is not an infringement to use the plaintiff's mark upon his own goods, that is, goods which possess the attribute connoted by the mark (*d*), the injunction is commonly expressed so as to prevent this being a breach of its terms (*e*).

(*z*) *Moet* v. *Couston*, 33 Beav. 578 (1864), Romilly, M.R.; *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, C.

(*a*) *The Bodega Co. Ld.* v. *Riviere*, 6 R. P. C. 243 (1888), Chatterton, V.-C.; *Montgomery* v. *Thompson*, (1891) A. C., p. 218; 8 R. P. C. 361.

(*b*) *Slazenger and Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

(*c*) See the forms of injunction collected in the Appendix, p. 648, and in Seton, 5th ed., Vol. I., 534.

(*d*) Chap. II., p. 32. And see *Condy* v. *Taylor*, 56 L. T. 691 (1887), Kekewich, J.

(*e*) Cf. the "passing off" cases;

And in cases where the infringement has been effected by the employment of a word, to the exclusive use of which the plaintiff has no title, the injunction should, it seems, be directed to restrain the defendant from using the word without clearly distinguishing his goods from those of the plaintiff, not to forbid his using it altogether (*f*).

Injunction directed to future consignments of goods only.

In a case where the plaintiffs refrained from taking proceedings on learning that the defendants had received a small quantity of the infringing goods, but waited until they had got a larger consignment, Malins, V.-C., ordered the injunction to be directed to stop the sale of future consignments only (*g*). It is submitted, however, with great deference, that the calculated conduct of the plaintiffs was not a sufficient reason for allowing the goods already received to be sold under the deceptive labels, although it might well have been an answer to a claim for damages for past infringements. It has certainly been held that acquiescence, not sufficient to bar the plaintiff's right, may, in some classes of actions, cause the Court to refuse relief by injunction, and to grant the plaintiff's damages only (*h*), but the case cited did not involve any continuing fraud or deception (*i*).

Injunction refused because of acquiescence.

Injunction limited to a particular market.

The injunction may also be limited with reference to the use of the mark in a particular country or market (*k*),

Siegert v. *Findlater*, 7 C. D. 801; and *Braham* v. *Beachim*, 7 C. D. 848, both (1878), Fry, J.

(*f*) *Seixo* v. *Provezende*, L. R. 1 Ch. (1865), Wood, V.-C., and Cranworth, L.C.; *Johnston* v. *Orr-Ewing*, 13 C. D. 434; 7 App. Cas. 219 (1880), Fry, J., C. A. and H. L.; and see *Montgomery* v. *Thompson*, (1891) App. Cas. 217; 8 R. P. C. 361.

(*g*) *The Anglo-Swiss Condensed Milk Co.* v. *The Swiss Condensed Milk Co.*, W. N. (1871), 163.

(*h*) *Sayers* v. *Collyer*, 28 C. D. 103, *per* Fry, L.J. A restrictive covenant in regard to buildings case.

(*i*) The action for infringement may wholly fail, because the defendant has used the plaintiff's mark so long that there is no longer any deception, as in *The Marquis of Londonderry* v. *Russel*, 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.

(*k*) *Carver* v. *Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C.; *Barber* v. *Manico*, 10 R. P. C. 93 (1893),

for instance, is calculated to deceive there only (*l*), or in a particular manner, as by sending goods marked with it to English ports for shipment to the colonies (*m*).

Interlocutory application for an interim injunction.

The plaintiff in an infringement or "passing off" action usually moves, as soon as the action is commenced, for an interim injunction to restrain the defendant, until the hearing of the action or further order, from continuing or committing the infringement or deceptive conduct of which he complains, either getting leave to serve notice of motion with the writ (*n*), or serving it after the defendant has appeared. In a plain case the motion is, in the first instance, often made *ex parte* for an injunction until the day for which the notice of motion is given; and in a case where the defendant is committing a deliberate fraud, it is important, if possible, to obtain an *ex parte* order before giving him a notice which may lead to the disposal of the spurious goods which he is about to put upon the market.

Balance of convenience.

Where the plaintiff's title is disputed, or the fact of infringement is doubtful, or misrepresentation amounting to a bar to the action, or some other defence is plausibly alleged upon the interlocutory motion, the Court, in granting or refusing the interim injunction, is guided principally by the balance of convenience, that is, by the relative amounts of damage which seem likely to result if the injunction is granted and the plaintiff ultimately fails, or if it is refused and he ultimately succeeds. Thus, in *Read* v. *Richardson* (*o*), on the defendants undertaking to keep an account, Jessel, M.R., refused an interlocutory injunction; but the Court of Appeal granted it because,

A. L. Smith, J.; see *Société, &c. de l'Etoile's Tm.*, 10 R. P. C. 436; (1894) 1 Ch. 61, Stirling, J.

(*l*) See *Wilkinson* v. *Griffith*, 8 R. P. C. 370 (1891), Romer, J., and above, p. 204.

(*m*) *Rodgers* v. *Rottgers*, 5 Times L. R. 678 (1889), Kay, J.

(*n*) O. 52, r. 9.

(*o*) 45 L. T. 54 (1881), (*Dog's Head Beer*). In *Evans* v. *Smith*, 3 Times L. R. 390 (1887), Kay, J., refused an interlocutory injunction because it was a serious question whether the plaintiff's registered trade-mark *Montserrat* was a "special and distinctive word." But *quære* whether sufficient weight was given to sect. 76 in this case; see above, p. 304 note (*t*).

while the defendants had only recently commenced to use their mark, and their trade was admittedly not dependent on it, the plaintiffs had a large trade in connection with which they used the label which the defendants' mark was alleged to infringe, and their rights would have been irremediably and incalculably injured unless the injunction were granted, if their allegation that the defendants' mark was an infringement should be supported and their title to sue should be established at the trial. The defendants' mark had been registered as well as the plaintiffs', and they asserted that the plaintiffs' action was barred because the plaintiffs had, before registration, printed the words "specially registered trade-mark" upon their labels (*p*).

As appears from the cases just cited, it is not necessary for the plaintiff, upon the interlocutory application, to give conclusive evidence as to his title to the mark. If he makes it appear probable that he will succeed at the hearing, that is sufficient, at least, to bring the question of balance of convenience before the Court, and where there is reason to doubt the good faith of the defendant, the Court is more easily induced to interfere (*q*).

Interim injunction refused on account of delay.

The interim injunction will not be granted if the plaintiff has delayed interfering until the defendant has built up a large trade in which he has notoriously used the mark. But a slight use, chiefly upon sales to a few purchasers for their private use, will not prevent the Court from interfering in a case where the plaintiff's trade is considerable (*r*).

(*p*) As to this plea, see above, p. 345. Jessel, M.R., had refused the injunction on the ground of no apparent infringement.

(*q*) *Radde* v. *Norman*, L. R. 14 Eq. 348 (1872), Wickens, V.-C.

(*r*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A. *Apollinis*, used in Germany from 1876, and in England from 1881. *Derby Photographic Dry Plate Co., Ld.* v. *Pollard*, 2 Times L. R. 276 (1886), Bacon, V.-C.; *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

Application adjourned to the trial.

And if no actual infringement is in progress, and no harm is likely to be done, the motion is usually referred to the trial (*s*).

Interim injunction limited as closely as possible;

only granted on undertaking as to damages.

The interim injunction being intended only to preserve the plaintiff's rights from serious detriment until the hearing is, at any rate in cases which appear to be doubtful or honestly disputed, limited as closely as possible to what is sufficient to attain that end (*t*). It is only granted upon the plaintiff undertaking to be responsible in damages for the loss (if any) occasioned by it to the defendant, should it turn out at the hearing that it ought not to have been granted (*u*).

A common form of interlocutory injunction is to restrain a wharfinger or consignee from passing into the market goods alleged to bear spurious marks until the trial or further order (*x*).

Since registration is *prima facie* evidence of title, and, in the absence of an application to rectify, conclusive evidence after five years, if the plaintiff's mark is registered, but it is desired to dispute his title to it, the defendant's proper course is to apply to expunge the mark under sect. 90 (*y*). This is the course usually adopted, and a large proportion of the seriously contested trade-

Cross motions for injunction and to expunge.

mark cases commence with cross motions for an interim injunction, and to expunge or vary the plaintiff's registered mark.

In a case where the defendant claimed a right to the mark in question, and had applied to register it himself, an interlocutory motion for an injunction by the plaintiff

(*s*) As in *The Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1877), Hall, V.-C.

(*t*) See *The Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A.

(*u*) As to the calculation of the damages covered by the undertaking, see *Mansell* v. *The British Linen Co. Bank*, (1892) 3 Ch. 159.

(*x*) *Rivers* v. *Norris* (1868), Seb. Dig. p. 178; Seton, 4th ed., p. 236, Giffard, V.-C.; *Del Valle* v. *Mayer*, (1870), Seb. Dig. p. 195; Seton, *ibid.*, James, V.-C.

(*y*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A.; *Read* v. *Richardson*, 45 L. T. 54, cited p. 352.

was ordered to stand over pending the result of the application (*z*).

Undertaking to keep an account.

And sometimes, where there is a substantial case to be tried, the application for an interim injunction is ordered to stand over to the hearing upon the defendant undertaking to keep an account of his sales under the mark objected to (*a*).

Enforcement of the injunction.

Breaches of the injunction are contempts of Court, which may be punished by the committal or attachment (*b*) of the guilty person, or by ordering him to pay a fine or costs. "Committal was the proper remedy for doing a prohibited act, and attachment the proper remedy for neglecting to do some act ordered to be done," but there is now no substantial difference between the two (*c*). The course usually adopted is to move to commit, the notice of motion being served upon the respondent, or if this is impracticable, leave for substituted service being obtained (*d*).

The order granting the injunction should be forthwith drawn up and served upon the defendant, but no formal service or notice of it is necessary to enable the Court to enforce it. It is sufficient that the defendant or other respondent is shown to have been in fact aware of the order for the injunction having been granted or made to subject him to the risk of committal if he infringes it (*e*).

Unintentional breach of the injunction.

The principal question upon an application to commit for breach of an injunction restraining the infringement of a trade-mark is, generally: Does the new mark of the defendant constitute an infringement or not? And it

(*z*) *Edwards* v. *Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

(*a*) *Mitchell* v. *Henry*, 15 C. D. 181 (1880), C. A.; *Apollinaris Co.* v. *Snook*, 7 R. F. C. 474 (1890), North, J.

(*b*) O. 42, r. 7, or in the case of a corporation, by sequestration of its property or attachment of its officers, O. 42, r. 31.

(*c*) *Callow* v. *Young*, 56 L. T. 147; *Harvey* v. *Harvey*, 26 C. D. p. 654; *Evans* v. *Norton*, (1893) 1 Ch. 252.

(*d*) See the notes to O. 44, r. 1, in the Annual Practice.

(*e*) *Marcovitch* v. *Bramble, Wilkins & Co.*, Seb. Dig. p. 363 (1873), Malins, V.-C. Annual Practice note to O. 42, r. 7; and see *United Telephone Co.* v. *Dale*, 25 C. D. 778.

may be assumed that if the Court is satisfied that the defendant has honestly tried to select a mark which is not objectionable, having regard to its order, it will be unwilling to send him to prison because he has failed in his endeavour. But the Court has jurisdiction to commit for disobedience to an order which is not shown to have been wilful (*f*).

Choice of a new mark by the defendant.

It may be safely assumed also that in the case just put the Court will be careful not to compel an honest trader to alter his mark more than is necessary to protect the plaintiff's rights. But the following passage from Lord Romilly's judgment, in *Bass* v. *Dawber* (*g*), goes, perhaps, too far, for the plaintiff is entitled to have the full extent of his right secured to him, without reference to the loss which it occasions to the defendant. "If a person has *bonâ fide* taken a label or trade-mark which does resemble the label of another person, and this is not done with the intention to deceive, the Court will not require him to change it completely, because the change of a trade-mark is a serious thing. . . . It is like beginning a new firm."

In a case where the plaintiff refused to take any notice of a label which the defendant suggested and proposed to adopt in lieu of the label against the use of which the injunction was granted, Langdale, M.R., himself undertook to determine whether the distinction between the labels was sufficient (*h*).

Delay in application to commit.

If the plaintiff delays taking steps to enforce the injunction for a considerable time after he knows of the fresh infringement, the delay may cause the Court to refuse to commit; but if the infringement is continuing, it has been said that "there must—in order to deprive the party who has obtained the injunction of the right to move for committal upon the breach of it—be a case made out almost amounting to such a licence to the party enjoined, to do the act enjoined against, as would enable him to maintain a bill against others for doing the act. The party enjoined

(*f*) *Hewitt* v. *Mansell*, 29 Sol. J. 66.

(*g*) 19 L. T. N. S. 626 (1869), Seb. Dig. p. 186.

(*h*) *Croft* v. *Day*, 28 Leg. Obs. 378; Seb. Dig. p. 39 (1844), on a motion to commit.

"must, I think, show such acquiescence as would be sufficient to create a new right in him" (*i*). In the case just quoted, the injunction was granted in 1847, the new infringement began in 1848, and was continued until the motion to commit in 1853. The Lords Justices, however, were not satisfied that the plaintiffs were aware of it. Stuart, V.-C., refused the motion on the ground of the delay, but the Lords Justices directed that the defendant should be committed unless, within a week, he suggested, and undertook to use for the future, a mark which the Court should consider satisfactory, and they ordered that he should pay the costs of the motion.

In *Cartier* v. *May* (*k*), where the plaintiff delayed moving for fifteen months after the defendant had commenced a new infringement not expressly covered by the injunction, Wood, V.-C., refused to commit the defendant, but ordered him to pay the costs of the application, and enlarged the injunction so as to make it extend to the new fraud.

(ii.) Delivery up of the Marked Articles.

Erasure of the spurious marks.

The Court not only forbids further infringement by its injunction, but, where the defendant is proved to have spuriously marked articles in his possession or under his control, it also orders the erasure of the marks (*l*), or the delivery up of the marked articles for that purpose, or, if erasure is impracticable, for destruction (*m*). Thus, in

(*i*) *Per* Turner, L.J., in *Rodgers* v. *Nowill*, 3 D. G. M. & G. 614; 22 L. J. Ch. 404 (1853).

(*k*) Seb. Dig. p. 111 (1861).

(*l*) *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Upmann* v. *Elkan*, L. R. 12 Eq. 140; 7 Ch. 130, Romilly, M.R., and Hatherley, L.C., note (*p*) below.

(*m*) *Farina* v. *Silverlock*, 4 K. & J. 650 (1858), Wood, V.-C. The repealed Merchandise Marks Act of 1862, s. 21, empowered the Court to direct any chattel to which any trade-mark had been fraudulently applied, or which had been exposed for sale with a forged or counterfeited trade-mark applied to it, to be destroyed or otherwise disposed of. The Act of 1887 forfeits every chattel by means of, or in relation to which, an offence under the Act has been committed,

Slazenger v. *Feltham* (*n*), where the word *Demotic*, an infringement of the plaintiffs' mark *Demon*, was stamped upon the defendants' tennis racquets, the order of Kekewich, J., for the destruction of the racquets, was varied by the Court of Appeal, upon it being pointed out that the spurious mark could be planed off; and it was ordered that the defendants should make an affidavit verifying the number of the racquets, and that they should either deliver up the racquets to the plaintiffs, to be destroyed, or satisfactorily erase from them the name *Demotic*, in the presence of the plaintiffs or their agent.

Interests of innocent persons in the marked goods unaffected.

Lien for costs.

The lien of a wharfinger for his charges in regard to goods deposited with him, including the costs he is put to by being made a defendant in a trade-mark action, is not destroyed if the goods turn out to be spuriously marked (*o*); and although, in some earlier cases (*p*), the plaintiff was adjudged to have a lien upon the goods, subject to that of any wharfinger or mortgagee who had an earlier charge, and who was innocent in regard to the infringement, the Court of Appeal, in the case last cited (*o*), expressed considerable doubt whether such a lien could be supported. Of course, neither the wharfingers nor any other persons interested in the goods would be allowed to sell or dispose of the goods until the spurious marks were removed.

The duty of the bailee of infringing goods.

A wharfinger, transport agent, or other bailee who finds that goods committed to his charge are spuriously marked, therefore, is justified in refusing to deliver them up until the objectionable marks have been erased (*q*). And, further,

to her Majesty, and it contains a power for the Court to order the destruction of the forfeited articles; sect. 2 (3), (4); Book II., Chap. I., pp. 514, 522.

(*n*) 6 R. P. C. 531 (1889), Kekewich, J., and C. A.

(*o*) *Moet* v. *Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), C. A. reversing Fry, J.

(*p*) *Ponsardin* v. *Peto*, 33 Beav. 642; 33 L. J. Ch. 371 (1863), Romilly, M.R.; *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

(*q*) *Hunt* v. *Maniere*, 34 Beav. 157; 34 L. J. Ch. 142 (1864), Romilly, M.R., and L.JJ. Action by indorsee of dock warrants against wharfingers restrained.

he is entitled to an indemnity from the bailor against the damages and costs incurred by him by reason of his dealing with the goods at the latter's request (*r*). His proper course, on being informed by the owner of the trade-mark infringed, or his agents, that goods in his possession are spuriously marked, is to give all necessary information to enable them to stop the infringement, to undertake that the goods shall not be removed or dealt with until the spurious marks have been obliterated, and to give the persons injured all requisite facilities for that purpose (*s*). If he takes this course, the costs of any proceedings subsequently taken against him by the plaintiff will be ordered to be paid to him (*t*); but he must pay the costs of proceedings previously taken, even though in an action commenced without notice to him (*u*), unless the value of the infringing goods in his possession is trifling (*x*).

(iii.) Damages.

Nominal damages.

It was long ago decided at common law, that the mere proof of an infringement entitles the plaintiff to nominal damages (*y*), and that, consequently, no allegation of special damage is a necessary part of his case (*z*). And the natural consequence of an infringement, even though it be made in complete ignorance of the plaintiff's rights, is that the infringer must pay at least nominal damages, and the costs of action, so that, if he acted under the direction of a third person, he may reasonably compound with the proprietor of the trade-mark on these terms, and claim an indemnity from his employer (*a*).

Indemnity to agent or purchaser.

(*r*) *Dixon* v. *Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861).

(*s*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

(*t*) Last case, and *Moet* v. *Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

(*u*) See last cases, and *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.

(*x*) *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

(*y*) *Blofeld* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833).

(*z*) *Rodgers* v. *Nowill*, 5 C. B. 109; 17 L. J. C. P. 52 (1847).

(*a*) *Dixon* v. *Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861). As to implied warranty by the use of a trade-mark, see below, Chap. XVII., p. 432.

Onus of showing substantial damage lies on the plaintiff.

But, if the plaintiff claims substantial damages, the onus of showing that he has incurred them through loss of custom, of trade reputation (*b*), or otherwise, by reason of the defendant's conduct, lies upon him; and it will not be presumed, in the absence of evidence, that the amount of goods sold by the defendant under the fraudulent trade-mark would have been sold by the plaintiff but for the defendant's unlawful use of the plaintiff's mark (*c*). The proper form of an order for an inquiry as to damages occasioned by the infringement of a trade-mark is, therefore, what damage (if any) has the plaintiff sustained (*d*).

If the infringement is a continuing one, the damages ought to be assessed down to the time of the assessment (*e*).

Plaintiff not solely entitled to the mark.

It has been held, that the plaintiff is entitled to the ordinary inquiry as to damages or account of profits, though he is not the only person entitled to the use of the infringed mark (*f*).

(iv.) Account of Profits or Inquiry as to Damages.

When the plaintiff has succeeded in establishing that his trade-mark rights have been seriously infringed, a recurrence of the wrong is forbidden by the grant of an injunction, and by way of redress for the injury, if any appears to have been caused, which has already been occasioned to him, the plaintiff may, in general, make his choice of either an account and payment to him of the profits which the defendant has gained by his wrongful conduct, or an inquiry as to, and payment of, the damages occasioned to the plaintiff by reason of it, that is, unless the case is tried before a jury and damages are assessed

(*b*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; 3 L. J. K. B. O. S. 46 (1824).

(*c*) *Leather Cloth Co.* v. *Hirschfield*, L. R. 1 Eq. 299 (1865), Wood, V.-C.

(*d*) *Davenport* v. *Rylands*, L. R. 1 Eq. p. 308, *per* Wood, V.-C.

(*e*) O. 36, r. 58.

(*f*) *Southorn* v. *Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C.; see also *Dent* v. *Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.

by the jury at once, or assessed by the judge sitting alone, acting as a jury.

Account of profits and damages are alternative.

The account and inquiry are alternative remedies (*g*), for, though in some of the earlier cases they were both allowed, they are now considered to be inconsistent. "If you take an account of profits, you condone the infringement," Lord Westbury said, in a patent case (*h*), and the same rule applies in trade-mark cases also.

Account or inquiry only granted if substantial damage is shown.

But neither an account nor an inquiry as to damages will be granted if the evidence of sales under the objectionable mark is not sufficient to make it worth while (*i*), or if it appears that the defendant has only used his mark for a short time (*k*). For instance, no account or damages was allowed or given in a case where the only infringement proved was by the defendant, at the request of a customer, filling with lime-juice, of his own make, a bottle embossed with the plaintiff's mark, removing the plaintiff's label, and replacing it by his own (*l*).

They only go back for six years;

Damages can only be recovered, and the profits to be included in the account can only be reckoned, in respect of infringements occurring within six years from the issue of the writ (*m*).

and, as against innocent purchasers or bailees, only to notice of infringement.

It has been shown that it is no answer to the claim for an injunction that the infringement was effected innocently, in ignorance of the existence of trade-mark rights; but damages or an account of profits are only calculated as against an innocent dealer in, or purchaser of, the spuriously marked goods, in respect of sales, dealings, or other infringements, if any, of which he is guilty after becoming aware of the plaintiff's rights (*n*).

(*g*) *Per* Cotton, L.J., in *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887).

(*h*) *Neilson* v. *Betts*, L. R. 5 H. L. 1 (1871); followed in *De Vitre* v. *Betts*, L. R. 6 H. L. 319 (1872).

(*i*) *Sanitas Co., Ld.* v. *Condy*, 4 R. P. C. 530 (1887), Kekewich, J.

(*k*) *McAndrew* v. *Bassett*, 10 Jur. N. S. 495 (1864), Westbury, C.

(*l*) *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

(*m*) *Per* Mellish, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. p. 633 (1872).

(*n*) *Edelsten* v. *Edelsten*, 1 De G.

The case of a manufacturer who copies a mark he finds on goods which he knows are not his own is different. He may not know whose mark it is, and may possibly be in doubt whether it is a trade-mark or not, but he knows that he has no right to the mark, and the damages or account are therefore calculated as against him from the first infringement, within six years of the writ (*o*).

Refused because of delay or acquiescence.

The Court has refused, in some cases, to order an account of profits where the plaintiff has neglected to take proceedings after becoming aware of the infringement (*p*); and it may be assumed that it certainly would not assist the plaintiff to recover profits which he had delibe allowed the defendant to earn in the expectation of obtaining them from him (*q*). But delay to obtain evidence necessary to establish his case would not bar the plaintiff of his ordinary remedy (*r*), nor, it is submitted, would any reasonable delay in the hope of avoiding litigation after a definite warning to the defendant.

Limited because of misrepresentation.

In a case where there had been some delay, and some amount of misrepresentation in his business, on the plaintiff's part, and the defendant's proper trade was larger than that of the plaintiff's, the account was limited to profits earned since the commencement of the suit, and Mellish, L.J., said that it was a case where a jury would have given forty shillings damages only (*s*).

Form of order for account.

The ordinary form of the order for an account directs an account of the profits made by the defendant in selling or

J. & S. 185 (1863), Westbury, L.C.; *Moet* v. *Couston*, 33 Beav. 578; 10 L. T. N. S. 395 (1864), Romilly, M.R.; *Ellen* v. *Slack*, 24 Sol. J. 290 (1880), Jessel, M.R.

(*o*) *Moet* v. *Couston*, *supra*; *Cartier* v. *Carlile*, 31 Beav. 292 (1862), Romilly, M.R.

(*p*) *Harrison* v. *Taylor*, 11 Jur. N. S. 408; 12 L. T. N. S. 339; *Beard* v. *Turner*, 13 L. T. N. S. 746, both (1865), Wood, V.-C.

(*q*) Cf. *Anglo-Swiss Condensed Milk Co.* v. *Swiss Condensed Milk Co.* (1871), W. N. 163, Malins, V.-C., cited above, p. 351; *Beard* v. *Turner*, *supra*.

(*r*) See *Cave* v. *Myers* (1868), Seb. Dig. p. 181, Giffard, V.-C.; and *Lee* v. *Haley*, 21 L. T. N. S. 546; L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J.

(*s*) *Ford* v. *Foster*, L. R. 7 Ch. p. 633 (1872), L.JJ.

otherwise disposing of the goods with the spurious mark or marks which he is proved to have used in infringement of the plaintiff's rights, to be taken by the chief clerk or the official referee, and orders payment of the amount found to be made by the defendant to the plaintiff within a time fixed from the date of the certificate or report (*t*).

In the case just cited, it was objected that the account should be limited to sales made to persons who bought the goods as and for the goods of the plaintiff, by reason of the use of the infringing mark upon them; but the Court overruled this objection (*u*). For the mischief done by the spurious marking of the goods is not merely that it is calculated to deceive immediate purchasers from the infringers, but that it puts "a weapon calculated to be fraudulently used by the middlemen" (*x*) into their hands, by which they may, intentionally or not, deceive the ultimate purchasers.

Costs of inquiry or account.

The costs of the inquiry as to damages or the account of profits, should generally be reserved until the result of the inquiry or account is known (*y*), at any rate, unless it is clear that it will be of substantial value to the plaintiff; for if no damage or profits are found to have been made (*z*), or if the proceedings subsequent to the judgment are oppressively conducted by the plaintiff, he ought to pay the costs. But where the defendant had filed a false affidavit greatly understating the number of goods sold, although the account showed that he had made no profit, Chitty, J., said it was a case for investigation, and allowed the plaintiff the costs (*a*).

(*t*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; Appendix, p. 652.

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

(*x*) *Per* Cotton, L.J., in *Lever* v. *Goodwin*.

(*y*) *Per* Fry, J., in *Stark* v. *Midland Rail. Co.*, 16 C. D. 81 (1880), a case of nuisance.

(*z*) *Tongo* v. *Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.

(*a*) *Dicks* v. *Jackson*, 31st March, 1884, cited Sebastian, 3rd ed. p. 255.

7. Costs.

Costs in the discretion of the judge.

Subject to sect. 77a of the Act, which is referred to below, the costs of and incident to an action for the infringement of a trade-mark, as the costs in any other action, are in the discretion of the Court or judge, and the Court or judge has full power to determine by whom and to what extent such costs shall be paid (*b*). Provided that where the action is tried with a jury, the costs follow the event, unless the judge by whom it is tried, or the Court, for good cause, otherwise orders (*c*).

Unsuccessful party usually ordered to pay costs.

The Court or judge in general follows the ordinary rule that the unsuccessful party shall pay the costs of the litigation, such costs being taxed upon the usual scale between party and party; but the discretion conferred by the Act and rule just cited is constantly exercised in trade-mark cases, where the nature of the case, or the conduct of the parties, or of one of them, makes it just that the ordinary practice should be departed from.

An unsuccessful defendant must usually pay costs, although he has only defended a mark which he honestly adopted without being aware of its too great resemblance to the plaintiff's mark (*d*), and though he has acted without fraud and in ignorance of the plaintiff's rights (*e*), and the action has been commenced against him without notice (*f*).

Infringer must offer complete redress before action.

But by offering the plaintiff all that he is entitled to, that is, in the case of the innocent holder of spuriously marked goods, an undertaking not to part with them until the spurious marks have been removed (*g*), and all requisite

(*b*) Supreme Court of Judicature Act, 1890, s. (5).

(*c*) O. 65, r. 1.

(*d*) *Blair* v. *Stock*, 52 L. T. 123 (1884), Kay, J.; cf. the registration cases, *Hyde & Co.'s Tm.*, 7 C. D. 724; *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n., both (1878), Jessel, M.R.

(*e*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; *Tonge* v. *Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.

(*f*) *Field* v. *Lewis*, Seb. Dig. p. 167 (1867), Wood, V.-C.; *Upmann* v. *Forester*, 24 C. D. 231 (1883), Chitty, J.

(*g*) An innocent consignee or

information to enable him to stop the infringement (*h*) and the payment of the taxed costs (*i*) (if any) already incurred by him in the action, if an action has been commenced, the defendant may escape liability for subsequent costs; and if the plaintiff, after such an offer has been made, commences or continues proceedings against the defendant making it, he will be ordered to pay him his costs subsequently incurred (*k*).

In *Moet* v. *Pickering* (*l*), where wharfingers with whom the spuriously marked goods had been warehoused in the ordinary course of trade, and who were entitled to a lien for their charges, were added as defendants, and the plaintiffs proceeded to trial against them, the Court of Appeal, reversing Fry, J., ordered that their costs of action should be paid by the plaintiffs. The wharfingers had pleaded that they had no knowledge of the infringement, and that they submitted to act as the Court should direct, upon payment of their charges and costs; but the Court of Appeal regarded this as meaning only that they claimed nothing adversely to the plaintiffs or the infringer. The case does not conflict with the rules stated above, for the plaintiffs had claimed to override the wharfingers' lien by a lien of their own for costs, and this was held to be wrong; and besides, it was clearly unnecessary to have added the wharfingers as defendants or to have proceeded to trial against them, since not only had they made no threat to

bailee may become liable for damages if he sends the spurious goods out of the country, or otherwise puts them beyond the control of the Court. *Upmann* v. *Elkan*, *infra*.

(*h*) Above, p. 358. The plaintiff is not entitled to the publication of an apology. *Hudson* v. *Bennett*, 14 L. T. N. S. 698 (1866), Stuart, V.-C.

(*i*) *Burgess* v. *Hills*, 26 Beav. 244; 28 L. J. Ch. 356 (1858), Romilly, M.R.; *McAndrew* v. *Bassett*, 33 L. J. Ch. 561; 4 De G. J. & S. 380 (1864), Wood, V.-C., and Westbury, C.; *Fennessy* v. *Day and Martin*, 55 L. T. 161 (1886), Bacon, V.-C.

(*k*) *Millington* v. *Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.; *Moet* v. *Couston*, 33 Beav. 578 (1864), Romilly, M.R.; *Upmann* v. *Elkan*, L. R. 12 Eq. 140; 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.; *Moet* v. *Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

(*l*) A similar order was made in *Upmann* v. *Elkan*, last note.

part with the goods, but after notice of the injunction obtained against the infringer it would have been a contempt of Court for them to do so.

Stay of proceedings.

And where the plaintiff has obtained, or is offered, all that he is entitled to, the Court will stay further proceedings in the action, at the defendant's instance (*m*).

Trivial cases.

And in a trivial case, where an action had been commenced without notice against the innocent purchaser of an inconsiderable quantity of spuriously marked goods, and he at once submitted to do as the Court directed, Stirling, J., refused to give any costs (*n*).

And it is no reason for not giving costs that the defendant is an infant (*o*).

Costs refused because plaintiff claimed too much.

Costs have been refused to a successful plaintiff because he claimed, besides the injunction to which he was entitled, an account to which he was not, against an innocent purchaser of the spuriously marked goods (*p*); and in a similar case, where the plaintiffs set up claims to a copyright in a music tutor, as well as an exclusive right to its title, and failed as to the copyright, they were allowed only half their taxed costs of action (*q*). On similar grounds, plaintiffs have been ordered to pay (*r*), or have been deprived of (*s*), the costs occasioned by allegations which they have failed to prove, although they have succeeded and obtained the general costs of their actions. But where the plaintiff, in an action for infringing his trade-mark and also for "passing off," failed as regards the infringement in respect of some of the goods for which he used, but had not registered, the trade-mark, and

(*m*) *Rudd* v. *Rowe*, L. R. 10 Eq. 610 (1870), James, V.-C; *Curtis and Harvey* v. *Pape*, 5 R. P. C. 146 (1888), North, J., (*Diamond Gunpowder*).

(*n*) *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218; cf. *Rose* v. *Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

(*o*) *Chubb* v. *Griffiths*, 35 Beav. 127 (1865), Romilly, M.R.

(*p*) *Moet* v. *Couston*, 33 Beav. 578 (1864), Romilly, M.R.

(*q*) *Metzler* v. *Wood*, 8 C. D. 606 (1877), Malins, V.-C., and C. A.

(*r*) *Pierce* v. *Franks*, 15 L. J. Ch. 122 (1846), Knight-Bruce, V.-C.

(*s*) *Standish* v. *Whitwell*, 14 W. R. 512 (1866), Wood, V.-C., an affidavit charging fraud.

succeeded as to the rest of the action, and the defendant was held to have been guilty of deliberate infringement in breach of an undertaking previously given by him, Kekewich, J., refused to deprive the plaintiff of any part of his costs (*t*).

And in a recent case, where an action for infringement and two motions by the defendants, one to expunge the plaintiffs' registration, and the other for an order to the comptroller to register a mark, propounded by the defendants, were tried together, and the action and the second motion failed, but the first motion succeeded, and both parties made unfounded allegations of fraud, North, J., refused to give any costs to either, principally on the ground that it was absolutely impossible for any taxing master to do justice between the parties by distinguishing the costs of one part of the case from another (*u*).

Successful defendant deprived of costs.

A successful defendant is much more often deprived of his costs than a successful plaintiff, for the plaintiff may fail in his action although the evidence makes it clear that the defendant has acted, or intended to act, dishonestly, and in such a case, although the Court decline to assist the plaintiff, it generally refuses to give costs to the defendant.

Where, for example, the plaintiff failed because of misrepresentations contained in his trade-mark (*x*), but the defendant had closely imitated the mark, the action was dismissed without costs; and the same course was followed where there was no sufficient proof that the defendant's mark was calculated to deceive, having regard to the long delay of the plaintiff to take proceedings, and the absence of evidence of actual deception (*y*); and in cases where

(*t*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888).

(*u*) *Baker* v. *Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890); *Jackson* v. *Napper*, 35 C. D. 162; 4 R. P. C. 162 (1886), Stirling, J.

(*x*) *The Leather Cloth Co., Ld.* v. *The American Leather Cloth Co., Ld.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53 (1863), Westbury, L.C., and H. L. The House of Lords held that there was no infringement.

(*y*) *Rodgers* v. *Rodgers*, 31 L. T. N. S. 285 (1874), L.JJ.

the action was dismissed, but the Court thought that the defendant's conduct had been uncandid and unfair (*z*).

So, too, no costs were given where it was proved that the defendant had represented the goods he sold as being those of the plaintiff, although the proof of the plaintiff's title failed (*a*).

In *The Patent Plumbago Case* (*b*), however, where the plaintiffs failed on the ground of misrepresentation, but the imitation of their trade-name was clearly made out, the action was dismissed with costs, the plaintiffs having continued to misdescribe their goods as "patent" after a summons taken out at their instance had been dismissed by the magistrate on that ground.

Defendant *in pari delicto*.

So, in cases in which the plaintiff fails because he is carrying on a fraudulent trade, and the defendant stands *in pari delicto*, the practice is to dismiss the action without costs (*c*).

Unfounded charges of fraud.

And a successful defendant has also been deprived of costs because he has made an unfounded charge of fraud (*d*).

Costs of appeal.

In a recent trade-name case, where the plaintiffs' action was dismissed by the Court of Appeal on the ground that they were not satisfied that the name adopted by the defendants would cause any deception likely to occasion damage to the plaintiffs, costs, both of the appeal and in the Court below, were refused because the Lords Justices believed that the defendants had chosen the name in dispute with

(*z*) *Estcourt* v. *The Estcourt Hop Essence Co.*, 31 L. T. N. S. 567; L. R. 10 Ch. 276 (1874), Malins, V.-C., Cairns, C., and L.JJ.; *Maxwell* v. *Hogg*, 15 L. T. N. S. 204; L. R. 2 Ch. 310 (1866), Stuart, V.-C., and L.JJ.

(*a*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C.; and see *Browne* v. *Freeman*, (1), 12 W. R. 305 (1864), Wood, V.-C., where the defendant misdescribed his goods as *The Original Chlorodyne*.

(*b*) *Morgan* v. *McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C.

(*c*) *Newman* v. *Pinto*, 4 R. P. C. 508; 59 L. T. 31 (1887), C. A.

(*d*) *Humphries* v. *The Taylor Drug Co.*, 59 L. T. 620 (1888), Kekewich, J.; *Hargreaves* v. *Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

the hope of obtaining some illicit advantage from the plaintiff's reputation (*e*).

But these reasons for depriving the defendant of costs do not apply to the costs of an appeal brought by the plaintiff against the dismissal of his action which fails. Thus, the appeal to the House of Lords in *The Leather Cloth Case* (*f*), and the appeal to the Court of Appeal in *Newman* v. *Pinto* (*c*), were both dismissed with costs. In the former case the plaintiff obtained judgment in the first instance, and when this was reversed on appeal by Lord Westbury no costs were given (*g*).

Higher scale.

The Court or judge may order the costs adjudged to be paid to be taxed upon the higher scale, if special grounds arising out of the nature and importance, or the difficulty or urgency, of the case, appear to exist (*h*). Such an order was made, by North, J., in *The Great Tower Street Tea Co.* v. *Smith* (*i*), where the hearing occupied a long time, and the facts were complicated, and a great number of witnesses were called. But some special reason for the order must be shown, for, although the application is almost always made in heavy trade-mark or patent actions, it is not granted as of course (*k*); and it is not granted as a punishment (*l*), or merely because a case of gross fraud is made out (*k*). That scientific witnesses are necessarily called has been held to be a special reason (*m*).

(*e*) *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A.

(*f*) 11 H. L. C. 523; 35 L. J. Ch. 53.

(*g*) 4 De G. J. & S. 137; 33 L. J. Ch. 199. This course was taken also in *Borthwick* v. *The Evening Post*, *supra*.

(*h*) O. 65, r. 9. See the note in the Annual Practice.

(*i*) 6 R. P. C. 165 (1889).

(*k*) *Sanitas Co., Ld.* v. *Condy*, 4 R. P. C. 530 (1887), Kekewich, J. In *Rodgers* v. *Rottgen*, 5 Times L. R. 678 (1889), Kay, J., said he gave costs on the higher scale very charily.

(*l*) *Hudson* v. *Osgerby*, 32 W. R. 566; 50 L. T. 323 (1884), Pearson, J.; and see *Pooley's Trustee* v. *Whetham*, 33 C. D. p. 120; and *Paine* v. *Chisholm*, (1891) 1 Q. B. 531, and the cases there cited.

(*m*) *Ellington* v. *Clark*, 58 L. T. 818 (1888), C. A.; *The Robin*, (1892) P. 95, Jeune, J.

It is provided by sect. 77 (a) (*n*) that—

Costs as between solicitor and client.

"In an action for the infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same."

This section corresponds to the provision of sect. 31 of the Act with regard to actions for the infringement of a patent (*o*).

Certificate that title to trade-mark came in question.

A certificate cannot be granted unless the right to the exclusive use of the trade-mark has, in fact, come in question, and, therefore, it was refused in a case where the defendant's counsel admitted that, upon the failure of the defendant's application to remove the plaintiff's mark from the register, he had no defence to the action (*p*).

In a case where the Court of Appeal refused an application by the defendant to expunge the plaintiffs' marks, partly on the ground that the defendant was a deliberate infringer, they declined to give the plaintiffs a certificate under the section (*q*).

The order granting a certificate is not appealable (*r*).

Costs of motion to rectify in aid of defence.

Similar considerations govern the grant or refusal of costs in respect of the application to rectify the register by expunging or varying the registration of the plaintiff's mark, which is an ordinary incident of the defence in an action for infringement. The usual practice is to give the

(*n*) Act of 1883, sect. 18.

(*o*) See Edmunds on Patents, pp. 329 *et seq.* and 487.

(*p*) *Benjamin Edgington, Ld.* v. *John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(*q*) *Paine & Co.* v. *Daniells and Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, cited p. 313.

(*r*) *Haslam & Co.* v. *Hall*, 5 R. P. C. 144 (1888), C. A.

applicant costs, if he succeeds (*s*); but if the application is made for the purposes of the action by the defendant, and it is doubtful whether he is not acting fraudulently, the costs may be reserved till the trial (*t*), or may be refused (*u*).

8. Appeal.

Appeal advanced.

In a case where the defendant desired to appeal against an interim injunction which the plaintiff had obtained, the Court, on his application, and on the ground that the continuance of the injunction would do irreparable damage to his business, advanced the case to the head of the list (*x*).

Stay of order.

An application to stay a new trial ordered to take place by the Court of Appeal, pending an appeal against the order to the House of Lords, was refused in *Edge* v. *Johnson* (*y*).

Barred by delay.

In *Burgess* v. *Burgess* (*z*), delay for five months in appealing against an order for an interim injunction, where the plaintiff was appellant, seeking to have the scope of the order enlarged, was held to be a bar to the appeal.

Non-suit.

If an appeal is brought, and the defendant succeeds, judgment is entered in his favour, not a non-suit (*a*); but the Court of Appeal, in dismissing the plaintiff's action, may reserve to him liberty to sue again in respect of any part of his claim. This course was adopted in an action where the plaintiff sought to raise a new case of "passing

(*s*) *Richards* v. *Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 37, Kay, J.

(*t*) *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

(*u*) *Perry-Davis' Tm.*, 5 R. P. C. 333 (1888), Kay, J.; *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J. See further Chap. XI., p. 244.

(*x*) *Lazenby* v. *White*, L. R. 6 Ch. 89 (1870), James, L.J.

(*y*) 9 R. P. C. 134 (1892).

(*z*) 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), L.JJ. So also in *Re Palmer's Application*, 22 C. D. 88 (1882), C. A., where the Court had decided against a preliminary objection. The time for appealing against an interlocutory order is now fourteen days. Rules of 1893, O. 58, r. 15A.

(*a*) *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A.

off," not set up by the pleadings, at the trial, and was not allowed to proceed with it (*b*).

9. Practice.

Pleadings.

There are no rules as to pleadings which are peculiar to actions for the infringement of trade-marks (*bb*); all that is necessary, therefore, is that the statement of claim, defence, and reply, if any, in any such action, shall respectively contain a statement, in a summary form, of the material facts upon which the party pleading relies for his claim or defence (*c*), giving particulars of the frauds, if fraud is alleged (*d*). What are material facts, having regard to the circumstances of the case, may be gathered from the statement of substantive law, given in the earlier part of the present chapter.

Forms in the Rules of the Supreme Court.

The forms provided by the appendices to the Supreme Court Rules, are set out below. They are, when applicable, and when they are not applicable forms of a like character, and as near as may be to them, to be used for all pleadings; and, where they are applicable and sufficient, any longer forms are to be deemed prolix, and the costs occasioned by such prolixity are to be disallowed, or to be borne by the party so using the same, as the case may be (*e*).

INDORSEMENT ON THE WRIT.

The plaintiff's claim is for damages for wrongfully using (or imitating) the plaintiff's trade-mark.

STATEMENT OF CLAIM.

(1.) The defendant has infringed the plaintiff's trade-mark.

(2.) The trade-mark is (*describe it*). (*If the plaintiff*

(*b*) *Native Guano Co.* v. *Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L.

(*bb*) Sect. 9 of the Merchandise Marks Act, 1887, provides that in any pleading, proceeding, or document in which any trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient, without any copy or facsimile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark.

(*c*) O. 19, r. 4.

(*d*) O. 19, r. 6.

(*e*) O. 19, r. 5.

is not the original proprietor of the trade-mark, show shortly how his title is derived.)

(3.) The following acts are complained of, viz.:—
(*Set them out.*)

The plaintiff claims an injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade-mark, and in particular from (*stating any particular injunction sought*).

The plaintiff also claims an account or damages (*f*).

DEFENCE.

(1.) The trade-mark is not the plaintiff's.
(2.) The alleged trade-mark is not a trade-mark.
(3.) The defendant did not infringe.

It will be observed that the form of statement of claim here given does not comprise an allegation that the plaintiff's trade-mark has been registered, or that sect. 77 of the Act has been otherwise complied with; but such an allegation is certainly proper, and, it is submitted, necessary.

Some more elaborate and detailed forms are given in the Appendix (*g*).

Particulars.

The ordinary rule (*h*) that the parties must state the facts upon which they rely and which they plead in their pleadings, or in particulars separately delivered, with sufficient particularity to prevent their opponents being taken by surprise at the trial, applies to trade-mark cases.

So where a plaintiff alleged that the defendant's mark was calculated to induce, and had in fact induced, divers persons to purchase the defendant's preparation as and for the goods of the plaintiff, he was ordered to give particulars of the divers persons referred to (*i*).

(*f*) Rules of the Supreme Court, Appendix C., sect. 6, Form 5.

(*g*) Pages 643 *et seq.*

(*h*) See the notes to O. 19, rr. 6 and 7 in the Annual Practice.

(*i*) *Humphries* v. *Taylor Drug Co.*, 39 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J.

Discovery.

The ordinary rules (*k*) governing discovery also apply to trade-mark actions (*l*).

Orders for discovery in trade-mark cases modified to prevent abuse.

But a process which enables a rival trader to extract from his opponent information concerning his customers, his trade, and his mode of doing business, is extremely likely to be abused, and in cases where a large trade-mark business is affected, even the ordinary order for discovery of documents upon oath may be very oppressive (*m*). The Court, therefore, will, upon a proper case being shown, modify the ordinary orders so that they shall occasion no more inconvenience to the party to whom they are directed than is necessary to ascertain the rights of his opponent.

Thus, in *Carver* v. *Pinto Leite* (*n*), it was held that the defendants, in a suit for infringement, who had been ordered to file an affidavit of documents and to produce the documents in the ordinary way, ought not to be ordered to disclose the names of customers, or of persons to or from whom letters referring to the matters in issue were sent or received, inasmuch as such discovery might be used in a manner prejudicial to the defendants in their trade, and was not likely to assist the plaintiffs in making out their case at the hearing.

Disclosure of sales.

Discovery in regard to the sales effected by the defendant under the disputed mark is not, in general, where the infringement is denied, material, until the fact that the

(*k*) O. 31. The Merchandise Marks Act, 1887, provides that nothing in that Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action: sect. 19.

(*l*) *Orr* v. *Diaper*, 4 C. D. 92 (1876), Hall, V.-C., demurrer to an action for discovery against shippers, brought in aid of an intended action against the consignors, dismissed.

(*m*) *Wills' Tms.*, (1892) 3 Ch. 201; 10 R. P. C. 269, C. A.

(*n*) L. R. 7 Ch. 90 (1871), C. A. See also *Benbow* v. *Low*, 16 C. D. 93 (1880), C.A.; and *The Attorney-General* v. *The North Metropolitan Tramways Co.*, (1892) 3 Ch. 70, North, J. Full discovery was ordered in *Howe* v. *McKernan*, 30 Beav. 547 (1862), Romilly, M.R., where the defendant was charged with advertising himself as the plaintiff's agent after the agency was determined.

mark is an infringement of the plaintiff's rights has been decided (*o*); but where the giving of an account would occasion little trouble to the defendant, and might enable the plaintiff to get final judgment at the trial, without further inquiry, the judge, in his discretion, might order it to be given (*o*). In a case where the questions of fact had been ordered to be tried by a jury, such discovery was refused, before the trial, on the ground that the plaintiff had not elected whether to claim damages or an account of profits if he succeeded (*p*). After an account of profits has been directed, discovery of the names of the persons to whom the marked goods were sold, or, if this cannot be had, goods which the accounting party cannot swear were not marked with the objectionable mark were sold, may be ordered (*q*).

Discovery in aid of inquiry or account.

Inspection, &c.

The Court or a judge has wide powers, under Ord. 50, r. 3, to make any order for the detention, preservation, or inspection (*r*) of any property or thing, being the subject of litigation, and to authorize any persons to enter upon or into any land or building in the possession of any party to the litigation, and, for all or any of the purposes aforesaid, to authorize any samples to be taken, or any observation to be made, or experiment to be tried, which may be

(*o*) *Benbow* v. *Low*, 16 C. D. 93 (1880), C. A. See also O. 31, r. 20, and the note in the Annual Practice thereon. And for the decisions in patent cases, see Edmunds on Patents, p. 308, and *De la Rue* v. *Dickinson*, 3 K. & J. 388 (1857).

(*p*) *Fennessy* v. *Clark*, 37 C. D. 184 (1887), Kay, J., and C. A.

(*q*) *The Leather Cloth Co., Ld.* v. *Hirschfeld*, 1 H. & M. 295 (1863), Wood, V.-C.

(*r*) Sect. 21 of the repealed Merchandize Marks Act of 1862 gave jurisdiction to order inspection. As to the powers of justices to issue *search warrants* for goods by means of or in relation to which an offence has been committed under the Merchandise Marks Act, 1887, see sect. 12 of that Act, p. 520. A person charged with an offence under the Act may find it necessary to show that "on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things"; sect. 2 (2), and sect. 6. See Book II., pp. 502, 509, and 511.

necessary or expedient for the purpose of obtaining full information or evidence.

Under this power the Court could, for instance, authorize the plaintiff to inspect goods upon which he showed reasonable grounds for suspecting that a mark infringing his mark had been placed (*s*).

The application is made in the Chancery Division by motion or summons; in the Queen's Bench Division by summons (*t*).

Documents referred to in the pleadings, &c.

Production and inspection of copies of the trade-marks or of other documents which are referred to in any of the pleadings or affidavits of any of the parties in a case, may be obtained by giving notice in writing to such party to produce them, unless some cause or excuse for not complying with the notice is shown, which the Court or judge deems sufficient (*u*).

Evidence.

The comptroller's certificate, and sealed copies of the register.

The registration of the plaintiff's mark, or the refusal to register it, is proved by the production of a certificate under the hand of the comptroller, and the actual terms of the registration, and proof of the mark itself as it is registered, are shown and given by the production of an extract or copy from the register certified by the comptroller and sealed with the seal of the Patent Office (*x*).

The request for the certificate should be made to the comptroller in writing, stating for what purpose it is required, in the form given in the schedule to the rules (*y*). It may be sent by post (*z*). The fee for a certificate for use in legal proceedings is one pound.

(*s*) Such inspection is frequently authorized in patent cases. See Edmunds on Patents, p. 307; and *Neilson* v. *Betts*, L. R. 5 H. L. p. 11, *per* Lord Westbury.

(*t*) See the Annual Practice notes to O. 50, rr. 3 and 6.

(*u*) O. 31, r. 15. *Smith* v. *Harris*, 48 L. T. 869 (1883), Chitty, J. The learned judge refused to order barrels branded with the mark to be produced. See also *Wills' Tms.*, above, p. 242.

(*x*) Sect. 88, Rule 52, Chap. III., p. 57.

(*y*) Rule 60, Form S., p. 614.

(*z*) Sect. 98.

By sect. 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." Copies of the register.

And by sect. 96—

"A certificate purporting to be under the hand of the comptroller of any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or left undone." Comptroller's certificates.

This section corresponds to sect. 8 of the Act of 1875.

The registered mark is, in practice, usually shown by the production of a copy of the advertisement in the Trade-Marks Journal, leading to its registration, and this is generally accepted as sufficient.

Where the mark is registered, and the plaintiff is the registered proprietor, proof of the registration, and of the identity (if any question as to this is raised) of the registered proprietor with the plaintiff is *prima facie* evidence of the plaintiff's right to the exclusive use of the mark, and, after five years from the date of the application for registration, is conclusive evidence of his right, until the registration is annulled upon an application under sect. 90 (*a*). Proof of title of registered proprietor;

If the plaintiff claims, by devolution or assignment, through the registered proprietor, he must prove the devolution or assignment by giving the proper evidence of the facts which effect it, and must prove in the same way that the goodwill of the business concerned has also devolved upon or been assigned to him (*b*). of title by assignment, &c.;

(*a*) Sects. 75 and 76. See above, p. 364.

(*b*) Sect. 70, Chap. XIII., p. 272.

of infringement;

The infringement must be proved by showing that the defendant, his servants, or agents, have dealt in, or threaten, or are about to deal in goods of the kind to which the plaintiff's trade-mark rights extend, in such a manner as to infringe his trade-mark (*c*).

of probability of deception.

The nature of the evidence which should be adduced to satisfy the Court that the defendant's mark has such a resemblance to the plaintiff's as to be calculated to deceive, has already been discussed (*d*). It has been shown that the Court, in general, attaches little weight to the mere statements of opinion by persons who are called as expert witnesses, or, as Fry, L.J., put it, in *Turton* v. *Turton* (*e*), as "compurgators," to say that they think there is no probability of deception.

The registrar's books are not evidence that a mark is *publici juris*.

In *Orr-Ewing* v. *Johnston* (*f*), Fry, J., held, that the books kept by the registrar of trade-marks were not evidence, in an action for infringement, to show that marks like the plaintiff's mark were in common use and had been refused registration, and that the plaintiff's mark was consequently *publici juris*. The books were only evidence, the learned judge held, that other persons had made claims. Certified copies of entries on the register are, however, evidence of such entries, and if they show that three or more marks other than, but similar to, the plaintiff's have been registered for the same goods, that would, it is submitted, be evidence that the mark is a common mark (*g*).

(*c*) *Ante*, p. 305.

(*d*) Above, p. 314, and Chap. X., p. 186.

(*e*) 42 C. D. 149 (1889). See also *Cope* v. *Evans*, L. R. 18 Eq. 138 (1874), Hall, V.-C.

(*f*) 13 C. D. at p. 442 (1879).

(*g*) See the "Three Marks Rule," Chap. X., p. 177.

CHAPTER XVI.

THE ACTION FOR "PASSING OFF."

PAGE

Foundation of the action 380
Comparison with the action for infringement 380
It often succeeds where that action fails 382
Common law trade-marks 383
New case of passing off or of fraud raised at the trial 383
Proof of fraud not essential 384
Property in trade-name, &c. 384
Inferiority of the spurious goods not essential 385
Rules and practice of infringement action generally apply .. 385

1. Direct misrepresentation as to business or goods 386
false pretence of business connection or of succession .. 387
"late" 387
circulars, names over shops, executing orders intended for the plaintiff 388
unauthorised use of name of a non-trader 389

2. Imitations of trade-name, get-up, &c. 389
evidence of repute 390
assignment and devolution of trade-name, &c. 391
A. THE PLAINTIFF'S TRADE-NAME 392
it may belong to others besides the plaintiff 394
need not be the plaintiff's family name 394
trade-name of a company 395
sect. 20 of the Companies Act is supplementary to the common law 395
Hendriks v. *Montagu* 396
no monopoly in names merely descriptive 397
cases of company trade-names collected 398
Tussaud v. *Tussaud* 399
right to use a name cannot be sold 401
names of houses of business 401
B. THE TRADE-NAME OF THE PLAINTIFF'S GOODS 402
summary of principles 403
names which are not distinctive, and descriptive names .. 403
name of introducer or patentee 405
common names 406
mere use of descriptive word constitutes no cause of action .. 406
disclaimed word 407
expunged trade-mark 407
use of common word by defendant may be an element in a "get-up" case 408
honest description of defendant's goods constitutes no cause of action 408
name of author, &c., name of book 410
C. IMITATION OF "GET-UP" 411
get-up common to the trade 411
no monopoly in the constituent elements 412
imitation of part of get-up 412

PAGE
3. Use in connection with the defendant's goods 413
4. Probability of deception 414
where deception is intended 414
badges of fraud: unexplained similarities, colourable differences, gradual approximations 414
proof of actual deception 415
5. Proof of damage 415
probability or proof of damage is essential 415
6. Defences 416
the usual defences summarised 416
concurrent right 417
partners after dissolution 417
purchaser of goodwill 417
RIGHT TO TRADE UNDER ONE'S OWN NAME 420
Turton v. *Turton* 421
anyone may describe his firm in the ordinary mercantile way .. 423
not necessarily by any fancy name 423
Burgess v. *Burgess* and *Massam* v. *Thorley* 423
the name must be the defendant's own 425
not a bought name, or one altered to resemble the plaintiff's .. 425
may be the defendant's name of repute 425
must be used *simpliciter*, not garnished 426
proximity as a badge of fraud 427
7. The relief granted 427
injunction 428
form of injunction in *Massam* v. *Thorley* 428
only deceptive use of common word, &c., restrained 429
8. Costs, appeals, practice, &c. (reference to Chap. XV.) 430

Foundation of the action.

IT is an actionable wrong for the defendant to represent, for trading purposes, that his goods or business are the goods or business of the plaintiff, either by direct statements, or by using any of the badges by which the goods of the plaintiff are known to be his, or any badges colourably resembling these, in connection with goods of the same kind, not being the goods of the plaintiff, in such manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff. Provided that the defendant may honestly trade under his own name, or under the names of the members of his firm, and may honestly describe his goods, and their place of origin, manner of manufacture, and other characteristics in the ordinary terms current in his trade.

Comparison with the action for the

The action to restrain the defendant from passing off his goods as the goods of the plaintiff, is obviously the

generalized form of the action to restrain the infringement of a trade-mark (*a*); and the old principles from which the latter action grew up, are still recognized and put into force by the Courts (*b*). The action for infringement has been specialized, and the proof of the plaintiff's case in it greatly facilitated and simplified by the registration of trade-marks and the provisions of the Acts; but the plaintiff's trade-mark, although the most important, is only one of the badges by which his trade or his goods are, or may be, identified with him; and it is equally a wrong, according to the principles laid down in the judgments quoted in the Introduction, and in the cases last cited, to imitate or copy any of the others—his trade-name or the get-up of his goods, for instance—so as to damage his trade by passing off other goods as his, or by leading his customers to suppose that there is a connection between such other goods and his, which does not in fact exist (*c*). infringement of a trade-mark.

In a trade-mark action the plaintiff must prove his title to the mark he claims, that it is registered as his mark or as the mark of his predecessor in business, or that sect. 77 has been otherwise complied with, and that the defendant has infringed the mark (*d*). And, generally, proof of the registration is, at least *primâ facie*, proof of title also. Further, if the mark has been actually or substantially copied, that constitutes an infringement, although it is not shown that the copy is calculated to deceive (*e*). In a passing off action the plaintiff's case is very similar to this, but registration forms no part of it, and the plaintiff must prove by direct evidence that the conduct of the defendant is calculated to pass off the defendant's goods as his; and to do this, he must show either that the defendant has

(*a*) See Chap. I., pp. 5 and 13, and Chap. XV., p. 297.

(*b*) See Chapters I. and II. *Lee* v. *Haley*, L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J.; *Somerville* v. *Schembri*, 12 App. Cas. 453; 4 R. P. C. 179 (1887) P. C.; *Montgomery* v. *Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361, (*Stone Ales*).

(*c*) See *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., cited below, p. 403.

(*d*) See the last Chapter.

(*e*) See p. 312.

actually represented that his goods or business are those of the plaintiff, or—and this is the common case—that he has used certain symbols or badges in connection with his goods or business, which are reputed in the market to import that the goods or business in connection with which they are used are the plaintiff's goods or business. A plaintiff may, therefore, fail to make out a case of infringement of trade-mark rights by failing to prove his title to the trade-mark, or its registration, or that its registration extends to the goods (*f*), or to all of the goods (*g*), in question, or because the registration is ordered to be expunged (*h*), and may yet show that by imitating the mark claimed as a trade-mark, or otherwise, the defendant has done what is calculated to pass off his goods as those of the plaintiff. It follows that a case of "passing off" is generally added as a second string to an action for infringement, and is frequently successful where the trade-mark action proper breaks down (*i*).

Where trade-mark action fails, passing off action may succeed on the same evidence.

The two actions are frequently combined.

The Acts, and in particular the definition sections and the sections barring, in certain events, proceedings to prevent or to recover damages for the infringement of unregistered trade-marks (*k*), seem to have been undoubtedly intended to limit and define the classes of symbols which could be appropriated as trade-marks, to restrict the latitude of choice of trade-marks which existed before 1875 (*l*), and to make registration a condition pre-

Sect. 77 affords no bar to a passing off action.

(*f*) *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*g*) *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*h*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Montgomery* v. *Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361, C. A. and H. L.

(*i*) See the cases cited in the last three notes. *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.; and the judgment of Lindley, L.J., in *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A., (*Camel Hair Belting.*) See also *Compania Général de Tobacos* v. *Rehder*, 5 R. P. C. 61 (1887), Kay, J., and *Curtis and Harvey* v. *Pape*, 5 R. P. C. 146 (1887), North, J., where the trade-mark questions were left undecided.

(*k*) Act of 1875, sect. 1; Act of 1883, sect. 77; see Chap. XII., pp. 255 *et seq.*

(*l*) See the judgment of Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 634; 4 R. P. C. 31 (1887); and above, p. 263.

cedent to all litigation in respect of subsequently acquired trade-marks corresponding to the trade-mark cases before the Acts; but this intention was not clearly expressed, and the Acts have, in consequence, been construed so as practically to leave a plaintiff in possession of all the rights he would have had if they had not been passed, while greatly facilitating the protection of such trade-marks as may be and are properly registered.

As the cases cited above show, it is no bar to an action for passing off that the trade-name, get-up, or any other of the badges identified with the plaintiff, which are alleged to have been copied or imitated by the defendant, might have been, but are not, registered under the Acts as trade-marks (*m*), even though the evidence is wholly addressed to what may be a mark capable of registration (*n*). Judges have even referred to such unregistered marks as "common law trade-marks" (*n*).

Common law trade-marks.

But a plaintiff who has raised no issue upon his pleadings except in regard to the infringement of his trade-mark, has been refused leave to amend his claim at the trial, so as to start a fresh case of "passing off" in order to save his action (*o*) In the case first cited in the note, however, leave was reserved to the plaintiffs to bring a fresh action to restrain the defendants from passing off their goods as the plaintiffs'. If a charge of fraud is to be made at the trial, it is essential that it should be put forward clearly and prominently on the pleadings (*p*).

New case of passing off or of fraud raised at the trial.

Passing off cases are usually cases of deliberate and

(*m*) See above, Chap. XII., p. 265, and *Great Tower Street Tea Co.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.

(*n*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, Lindley, L.J; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.

(*o*) *Native Guano Co.* v. *Sewage Manure Co.*, 4 R. P. C. 478; 8 R. P. C. 125 (1887), Kay, J., C. A. and H. L. Leave was granted, the defendants not objecting, in *Jay* v. *Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; and also in *Barber* v. *Manico*, *supra*, where the defendants raised the objection.

(*p*) *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.

intentional misrepresentation, and they have been referred to in many reported judgments even in recent cases, in which the attention of the Court was not directed to the point, as though fraud were a necessary element of the right of action; but it is well settled that this is not the case (*q*). Proof that the defendant intended to deceive, if his conduct is shown to be calculated to pass off his goods as those of the plaintiff, or to cause them to be so passed off, is no more necessary than in an action for infringement (*r*). And if it were necessary, it would be sufficient evidence of fraud to show that the defendant continued, or sought to continue, to use the deceptive badges or descriptions, after the danger of mistake arising from their use had been brought to his notice (*s*). For it has never been held that innocent inception is a defence (*t*).

Proof of fraudulent intention is not essential.

"Property" in trade-names and get-up.

It is obvious, therefore, that a trader has much the same right in respect of his trade-name, the get-up of his goods, and all the other distinctive badges and descriptions by which goods are known to be his, as he has in respect of his trade-marks, although the latter right is called a right of property, and the former is commonly, but not invariably (*u*), denied that title (*x*). There are, however, important practical differences between the two rights. A

(*q*) *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376 (1877), Cairns, L.C., cited above, p. 14; *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219 (1882); *Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 15; *Reddaway* v. *Bentham*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; and see the judgments of Cotton, L.J., in *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), and *Turton* v. *Turton*, 42 C. D. 128 (1889), cited below, p. 421.

(*r*) Chap. XV., p. 313. This rule seems to have been too well settled to be disturbed by the judgments in *Derry* v. *Peek*, 14 App. Cas. 337 (1889), although it originally rested upon that extension of the action of deceit, and analogous actions to cases where there was no intentional deception, which was reprobated in that case.

(*s*) See p. 317, above.

(*t*) *Paine & Co.* v. *Daniells and Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, C. A.

(*u*) *Clement* v. *Maddick*, 1 Giff. 98 (1859), Stuart, V.-C.; *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1887), Kay, J., property in the name of a newspaper.

(*x*) See *per* Lord Blackburn, in *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. p. 400.

trade-mark, being deliberately assumed and invented as a distinctive mark to identify the goods of its proprietor because of its supposed fitness for the purpose, could hardly be adopted by any other trader for similar goods in the same market without its use by him being calculated to deceive. But the other badges and descriptions referred to, although by use they may become more or less identified with the trader who used them first, or most extensively, may have been adopted merely for purposes of convenience or of ornament, and may have been suggested by the circumstances of the trade in question, or of the trader himself; and the same considerations or circumstances may suggest the use of the same badges and descriptions to others also, and their use of them will not necessarily be calculated to deceive. The cases in which a defendant can plead an independent right to the use of badges or descriptions which are not trade-marks—for instance, to the use of the same trade-name as the plaintiff—are much more important than the rare cases in which he can claim a right to use the trade-mark of the plaintiff or a trade-mark closely resembling it (*y*).

Inferiority of the spurious goods need not be shown.

It is immaterial to the existence of the plaintiff's right of action that the goods passed off as his are as good or better than his own (*z*); but it would seem that if they are not inferior no case of damage by injury to the plaintiff's trade reputation could be made out.

Rules and practice of infringement action apply, in general, to passing off action.

It will be seen from the definition stated at the beginning of the chapter, and the comparison of the two actions in the preceding pages, that the rules and principles collected in the last chapter, with regard to the action of infringement, in general apply also to the action for "passing off," substituting proof of repute for evidence of title and registration. The defences available, the relief

(*y*) See *per* Cotton, L.J., in *Turton* v. *Turton*, 42 C. D. p. 142, and Chap. XV., p. 325.

(*z*) *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833); *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; *per* Lord Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 4 App. Cas. p. 29.

granted, and the practice and procedure in both actions are the same.

1. Direct Misrepresentation as to Business or Goods.

Where there is a direct representation by the defendant that his own goods are the goods of the plaintiff, by reason of which they are likely to be sold or bought as such, the case presents no difficulty.

No case if the defendant believed that his representation was true.

Thus, in *Ainsworth* v. *Walmsley* (*a*), it was shown that the defendant had sold certain spools of thread wound and marked like the plaintiff's thread, with a representation that it was of the plaintiff's make. The defendant asserted that he had himself bought it on a like representation, which he believed, and this assertion was not disproved. The Vice-Chancellor accordingly dismissed the suit, for if the defendant in fact believed that the thread was the plaintiff's thread, he had committed no act of which the plaintiff could complain. Had he known it was not, there would have been a clear case for an injunction. "The use (by one manufacturer) of the name of another manufacturer," the Vice-Chancellor said, "whether *scienter* or not, is an interference with his business which this Court will interpose to prevent, on the ground that the defendant is endeavouring to pass off the goods of his own, or somebody else's, manufacture, as the manufacture of the plaintiff." But, he added, "taking the case most strongly against the defendant, it merely amounts to this, that Walmsley stated to the purchaser, 'I sell you thread which I have bought of Wreford, but which I know to be Ainsworth's.'"

Representation that the defendant's business is that of the plaintiff.

And cases in which the defendant directly represents that his business is the plaintiff's business, or a branch of it, are equally clear as soon as the false representation is made out.

False pretence of a business connection.

A partner or servant who has left a well-known firm and set up a similar business of his own, is entitled to

(*a*) L. R. 1 Eq. 518 (1866), Wood, V.-C.

advertise his former connection (*b*), unless restrained from doing so by contract with his late partners or employers (*c*); but he must take care to do it so as not to suggest that the connection is still existing between them and him (*d*), or that they have ceased to carry on business and he is their successor (*e*).

And the same rule holds good of a trader who (*f*), or whose trustee in bankruptcy (*g*), has sold the goodwill of his business.

False representation of succession to business.

Thus, where the son of the plaintiff quitted his father's employment, and described himself as "late of 107, Strand" (*d*), an injunction was granted to restrain him from continuing to do so. So, in *Scott* v. *Scott* (*h*), a door-plate, bearing the words "Scott and Nixon, late Robert and Walter Scott," was held to be a representation that Walter Scott had retired, and that Scott and Nixon were carrying on the business of his old firm.

"Late."

And in a case where no such connection as those referred to had ever existed between the defendants and the plaintiffs, but the defendants, having obtained a lease of clay mines formerly leased to the plaintiffs, described themselves in advertisements, referring not only to the mines, but to certain works also, where they carried on a trade similar to that of the plaintiffs, as *E. and J. Pearson* (late Harpers and Moore); the description was held to be a representation calculated to lead the public to believe that

(*b*) *Clark* v. *Leach*, 32 Beav. 14; 1 De G. J. & S. 409; 32 L. J. Ch. 290 (1862), Romilly, M.R., and Westbury, L.C.

(*c*) As in *Wolmershausen* v. *O'Connor*, 36 L. T. N. S. 921 (1877); and *Selby* v. *The Anchor Tube Co.*, W. N. (1877), 191, both Bacon, V.-C., where the style and goodwill passed, under the articles, to one partner on a dissolution.

(*d*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L.JJ.; and see p. 323.

(*e*) See the cases next cited, and *Labouchere* v. *Dawson*, L. R. 13 Eq. 322 (1372), Romilly, M.R.

(*f*) *Churton* v. *Douglas*, Johns. 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Fullwood* v. *Fullwood*, W. N. (1873), 93 and 135, Malins, V.-C., and L.JJ.

(*g*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. See further, as to this, below, p. 417.

(*h*) 16 L. T. N. S. 143 (1866), Wood, V.-C.

Description of new comer as "the old established."

the plaintiffs, Harpers and Moore, had retired from business (*i*). So where the plaintiff and defendant were carrying on business as rival dentists in the same street, and, on the expiration of his tenancy, the plaintiff was compelled to remove, the defendant put up a board describing himself as the "old established dentist," so as to suggest that the plaintiff had removed to his place of business. An interim injunction would have been granted had the defendant not undertaken to put his name very conspicuously upon the board (*j*).

Pretence of agency.

Another description of false representation of a business connection which sometimes comes before the Courts, is where the defendant has pretended to be agent for the sale of the plaintiff's goods (*k*).

Deceptive circulars.

Names over shops.

Executing orders intended for the plaintiff.

The fraud is commonly effected by issuing misleading circulars or advertisements (*l*), or by placing the deceptive name or title on the facia over the defendant's shop (*m*), and by opening and replying to letters addressed to, or intended for, the plaintiff, and executing the orders contained in them (*n*); or some one or more of these devices.

(*i*) *Harpers* v. *Pearson*, 3 L. T. N. S. 547 (1860), cited p. 302; *Stevens* v. *Paine*, 18 L. T. N. S. 600 (1868), Giffard, V.-C.

(*j*) *Mallam* v. *Davis*, 3 Times L. R. 221 (1887), Stirling, J.

(*k*) *Howe* v. *McKernan*, 30 Beav. 547 (1862), Romilly, M.R., (discovery ordered); *Wheeler and Wilson Co.* v. *Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C., (injunction granted).

(*l*) As in *Purser* v. *Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C.; *Burrows* v. *Foster*, 32 Beav. 18 (1862), L.JJ.; *Graveley* v. *Winchester*, Seton, 4th ed. 257; Seb. Dig. p. 162 (1867), Wood, V.-C., (circulars ordered to be given up); *Stevens* v. *Paine*, 18 L. T. N. S. 600 (1868), Giffard, V.-C.; *Selby* v. *Anchor Tube Co.*, W. N. (1877) 191, Bacon, V.-C., (defendants restrained from soliciting or executing orders obtained by the misrepresentations); *Mogford* v. *Courtenay*, 45 L. T. N. S. 303; *Vernon* v. *Hallam*, 34 C. D. 748 (1886), Stirling, J.

(*m*) *Foot* v. *Lea*, 13 Ir. Eq. 484 (1850), Smith, M.R.; *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. 675 (1853), Kindersley, V.-C., and L.JJ.; *Scott* v. *Scott*, 16 L. T. N. S. 143 (1866), Wood, V.-C., (door plate); *Hookham* v. *Pottage*, L. R. 8 Ch. 91 (1872), Malins, V.-C., and L.JJ.

(*n*) *Schiele* v. *Brackell*, 11 W. R. 796 (1863), Stuart, V.-C.; *Edgington* v. *Edgington*, 10 L. T. N. S. 299 (1864), Wood, V.-C., (a single

Unauthorized use of the name of a non-trader.

In the old case of *Clark* v. *Freeman* (*o*), Lord Langdale, M.R., refused to restrain the defendant from selling a quack medicine as "Sir J. Clarke's Consumption Pills," at the instance of the Sir J. Clark referred to, who was an eminent physician, on the ground that the plaintiff carried on no business in pill-making, and that the wrong done to him was a libel only, which the Court of Chancery had no jurisdiction to restrain (*p*). It has always been considered (*q*) that a narrow view was taken of the facts of this case, as the sale of pills under a well-known doctor's name is eminently calculated to suggest that the pills are prepared according to his directions, and to injure his practice if they do not meet with a favourable reception by purchasers who are, or who might become, his patients; but, in a similar recent case, Kay, J., refused to treat the older authority as no longer law, at least, upon an interlocutory application (*r*).

2. Imitations of Trade-Name, Get-up, &c.

The name or get-up must be known as that of the plaintiff or his predecessors whose business he has.

Actions based upon direct misrepresentation are comparatively rare. The plaintiff's case more commonly is that the defendant has copied or imitated the trade-name, or the get-up, or some other badge or description by which the plaintiff's business and goods are known to be his. Where the charge is one of indirect misrepresentation of this sort, the onus is cast upon the plaintiff, in the first place, to show that the things copied or imitated are reputed in the market to connote a connection between himself or his

instance proved, injunction refused); *Witt* v. *Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.

(*o*) 11 Beav. 112, 17 L. J. Ch. 142 (1848).

(*p*) As to this see *Bonnard* v. *Perryman*, (1891) 2 Ch. 269; *Collard* v. *Marshall*, (1892) 1 Ch. 571, and *Monson* v. *Tussaud*, 10 Times L. R. 227 (1894).

(*q*) Lord Selborne said the case had seldom been cited except to be disapproved. *Re Rivière's Tm.*, 26 C. D. 48 (1884). See also *Maxwell* v. *Hogg*, L. R. 2 Ch. 307 (1867), Lord Cairns; *Springhead Spinning Co.* v. *Riley*, L. R. 6 Eq. 551 (1868), Malins, V.-C. As to authors' names, see p. 410, below.

(*r*) *Williams* v. *Hodge*, 4 Times L. R. 175 (1887).

predecessors in business, and the business or goods in, upon, or in reference to which they are used. And this is precisely the proof which the plaintiff had to adduce in trade-mark actions before the Acts, and, so far as regards matters applied or attached to the goods themselves, it has been considered, and the authorities relevant to it have been collected in a previous chapter (*s*).

It is not, however, necessary to show that the customers who knew the goods of the plaintiff's firm by a particular name or get-up knew anything whatever about the plaintiff. It is immaterial that they did not even know his name (*t*); for it is sufficient to prove that purchasers of his goods recognized, by the presence of the marks in question in connection with them, that they were goods of a particular class, and that such class is, in fact, constituted by his goods.

Evidence of repute.

Where the existence of such repute is not shown, the action cannot succeed (*u*). Thus, in a case where the plaintiff claimed only as the mortgagee of a business and its trade-name, and had never used, and did not intend to use, the trade-name (*x*), and in a case in which the plaintiffs were carrying on no business in England (*y*), the actions were dismissed. But no length of time during which the use of the badges in question by the plaintiff or his predecessors must have extended can be laid down (*z*), although it seems safe to assume that an actual and practical knowledge of the connection between them and him

(*s*) Definition of a trade-mark, Chapter II., p. 24; *Lawson* v. *The Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188 (1856).

(*t*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A., (*Sunlight Self-washer Soap*).

(*u*) *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A.

(*x*) *Beazley* v. *Soares*, 22 C. D. 660 (1882), Pearson, J.; cf. *Clark* v. *Freeman*, *ante*, p. 389.

(*y*) *Robineau* v. *Charbonnel*, W. N. (1876) 160, Malins, V.-C. The plaintiffs were confectioners (*quære* dressmakers) in Paris, having no agency in England. Held, no probability of injury.

(*z*) This was stated to be a question for a jury in the old case of *Purser* v. *Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C., (*The London Manure Co.*).

by a number, apparently considerable, of probable dealers in, or purchasers of, the goods must be shown, and that, therefore, a name, get-up, or other badge just adopted and brought into use, would not be protected, as a newly adopted trade-mark would have been before the Registration Acts (*a*), and would be now, if registered, under sect. 76.

It has been held that three days' use of the name of a new weekly newspaper, of which fifteen copies had been sold (before the defendant's publication began), was not sufficient to give the owners any right to stop other persons using the same name for a rival paper (*b*).

The reputed connection must be a connection between the trade or goods, in or upon which the name, get-up, or other badges are used, and the plaintiff himself, or his predecessors as owners of the business in which he is at the time of action, using, or intending to use them. And trade-names may be assigned and may devolve in connection with the goodwill of the business (*c*). The rules in regard to assignment already discussed in relation to trade-marks (*d*), apply, therefore, to trade-names and similar matters, for if the things which the defendant has copied or imitated connote a connection, not with the plaintiff, but with someone else, he can have no claim to sue in respect of the deception which, he alleges, the defendant's use of them is

Assignment and devolution of trade-name, &c.

(*a*) *Maxwell* v. *Hogg*, L. R. 2 Ch. 307 (1867), L.JJ.; *Hall* v. *Barrows*, 32 L. J. Ch. 548 (1863), Romilly, M.R.; *McAndrew* v. *Bassett*, 33 L. J. Ch. 561 (1864), Wood, V.-C., *ante*, p. 34.

(*b*) *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 C. D. 139 (1888), North, J., and C.A.; Cotton, L.J., said, that the larger sale of the plaintiffs' paper subsequently was immaterial; cf. *Maxwell* v. *Hogg*, *supra*, and p. 33 above.

(*c*) "I think it is settled by a series of cases, of which *Hall* v. *Barrows* (note (*a*)) is, I think, the leading one, that both trade-marks and trade-names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed, so that they are no longer strictly correct"; *per* Lord Blackburn, in *Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. p. 33 (1882).

(*d*) Chap. XIII. p. 272.

calculated to occasion. Thus, in *Pinto* v. *Badman*, the jury at the trial found upon the same facts that the defendant had infringed the plaintiff's trade-mark, and had passed off his goods as those of the plaintiff. On the appeal it appeared that the label and brand copied by the defendant had, not long before the commencement of the action, been assigned, without the business with which they were connected, by certain third parties to the plaintiff. Upon this ground the Court of Appeal set aside the verdict, and entered judgment for the defendants, notwithstanding the finding as to "passing off" (*e*). And neither a license to use, nor an absolute assignment of a trade-name without the goodwill of the business to which it was attached, can enable the licensee or assignee to sue to restrain the use of the name by another trader (*f*).

The question as to repute is not generally considered separately.

The question of repute is, however, rarely considered separately, for, as a right of property in respect of the exclusive use of marks or badges other than registered trade-marks (and, to some extent, the trade-name of the plaintiff) is not recognized, it is generally more convenient to deal directly with the more general question: Is the defendant's conduct calculated to pass off his goods as those of the plaintiff?

The imitation by the defendant of any of the badges by which the plaintiff's goods are known to be his, falls within the scope of the action to restrain passing off; but the most important of these badges are the trade-name of the plaintiff, and the trade-name and the get-up of his goods.

A. The Plaintiff's Trade-name.

A man's own name, or the name under which he trades, may be an ordinary trade-mark, if used as such, that, if

(*e*) 8 R. P. C. 181 (1891). The case, so far as regards passing off, was not expressly referred to in the judgments, but the principles stated were as applicable to that as to the case for infringement.

(*f*) *Thorneloe* v. *Hill*, W. N. (1894) 15, Romer, J., (*John Forrest*). It follows that the mere right to use a name cannot be sold; see below, p. 401.

applied or attached to the goods he deals in (*g*), and if it is "printed, impressed, or woven in some particular and distinctive manner," or in the form of "a written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark," it may be entered upon the register (*h*). But if it is not so used or registered, and it therefore does not become a trade-mark, its use by the defendant for trading purposes in connection with goods which are not the plaintiff's, is obviously calculated to mislead, unless it happens to be the name of the defendant also, or a name under which he is entitled to trade (*i*).

Principle on which a trade-name is protected.

The ground upon which the Court acts in protecting a trade-name was stated by James, L.J., in *Levy* v. *Walker* (*k*) in the following passage: "It should never be forgotten that in these cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade-mark, that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not, which is to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent (*l*) misstatement, deprive me of the profits of the business which would otherwise come to me.' An individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he has a right to restrain anyone else from injuring his business by using that name" (*m*).

(*g*) See Chap. I., p. 24.

(*h*) Sect. 64, Chap. VIII., pp. 114 and 117.

(*i*) See *per* Wood, V.-C., *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), and p. 420, below.

(*k*) 10 C. D. p. 447 (1879).

(*l*) See above, pp. 14 and 384.

(*m*) Cf. Lord Chelmsford's statement in *Du Boulay* v. *Du Boulay*, L. R. 2 P. C. p. 441 (1869): "The right to the exclusive use of a name in connection with a trade or business is 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

It may belong to others beside the plaintiff.

The name taken or copied by the defendant need not be that under which the plaintiff alone, and no other person, is properly trading. Thus, in *Dent* v. *Turpin* (*n*), Wood, V.-C., held that each of two firms carrying on business separately as watchmakers under the name *Dent*, might sue a third person who set up a similar business under the same name for an injunction, delivery up of the marked articles, and an account of profits.

It need not be the plaintiff's family name.

And, as stated by James, V.-C., in the judgment quoted above, the name need not be the personal name of the plaintiff (*o*). It need not even be that of a predecessor in business, for a trader may lawfully adopt and trade under any name which is unappropriated for businesses of the same kind, and when the name has become his by repute, he is as well entitled to protection for it as if it were his own (*p*). A recent case before North, J., is an illustration of this rule. There the plaintiffs made and sold a sauce which, by his permission, they called by the name of one of their servants, "Holbrook's Worcester Sauce." The servant left them and joined the defendants, who thereupon advertised that they had acquired the right to make "Holbrook's Worcester Sauce." It was shown that the sauce sold by the plaintiffs was well known as theirs by the name, and the learned judge held that they had a right to the name in question, and that Holbrook could not sell it to the defendants (*q*). In this case the sauce was identified by the name with the plaintiffs, and not with Hol-

himself liable to an action, or he may be restrained from the use of the name by injunction"; and *Clark* v. *Freeman*, cited *ante*, p. 389; see also the judgment of James, L.J., and Jessel, M.R., quoted above, pp. 1 and 13.

(*n*) 2 J. & H. 139; 30 L. J. Ch. 495 (1861); *Southorn* v. *Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C.

(*o*) Cf. "Defences," below, p. 425.

(*p*) In *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C., for instance, the plaintiff traded as *Mme. Louise*.

(*q*) *Birmingham Vinegar Brewery Co.* v. *Liverpool Vinegar Co.*, W. N. (1888) 139, an interlocutory injunction was granted; cf. *Dence* v. *Mason*, W. N. (1877) 23, (1878) 42, Malins, V.-C. (*Brand's Essence of Beef*).

brook; an opposite result would have been reached if the name had been understood to indicate that the latter person was the actual maker of the goods, and that they were his goods of which plaintiffs happened to be vendors (*r*). Thus, in *Franke* v. *Chappell* (*s*), although the plaintiff had organized series of concerts known as "Richter Concerts" for many years, when Herr Richter made arrangements to conduct the rival concerts of the defendant, it was held that the defendants might rightly advertise their series under the name, since it was understood to mean, not concerts got up by the plaintiff, but anybody's concerts conducted by Richter.

The trade-name of a company.

In the case of a company registered under the Companies Act, 1862, it is enacted that (*t*)—

Sect. 20 of the Companies Act, 1862.

"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 (*u*), and testifies its consent in such manner as the registrar requires."

And the section further makes provision for a change of the name of any company which, through inadvertence or otherwise, is registered under a name which falls within the prohibition.

As Mr. Buckley points out in his note to the section (*x*), it is to be observed (1) that it only applies to the case of taking the name of a subsisting company already registered, and not to a case like *Hendriks* v. *Montagu* (*y*), where a new company proposes to register in the name of, or in a name closely resembling, the name of an old-

(*r*) As to joint trade-marks, see p. 301, above.

(*s*) 57 L. T. N. S. 141 (1887), Chitty, J.

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

(*u*) For example, upon a reconstruction.

(*x*) Buckley on the Companies Acts, 6th ed., p. 24; see also Palmer's Company Precedents, 5th ed., p. 309.

(*y*) 17 C. D. 638 (1881), Jessel, M.R., and C. A.

established company, which is not registered, or of a firm or individual trader (z); (2) that so soon as the new company is registered, the section has ceased to be applicable, so that the old registered company cannot found upon the section any claim for an injunction to restrain the newly registered company from trading in the name; (3) that the Act forbids registration in the same or a similar name, irrespective of the fact whether the business to be carried on under the name is the same or not.

The section is supplementary to the common law.

But the provision of the section is merely in supplement of the ordinary principle upon which the Court acts in protecting trade-names, and that principle is in no way limited by the registration of the name objected to by the plaintiff in any case as the name of the defendant company (*a*). An injunction will therefore be granted to restrain the defendant from carrying on the same trade as that of the plaintiff under a name so nearly resembling his as to be calculated to deceive, whether it has been registered as the name of the defendant company or not, and, in the latter event, to restrain the defendants also from applying for registration of the name. In *Hendriks v. Montagu* (*b*), the leading case on the point, the plaintiff, on behalf of the *Universal Life Assurance Society*, sued certain persons who were the promoters of an intended new company, to be called the *Universe Life Assurance Association*, and an injunction in the following form was granted:—

Hendriks v. Montagu.

The injunction granted.

"To restrain the defendants from applying to the registrar of joint stock companies in England, for registration under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life*

(z) *Hoby v. The Grosvenor Library Co., Ltd.*, 28 W. R. 386.

(a) *Merchant Banking Co. of London v. Merchants Joint Stock Bank*, 9 C. D. 560 (1878), Jessel, M.R.

(b) 17 C. D. 638 (1881), Jessel, M.R. and C. A.

"*Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses representing that a company is to be incorporated pursuant to the Companies Act, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid."

The Master of the Rolls had refused the first branch of the injunction (as to the application to register), on the ground that no case could be made for granting it except under the section, and that the section did not apply, because the plaintiffs were not a registered company, and he had refused the second and third branches (as to advertising and carrying on business), on the ground that it was not shown that the defendants would carry on the same business as the plaintiffs, or that, if they did, the resemblance of the names must necessarily lead to the unfair appropriation by them of part of the plaintiffs' business; but the Court of Appeal overruled all these objections. The Lords Justices held, that the defendants were shown to have threatened and intended to carry on the same business, and that it was morally certain that, if they did so under the name they had adopted, persons who had heard of the *Universal* would be misled into going to the *Universe*. And this, the Court said, according to the rules of equity, was sufficient, without reference to the Act, to entitle the plaintiffs to the injunction they claimed.

The ground of the interference of the Court is, that the use of the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff to the defendant, or to occasion a confusion between the two businesses. If this is not made out there is no case (*c*).

No monopoly allowed in names merely descriptive.

And the mere employment of a term which is descriptive of the business of both the parties, will not of itself

(*c*) See the cases collected below.

be accepted as sufficient to make out the plaintiff's case (*d*). If it were it would give the first user a monopoly in the term. "If a company which does colonial business cannot call itself colonial, it is obvious that, under a species of assertion that the word colonial is symbolical, the plaintiffs might prevent every other person using it as descriptive of his trade" (*e*).

Cases of company trade-names.

In *The Guardian Fire and Life Assurance Co.* v. *The Guardian and General Insurance Co.* (*f*), the plaintiff company were a very old-established institution, and were commonly known as *The Guardian* or *The Guardian Assurance Co.*, and the defendant company had been lately formed by the re-construction of the *Guardian Horse and Vehicle Insurance Association*. They had assumed powers to carry on general insurance business, and their offices were near those of the plaintiffs, in Lombard Street. It was shown that there were two other companies doing some insurance business in other parts of London, under names comprising the word *guardian*; but notwithstanding this, Jessel, M.R., held, that the defendants' new name was calculated and intended to deceive, and he would have granted an injunction, had they not undertaken to call themselves the "Guardian Horse, Vehicle, and General Insurance Company."

Injunctions granted.

Injunctions were granted also in *Hoby* v. *The Grosvenor Library Co., Ld.* (*g*), where the plaintiff's library was called the Grosvenor Library, and in *The Accident Insurance Co., Ld.* v. *The Accident, Disease, and General Insurance Co.*,

(*d*) Cf. the rule against descriptive trade-marks, Chap. II., p. 127; Chap. VIII., p. 127; and as to infringement in similar cases, Chap. X., pp. 201, 202, and below, p. 406.

(*e*) *Per* Lord Romilly, in *The Colonial Fire Assurance Co.* v. *The Home and Colonial Assurance Co., Ld.*, 33 Beav. 548; 33 L. J. Ch. 741 (1864); see also *India and China Tea Co.* v. *Teide*, W. N. (1871) 241, Jessel, M.R.; and *The Australian Mortgage, Land, and Finance Co.* v. *The Australian and New Zealand Mortgage Co.*, W. N. (1880) 6, C. A., cited p. 399.

(*f*) 50 L. J. Ch. 253 (1880), Jessel, M.R.

(*g*) 28 W. R. 386.

Ld. (*h*), where the plaintiff company was popularly known as *The Accident Company* or *The Accident.*

Injunctions refused.

In the following cases injunctions were refused: *London and Provincial Law Assurance Society* v. *London and Provincial Joint Stock Life Assurance Co.* (*i*), although there was evidence that the former company were usually called the *London and Provincial Insurance Co.*; *London Assurance* v. *London and Westminster Assurance Corporation* (*k*); *Colonial Life Assurance Co.* v. *Home and Colonial Assurance Co., Ld.* (*l*); *London and County Banking Co.* v. *Capital and Counties Bank* (cited in the next case); *Merchant Banking Co. of London* v. *Merchants Joint Stock Bank* (*m*); *The Army and Navy Co-operative Society, Ld.* v. *The Junior Army and Navy Stores, Ld.* (*n*); *Australian Mortgage Land and Finance Co.* v. *Australian and New Zealand Mortgage Co.* (*o*). In *Bamstead* v. *The General Reversionary Co., Ld.*, an interlocutory injunction was refused, because, although the defendant company had adopted a name resembling that of the company of which the plaintiff was secretary, the General Reversionary and Investment Co., yet there was no probability of deception because the former was a small Liverpool concern, and the latter a very large London one (*p*).

Tussaud v. *Tussaud.*

In the recent case of *Tussaud* v. *Tussaud* (*q*), an unsuc-

(*h*) 54 L. J. Ch. 104 (1884), Pearson, J.; see also *Wolmershausen* v. *G. S. Wolmershausen & Co., Ld.*, W. N. (1892) 87, Chitty, J.; and *Saunders* v. *The Sun Life Assurance Co. of Canada* (1894) 1 Ch. 537; 10 Times L. R. 183, Stirling, J.

(*i*) 17 L. J. Ch. 37 (1848), Shadwell, V.-C.

(*k*) 32 L. J. Ch. 664 (1863), Stuart, V.-C.

(*l*) 33 Beav. 548; 33 L. J. Ch. 741 (1864), Romilly, M.R.

(*m*) 9 C. D. 560 (1878), Jessel, M.R.

(*n*) Seb. Dig. p. 393 (1879), Jessel, M.R.

(*o*) W. N. (1880) 6, C. A., James, L.J., said: "The difficulty in these cases was, that while the business name of another could not be appropriated, a man could not, on the other hand, give himself any monopoly in a name which, as in this case, merely described the nature of the business or the locality of its operations"; see above, p. 397.

(*p*) 4 Times L. R. 621 (1888), Stirling, J.

(*q*) 44 C. D. 678 (1890), Stirling, J.: *Rendle* v. *Rendle*, 63 L. T. 94 (1890), Kay, J., is a somewhat similar case.

cessful attempt was made by the defendant to shelter himself under the general exception to the principle stated at the head of this chapter, that anyone may honestly trade under his own name, which is discussed more fully below (*r*). In that case the plaintiffs, Madame Tussaud and Sons, Limited, were the owners of a waxwork exhibition originally founded by a Madame Tussaud, and subsequently carried on by the father and uncles of the defendant. Their business, according to the evidence, was often referred to as *Madame Tussaud's*, and, not infrequently, as *Tussaud's* only. The defendant, who was a wax modeller by trade, was promoting a company to be called *Louis Tussaud, Ld.*, to open and carry on a waxwork exhibition under that name in Shaftesbury Avenue, the plaintiffs' exhibition being situated in the Marylebone Road. He was to be engaged as manager of the exhibition, and modeller of the exhibited figures. He had never carried on, and did not possess the goodwill of, any business in any such exhibition.

The judgment of Stirling, J.

It follows, Stirling, J., said, in his judgment in this case, "from the decisions in *Burgess* v. *Burgess* (*s*) and *Turton* v. *Turton* (*t*), that the defendant is at perfect liberty to open on his own account, and to carry on in his own name an exhibition of waxworks. Further, he might take partners into his business, and carry it on under the name *Louis Tussaud & Co.* That seems to me to have been expressly decided in *Turton* v. *Turton*. Having commenced business on his own account, I apprehend that he might sell it with the benefit of the goodwill to third parties, and that the third parties might, if they thought fit, continue to carry on the business under the same name—that of the defendant; that is to say, they would be entitled to the full benefit of the goodwill which they had honestly and legitimately purchased from the defendant. Again, the

(*r*) Page 420.

(*s*) 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Knight-Bruce and Turner, L.JJ., cited p. 423.

(*t*) 42 C. D. 128 (1889), C. A., reversing North, J., cited p. 421.

"third parties might transfer the business and the goodwill to a joint stock company, and (without expressing a final opinion on the point) I am not prepared at present to say that that company might not be registered under the same name as had previously been used in connection with the business" (*u*).

Right to use a name cannot be sold.

But the defendant could not, the learned judge held, sell the right to use his name in connection with a business which he had never carried on, and in which he had no interest whatever, or in which he stood simply in the position of a paid servant (*x*). And the proper inference to be drawn from the facts of the case *primâ facie* was, he concluded, that the object of the defendant in promoting the proposed company was to induce the world to believe that the business intended to be carried on was that of the plaintiff company or a branch of it, notwithstanding that the prospectus issued by the defendant plainly stated on the face of it that the new exhibition had no connection with the plaintiff company. An interim injunction in the terms of that in *Hendriks* v. *Montagu* (*y*), set out above, was accordingly granted.

Name of business, house, or factory.

A trader has the same rights in respect of the name of the house, shop (*z*), or factory (*a*), where he carries on his trade or business, as he has in respect of his trade-name. He can,

(*u*) 44 C. D. p. 687.

(*x*) Cf. *The Birmingham Vinegar Brewery Co.* v. *The Liverpool Vinegar Co.*, *supra*, p. 394; and *Warner* v. *Warner*, 5 Times L. R. 327, 359 (1889), Stirling, J., and C. A., (*Warner's Cure*); and see below, p. 425.

(*y*) *Ante*, p. 396.

(*z*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C., (*Osborne House*); *Boulnois* v. *Peake*, 13 C. D. 512 n. (1868), Giffard, V.-C., (*The Carriage Bazaar*); *Bodega Co.* v. *Owens*, 6 R. P. C. 236; 7 *ib.* 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C., (*Bodega Wine Shop*). A number of American decisions are cited by Mr. Sebastian, 3rd ed., p. 294. In *Charleston* v. *Campbell*, 4 Sess. Cas. 4th ser. 149, an injunction to restrain the use of the "Royal Station Hotel," at the instance of the proprietor of the "Station Hotel," was refused.

(*a*) *Braham* v. *Beachim*, 7 C. D. 848 (1878), Fry, J., (*Radstock Colliery*); *Montgomery* v. *Thompson*, 41 C. D. 35 (1891), A. C. 217; 8 R. P. C. 361, Chitty, J., C. A., and H. L., (*Stone Brewery*).

therefore, support an action for passing off, and obtain an injunction by showing that the name of the house, &c., has a reputed connection with his trade or business or goods, and that the defendant, without having any independent right to do so (*a*), is using for business purposes a name which is calculated to cause his trade, business, or goods to be taken for, or to be confounded with, the plaintiff's (*b*). There is no right to the exclusive use of the name of a mere private house (*c*), and no cause of action arises where, although the defendant has adopted, for business purposes, an address likely to be confused with that of the plaintiff, yet the businesses of the parties are so different that no damage can result to the plaintiff's trade (*d*).

B. The Trade-name of the Plaintiff's Goods.

A name which is applied or attached to a trader's goods when they are offered for sale, so as to distinguish them from similar goods, and to identify them with him, or with his successors as the owners of a particular business, as being made, worked upon, imported, selected, certified, or sold by him or them, is a trade-mark (*e*). And if it is within any of the classes enumerated in sect. 64 it may be registered as a trade-mark. But whether the name is applied or attached to the goods, so as to conform to the definition just stated, or is registered as a trade-mark or not, if it is in fact known in the market as the distinctive name of the goods of a particular trader, it is an actionable interference with his rights to sell or deal in goods of the kind for which the name has acquired such significance, not being his goods, under the name in question, if such

(*a*) As in *Mason* v. *Queen*, 23 Scot. Law Rep. 641, where the defendant, as tenant of a railway company, who had bought the plaintiff's hotel, re-opened it as the "Old Waverley," the plaintiff, on the sale, having moved his business to another building.

(*b*) See note (*z*) on preceding page.

(*c*) *Day* v. *Brownrigg*, 10 C. D. 294 (1878), C. A.

(*d*) *Street* v. *Union Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J.; the plaintiffs were advertising agents, (telegraphic cypher).

(*e*) Chap. II., p. 25.

use of the name is, as it almost necessarily must be, calculated to pass off the goods sold or dealt in as his goods.

The acquisition of a trade-name by the use of it in connection with the plaintiff's goods has already been considered, and the authorities bearing on the subject have been collected in the chapter on the definition of a trade-mark. It will be sufficient, therefore, to summarize shortly the results deduced from the reported cases.

Right restricted to particular goods.

The qualified right in the trade-name,—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it,—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business indicated by the name extends (*f*). So, where the proprietors of *The Morning Post* sought to restrain the publishers of a new evening newspaper from calling their paper *The Evening Post*, the Court of Appeal thought there was no probability of the defendant's paper being taken for the plaintiff's, or being taken to have any connection with it so as to cause damage to the plaintiffs, and they accordingly dismissed the action (*g*).

The Evening Post Case.

The name may be used on the right goods.

And anyone may use the name in connection with goods which are in fact the goods of the plaintiff (*h*).

It must be distinctive of the plaintiff's goods;

It is the essence of the plaintiff's case that the use of the name should be understood in the market to imply that the goods sold or dealt in under it are the plaintiff's goods (*i*).

In *The Two D. Case* (*j*), Herschell, L.C., said, the founda-

(*f*) Page 31; and cf. the rule in respect of the infringement of trade-marks, Chap. XV., p. 308.

(*g*) *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A., overruling Kay, J.; but see *Re The Australian Wine Importers, Ld.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A., where a mark for wine was refused registration, as too closely resembling a mark for spirits, and the Court left open the question whether its use would amount to infringement or passing off; and other cases, cited above, p. 180. Injunctions were granted in *Walter* v. *Emmott*, 54 L. J. Ch. 1059 (1885), C. A. (*The Morning Mail*) and *Reed* v. *O'Meara*, 21 L. R. Ir. 216 V.-C. (*The Grocer*).

(*h*) Pages 32 and 309; and *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C., cited p. 386.

(*i*) Page 35.

(*j*) *Leahy, Kelly and Leahy* v. *Glover*, 10 R. P. C. p. 155 (1893), H. L.

tion of a passing off case "is that the party alleging it should prove, in the first instance, that any name which he claims as his trade-name has been so extensively used in connection with his manufacture or with the goods which he sells, that his goods have come to be known in the market by that name; that anyone using that name would intend to refer to his goods; and that anyone to whom the name was used would understand that his goods were referred to."

not the mere name of the goods.

Hence the critical question of fact in cases under this head is often whether a word or term is the distinctive name of the plaintiff's goods, or the name of anybody's goods of the kind (*k*), like *Liebig's Extract* (*l*), *Chloro-dyne* (*m*), *Linoleum* (*n*), *Wellington Boots*, *Gladstone Bag*, and *Hansom Cab*, or a mere description of the goods, denoting only their pattern (*o*), mode of manufacture (*p*), or sale (*pp*), ingredients (*q*), or place of origin (*r*), or the use for which they are intended.

Descriptive names may have a secon-

Words and terms which *primâ facie* are merely descriptive in the sense just explained may, however, acquire by

(*k*) See pp. 36 and 201 *et seq.*

(*l*) *Liebig's Extract of Meat Co., Ld.* v. *Hanbury*, 17 L. T. N. S. 298 (1867), Wood, V.-C.; *Liebig Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.

(*m*) *Browne* v. *Freeman*, (1) 12 W. R. 305 (1864), Wood, V.-C.; (2) W. N. (1873) 178, L.JJ.

(*n*) *Linoleum Manufacturing Co.* v. *Nairn*, 7 C. D. 834 (1878), Fry, J.

(*o*) *Ford* v. *Foster*, L. R. 7 Ch. 616 (1872), L.JJ., (*Eureka Shirts*); *Hirst* v. *Denham*, L. R. 14 Eq. 542 (1872), Bacon, V.-C.; *Harrison's Tm.*, 42 C. D. 601; 7 R. P. C. 25 (1889), Kekewich, J.

(*p*) *Singer Manufacturing Co.* v. *Wilson*, 2 C. D. 434; 3 App. Cas. 376 (1876); *Id.* v. *Loog*, 18 C. D. 395; 8 App. Cas. 15 (1877); *Id.* v. *Spence & Co.*, 10 R. P. C. 297 (1893), Romer, J., (*Singer System*, *Singer Sewing Machines*), cited *ante*, p. 38.

(*pp*) *Symington* v. *Footman*, 56 L. T. 696 (1885), Kay, J. (*Guaranteed corset*).

(*q*) *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A.

(*r*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; 33 L. J. Ch. 561, (*Anatolia Liquorice*); *Seixo* v. *Provezende*, L. R. 1 Ch. 192 (*Seixo Wine*); *Wotherspoon* v. *Currie*, 5 L. R. H. L. 508, (*Glenfield Starch*), all cited pp. 45 and 46; see also *The Reading Biscuit Case*, *Huntley & Palmer* v. *The Reading Biscuit Co., Ld.*, 10 R. P. C. 277 (1893), Chitty, J.; and *The Rugby Portland Cement Case*, *Rugby Portland Cement Co., Ld.* v. *The Rugby and Newbold Portland Cement Co.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A.

use and reputation a secondary distinctive meaning (*s*), so that, although no longer treated as trade-marks proper, even where they are used as such, and not admitted, unless as old marks, to registration under the Acts, they may be practically monopolized for use in connection with certain classes of goods by a particular trader, since their employment by anyone else would be calculated to deceive (*t*). "I take it to be clear from the evidence," Lord Westbury said, in *The Glenfield Starch Case* (*u*), "that long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants." Secondary distinctive meaning.

This is well illustrated by the recent case of *Reddaway & Co.* v. *Bentham Hemp Spinning Co.* (*v*), in which the Court of Appeal ordered a new trial on the ground that there was evidence that the use of the expression *Camel Hair Belting* by the defendants was calculated to pass off their goods as the goods of the plaintiffs.

The name of the inventor or first introducer of goods which are new to the market, or the name which he gives to those he manufactures or sells, is very readily adopted as the name of goods by whomsoever they are made; and in the case of goods made under a patent, the Court is careful not to extend the patentee's monopoly by forbidding other manufacturers, after the patent has expired, to sell goods lawfully made by them according to its specification under the only name by which they are known (*x*). Name of introducer or patentee.

(*s*) Chap. II., p. 36.

(*t*) See the cases cited in the last three notes, and *Montgomery* v. *Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361, (*Stone Ales*).

(*u*) See note (*r*), p. 404.

(*v*) (1892) 2 Q. B. 639; 9 R. P. C. 503. See the Pleadings, Appendix, p. 646.

(*x*) See Chap. II., p. 42.

In *James* v. *James* (*y*), Romilly, M.R., said that anyone who was possessed of the secret of an invention might make the goods according to it, and might sell them under the name of the inventor after his death, but might not sell them in his lifetime, so as to suggest that they were made by him. But the distinction here suggested was questioned by James, L.J. (*z*), in a later case, for the death of the inventor would not necessarily prevent the use of his name being calculated to pass off the goods of others, as goods manufactured in the business lately carried on by him, if his successors were continuing it, and, on the other hand, during his lifetime, if there was no monopoly in the manufacture, anyone might state that the goods were made according to his system. It is material also to remember that the name of the first maker or inventor is often understood to imply the good quality of work or materials which has brought the new goods into favour rather than the mode of manufacture or the nature of the ingredients employed (*a*). Where this is the case the use of the name by traders who have no connection with him must almost always be calculated to deceive.

Names may become *publici juris*.

On the other hand, names which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such (*b*), or for other reasons, lose it and fall into common use and become *publici juris* (*c*), in the same way as trade-marks may be lost or abandoned.

Mere use of descriptive word.

No case of passing-off can be made out, therefore, merely by showing that the defendant has adopted and

(*y*) L. R. 13 Eq. 421 (1872), (*Lieutenant James' Horse Blister*).

(*z*) *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. p. 754 (1880).

(*a*) See the last case; and cf. the use of "original," above, p. 44.

(*b*) *Wood* v. *Butler*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A., (*Eton Cigarettes*).

(*c*) Chap. II., p. 37; and Chap. XIV., p. 283.

used a descriptive or other "open" word previously used by the plaintiff (*d*).

Disclaimed word.

A word, or other particular, forming part of a registered label or other trade-mark, and which the plaintiff has disclaimed as a condition of registration, is necessarily open, for the plaintiff cannot, it would appear, be heard to allege that it forms a distinctive mark (*e*). The same rule does not hold good of a word or particular which has been expunged from the register without the plaintiff's assent, for the removal of the mark does not prevent the plaintiff from showing that the mark is, nevertheless, distinctive of his goods. It has already been shown that a trade-mark which has never been registered, or which has been removed from the register, may be the basis of a passing off case (*f*). *The John Bull Beer Case* (*g*)—in which the Court of Appeal assumed that the plaintiff's action must fail if his trade-mark were expunged from the register, although it was brought, not only in respect of infringement, but also in respect of passing off—is not in conflict with this, for the only matter which led the Court to think the defendants' conduct was calculated to pass off their goods as those of the plaintiffs, was the use by the former of a label, bearing the words *Registered* and *John Bull*, whereas, in fact, the only registered John Bull mark was that of the plaintiffs.

Expunged trade-mark.

(*d*) *Kelly* v. *Byles*, 13 C. D. 682 (1880), Bacon, V.-C., and C. A., (*Post Office Directory*); *Schove* v. *Schmincke*, 33 C. D. 546 (1886), Chitty, J., (*Castle Album*); *Great Tower Street Tea Co.* v. *Smith*, 6 R. P. C. 165 (1889), North, J., (*Tower Tea*); *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J., (*Washerine*); *Rugby Portland Cement Co., Ld.* v. *Rugby and Newbold Portland Cement Co.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A., (*Rugby Portland Cement*); and cf. Chap. X., p. 201; and *The Colonial Fire Assurance Co.* v. *The Home & Colonial Assurance Co., Ld.*, *ante*, p. 398.

(*e*) *Rosenthal* v. *Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J., (*W. R. Corsets*), interim injunction refused, *ante*, p. 203.

(*f*) Above, p. 282; Chap. XII., p. 265.

(*g*) *Paine & Co.* v. *Daniells & Sons' Breweries Co., Ld.*, (1893) 2 Ch. 567; 10 R. P. C. 217.

Use of common word by defendant may be an element in a *get-up* case.

But an open, that is to say, a non-distinctive word, or open words, may be an important element in the plaintiff's labels, and the use of the same word or words by the defendant in the same manner, especially if coupled with the use of other details of "get-up" which are similar to those which the plaintiff uses, may be strong evidence to support a passing off case based upon imitation of get-up (*h*).

This was pointed out by Wood, V.-C., in *Woollam* v. *Ratcliff* (*i*), where, in commenting upon *The Omnibus Case* (*k*), he said, "the words *Conveyance Company*, the green omnibus, &c., were held sufficient together to entitle the plaintiffs to an injunction. The defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone."

As personal names which are adopted as trade-names or trade-marks are subject to the inconvenience that they may lawfully be used by anyone who, in using them, is only honestly trading in his own name (*l*); so a trade-name which is *primâ facie* geographical, or otherwise descriptive, is subject to a similar interference by its honest and proper use by persons other than the owner of the trade-name. Thus, in *Braham* v. *Beachim* (*m*), the plaintiff, being owner of all the collieries in Radstock, except a very small one, traded as the "Radstock Coal Co.," and the defendants began to sell coal under the same name, and also as "The Radstock Colliery Proprietors." An injunction was granted, "to restrain the defendants, unless and until they shall acquire a colliery

Mere honest description of the defendant's goods.

(*h*) As in *Lever* v. *Goodwin*, 36 p. 165.

(*i*) 1 H. & M. 259 (1863).

(*k*) *Knott* v. *Morgan*, 2 Keen, 213 (1836), Lord Langdale, M.R., and Cottenham, L.C.

(*l*) Below, p. 420.

(*m*) 7 C. D. 848 (1878), Fry, J.

C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A., (*Sunlight Self-Washer*, and *Goodwin's Self-Washing Soap*); and see the report of Lord Herschell's Committee on disclaimed additions, Chap. IX.,

"or coal mine within the parish of Radstock, from trading under, or using, the name or style of 'The Radstock Colliery Proprietors,' or any other name or style signifying that the defendants or either of them are proprietors of any colliery or collieries at Radstock." Subsequently the defendants acquired a colliery, but not in Radstock, and began to trade as "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset," and a motion to commit for breach of the injunction was refused on the ground that the terms used by them did no more than imply that they were proprietors of collieries, and that their place of business was at Radstock, and this was true (*n*). So, in *The Whitstable Oyster Case* (*o*), where it was held that the name "Whitstable Native Oysters" meant the plaintiffs' oysters, and could not be fairly used of French oysters relaid and brought to maturity at Whitstable; the learned judge said, the plaintiffs' right in respect of the name was subject to the inconvenience that the name might honestly be used by anyone to describe real Whitstable natives, whether the plaintiffs' oysters or not.

It may, perhaps, be doubted whether the decision in *The Radstock Colliery Case*, and the dicta just referred to, are quite consistent with the judgments delivered in the House of Lords, in *The Stone Ales Case* (*p*), where, although the right of the appellant to state that his beer was brewed at Stone was recognized, it was held to be subject to an obligation not to do so in any manner calculated to cause the appellant's beer to be passed off as that of the respondents, which was commonly known as *Stone Ale*, and the learned lords were clearly of opinion that the obligation would prevent the appellant from using the last-mentioned term at all.

(*n*) Seb. Dig. p. 633 (1878), Fry, J.

(*o*) *Free Fishers of Whitstable* v. *Elliot*, 4 Times L. R. 273; W. N. (1888) 27, Stirling, J., injunction to restrain the use of *native*.

(*p*) *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361.

Author's name.

An author can restrain the publication under his name of books which are not written by him, on the same principles as a trader can obtain an injunction to protect his trade-name, or that of his goods (*q*). And, further, it has been held that the writer of a work can maintain an action against the owner of the copyright for the damage occasioned to his reputation by the publication of a new edition of the book, purporting to be prepared by him, but in fact not so prepared (*r*). But in the case of a serial publication, the purchaser of the goodwill of the business of conducting it—sometimes, but erroneously, called the copyright in the publication—is at liberty to publish subsequent numbers under the old name after determining his business relations with the author or editor of earlier numbers, and notwithstanding that the name is that of the first editor or author (*s*).

Title of book.

Titles of books, newspapers, or other publications (in regard to which no copyright can exist (*t*)), are also protected on the same principles, that is, as trade-names, and no cause of action arises, therefore, unless it is shown that the title is known to indicate the plaintiff's book or paper, so that its use by the defendant would be calculated to lead to deception (*u*).

(*q*) *Lord Byron* v. *Johnson*, 2 Mer. 29 (1816), Eldon, L.C.; cf. *Barnard* v. *Pillow*, W. N. (1868) 94, Romilly, M.R. (music); and *Martin* v. *Wright*, 6 Sim. 297 (1833), Shadwell, V.-C., copy of work of diorama painter.

(*r*) *Archbold* v. *Sweet*, 1 M. & R. 162; 5 C. & P. 219 (1832), Lord Tenterden, C.J.

(*s*) *Ward* v. *Beeton*, L. R. 19 Eq. 207 (1874), Malins, V.-C., (*Beeton's Christmas Annual*); cf. *Condy* v. *Mitchell*, 37 L. T. N. S. 766 (1877), C. A., (*Condy's Fluid*); a late editor would be restrained from advertising that a serial is discontinued; *Bradbury* v. *Dickens*, 27 Beav. 53; 28 L. J. Ch. 667 (1859), Romilly, M.R., (*Household Words*).

(*t*) *Dicks* v. *Yates*, 18 C. D. 76 (1880), Bacon, V.-C., and C. A., (*Splendid Misery*); *Licensed Victuallers' Newspaper Co.* v. *Bingham*, 38 C. D. 139 (1888), North, J., and C. A. (*Licensed Victuallers' Mirror.*)

(*u*) *Shove* v. *Schmincke*, 33 C. D. 546 (1886), Chitty, J., (*Castle Album*); *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A.; and cases in the last note.

C. Imitation of Get-up.

The general appearance of a trader's goods as they are presented to purchasers is often the most important of the signs by which the goods are recognized as his, and an imitation of it frequently affords the readiest means by which a fraudulent rival, and fraudulent retail dealers in collusion with him, can pass off his goods as the goods of the other. The cases falling under this head are almost necessarily cases of deliberate fraud, for such similarity of "get-up" as is calculated to deceive is the result, as a rule, of a resemblance, more or less close, in a number of corresponding details, and this can hardly happen by accident or coincidence. In effect, if the get-up of the defendant's goods appears, on first inspection, to closely resemble that of the plaintiff's, and it is shown that it has recently been adopted by him, the only explanation, consistent with honest conduct, that can ordinarily be given is, that the leading features of the get-up, as the square tin box covered in yellow paper, bearing red and black letters, for the mustard trade (*x*), are common to the trade in question.

Get-up common to the trade.

What is compendiously called the "get-up" of goods—the dress in which they are presented to the buyer (*y*)—comprises, in particular, the size and shape of the packages, where the goods have no definite outline, or none which is shown to the buyer, the material, colour, and decoration of their wrappers, and the lettering and arrangement of their labels. Thus, in *Lever* v. *Goodwin* (*z*), the plaintiffs sold their soap in packets wrapped up in a peculiar parchment paper, with *Sunlight Self-washer* printed in spaced type upon the wrapper; the defendants began to use similar packets and

(*x*) See *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

(*y*) In *Knott* v. *Morgan*, 2 Keen, 213 (1836), Langdale, M.R., and Cottenham, L.C., the fraud consisted in the imitation of the painting of the plaintiff's omnibuses, the uniforms of their servants, and the use of their descriptive title—the London Conveyance Co.

(*z*) 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.

paper, with the words *Goodwin's Self-washing Soap* printed upon it in similar type. It was treated as an obvious case of fraud (*a*).

No monopoly in the constituent elements.

"Looking at the two tablets," Cotton, L.J., said, "one cannot but see that there is a strong general resemblance between them, and especially in the eyes of people who cannot read. But (the defendants') contention was this: there is no trade-mark in *Self-washer* or *Self-washing* (*b*); there is no monopoly in this parchment paper; there is no monopoly in the spaced printing; then why should we be restrained, in carrying on business, from using those things as to which the plaintiffs cannot claim any monopoly? That is an obvious fallacy. There may be no monopoly at all in the individual things, but if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs' then the defendants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction to restrain the defendants from passing off their goods as those of the plaintiffs" (*c*).

Imitation of part of get-up.

It is not, however, necessary that every part of the get-up should be imitated, for, though no exclusive right to the use of any single feature of it which is not a registered trade-mark is recognized, yet a part of the get-up, a picture, for instance, which is used on the label or wrapper, may be shown to be so identified with the plaintiff's goods that its use for similar goods is calculated to pass them off as his. The picture, in effect, may become—as the trade-

(*a*) Imitations of the descriptive and commendatory inscriptions, and of the directions for use printed on the covers of patent medicines and proprietary articles are very common; *Franks* v. *Weaver*, 10 Beav. 297 (1847), Langdale, M.R.; and *Massam* v. *Thorley's Cattle Food Co.*, 14 C. D. 743 (1880), C. A., are instances.

(*b*) It had been struck off the register on the defendants' application.

(*c*) *Blofield* v. *Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833), imitation of envelope; *Great Tower Street Tea Co.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling J., of packets; *Hammond* v. *Brunker*, 9 R. P. C. 301 (1892), Chitty, J., of label; *Stephens* v. *Peel*, 16 L. T. N. S. 145 (1367), Wood, V.-C., of bottle, and Steel-pens for *Stephens*.

name of the plaintiff's goods may—a "common law trade-mark" (*d*).

Thus, in *Jay* v. *Ladler* (*e*), the plaintiff used the device of a lady and a bear, in his trade as a furrier, by attaching it to the wrappers and boxes in which he sent out his goods, but he had registered it only as a trade-mark for sealskin mantles and coats. The defendant began to issue a circular, bearing a similar mark, in connection with his trade, which was also that of a furrier. Two injunctions were granted, one, restricted to the mantles and coats, to restrain infringement of the trade-mark, the other, not so restricted, to restrain the defendant from using the device so as to deceive the public.

And, on the other hand, the imitation of a number of things, each of which is in itself not distinctive of the plaintiff's goods, may make a strong case on account of the cumulative effect of the detailed resemblances (*f*).

3. Use in Connection with the Defendant's Goods.

Name, &c. need not be attached to the goods.

The spurious badges must be used in connection with goods which are not the plaintiff's, but they need not be stamped or printed upon them or their envelopes. The fraudulent trade-names, for instance, in most of the cases where injunctions have been granted, were used as descriptions of the defendants for general purposes, and in their advertisements and circulars (*g*), or were placed over their shop doors (*h*). In *Jay* v. *Ladler* (*i*), the deceptive repre-

(*d*) Above, p. 383.

(*e*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; see also *Hart* v. *Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.; and *Great Tower Street Tea Co.* v. *Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.; and see p. 408 above.

(*f*) See the judgment in *Lever* v. *Goodwin*, quoted above; and *per* Wood, V.-C., in *Woollam* v. *Radcliff*, 1 H. & M. 259, cited *ante*, p. 408.

(*g*) See the injunctions in *Hendriks* v. *Montagu*, 17 C. D. 638; and *Massam* v. *Thorley*, 14 C. D. 748; Appendix, p. 650.

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

(*i*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

sentation was effected by sending to the defendant's customers a circular inclosing a print of a design resembling the plaintiff's distinctive design. The action extends to every kind of representation which is calculated to pass off the defendant's goods as the plaintiff's.

4. Probability of Deception.

Where deception is intended.

The Court must be satisfied that the defendant's conduct is calculated to pass off other goods as those of the plaintiff, or, at least, to produce such confusion in the minds of probable customers or purchasers as would be likely to lead to the other goods being bought and sold for his (*k*). This is the foundation of the action.

But if it is shown to have been intended to deceive in this way, the Court will not generally push the inquiry further (*l*).

Badges of fraud: unexplained similarities; colourable differences; gradual approximation.

The existence of unexpected and unexplained similarities (*m*) between the goods of the defendant and those of the plaintiff, or of similarities which have been modified by colourable differences (*n*) or by differences and distinctions so arranged as to escape notice (*o*); the use by the defendant of descriptions, which, as applied to himself or his own trade, are inaccurate, and by reason of their inaccuracy approach more nearly to the proper description of the plaintiff (*p*), and the gradual approximation of the defendants' names, get-up, or description to those of the plaintiff (*q*), are all obvious badges of fraudulent intention

(*k*) *Hendriks* v. *Montagu*, 17 C. D. 638 (1881); see *per* James, V.-C., p. 646.

(*l*) "Why should we be astute to say that (the defendant) cannot succeed in doing what he is straining every nerve to do"? Lindley, L.J., asked, in *Slazenger* v. *Feltham*, 6 R. P. C. p. 536 (1889).

(*m*) *Taylor* v. *Taylor*, 2 Equity, 230; 23 L. J. Ch. 255 (1854). Wood, V.-C.

(*n*) *Slazenger & Sons* v. *Feltham & Co.*, 6 R. P. C. 551 (1889), C. A., (*Demon, Demotic*).

(*o*) *e.g.*, "*late of*," &c., in small letters, Chap. XV., p. 322.

(*p*) *Holloway* v. *Holloway*, 13 Beav. 209 (1850), Langdale, M.R.

(*q*) *Boulnois* v. *Peake*, 13 C. D. 513 n. (1868), Giffard, V.-C., *Carriage Repository* changed to *New Carriage Bazaar*; *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887),

frequently recurring in the cases which come before the Court (*r*).

Proof of actual deception.

Instances of actual deception need not be proved if the Court is otherwise satisfied of the probability of deception (*s*); and on the other hand, they are not necessarily conclusive where they have occurred, in cases, for example, where their number is comparatively insignificant (*t*).

Proof of probability of deception.

The question what resemblance is calculated to deceive, and the modes of comparison adopted, have been sufficiently considered in the preceding chapters (*u*).

5. Proof of Damage.

Probability or proof of damage is essential.

Proof of damage is not in every case essential to enable the plaintiff to maintain his action, for if he shows that the defendant is acting so as to pass off goods which are not the plaintiff's as his, it will generally be assumed that the plaintiff is thereby prevented from selling as many of the goods as he otherwise would. But if this assumption is negatived by the circumstances of the case, proof of actual or probable damage is necessary (*x*). For the assumption of a name (*y*), or an address (*z*), similar to the name or address of the plaintiff, without malicious intent, although it may cause annoyance and inconvenience to him,—for

C. A., (*Apollinis*); *Sanitas Co., Ld.* v. *Condy*, 4 R. P. C. 195, 530; 56 L. T. 621 (1886), Kay, J., (*Condi-Sanitas*).

(*r*) See further, p. 322.

(*s*) See the last chapter, p. 316.

(*t*) *Civil Service Supply Association* v. *Dean*, 13 C. D. 512 (1879), Malins, V.-C.; *Borthwick* v. *The Evening Post*, 37 C. D. 449 (1888), C. A.; *Leahy, Kelly, & Leahy* v. *Glover*, 10 R. P. C. 141 (1893), H. L.

(*u*) Chap. XV., p. 314; Chap. X., p. 186; see also *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A., (plaintiff and defendant both mere importers); *Bodega Co.* v. *Owens*, 6 R. P. C. 236; 7 R. P. C. 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C., (defendant called his wine-shop in Belfast *Bodega*; plaintiff had no Bodega shop in Ireland outside Dublin); and the cases in the last note.

(*x*) So that a non-trader has no action, *ante*, p. 308; *Delondre* v. *Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.

(*y*) *Borthwick* v. *The Evening Post*, *supra*; *Du Boulay* v. *Du Boulay*, L. R. 2 P. C. 430.

(*z*) *Day* v. *Brownrigg*, 10 C. D. 294 (1878), C. A.; *Street* v. *Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J., adoption by the defendants (bankers) of the same cypher telegraphic address as that of the plaintiff.

instance, by delaying his letters,—is not actionable, unless it is shown to be calculated to injure him in his trade. And no action lies at the suit of any private individual for deception practised upon the public, unless it incidentally causes, or is calculated to cause, damage to him as an individual; if this is not the case, the wrongdoer can only be punished through the criminal law, or in a civil action on information brought in the name of the Attorney-General (*a*).

6. Defences.

The defences, other than a simple denial of the acts alleged, which are commonly set up, may be tabulated as follows: that—

(1.) The name, or other badge, which the plaintiff charges the defendant with having imitated, carries no distinctive reference to the plaintiff's goods.

(2.) The defendant has an independent or a concurrent right to use them (*b*).

(3.) The name or other badge which the defendant is using, is not such, or is not so used, as to be calculated to pass off other goods for those of the plaintiff (*c*).

(4.) The plaintiff is barred from suing the defendant for all or part of the relief he seeks by (a) an agreement, or some personal estoppel (*d*) (other than those next alluded to); (b) acquiescence (*e*); (c) delay (*f*); (d) deceptive use of the name or badges he relies on, or because his trade is fraudulent (*g*).

(*a*) *Per* Cotton, L.J., in *The Native Guano Co.* v. *The Sewage Manure Co.*, 8 R. P. C. p. 128 (1891); see also *Clark* v. *Freeman*, and *Williams* v. *Hodge*, cited above, p. 389; *Batty* v. *Hill*, 1 H. & M. 264 (1863), Wood, V.-C., false pretence of award of gold medal.

(*b*) See, as to the right to use a man's own name, p. 420; and as to the right to honestly describe the place of origin, &c. of his goods, p. 408; and, further, the last chapter, "infringement," pp. 325 *et seq.*

(*c*) Above, p. 414; and Chap. XV., p. 314.

(*d*) Page 330.

(*e*) Page 332.

(*f*) Page 333.

(*g*) Page 346.

(1.) This is a traverse of part of the plaintiff's case. It may take the form of an allegation that the name or other badge is merely descriptive (*h*). If so, the defence falls under the second head also. Denial of repute.

(2.) This defence is discussed below. The most important case is the right of any man, apart from restriction by contract, to trade honestly under his own name. That right is, of course, an answer only to a case which rests wholly upon an alleged imitation or adoption of the trade-name which the plaintiff is using. Concurrent right.

(3.) This defence also is a mere traverse. It has been considered already (*k*). Denial of deception.

(4.) The defences collected under the fourth head are precisely analogous to those discussed in the last chapter; they depend on the same considerations, and are governed by the same rules (*l*). Estoppel.

Concurrent Right.

The defendant may have as good a title to use the name or other matters in question as the plaintiff has to use that with which it or they are, as he alleges, likely to be confused. For instance, on the dissolution of a partnership, in the absence of special agreement, and unless the firm name is sold with the goodwill, as it may be (*m*), each partner has an equal right to use it, if he continues to carry on the same business as that of the late firm (*n*). Partners after dissolution.

It is convenient to note here, in passing, that the purchaser of the goodwill of a business, or a partner succeeding to it under agreement upon dissolution of partnership, has a right to use the trade-name under which it was con- Purchaser of goodwill.

(*h*) Above, pp. 406 *et seq.*

(*k*) Note (*c*), above.

(*l*) See *Read* v. *Richardson*, 45 L. T. N. S. 54 (1881), C. A. (*Dog's Head Beer*).

(*m*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; and see Lindley on Partnership, 5th ed., p. 445.

(*n*) *Banks* v. *Gibson*, 34 Beav. 566; 34 L. J. Ch. 591 (1865), Romilly, M.R.; *Levy* v. *Walker*, and *Chappell* v. *Griffiths*, *infra*; and see further on this subject, Sebastian, 3rd ed., p. 289.

ducted (*o*). And this, even though it comprise the personal name of a late partner (*p*), or of any other late owner of the goodwill, but not so as to cast any risk of liability upon the late owner (*q*) or his late partners by using their personal names in such manner as to represent that they are still members of the firm (*r*).

Trader may use his own name after the sale of his business, where no contrary agreement;

But where the goodwill of a business is sold, or is taken over on the dissolution of a partnership by agreement, without any restrictive condition being imposed upon the late owner or the retiring partner which restrains him from exercising his ordinary right, he is at liberty to start in the same trade again at once under his own name, so long as he uses it honestly, even though it be the same as, or be similar to, the name under which the old business was, and continues to be, carried on (*s*). The case most commonly arises after a sale, by the trustee in bankruptcy of a trader, of the goodwill of the debtor's business (*t*), for a careful

(*o*) *Levy* v. *Walker*, 10 C. D. 436 (1879), C. A.

(*p*) *Condy* v. *Mitchell*, 37 L.T.N.S. 268, 766 (1877), Bacon, V.-C., and C. A. (*Condy's Fluid Co.*); *Chappell* v. *Griffith*, 53 L. T. N. S. 459 (1885), Kay, J.

(*q*) *Chatteris* v. *Isaacson*, 57 L. T. N. S. 177 (1887), Kekewich, J. The vendor of the business of "Mme. Elise" agreed that the purchaser should have the exclusive right to use the name "Mme. Elise & Co." Mme. Elise was his wife's name. Held, the purchaser must use the addition "& Co."

(*r*) *Dickson* v. *McMaster & Co.*, 18 Ir. Jur. 202 (1866), Brady, C.; *Scott* v. *Rowland*, 26 L. T. N. S. 391 (1872), Wickens, V.-C.; *Gray* v. *Smith*, 43 C. D. 208 (1889), C. A.; *Thynne* v. *Shove*, 45 C. D. 577 (1890), Stirling, J. There can be no risk where the late partner is dead, *Webster* v. *Webster*, 3 Swan. 490 (1791), Thurlow, L.C.; see Lindley on Partnership, 5th ed., p. 446.

(*s*) *Churton* v. *Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Johnson* v. *Helleley*, 34 Beav. 63; 34 L. J. Ch. 32, 179; 2 De G. J. & S. 446 (1864), Romilly, M.R., and L.JJ.; *Labouchere* v. *Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M.R. The decisions in this case and in *Mogford* v. *Courtenay*, 45 L. T. N. S. 303 (1881), Fry, J., that the vendor must not solicit the old customers to trade with him, are now overruled; *Pearson* v. *Pearson*, 27 C. D. 145 (1884), Baggallay and Cotton, L.JJ., Lindley, L.J., dissenting; *Vernon* v. *Hallam*, 34 C. D. 748 (1886), Stirling, J.

(*t*) *Cruttwell* v. *Lye*, 17 Ves. 335 (1810), Eldon, L.C.; *Hudson* v. *Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

purchaser would hardly consent to buy the goodwill of a business from its owner without stipulating for the exclusive use of the trade-name; but the trustee in bankruptcy has no power to contract on the debtor's behalf, so as to restrict the right of the debtor to trade under his own name (*u*).

"It has been settled," James, V.-C., said, in *Hudson* v. *Osborne* (*x*), "that there is no implied covenant of any kind in the sale by an individual himself of the goodwill of his business; but it seems to be settled that a trader, whose business, and the goodwill of whose business, have been sold by himself, or by any person deriving title under him, has no right to represent himself as carrying on that identical business; he has no right to use the trade-marks which were the marks of that business, or, by the use of the name, or of a title of the firm, to represent himself as being the continuer of that identical business which has been sold." If the restriction stated in the last sentence of the quotation covers, as it appears to, the mere honest use of the trader's own name, it is, according to other decisions, too widely expressed (*y*). But it is clear that the late owner or partner must do nothing, other than such honest use of his own name, calculated to suggest that he is carrying on the old business (*z*).

but not represent that his business is the old business, or its successor.

Thus, in *Churton* v. *Douglas* (*a*), a partner who had sold his share in the business of "John Douglas & Co." to his co-partners, who continued to trade as "Churton, Bankart, and Hirst, late John Douglas & Co.," was restrained from trading as "John Douglas & Co." The question whether a late partner, or other late owner of a business which has passed into the hands of the plaintiff, is representing that he is still carrying it on, or that his present business is its successor, or is only fairly working and advertising the

(*u*) *Walker* v. *Mottram*, 19 C. D. 355 (1881), C. A.

(*x*) *Supra*, note (*t*).

(*y*) See the next division of this chapter.

(*z*) As to the use of the word "late," see above, p. 322.

(*a*) Note (*s*); *Witt* v. *Concoran*, 2 C. D. 69 (1873), Bacon, V.-C., is a similar case. *Benbow* v. *Low*, 44 L. T. 875; 29 W. R. 837 (1881), Bacon, V.-C.

latter business as his own, is often one of great nicety (*b*). The case of *Mogford* v. *Courtenay* (*b*), probably falls very near the line. There the partnership between the parties having expired by effluxion of time, and the goodwill passing under the partnership articles to the plaintiff, but without any restrictive covenant binding the defendant not to use the firm name or any similar name, the defendant was restrained from issuing a circular to the old customers stating the fact of dissolution, and that he had joined a new firm, and asking the customers for a "continuance" of their custom. This was held to be a suggestion that he was about to carry on, not merely a similar business, as he lawfully might, but the identical business which had passed to the plaintiff.

The right to Trade under one's own Name.

Anyone may honestly trade under his own name.

The most important limitation of the principle stated above is the rule that a man may honestly trade under his own name, or the names of himself and his partners, even though their similarity to the name under which other persons have been previously carrying on business in the same trade may occasionally cause his goods, or his firm's goods, to be passed off for theirs.

"All the Queen's subjects have a right to sell (their goods)," Knight-Bruce, L.J., said, in a suit between father and son (*c*), "in their own names, and not the less that they bear the same name as their father"; but, he added, "if any circumstance of fraud had accompanied, and were continuing to accompany, the case, it would stand very differently."

And where a man named Warner bought a business in a medicine, at the time known as Ashton's Gout and

(*b*) 45 L. T. N. S. 303 (1881), Fry, J. The decision that the defendant might not solicit the old customers is, as already stated (p. 418, note (*s*)), not now law; *Pearson* v. *Pearson*, 27 C. D. 145.

(*c*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), *infra*.

Rheumatic Cure, and proceeded to sell his goods as *Warner's Cure*, in imitation of a well-known and widely advertised medicine called *Warner's Cure*, or *Warner's Safe Cure*, the Court of Appeal said that no injunction could be granted unless it were shown that the defendant was making a fraudulent use of his name (*d*).

Turton v. *Turton.*

The subject was recently fully discussed by the Court of Appeal in the important case of *Turton* v. *Turton* (*e*). In that case the plaintiffs, Thomas Turton and Sons, Limited, were carrying on a widely known and extensive business acquired by the company in 1886, but established many years previously, under the name of *Thomas Turton and Sons*, in Sheffield, and one of the trade-marks of the company bore that name upon it. The defendants, John Turton and his two sons, were carrying on a business of a similar description in the same town. Their business had also been established for many years, although not for so long as that of the plaintiffs. For ten years before June, 1888, its style had been *John Turton & Co.*, but John Turton then took his sons into partnership, and changed the style to *John Turton and Sons*, the name the plaintiffs complained of. There was evidence that the plaintiff company were often referred to as *Turton and Sons*, and *Thomas*, or *T. Turton and Sons*, and there were conflicting affidavits by persons engaged in the trade as to whether the distinction between the trade-names was sufficient to prevent mistakes being made. It was also shown that letters intended for the plaintiffs had, in some instances, been delivered to the defendants, but, apart from the adoption of the addition *and Sons*, in place of *and Co.*, there was no evidence that the defendants' conduct was intended or calculated to pass off their goods as those of the plaintiffs.

(*d*) The C. A. thought it very probable the plaintiff would succeed in proving fraud, and accordingly they granted an interim injunction, 5 Times L. R. 327, 353 (1869).

(*e*) 42 C. D. 128 (1889), C. A., reversing North, J.

Mr. Justice North, at the trial, granted an injunction in the terms of that in *Hendriks* v. *Montagu* (*f*); but the Court of Appeal reversed this order, and dismissed the action.

In the view of the facts taken by the Court of Appeal, the defendant, John Turton, was not shown to have done anything to give to the name objected to any other meaning than that he was carrying on business in partnership with his sons; he had not done anything with the intent or for the purpose of making the use of his simple name look as if his name were the name of the plaintiffs.

Lord Esher's judgment.

"In some cases," Lord Esher said, "besides using the names, parties have, to use what, I think, is a happy phrase of my brother Cotton's, 'garnished that use'—that is, they have done things besides using the name, in order that the use of that name might look as if it were being used by the old firm. There is nothing of that kind here."

Lord Justice Cotton's judgment.

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

Notwithstanding the possibility of mistakes between the two firms being made by careless people, therefore, the

(*f*) *Ante*, p. 396.

Court held that the defendants were justified in adopting the name complained of, and in continuing its use after the possibility of mistake had been brought to their knowledge, and the action was accordingly dismissed.

The decision is certainly not in conflict with the earlier cases, and it is probably a final authority on the question involved; but one may venture to regret that the Court did not adopt the slight extension of the principles appealed to which would have been necessary to forbid the defendants from choosing out of several alternative styles, all equally accurate as descriptions, and equally convenient according to business usage, the only one which was calculated to lead to mistake. If *Turton & Co.* did not suit the defendants, they might have been satisfied with *Turton*, *Turton and Turton*, or *Turton* preceded by the initials of the partners.

A man may describe his firm in the ordinary mercantile way; not necessarily by any "fancy name."

The foundation of the judgments of all the Lords Justices was that the statement comprised in the defendant's name was nothing other than a statement of the actual fact that their business was the business of Joseph Turton and his sons, expressed in the "ordinary mercantile way" (*g*), and made "truly, honestly, and in the usual manner in which such statements are made in the course of business" (*h*). The case is, therefore, readily distinguishable from cases where a "fancy name" which is not descriptive of actual facts in ordinary language is adopted (*i*), such as, for instance, the name—the "Universal Life Assurance Association"—in *Hendriks* v. *Montagu* (*i*); and there is no justification for the adoption and use of any such name if it is calculated to deceive. And the decision accords with the earlier authorities next referred to.

Burgess v. *Burgess*.

In *Burgess* v. *Burgess* (*k*), the defendant, who had recently left the employment of his father, the plaintiff, and set up a rival business in King William Street, was

(*g*) Cotton, L.J., p. 142.

(*h*) Fry, L.J., p. 147.

(*i*) *Ante*, p. 396; and see the latter part of the judgment of Cotton, L.J., 42 C. D. 145.

(*k*) 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and Knight-Bruce and Turner, L.JJ.

restrained from describing his business as "late of 107, Strand," his father's address; but the Court refused to forbid him to trade under his own name, or to describe his goods as "Burgess' Essence of Anchovies."

Massam v. *Thorley.*

Massam v. *J. W. Thorley's Cattle Food Co., Ld.* (*l*), closely resembled the case of *Tussaud* v. *Tussaud* already referred to (*m*). There the plaintiffs, as executors of one Joseph Thorley, were carrying on a well-known business in a particular food for cattle established by their testator. The defendant company had engaged as their manager J. W. Thorley, who was a brother of Joseph Thorley, and, having been in his employment some ten years previously, had become possessed of the recipe according to which the cattle food was made by the plaintiffs' testator. J. W. Thorley was also the holder of a one-shilling share in the company. The defendants endeavoured to defend their use of the name they had adopted on the ground of their relations with J. W. Thorley, but unsuccessfully, and the Court of Appeal were further of opinion that the defendants had imitated the get-up of the plaintiffs' goods, and had intentionally acted so as to induce buyers to take their goods for them.

The injunction granted left the defendants at liberty to use their name, and to use the word *Thorley* in connection with their goods (if they could) in any way not calculated to mislead the public (*n*).

The injunction in this case might, in the view of the facts the Lords Justices took, have been granted on the fraudulent intention of the defendants alone, for, as appears from the judgments quoted above, it is only the honest use of a man's own name which is a defence (*o*).

(*l*) 14 C. D. 748 (1880), C. A., reversing Malins, V.-C.

(*m*) *Ante*, p. 400.

(*n*) See the form of injunction, 14 C. D. 762; and Appendix, p. 661.

(*o*) See also *Warner* v. *Warner*, 5 Times L. R. 327, 359, cited p. 420; *Huntley & Palmer* v. *The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J.; and *Clayton* v. *Day*, where one Day joined one Martin in a fraudulent attempt to carry on business as "Day and

Name must be the defendant's own name;

And the justification only extends to the use of a man's own name, or that of his predecessor who founded his business and established it under the name which the defendant is using (*p*); not to the use of that of his servant (*q*), or of an alleged partner who has really no interest in his business and has been brought into it only in aid of an attempt to cover the employment of a deceptive name (*r*).

not a bought name,

Still less to the use of the name of a stranger (*s*), even though it is alleged that he has authorized the defendant to use it (*t*).

Such practices are badges of fraud rather than grounds of defence. So, where the defendant has altered his name in such a way as to make it more nearly resemble the plaintiff's, the inference is almost inevitable that fraud is intended (*u*), and whether it is or not, the rule in question only applies to the use of the defendant's name in its ordinary form.

or a name altered to resemble the plaintiff's;

but may be the defendant's name of repute.

But it is submitted that the name need not be that which the defendant received from his parents. A name he has adopted and used until it has come to be his name by repute is as much his name as that by which his parents

Martin," in unfair competition with the well-known firm, 26 Sol. J. 43 (1881), Chitty, J.

(*p*) See *Turton* v. *Turton*, *ante*, p. 421; *Barber* v. *Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.

(*q*) *Southorn* v. *Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C., (*Southorn's Broseley Pipes*); *Birmingham Vinegar Brewery Co.* v. *Liverpool Vinegar Co.*, W. N. (1888) 139, North, J., cited p. 394; *Tussaud* v. *Tussaud*, *ante*, p. 400.

(*r*) See *Croft* v. *Day*, *infra*; *Schweitzer* v. *Atkins*, 37 L. J. Ch. 847 (1868); *Dence* v. *Mason*, W. N. (1877) 23, (1878) 42, (*Brand's Essence of Beef*), both Malins, V.-C.

(*s*) *Isaacson* v. *Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C., (*Madame Louise*), defendant used his daughter's name, *E. Louise*; interim injunction refused on account of delay.

(*t*) *Croft* v. *Day*, 7 Beav. 84 (1843), Langdale, M.R., (*Day and Martin*); *Shrimpton* v. *Laight*, 18 Beav. 164 (1854), Romilly, M.R.; *Melachrino & Co.* v. *The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.

(*u*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.; *James* v. *James*, L. R. 13 Eq. 421 (1872), Romilly, M.R., (*Robert Joseph James* called himself *Robert James*); and see *Slazenger* v. *Feltham*, 6 R. P. C. 531 (1889), C. A.

were known (*x*). Of course, a new name adopted at the time of, or shortly before, the alleged deceptive user of it would generally be taken to have been adopted for fraudulent purposes, even if it could be shown by the date of the trial to have become the defendant's name by repute.

It must be used *simpliciter*, not garnished to look like the plaintiff's.

In most of the reported cases in which a defendant has been restrained from passing off his goods as those of the plaintiff under cover of a similar name, the defendant has added the "circumstances of fraud," to which Knight-Bruce, L.J., referred, in *Burgess* v. *Burgess* (*y*), or, in the phrase of Cotton, L.J., in *Turton* v. *Turton* (*z*), has "garnished the use of his name" by imitating the get-up of the plaintiff's goods (*a*), or his labels and show-cards (*b*), or has issued circulars or advertisements (*c*) calculated to foster the error which the resemblance of his name and that of the plaintiff's was calculated to produce.

Thus, in *Moet* v. *Clybouw* (*d*), the defendant claimed to be entitled to use the names *Meadows* and *Clybouw*, and, by virtue of such right, to brand upon the corks of his champagne bottles the letters *M. & C.* in a circle on the bottom, and the word *England* at the side, in obvious imitation of the plaintiff's practice. And in *Holt* v. *Smith* (*e*), the defendant bought the business of H. Newman and changed

(*x*) See *per* James, L.J., and Bramwell, L.J., in *Massam* v. *Thorley, &c.*, 14 C. D. pp. 757 and 760. It has already been shown that a name of repute is protected as a trade-name, above, p. 394.

(*y*) *Ante*, p. 420; *e.g.*, by adding *& Co.*; *Graveley* v. *Winchester*, Seb. Dig. p. 162 (1867), Giffard, V.-C.; *Churton* v. *Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Witt* v. *Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.

(*z*) *Ante*, p. 422.

(*a*) *Holloway* v. *Holloway*, 13 Beav. 209 (1850), Langdale, M.R.; *Taylor* v. *Taylor*, note (*u*); *Schweitzer* v. *Atkins*, note (*r*); *Fullwood* v. *Fullwood* (1), W. N. (1873) 93, 185, Malins, V.-C., and L.JJ.

(*b*) *Croft* v. *Day*; *Melachrino* v. *The Melachrino Egyptian Cigarette Co.*, note (*t*).

(*c*) *Massam* v. *J. W. Thorley's Cattle Food Co.*, *supra*.

(*d*) Seb. Dig. p. 316 (1877), Jessel, M.R., (*Moet and Chandon*).

(*e*) 4 Times L. R. 329 (1886), Kay, J. Action stayed on the defendant undertaking to use *H.* and drop *Co.*; defendant to pay costs.

its name to Newman & Co., in imitation of the plaintiff's trade-name.

Proximity may be a badge of fraud.

The proximity of the place where the defendant sets up his business to that where a well-known firm is already trading may be evidence to show that, although trading under his own name, the defendant is seeking to take fraudulent advantage of its similarity to the plaintiff's name. The case of somebody finding a man named *Bass* and setting up a brewery at Burton as Bass & Co. (*f*), and the case of a man starting business as a banker in the Strand under the name of Coutts (*g*), have been cited as instances in which it is scarcely conceivable that the use of the name could be honest (*h*). In *Turton* v. *Turton* (*i*), the defendants were trading in the same town, Sheffield, as the plaintiff, but their presence there was reasonably accounted for, because their business had been established in the town long before the circumstances which led them to adopt the name complained of arose.

7. The Relief granted.

The relief granted to the plaintiff, if he succeeds in a passing off action, corresponds to that granted in the action for infringement of a registered trade-mark to which the first-mentioned action is so closely allied. It comprises, therefore—(i.) an injunction restraining the defendant from passing off, or doing or continuing acts which are calculated to pass off, his goods as those of the plaintiff (*k*); (ii.) an order for the delivery up for destruction,

(*f*) James, L.J., in *Massam* v. *Thorley, &c.*, 14 C. D. p. 757.

(*g*) Chitty, J., in *Melachrino* v. *The Melachrino, &c. Co.*, 4 R. P. C. p. 221.

(*h*) *Lee* v. *Haley* is another illustration. There the plaintiff's late manager set up in business as the "Pall Mall Guinea Coal Co.," in the Strand, and afterwards removed to 46, Pall Mall. The plaintiffs traded, at 22, Pall Mall, as "The Guinea Coal Co." An injunction was granted; 21 L. T. N. S. 546; 22 *ib.* 251; L. R. 5 Ch. 155, Malins, V.-C., and Giffard, L.J.

(*i*) Page 421.

(*k*) Last chapter, p. 348. See the orders collected in the Appendix, pp. 648 *et seq.*

or for the erasure of the names or other badges, of any goods already marked with the deceptive names or badges, and in the possession or under the control of the defendant (*l*); and (iii.) damages in respect of the past interferences with the plaintiff's rights (*m*); or (iv.) an account of the profits made by the defendant by the sale of goods under the deceptive names or badges (*n*), or some one or more of these.

Injunction.

The general principles governing the grant of an injunction have been sufficiently considered in the last chapter.

Form of the injunction.

The form of the injunction granted varies considerably, according to the nature of the deceptive representation which the defendant is shown to have made use of, or threatened to make use of.

Where he has imitated or adopted the plaintiff's trade-name, the order may be an absolute injunction that he shall not carry on business under that name (*o*).

Injunction in *Massam* v. *Thorley*.

A very full form of order was adopted in *Massam* v. *Thorley's Cattle Food Co.* (*p*). It restrained the defendant company and their servants from selling, or procuring to be sold, and from in any manner representing any goods manufactured by them as the goods of the late Joseph Thorley or the plaintiffs, his successors; from in any manner representing, or doing anything which should lead to the belief that the defendant company were carrying on the business of the late Joseph Thorley; from affixing to their goods, or otherwise employing, any labels, wrappers, or marks used by him or the plaintiffs, or so contrived as to represent, or lead to the belief, that the goods manufactured or sold by the defendant company were his goods or those of the plaintiffs; and from using or circulating any circulars or advertisements, used or circulated by him or the plaintiffs, or which should in any manner represent or lead to

(*l*) Page 356.
(*m*) Page 359.
(*n*) Page 360.
(*o*) As in *Hendriks* v. *Montagu*, 17 C. D. 638, set out above, p. 396.
(*p*) 14 C. D. p. 762, set out in the Appendix, p. 650.

the belief that the defendant company had been or were carrying on the business of the late Joseph Thorley, or were his successors.

Only deceptive use of open word, &c. restrained.

But a device or name, which is not a trade-mark or the trade-name of the plaintiff, may always be used by the defendant in any way which is not calculated to deceive, if such way can be found; and the injunction in passing off cases is usually drawn so as to preserve this right, the order not to use a particular device or word being qualified by the addition "so as to represent, or lead to the belief," that the defendant's goods are the plaintiff's (*q*).

Thus, in *Massam* v. *Thorley's Cattle Food Co.*, the Lords Justices refused to prohibit the defendants from using the word Thorley in connection with cattle food altogether (*r*). And in *Slazenger* v. *Feltham*, the Court of Appeal modified the order of Kekewich, J., forbidding the defendants to stamp *Demotic* on their lawn-tennis bats, by adding the words "so as to represent that (they) are manufactured by the plaintiffs, or in any other way from passing off their lawn-tennis bats as the goods of the plaintiffs."

So, where a word is an open word, although associated with the plaintiff's trade or goods, the form of injunction is sometimes directed to prevent the defendant from using it without clearly distinguishing his goods from the plaintiff's. This was the form adopted in the infringement cases *Seixo* v. *Provezende* (*s*), and *Johnston* v. *Orr-Ewing* (*t*), and in *The Stone Ales Case*, where the action was to restrain passing off, several of the Lords of Appeal referred to it as the proper form to adopt unless the plaintiff had a claim to the exclusive use of the word, name, or other mark in question (*u*).

(*q*) *Slazenger & Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889); *Jay* v. *Ladler*, 40 C. D. p. 656; 6 R. P. C. 136 (1888), Kekewich, J.

(*r*) 14 C. D. 763.

(*s*) L. R. 1 Ch. 194 (1865), Wood, V.-C., and Cranworth, L.C.

(*t*) 13 C. D. 434; 7 App. Cas. 219, Fry, J., C. A., and H. L.

(*u*) Lord Watson and Lord Macnaghten, *Montgomery* v. *Thompson*, (1891) A. C. 217; 8 R. P. C. 361; see also *Thompson* v. *Bent's Brewery Co., Ld.*, 8 R. P. C. 479 (1891), Chitty, J.

The Stone Ales Case.

In the last-mentioned case, however, the injunction to restrain the defendant (*inter alia*) from selling beer not of the plaintiff's manufacture, under the term *Stone Ales* or *Stone Ale*, or in any way so as to induce the belief that such ale was of the plaintiff's manufacture, was, under the circumstances, maintained, the Lords of Appeal, referred to above, holding that the *Seixo* v. *Provezende* form of injunction would be more stringent, as it would, in effect, prevent the defendant using the term *Stone Ale* at all (*x*).

And the defendant has, in some instances, been restrained from using a word or words which could not be used by him at all, except deceptively, so long as this should continue to be the case; for instance, from calling his bitters *Angostura Bitters* until he should find out how to make the real *Angostura Bitters* (*y*); or from using the name *Radstock Colliery Proprietors* until he should be able to sell coal from Radstock (*x*).

Interim injunctions.

Interim injunctions are granted in passing off actions on the same terms and according to the same principles as in infringement actions (*z*).

8. Costs, Appeals, and Practice.

And the rules and principles in regard to costs (*a*), appeals (*b*), and practice (*c*), are also the same in both actions, except in so far as they depend upon registration and the Registration Acts, which do not extend to or affect passing off actions.

(*x*) See above, p. 408; and *Braham* v. *Beachim*, there cited.

(*y*) *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J.

(*z*) Chap. XV., p. 352.

(*a*) Page 364.

(*b*) Page 371.

(*c*) Page 372; forms of pleadings, p. 643.

CHAPTER XVII.

WARRANTY OF TRADE-MARKS AND TRADE DESCRIPTIONS (*a*).

	PAGE
Under the Merchandise Marks Act, 1887	431
Implied at common law	432
Where goods are described by reference to a trade-mark	433
Pictures ascribed to particular artists	433
Remedies for breach of warranty	434
Indemnity to manufacturer employed to apply an infringing mark ..	437

It is provided by sect. 17 of the Merchandise Marks Act, 1887, that:—

> "On the sale or in the contract for the sale of any goods to which a trade-mark (*b*), or mark, or trade description (*c*) has been applied (*d*), the vendor shall be deemed to warrant that the mark is a genuine (*e*) trade-mark and not forged (*f*) or falsely applied (*g*), or that the trade description is not a false trade description (*h*) within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee."

This section corresponds to sect. 19 of the Merchandise

(*a*) The references in this chapter are to the Merchandise Marks Act, 1887, which is set out and commented on in Book II.

(*b*) "trade-mark," sect. 3 (1), see next page.

(*c*) "trade description," sect. 3 (1), p. 476.

(*d*) "applied," sect. 3 (2), and sect. 5 (1), p. 473.

(*e*) "genuine," cf. sect. 2 (2) (a), p. 511.

(*f*) "forged," sect. 4, p. 468.

(*g*) "falsely applied," sect. 5 (3), p. 474.

(*h*) "false trade description," sect. 3 (1), pp. 476, 478.

Marks Act, 1862, but the older section applied only to trade-marks which were applied to goods sold, and the implied warranty was that the trade-marks were "genuine and true, and not forged or counterfeit, and not wrongfully used."

Trade-mark.

Trade-mark (*g*) here means registered trade-mark or trade-mark protected by law in any British possession or foreign state to which sect. 103 of the Patents, &c. Act, 1883, is applicable (*h*). The section, however, imports a warranty of the genuineness of unregistered English trade-marks, at any rate when the application of them to the goods is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of the proprietor of the trade-mark, and also of any trade-mark, whether registered or not, which the mark applied to the goods purports to be, for in such cases the unregistered trade-mark is a false trade description applied to the goods (*i*). "Mark," where it first occurs in the section, can hardly include an unregistered trade-mark, for the warranty implied is that the mark is a genuine trade-mark, that is, a genuine registered trade-mark, and that it does not purport to be. "Mark," where it occurs the second time, should be trade-mark or mark.

The several terms occurring in the section have the meanings given to them respectively by the sections of the Merchandise Marks Act, 1887, which are referred to in the notes (*k*). The general effect of the implied warranty is that the trade-marks, or marks purporting to be trade-marks, applied to the goods, are used with the assent of the proprietor of the trade-marks which they purport to be, and that the statements made or implied by the trade descriptions are true.

Implied warranty at common law.

Apart from the statutory warranties implied by the Merchandise Marks Act, it is held, at common law (*l*),

(*g*) "trade-mark," sect. 3 (1), p. 465.

(*h*) See Chap. XX., p. 454, and the list in the Appendix, p. 666.

(*i*) Sect. 3 (2), p. 476.

(*k*) See Book II., Chap. I., p. 430.

(*l*) Warranties of the genuineness of marks are implied, in re-

that when a purchaser orders goods from a firm who are manufacturers only of such goods, and not dealers in them, then, unless it is shown that in the particular trade, or as regards the particular goods, there is a custom for the manufacturer to supply the goods of other makers, the purchaser must be assumed to have contracted with the particular manufacturers in reliance on the general excellence of the work of their firm, and he is entitled (in the absence of any express stipulation to the contrary) to have goods of the manufacturer's own make delivered in performance of the contract (*m*).

Warranty where goods are described by a trade-mark.

It is a question of fact, or, if there is a written contract, of construction, whether a manufacturer or vendor has agreed to deliver goods, which are referred to by a trade-mark in the contract, stamped with the mark, and being, therefore, goods of the kind properly denoted by it, or whether he has agreed only to deliver goods of the same quality as those which are denoted by the mark. Thus, in *Hopkins* v. *Hitchcock* (*n*), where the contract was for iron described as "S. and H. (crown) bars," and the vendors were Hopkins & Co., the successors of Snowden and Hopkins, iron marked "H. & Co." with a crown was delivered, and the jury found that the mark was not a material part of the bargain. Judgment was given for the vendors in an action for the price of the iron, and the Court of Queen's Bench upheld the judgment, on the ground that the contract was for iron of a particular quality, not for iron bearing a particular mark.

Pictures ascribed to particular artists.

A somewhat similar question has arisen upon sales of pictures under the names of the supposed painters of them, and in such cases the matter to be decided is whether the

spect of *anchors and chain cables*, by 37 & 38 Vict. c. 51, s. 4, and in respect of *hops*, by 29 & 30 Vict. c. 37, s. 8.

(*m*) *Per* Cotton, L.J., in *Johnson* v. *Raylton*, 7 Q. B. D. 438 (1881), Cotton and Brett, L.JJ., Bramwell, L.J., dissenting; *Starey* v. *Chilcorth Gunpowder Co.*, 24 Q. B. D. 90 (1889), Div. Court.

(*n*) 14 C. B. N. S. 65; 32 L. J. C. P. 164 (1863).

use of the artist's name amounts to a warranty by the vendor that the picture in question is his, or merely to an expression of the vendor's opinion.

In a case where pictures had been sold as "Views in Venice, Canaletto," and they were not by Canaletto (*o*), the question was left to the jury; but where the supposed artist was an old master, Lord Kenyon, at *Nisi Prius*, held that it was impossible to make the case one of warranty. The pictures, he said, were the work of artists of some centuries back, and, there being no way of tracing the picture itself, it could only be matter of opinion whether the picture in question was the work of the artist whose name it bore or not, the catalogue only expressed the opinion of the vendor, but left the determination to the buyer's own judgment" (*p*).

Remedy for breach of the warranty.

The remedy for breach of warranty, whether implied under the section set out above, or at common law (*q*), or imported by express agreement in any contract in regard to goods sold or agreed to be sold, is an action for damages, reduction of the agreed price, or rescission of the contract. The rules determining the nature and extent of the remedy are now contained in the Sale of Goods Act, 1893 (*r*), from which the following sections are quoted:—

"53.—(1.) Where there is a breach of warranty by the seller, or where the buyer elects, or is compelled, to treat any breach of a condition on the part of the seller as a breach of warranty, the buyer is not by reason only of such breach of warranty entitled to reject the goods; but he may—

"(a) Set up against the seller the breach of warranty in diminution or extinction of the price; or

(*o*) *Power* v. *Barham*, 7 C. & P. 356; 4 Ad. & E. 472; 5 L. J. K. B. N. S. 88 (1835); (Canaletto died in 1768). The jury found there was a warranty.

(*p*) *Jendwine* v. *Slade*, 2 Esp. N. P. C. 572 (1797), (Teniers and Claude Lorraine, who died in 1694 and in 1682 respectively).

(*q*) See Benjamin on Sale, Book IV., Part II., Chap. I.

(*r*) 56 & 57 Vict. c. 71.

"(b.) Maintain an action against the seller for damages for the breach of warranty.

"(2.) The measure of damages for breach of warranty is the estimated loss directly and naturally resulting, in the ordinary course of events, from the breach of warranty.

"(3.) In the case of a breach of warranty of quality such loss is *primâ facie* the difference between the value of the goods at the time of delivery to the buyer and the value they would have had if they had answered to the warranty.

"(4.) The fact that the buyer has set up the breach of warranty in diminution or extinction of the price, does not prevent him from maintaining an action for the same breach of warranty if he has sustained further damage.

"(5.) Nothing in this section shall prejudice or affect the buyer's right of rejection in Scotland as declared by this Act."

54. "Nothing in this Act shall affect the right of the buyer or seller to recover interest or any special damages in any case where by law interest or special damages may be recoverable, or to recover money paid where the consideration has failed."

The right to rescind the contract and return the goods is dealt with by an earlier section of the same Act.

Rescission of the contract for breach of warranty.

"11.—(1) In England or Ireland—

When condition is to be treated as warranty.

"(a.) Where a contract of sale is subject to any condition to be fulfilled by the seller, the buyer may waive the condition, or may elect to treat the breach of such condition as a breach of warranty, and not as a ground for treating the contract as repudiated.

"(b.) Whether a stipulation in a contract of sale is a condition the breach of which may give rise to a right to treat the contract as repudiated, or a warranty, the breach of which may

"give rise to a claim for damages, but not to a right to reject the goods and treat the contract as repudiated, depends in each case upon the construction of the contract. A stipulation may be a condition, though called a warranty in the contract (*s*).

"(c.) Where a contract is not severable, and the buyer has accepted the goods, or part thereof, or where the contract is for specific goods, the property in which has passed to the buyer, the breach of any condition to be fulfilled by the seller can only be treated as a breach of warranty, and not as a ground for rejecting the goods and treating the contract as repudiated (*t*), unless there be a term of the contract, express or implied, to that effect.

The Scotch rule.

"(2.) In Scotland, failure by the seller to perform any material part of a contract of sale is a breach of contract, which entitles the buyer either within a reasonable time to reject the goods and treat the contract as repudiated, or to retain the goods and treat the failure to perform such material part as a breach which may give rise to a claim for compensation or damages.

"(3.) Nothing in this section shall affect the case of any condition or warranty, fulfilment of which is excused by law by reason of impossibility or otherwise."

Damages for breach of warranty of trade-mark.

The warranty implied by the Merchandise Marks Act will accordingly operate to enable an innocent purchaser of goods which have been forfeited under that Act, or which have led to a prosecution, entailing expenses upon him, to recover damages in respect of the loss or expenses

(*s*) See *Behn* v. *Burness*, 3 B. & S. 756; 32 L. J. Q. B. 204 (1863), Blackburn on Sale, 2nd ed., p. 198.

(*t*) *Street* v. *Blay*, 2 B. & Ad. 460 (1831); *Heycorth* v. *Hutchinson*, L. R. 2 Q. B. 447 (1867); *Hooper* v. *Balfour*, 62 L. T. 646 (1890); *Re Green and Balfour*, 63 L. T. 97, 325 (1890).

from the vendor, for such damages directly and naturally result in the ordinary course of events from the breach of warranty. It will also enable the purchaser to recover from the vendor any damages which may have been recovered from the purchaser by a sub-purchaser upon a resale by him, at any rate where the goods were known by the vendor to have been bought for the purpose of resale (*u*).

Indemnity to manufacturer infringing a trade-mark at his customer's request.

A manufacturer has at common law, and apart from any question of implied warranty, a right of indemnity by his customer, if, in compliance with the customer's orders, he innocently places a mark upon goods made for him, and the mark turns out to be an infringement of some third person's trade-mark, so that the manufacturer is rendered liable to an action by the owner of the trade-mark (*x*).

(*u*) *Hammond* v. *Busvey*, 20 Q. B. D. 79 (1887), C. A. See further, as to consequential damages, *The Argentino*, L. R. 13 P. D. 191 (1888), C. A.

(*x*) *Dixon* v. *Faucus*, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137 (1861). As to the defence of the manufacturer in any such case upon proceedings under the Merchandise Marks Act, see sect. 2 (2), sect. 6, and sect. 19 (3) of that Act, and Book II., Chap. I., below.

CHAPTER XVIII.

TRADE-LIBEL AND TRADE-NAME.

	PAGE
No action for threats lies in respect of a trade-mark	.. 438
but a threat may be libel, or slander of title	.. 439
A warning against infringements may be issued in good faith	.. 439
suggestion that goods are spurious	.. 440
evidence of damage	.. 441
the threat or warning must be *bonâ fide*	.. 442
Misleading report of a trade-mark action	.. 442
True statements are not libellous	.. 443
Publication of an apology	.. 443
Statements, pending proceedings, may be contempt of Court ..	.. 443
although published in reply	.. 444
undertaking as to damages	.. 445
contempts by editors of newspapers	.. 445
Injunctions to restrain trade-libels	.. 446
interlocutory injunctions	.. 446
The right of action survives to executors	.. 447

There is no threats action in respect of a trade-mark;

UNDER sect. 32 of the Patents, &c. Act, 1883, an action for damages or an injunction lies against any person claiming to be a patentee, who by circulars, advertisements, or otherwise, threatens any other person with legal proceedings or liability, at the instance of anyone who is aggrieved by the threats (*a*). But the section does not extend to threats in respect of the use of a trade-mark or trade-name, and there is no precisely corresponding right apart from it. So that the publication in good faith of a statement that the plaintiff is infringing the defendant's trade-mark, and that the defendant intends to take proceedings against all persons dealing in the infringing

(*a*) See Edmunds on Patents, p. 348; *Challender* v. *Royle*, 36 C. D. 425; 4 R. P. C. 363 (1887), C. A.; *Johnson* v. *Edge*, (1892) 2 Ch. 1; 9 R. P. C. 142, C. A.

goods, is not actionable, and cannot be restrained by injunction (*b*).

But disparaging statements calculated to injure the plaintiff's trade or to diminish the value of his goods, if they are not made in good faith, are actionable; and the continued publication of them after they have been shown, or have been held by the Court to be untrue may be restrained (*c*). For they amount to libels on the plaintiff in the way of his trade, or to slander of title (*d*).

but the threats may amount to libel or slander of title.

A fair warning to the public, or to probable purchasers of the goods, or customers of the businesses concerned, by a trader that he regards the conduct of another as an infringement of his rights, for instance, that the latter's marks are, in his view, an infringement of his trade-marks, published in good faith, and in the belief that it is well-founded, is not libellous (*e*), although it may turn out to be mistaken (*f*). So, anyone who thinks his trade-name is likely to be confused with that of another business may

A warning against infringements, &c. may be issued in good faith.

(*b*) *Colley* v. *Hart*, 44 C. D. 170; 6 R. P. C. 17 (1888), North, J. (interim injunction refused as to the trade-mark).

(*c*) *Wren* v. *Weild*, L. R. 4 Q. B. 213 and 730 (1869); *Halsey* v. *Brotherhood*, 15 C. D. 514; 19 C. D. 386 (1880), Jessel, M.R., and C. A. (both patent cases before the Act).

(*d*) A false and malicious statement in writing, printing, or by word of mouth, injurious to any person's title to property, and causing special damage, is an actionable slander of title. Tindal, C.J., in *Malachy* v. *Soper*, 3 Bing. N. C. 371 (1836).

(*e*) *Wren* v. *Weild*, L. R. 4 Q. B. 730 (1869), a patent threats action before the Act of 1883. In *Halsey* v. *Brotherhood*, 19 C. D. p. 392 (1881), a similar action, Lindley, L.J., said: "*Wren* v. *Weild* comes to this: that if I am a patentee, so long as I act honestly, I am entitled to say, without running the risk of having an action for damages brought against me, that somebody is infringing my patent, or that somebody else's manufacture is an infringement of my patent. . . . If I say it dishonestly, I am so liable; and if I know that what I say is untrue, it would not take much to persuade a jury that I was acting dishonestly."

(*f*) In *Dicks* v. *Brooks*, 15 C. D. p. 40 (1880), Bramwell, L.J., said: "Although, according to our opinion, they would have been wrong in their law with respect to its being a piracy, I think their saying so would not have been actionable, because a man is not bound to be correct in his statement of law, though he is bound to be correct in his statement of facts."

publish a warning that there is no connection between his business and the other (*g*). And this, notwithstanding the pendency of proceedings in which the right of the proprietor of the other to use the name or marks he has adopted comes into question (*h*). But under pretence of the honest publication of a fair warning there is no excuse for an allegation that the goods of the other party are spurious (*i*), or that he is foisting a fictitious article upon the public (*g*), or is fraudulently endeavouring to pass off his goods as those of the person who issues the advertisement or circular complained of (*k*).

Suggestion that the plaintiff's goods are spurious.

Thus, in *Thorley's Cattle Food Co.* v. *Massam* (*l*), the defendants had published an advertisement warning the public that any goods purporting to be Thorley's Cattle Food, and not signed by their trade-name "Joseph Thorley," were not of their manufacture, and alleging that they were the only persons possessed of the secret recipe according to which the food was compounded, and also a circular stating that the plaintiffs were seeking to "foist upon the public an article which they pretend is the same as that manufactured by the late Joseph Thorley." The defendants were the executors of the late Joseph Thorley, the inventor of the cattle food, and they were carrying on his business; but the statement that they alone possessed the secret recipe, and the suggestion that the goods of the plaintiffs were not prepared according to it, were false, for one Josiah Thorley, a brother of Joseph Thorley, who had obtained the recipe from him, was manager of the plaintiff company (*m*). An injunction

(*g*) *Thorley's Cattle Food Co.* v. *Massam*, 14 C. D. 763 (1880), C. A.; *William Coulson and Sons* v. *James Coulson and Sons*, 3 Times L. R. 740 (1887), Div. Court. In this case the defendants added to their warning a statement that the plaintiff firm was lately bankrupt.

(*h*) *Coats* v. *Chadwick*, (1894), 1 Ch. 347, Chitty, J.; see p. 443, below; *Anderson* v. *Liebig, &c. Co.*, 45 L. T. 767 (1881), Chitty, J.

(*i*) *Thorley's Case, supra.*

(*k*) *Coats* v. *Chadwick, supra.*

(*l*) *Supra; Liebig, &c. Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.

(*m*) A suit for an injunction by the defendants to restrain the use of the name *Thorley's Cattle Food* by the plaintiffs had been aban-

was granted at the trial to restrain the defendants from advertising, or representing, or suggesting in their advertisements or circulars that they, or the proprietors of their testator's business, were alone possessed of the secret recipe, and from representing or suggesting, or doing anything calculated to represent or suggest, that the cattle food manufactured or sold by the plaintiffs was spurious or not genuine.

And in *Thomas* v. *Williams* (*n*), the publication of circulars suggesting that the goods of the plaintiff were not genuine, but were imitations of goods sold by the defendants, was restrained.

But a mere puff of the defendant's own goods, such as a statement that his patent food is "far more nutritious than any other preparation known" is not a libel of the goods of rival traders (*nn*).

Evidence of special damage is not essential,

In the cases just cited it was held that no evidence of special damage was necessary in order to obtain the injunction where, in the opinion of the Court, the libellous statement was calculated to do a serious injury to the plaintiff's business (*o*); but if this is not clear and no appreciable damage is proved to have been caused by the publication of the statement, an inquiry as to damages will be refused, and if, in addition to this,—there being no threat to continue the publication,—there is no case for an injunction, the action should, it seems, be dismissed with costs (*p*).

but proof of probable damage is.

doned, after an application in it for an interim injunction had failed; 6 C. D. 583, Malins, V.-C. The defendants subsequently succeeded in a trade-name and passing-off action against the plaintiffs, *ante*, p. 424.

(*n*) 14 C. D. 864 (1880), Fry, J.; *Liebig, &c. Co.* v. *Anderson*, note (*h*), "only genuine brand."

(*nn*) *Mellin* v. *White*, (1894) W. N. 59, Romer, J.

(*o*) So also, *per* North, J., in *Hayward & Co.* v. *Hayward & Sons*, 34 C. D. 207 (1886), cited below.

(*p*) *Dicks* v. *Brooks*, 15 C. D. 22 (1879), C. A. There the defendants, who owned the copyright in an engraving of Millais' "Huguenots," had threatened proceedings against persons who bought copies of the plaintiff's paper containing a wool-work pattern, wrongly alleged to be an infringement of the copyright. Only two or three numbers were shown to have been returned or not sold in consequence of the threats.

And in a case where the only evidence of damage to the plaintiff having been occasioned by the publication of a libellous circular misstating the result of an action for passing off the plaintiff's goods as those of the defendant, was the plaintiff's own affidavit alleging that his business had fallen off, and the plaintiff had delayed bringing his action for three months after he first knew of the publication, North, J., assessed the damages at 5*l.*, but granted an injunction, and gave the plaintiff the costs of the action (*q*).

The threat or warning must be *bonâ fide*.

It is essential, in order to entitle the plaintiff to redress in respect of the publication of a threat or warning, that he should make out that the statements complained of are not published in good faith, and upon an application for an interim injunction to restrain the publication of threats by the defendant, it is not sufficient, if it is any, proof of want of good faith, to show that he has commenced an action for infringement of trade-mark, or for passing off goods as his against the plaintiff, but has neglected to apply in it for an interlocutory injunction (*r*).

Misleading report of a trade-mark action.

The publication of a misleading report of a trade-mark action, or of an order obtained by the successful party therein either at the trial or on an interlocutory application, may be a trade-libel falling within the principles of the cases referred to in this chapter. Thus, where an action for passing off had failed and been dismissed without costs, the evidence showing only a few instances of representations that the defendant's goods were those of the plaintiff's, and that these were made by the defendant's agents without his knowledge or authority, but the defendant had offered an undertaking that he would never make such representations, and this undertaking was inserted in the order at the desire of the judge, the plaintiffs published a circular headed "Caution," which, referring to the action, alleged that:—

"By the judgment the defendant was ordered to undertake

(*q*) *Hayward & Co. v. Hayward & Sons*, 34 C. D. 198 (1886).

(*r*) *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. N. S. 757 (1881), Chitty, J.; see next note.

"not to represent that his firm is, or that the plaintiff's firm is not, the original firm of Richard Hayward & Co.," and added that the plaintiffs, "finding that serious misrepresentations were in circulation to their prejudice, felt themselves compelled to bring the above action." In a subsequent action (*s*), brought by the former defendants against the former plaintiffs, this circular was held to be untrue and libellous, and to have been published maliciously, and an injunction was granted to restrain its further publication.

True statements are not libellous.

So far as the case against an advertisement or other publication rests upon its being a libel, proof that the statements complained of in it are, in fact, true, is an answer to any action for damages, or an injunction in respect of its publication (*t*).

Accordingly, an action for publishing a statement that certain persons, meaning the plaintiff company, had wrongfully used the word *Singer* to designate machines not manufactured by the defendant company, which came on for trial after the latter company had established, in a passing off action against the former, that the use of the word by the plaintiff company was actually wrongful, was dismissed with costs (*t*).

Publication of an apology.

So the publication of an apology actually made by the plaintiffs to the defendants is justifiable, though it may have been extracted from the plaintiffs under duress of civil or criminal proceedings in respect of the false marking of their goods (*u*).

But a statement pending proceedings, whether true or not, may be a contempt of Court.

But the publication of a statement which turns out to be true may be improper pending legal proceedings in which the matters it refers to are in issue, not as being libellous, but as contempt of Court, if it tends to interfere with the fair trial of the action, or to embarrass one of the parties in the preparation or conduct of his case. And such con-

(*s*) *Hayward & Co.* v. *Hayward & Sons*, 34 C. D. 198 (1886), North, J.; *Liebig's &c. Co.* v. *Anderson*, 55 L. T. 206 (1887), Chitty, J.

(*t*) *Nähmaschinen Fabrik, &c.* v. *Singer Manufacturing Co.*, 13 R. P. C. 310 (1893), Romer, J.

(*u*) *Fisher* v. *Apollinaris Co.*, L. R. 10 Ch. 297 (1875), L.JJ.

tempt may be punished by imprisonment (*x*), fine, or sequestration of goods, or the publication may be restrained by injunction, upon a summary application by motion in the action (*y*). The reluctance of the Court to interfere by interlocutory injunction to restrain the further publication of an alleged libel which the defendant justifies, does not extend to such cases as these. As already stated, the parties are at liberty to warn the trade as much as they like, notwithstanding the pendency of the action; but they are bound to refrain during its pendency from public discussion on the merits or demerits of the case (*z*). "You can warn as much as you like," Kay, J., said, in *Goulard* v. *Lindsay* (*y*), "but can you advertise: 'I have brought an action against A. B. which is certain to succeed'?" And the learned judge added that to advertise a positive statement that the defendants had infringed the plaintiff's patent was wrong.

Statement in reply to one published by the other side.

It is no answer to an application for an injunction in respect of a publication alleged to be a contempt of Court, to say that it was made in reply to a statement published by the applicant himself with reference to the same matter, although this circumstance may influence the Court in dealing with the costs of the application (*a*).

But every publication bearing upon the matters in question *pendente lite* is not a contempt. A fair and accurate report of interlocutory proceedings, for instance, is allowable (*b*). And the Court may refuse to restrain a

(*x*) *Roach* v. *Hall*, 2 Atk. 469 (1742), Hardwicke, L.C. The respondents were imprisoned for publishing statements calling some of the witnesses "affidavit men." *Kitcat* v. *Sharp*, 31 W. R. 227 (1883), Fry, J., (defendant restrained from publishing the statement of claim and correspondence).

(*y*) *Coate* v. *Chadwick*, (1894) 1 Ch. 347, Chitty, J. The plaintiffs, in an action for passing off, were restrained from publishing a circular charging the defendants with fraudulent imitation of their goods. *Goulard* v. *Lindsay*, 4 R. P. C. 189 (1887), Kay, J., (a patent case).

(*z*) *Per* Chitty, J. (1894), 1 Ch. 350.

(*a*) *Coleman* v. *West Hartlepool Ry. Co.*, 8 W. R. 734 (1860), Wood, V.-C.

(*b*) A newspaper report published contemporaneously, if otherwise libellous, would be privileged under the Law of Libel Amendment Act, 1888.

report which it thinks unfair or discreditable to the persons responsible for it, if not convinced that the report is calculated to obstruct the course of justice, or to prejudice the public mind (*c*).

Undertaking as to damages.

Where the publication of a statement *pendente lite* is restrained as being a contempt of Court, the applicant is not required to give an undertaking to be answerable in damages to the respondent for any loss occasioned by the injunction if it turns out that the respondent was in the right (*d*), as is usual upon the grant of an interlocutory injunction, for the publication is wrong in any event, whether the statements are found in the end to be false or to be well-founded.

Contempts by newspaper editors.

The rule under which the publication of biassed comments reflecting on matters in issue in pending litigation, and calculated to interfere with the fair trial of the action, is restrained, is of general application, and it is not confined to publications made by, or at the instance of, interested parties. Applications under it to commit the editors of newspapers have, of late years, become very frequent, and, in spite of the constantly expressed reluctance of the judges to interfere where it is not necessary to protect the fair prosecution of the action (*e*), the applications generally result in the costs incurred, or part of them (*f*), and some-

(*c*) *Brook* v. *Evans*, 29 L. J. Ch. 616 (1860), Stuart, V.-C. and L.JJ. The plaintiffs advertised that they had established that they first used the word *Glacé*, but that the defendants relied on the lapse of time as an answer to the motion, although the plaintiffs had constantly protested against the defendants' use of the word. The defendants, in fact, had not been called upon on the motion.

(*d*) *Fenner* v. *Wilson*, (1893) 2 Ch. 656, Kekewich, J.

(*e*) *In re Clements*, 46 L. J. Ch. 383 (1877), Jessel, M.R., said: "I say that a judge should be most careful to see that the cause cannot be fairly prosecuted to a hearing unless this extreme mode of dealing with persons brought before him on accusations of contempt should be adopted." In *The Plating Co.* v. *Farquharson*, 17 C. D. 49 (1881), the C. A. dismissed an application to commit the editor of a paper in respect of an advertisement asking for subscriptions and evidence to assist the appeal in a patent case.

(*f*) See *Duncan* v. *Sparling*, The Times, 9th March, 1894.

times a substantial fine (*g*), being thrown upon the respondents if they have ventured at all beyond a mere accurate report, or a colourless account of the proceeding.

Injunction to restrain trade-libels.

Before the Judicature Act the Courts had no jurisdiction to restrain the publication of a libel, even though it affected the plaintiff's trade or property (*h*); but the jurisdiction is conferred by that Act upon all the divisions of the High Court, and it has been exercised in many cases (*i*).

Interlocutory injunction.

The Court has also jurisdiction to interfere by interlocutory injunction to restrain the further publication of an alleged trade libel, which is the subject of an action, until the hearing. But it will only do so if it is satisfied, upon the facts and evidence before it, that the statements complained of are false (*k*), however much the balance of convenience may be in favour of staying the publication (*kk*), and only in the clearest cases (*l*)—where, as it has been put, the plaintiff's case is so strong that if the jury at the trial found for the defendant, their verdict would be set aside as unreasonable (*m*).

For the question, libel or no libel, is peculiarly a question for a jury; and in order to interfere before the hearing the Court must determine that question in advance, without the jury's assistance (*m*). The reluctance to interfere by

(*g*) *Re The Crown Bank*, 44 C. D. 649 (1890), (a bad case of contempt).

(*h*) *Prudential Assurance Association* v. *Knott*, L. R. 10 Ch. 142 (1875), Cairns, L.C. and L.JJ.

(*i*) *Thorley's Cattle Food Co.* v. *Massam*, 6 C. D. 582 (1877), Malins, V.-C.; 14 C. D. 763 (1880), Malins, V.-C., and C. A.; *Thomas* v. *Williams*, 14 C. D. 864 (1880), Fry, J.; *Saxby* v. *Easterbrook*, 3 C. P. D. 339 (1878), Div. Court, and the cases cited below.

(*k*) *Collard* v. *Marshall*, (1892) 1 Ch. 571, Chitty, J. The libel was that the plaintiffs were "sweaters," and that their work was not properly executed. The defendants said the statements were, in substance, true, but did not suggest that they had any further evidence not before the Court. They were willing to treat the motion as the trial. An interim injunction was granted. *Punch* v. *Boyd*, 16 L. R. Ir. 476 (1885).

(*kk*) *Société des Manufactures des Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 C. D. 1 (1883), C. A.

(*l*) *Monson* v. *Tussaud*, (1894) 1 Q. B. D. 671, C. A., *per* Davey, L.J., (case of a personal libel).

(*m*) *Per* Lord Esher, M.R., in *Coulson* v. *Coulson*, 3 Times L. R. 846, adopted in *Bonnard* v. *Perryman*, (1891) 2 Ch. 269, C. A.

interlocutory injunction is so strong, that the cases cited of *Bonnard* v. *Perryman* (*mm*), and *Monson* v. *Tussaud* (*n*), seem to show that, where the defendant alleges justification, and reserves the particulars of his case, and the evidence in support of it, the injunction ought never to be granted. In any case, the probability of very serious injury to the plaintiff if the libellous statements are allowed to continue must be made out (*o*).

Action survives to executors.

An action in respect of a trade-mark for slander of title, unlike a mere personal libel, survives to the executors since it occasions an injury to the estate of the testator (*p*).

(*mm*) See note (*n*) *ante*, p. 446.

(*n*) Note (*l*). These were not, however, trade libels, but the rule was applied in *Champion & Co.* v. *The Birmingham Vinegar Brewery Co.*, 10 Times L. R. 163 (1893), Div. Court, (which was a trade case).

(*o*) *Salomons* v. *Knight*, (1891) 2 Ch. 294, North, J., and C. A.; *Mogul Steamship Co.* v. *McGregor*, *Gow & Co.*, 15 Q. B. D. 476 (1885), Coleridge, L.C.J., and Fry, L.J.

(*p*) *Hatchard* v. *Mège*, 18 Q. B. D. 771 (1887), Div. Ct.

CHAPTER XIX.

TRADE-SECRET AND TRADE-NAME.

PAGE

Use of the trade-name of a secret preparation 448
The use of the name or secret may be a breach of contract or of confidence 449
Summary of the leading cases of trade-secret 450
Prince Albert v. *Strange*; *Morison* v. *Moat* 450
other examples 451
The jurisdiction rests on implied contract 452
Reuter's Telegram Co. v. *Byron* 452
No injunction where no threat to use the information 453

Use of the trade-name of a secret preparation.

It has been shown that anyone is entitled to use a name or mark for the goods to which that name or mark is properly applied (*a*). Thus, anyone who is in possession of goods made or sold by the owner of a trade-mark or trade-name, may apply the trade-name or trade-mark to them (*b*), and may, for instance, replace the old labels upon the goods by new ones (*c*). So, the name of a secret preparation may be used by anyone for goods actually prepared according to the recipe (*d*), for they are the goods indicated by the name, whether prepared by the original inventor of the recipe, or his successors in business, or not. Until

(*a*) See Chap. II., p. 32, and Chap. XV., p. 309.

(*b*) *Condy* v. *Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*c*) *Farina* v. *Silverlock*, 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1856), Cranworth, L.C., cited, p. 32.

(*d*) *Canham* v. *Jones*, 2 V. & B. 218 (1813), Plumer, V.-C., (*Velno's Vegetable Syrup*); *James* v. *James*, L. R. 13 Eq. 421 (1872), Romilly, M.R., (*Lieutenant James' Horse Blister*); *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766 (1877), Bacon, V.-C., and C. A., (*Condy's Fluid*); and see the injunction in *Siegert* v. *Findlater*, 7 C. D. 801 (1878), Fry, J., cited p. 309, (*Angostura Bitters*). In *Benbow* v. *Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C., held that an outgoing partner who retained the receipt could use the name of a secret preparation.

the secret is discovered or betrayed the goods of the original inventor or his successors can be the only goods to which the name is applicable, or which are denoted by it; but when other people can make them, the difficult question of fact, discussed in a previous chapter of this book (*e*), arises, whether the name is merely that of the goods themselves, or that of goods of the kind prepared or sold by the original inventor or his successors in business. This was well put by Fry, J., in the *Angostura Bitters Case* (*f*). "I cannot say," the learned judge said, "that Meinhard (*g*) may not, if he can, make a bitter identical with the plaintiffs', and, if he does, I cannot prevent him from selling it as *Angostura Bitters*. It is to be observed that the person who produces a new article, and is the sole maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from. No distinction can arise from using the name of the class, so long as the class consists of only one species, for then the name of the species and the name of the class will be the same."

The use of the name or secret may be a breach of contract or of confidence.

But, as regards any particular person or persons, the use of a mark or name which is open to the world at large may be restrained by reason of a contract he has entered into, or of circumstances which make it contrary to conscience for him or them to avail themselves of their general right. Putting aside cases of express contract,—as where, for instance, a partner or servant has covenanted not to use the firm name, or any particular name or marks, or not to engage in any particular business, after the determination of the partnership or employment,—the most important cases of this kind are cases of trade secrets. The law relating to trade secrets does not properly fall within the scope of this book, but as it touches upon the

(*e*) Above, pp. 36 *et seq.*

(*f*) *Siegert* v. *Findlater*, 7 C. D. p. 813.

(*g*) The maker of the defendant's bitters.

limitation of trade-mark and trade-name rights referred to above, it is convenient to shortly refer to the leading cases on the subject.

Information obtained by breach of contract or of confidence.

Wherever a secret information has been obtained under circumstances which import a contract not to disclose or make use of it, or by breach of confidence, or under other circumstances which make the disclosure, or the use of the information, contrary to conscience, the Court will restrain the person who has obtained it, or anyone to whom it has been communicated by him, from using or disclosing it.

Thus, in *Prince Albert* v. *Strange* (*h*), the publication of a catalogue of a number of etchings made by the Queen and Prince Albert for their private use and amusement, and never published or authorized to be published by them, and the exhibition of the etchings, was restrained, the copies of the etchings which had passed into the defendant's possession having been obtained surreptitiously and in breach of confidence from or through a printer employed to print them. And in *Morison* v. *Moat* (*i*) the defendant, who had obtained the secret of manufacturing *Morison's Universal Medicine* from his father, was restrained from using it. Both the defendant and his father had formerly been in partnership with the plaintiff, but the father of the plaintiff, to whom alone the original inventor had disclosed the secret, had entered into a covenant not to divulge it to any other person. The injunction restrained the defendant, his agents, &c., from selling, under the title of *Morison's Universal Medicine*, any medicine made by him or under his directions, and also

(*h*) 2 De G. & Sm. 652; 1 Mac. & G. 25; 18 L. J. Ch. 120 (1849), Knight-Bruce, V.-C., and Cottenham, L.-C.

(*i*) 9 Hare, 241; 20 L. J. Ch. 513; 21 ibid. 248 (1851), Turner, V.-C., and Knight-Bruce, and Lord Cranworth, L.JJ., App., p. 648. The case of *Canham* v. *Jones*, 2 Ves. & B. 219, was distinguished by Turner, V.-C., on the ground that it was not put forward as one of breach of confidence or contract; but the report shows that the bill stated the employment of the defendant, and that the plaintiff's counsel, on the demurrer, to some extent rested their case on breach of confidence. The case would now be differently decided on the alleged facts.

from making any medicines according to the secret, or in any manner using the secret of compounding the medicines, or any part thereof.

Injunctions have been granted on the same principles to restrain the use or publication of secret information obtained by a clerk or servant in the course of his employment (*k*), and it is said that "every clerk employed in a merchant's counting-house is under an implied contract that he will not make public that which he learns in the execution of his duty as a clerk" (*l*); of a table of details of the dimensions of machinery designed by, or for the plaintiffs, collected from their plans by one of their draftsmen, although the details could all have been gathered from the machines made according to the designs and sold, if access could have been obtained to them (*m*); of materials for the construction of a book of advertisements collected by the plaintiff's advertising canvassers (*n*); of lectures delivered to a class of students, and not published or authorized to be published by the lecturer (*o*); of private letters written by the plaintiff, or by a person whose estate the plaintiff represents (*p*); of copies of the plaintiffs' pictures, delivered to the defendants for the making of copies, in excess of the number made for and delivered to the plaintiffs (*q*); and of prints from a photographic negative likeness of the plaintiff, which the defendants had been employed by the plaintiff to take (*r*).

Information obtained by a clerk;

table of dimensions by engineer's draftsman;

book of advertisements by canvasser;

lectures;

private letters;

copies of pictures by lithographer;

photographs of the plaintiff.

(*k*) *Yovatt* v. *Winyard*, 1 Jac. & W. 394 (1820), Eldon, L.C.

(*l*) *Per* Wigram, V.-C., in *Tipping* v. *Clarke*, 2 Hare, 383 (1842); and *per* North, J., in *Pollard* v. *Photographic Co.*, 40 C.D. 345 (1888).

(*m*) *Merryweather* v. *Moore*, (1892) 2 Ch. 518, Kekewich, J. The defendant had been apprenticed to the plaintiffs, and had remained in their employment after his articles expired; cf. *Reuter's Telegram Co.* v. *Byron*, cited below, p. 452.

(*n*) *Lamb* v. *Evans*, (1892) 3 Ch. 462; (1893) 1 Ch. 218, Chitty, J., and C. A.

(*o*) *Abernethy* v. *Hutchinson*, 3 L. J. Ch. O. S. 214 (1824), Eldon, L.C.; *Caird* v. *Sime*, 12 App. Cas. 326 (1887).

(*p*) *Perceval* v. *Phipps*, 2 Ves. & B. 19 (1813), Plumer, V.-C.; *Earl of Lytton* v. *Devey*, 54 L. J. Ch. 293 (1884), Bacon, V.-C.

(*q*) *Tuck and Sons* v. *Priester*, 19 Q. B. D. 629 (1887), C. A.

(*r*) *Pollard* v. *Photographic Co.* note (*l*).

The jurisdiction rests on implied contract.

"Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the Court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of performing a promise, on the faith of which the benefit has been conferred" (*s*). But it is submitted that the true ground is always implied contract (*t*), for if information, which both parties understand the present possessor intends to be kept, and to remain secret, is communicated by him to another, or the means of obtaining it are placed by him within the reach of another, for particular purposes, for instance, in the course of an employment, an undertaking not to use or disclose the information ought almost necessarily to be inferred.

Use of agent's information where no breach of contract or confidence.

The mere fact that the defendant obtained the information in question as, and while he was the agent of the plaintiff, is not a sufficient ground for restraining him from using it, provided there is nothing of a secret character in the information itself, or confidential or surreptitious in the manner in which it was communicated or obtained, so that a contract not to communicate or use it can be implied. *Reuter's Co. v. Byron.* "The plaintiffs here do not seek to restrain the defendant from publishing anything," Jessel, M.R., said, in *Reuter's Telegram Co.* v. *Byron* (*t*), "but from making use of knowledge acquired while the relation of principal and agent subsisted, after that relation had terminated. Now I am not aware of any authority in which this has been done in the absence of a contract, expressed or implied." But he added, "that being so, the jurisdiction of the Court cannot be stretched on an

(*s*) *Per* Turner, V.-C., in *Morison* v. *Moat*, 20 L. J. Ch. p. 522. So, *per* Kekewich, J., in *Merryweather* v. *Moore*, (1892) 2 Ch. p. 522.

(*t*) *Merryweather* v. *Moore*, *supra*; *Reuter's Telegram Co.* v. *Byron*, 43 L. J. Ch. 661 (1874), Jessel, M.R.

"interlocutory application. I do not mean to say it cannot be done at all." The circumstances of the case just cited were, that the plaintiffs had invented a large number of telegraphic cyphers indicating the names of their customers, which were communicated to the defendant while he was the plaintiffs' agent, and after he had left their employment, and started a rival business, he sent circulars to the customers, stating that he had their cyphers, and soliciting their custom. It was said that the defendant had committed no breach of confidence with regard to the cyphers, because these were known to the customers, and could have been obtained by the defendant from such of them as chose to do business through him. It may be doubted whether the importance of having access to the large number of cyphers invented or collected by the plaintiffs was fully appreciated in this case, and whether the decision is consistent with the reasoning accepted in the later cases of *Lamb* v. *Evans*, and *Merryweather* v. *Moore*, cited above (*u*). It was, however, as appears from the judgment of the learned Master of the Rolls, a decision on an interlocutory application only. The principle stated in the judgment, and quoted above, is undoubtedly sound, whatever may be thought of its application to the facts of the case.

No injunction unless there is danger of the secret being communicated.

Following the ordinary rule in regard to injunctions, no injunction to restrain the communication of a secret will be granted unless by reason of a threat or otherwise, the Court is satisfied that there is a danger of the communication being made (*x*).

(*u*) Page 451.

(*x*) *Morison* v. *Moat*, 20 L. J. Ch. p. 529.

CHAPTER XX.

REGISTRATION OF FOREIGN AND COLONIAL TRADE-MARKS.

Before the introduction of a register of trade-marks a foreigner, not being an alien enemy, was allowed to sue for the infringement of his trade-mark in the English Courts (*a*), provided the trade-mark had become his trade-mark in England by user, or to prevent or obtain damages for the passing off the goods of others as his goods, in the same way and on the same terms as an English subject. And many treaties existed by which this country agreed to give to the subjects of other countries the same right of protection, in respect of their trade-marks, as it gave to its own subjects (*b*). The prohibition contained in sect. 77 of the present Act, and the corresponding section of the Act of 1875, restraining actions in respect of the infringement of unregistered trade-marks (*c*), however, apply to the trade-marks of foreigners (*d*), and therefore actions for infringement could not, since 1875 (in general (*c*)), be brought by a foreigner without his trade-mark being registered in England; actions for passing off, to which the prohibitory sections of the former or the present Acts do not apply, remaining as before.

A foreigner, or any resident in a British possession, may apply for and obtain registration under sect. 62; but if he does not apply under the convention mentioned below,

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

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

(*c*) For the precise effect of the section, see its terms, and Chap. XII., pp. 260, 268.

(*d*) *Goodfellow* v. *Prince*, 35 C. D. 9 (1887), C. A., see above, pp. 264, 270.

and is out of the United Kingdom at the time of making the application, he must give an address for service in the United Kingdom (*e*); and under sects. 103 and 104 of the Act, further provisions are made in his favour if he is a subject of a state in respect of which, or a British subject resident in a British possession to which, these sections have been, by Order in Council, declared to be applicable.

The sections referred to, so far as they relate to trade-marks (*f*), provide that—

International arrangements for protection of inventions, designs, and trade-marks.

"**103.** (1.) If her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of trade-marks, then any person who has applied for protection for any trade-mark in any such state, shall be entitled to registration of his trade-mark under this Act, in priority to other applicants; and such registration shall have the same date as the date of *the protection obtained* [the application (*g*)] in such foreign state.

"Provided that his application is made, in the case of a trade-mark, within four months from his applying for protection in the foreign state with which the arrangement is in force.

"Provided that nothing in this section contained shall entitle the proprietor of the trade-mark to recover damages for infringements happening prior to the date of the actual registration of his trade-mark in this country (*h*).

"(2.) The use in the United Kingdom, or the Isle

(*e*) Act of 1888, s. 8 (62 (6)), *ante*, p. 60.

(*f*) The words referring only to patents or designs are here omitted; the full text is printed in the Appendix, p. 572.

(*g*) Act of 1888, s. 6.

(*h*) The ordinary rule is, that where trade-mark rights exist, damages for infringements before the registration may be recovered; *Barlow* v. *Johnson*, 7 R. P. C., p. 411 (1890), Chitty, J., *ante*, p. 265. Cf. with this sub-section the International Copyright Act. See *Moul* v. *Groenings*, (1891) 2 Q. B. 443; and *Schauer* v. *Field*, (1893) 1 Ch. 35.

"of Man, during such period of the trade-mark, shall not invalidate the registration of the trade-mark.

"(3.) The application for the registration of a trade-mark under this section must be made in the same manner as an ordinary application under this Act (*i*). Provided that, in the case of trade-marks, any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act (*ii*).

"(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 (*k*).

Provision for colonies and India.

"**104.** (1.) Where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of (inventions, designs, and) trade-marks, (patented or) (*kk*) registered in this country, it shall be lawful for her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit to such British possession.

"(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act" (*k*).

At the time when these sections were passed into law the international convention for the protection of industrial property, as it was originally settled at Paris, had been

(*i*) Sect. 62, Chap. IV., p. 68.

(*ii*) See p. 459.

(*k*) For list of States and Possessions to which the sections apply, see Appendix, p. 656.

(*kk*) The brackets are not part of the Act; see note (*f*) above.

drawn up and agreed to by several of the countries which are parties to it, and in the following year (*l*) this country acceded to the convention. Amendments of the convention were agreed to at the subsequent Conference at Madrid, in 1891, and practically all civilized states, except Germany, Austria and Russia, and Norway and Denmark, have now acceded to the original convention. The text of the convention, and a list of the countries and British possessions to which the above sections have been made applicable by Orders in Council, are set out in the Appendix (*m*).

The international convention.

The convention and the accession thereto of this country may be referred to by the Court as a matter of history, in order to enable it to understand under what circumstances the sections were passed (*n*); but the terms of the convention cannot be employed as a guide to interpret the sections (*o*), for a treaty with a foreign state binds the subjects of the Crown only in so far as it has been embodied in legislation passed into law in the ordinary way (*p*).

The provisions of the sections, in fact, do not carry out the international agreements constituted by the convention, for by Art. VI. of the Convention, it is agreed that "every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the forms originally registered in all other countries of the Union"(*q*); and by clause 4 of the final protocol, it is explained that this article "is to be understood as meaning that no trade-mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the

Foreign trade-mark may be refused registration.

(*l*) 20th March, 1883.

(*m*) Pages 656, 658.

(*n*) *Carter Medicine Co.'s Tms.*, (1892), 3 Ch. 472; 9 R. P. C. 401, North, J.

(*o*) *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

(*p*) See last case, and *Walker* v. *Baird*, (1892) A. C. 491.

(*q*) *i. e.*, the union of the contracting states for the protection of industrial property.

"legislation of the State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin"; but it has, nevertheless, been decided that, in order to be qualified for registration, a mark tendered under these sections, just as any other mark which is sought to be registered, must fall within the descriptions of sect. 64. So that the words *Syrup of Figs* (*r*), and the words *Carter's Little Liver Pills* (*s*), were refused registration as trade-marks, although registration of them respectively had been duly applied for and actually obtained in the United States, one of the states to which sect. 103 has been applied.

The effect of the decisions just referred to is to reduce the operation of the convention, in regard to trade-marks (*t*) in this country, to very narrow limits. As between applicants for the registration of new marks, or marks acquired as trade-marks since the application for protection in a foreign state within the Union, the applicant in the foreign state is to have priority, provided that he makes his application in this country within four months from the date of the foreign application on which he relies. And this priority is not affected by the success or failure of the foreign application.

Publication of foreign trade-mark.

The proviso that use of the trade-mark in this country during the period of four months shall not invalidate the registration, is surplusage, if it is directed to use by the applicant himself, as it seems intended to be, for the publication or use of a mark by the applicant before registration in no case prejudices, although it may confer (*u*), a right to registration. The proviso might

(*r*) *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

(*s*) *Carter Medicine Co.'s Tms.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(*t*) Another part of the convention, relating to false marking and false trade description and the seizure on importation of falsely marked goods, has been carried into effect by the Merchandise Marks Act, see p. 526, below.

(*u*) *i. e.*, if the mark, being capable of registration, is acquired by user as a trade-mark.

have some useful meaning and operation, if it were construed to prevent an opponent, who had first used the trade-mark in question after the application in a foreign state by the applicant for registration here, relying on his use of the mark, or the title acquired by him in consequence of that use, as an objection to the registration of the applicant. But so long as the convention is not embodied in legislation, as already stated, it can have no operation upon the right to registration at all. It might, however, it is submitted, properly affect the comptroller's discretion.

The last clause of sub-sect. (3), providing that "any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act," does not give an independent or new right of registration under the Act (*x*), and it seems to bear no other construction than that suggested on behalf of the comptroller in *The Carter Medicine Co. Case* (*x*), namely, that "may be registered" is to be read as "may be the subject of application for registration," although this construction reduces it also to surplusage.

The application of the sections to any foreign state can, under no circumstances, afford any answer to a motion under sect. 90 to remove from the register a mark which was originally registered without sufficient cause (*y*).

(*x*) *Californian Fig Syrup Co.'s Tm.*, and *Carter Medicine Co.'s Tms.*, *supra*.

(*y*) *Vignier's Tm.*, 3 R. P. C. 490 (1889), Kay, J., (*Monobrut Champagne*).

Book II.

THE CRIMINAL LAW OF FALSE MARKING.

CHAPTER I.

THE MERCHANDISE MARKS ACT, 1887.

(50 & 51 Vict. c. 28.)

PAGE

Section 2.—Offences against the Act 462
Offences by a corporation or partnership 463

1. Forging trade-marks 465
trade-mark 465
what constitutes forgery of a trade-mark 468
assent of the proprietor 470
mark nearly resembling a trade-mark 471
falsifying a genuine trade-mark 472

2. Falsely applying a trade-mark to goods 472
what constitutes an application to goods 474
what is a false application 474

3. Applying a false trade description to goods 475
the Act does not extend to false descriptions of quality .. 475
Trade description 476
not a verbal description 476
words forming part of the goods 478
a trade-mark may be a trade description 479
number, measure, weight 479
place or country of origin 480
material, "patent" 483
custom of the trade 485
Customs entry 486
What is a false trade description 487
false in a material respect 488
alteration of trade description 491
application of false trade description 491
false names and initials 493
blind names 497
conventional or generic description 498

4. Causing an offence to be committed 503
master and servant 500
persons employed 502
accessories 504

PAGE
Offences committed abroad 504
5. Defences under section 2 (1) 505
proof of innocence 505
intent to defraud 507
giving information as to principal offender 509
evidence of defendant 509
6. Sale or possession of falsely-marked goods 510
7. Defences under section 2 (2) 511
giving information as to principal offender 512
8. Punishment 513
forfeiture and destruction of the goods 514, 522
9. Prosecution 514
official prosecutions 515
right to be tried by indictment 516
limitation of time 517
Voxatious Indictment Act applies 517
costs 518
appeal 519
SAVING OF OTHER PROCEEDINGS 520
SEARCH WARRANT 520
MARKS ON WATCH CASES 522
10. Prohibitions on importation 526
The International Conventions 529
only marked goods are affected 530
GOODS FORFEITABLE UNDER SECTION 2 531
goods bearing English words or names 532
GOODS OF FOREIGN MANUFACTURE BEARING BRITISH OR IRISH TRADE-MARKS OR NAMES 532
Customs register of names and marks 534
"made in Germany" 534
goods in transit 535
goods bearing the name of a place in the United Kingdom 536
Customs regulations 536
proceedings against Customs officers 538

A SHORT introductory account of the Merchandise Marks Act, 1887 (*a*), and of the Act of 1862, which it repealed and replaced, will be found in Chap. I. of Book I. (p. 17), and the nature of the contents and subject-matter of the Act can be readily gathered from the table placed at the head of this chapter, and sect. 2 of the Act which is set out on the following page. The table of sections given in the

(*a*) This Act is quoted throughout this and the following chapter as "M. M. A. 1887," and the Merchandise Marks Act, 1891, as "M. M. A. 1891." The Report of the Select Committee of the House of Commons of 1862 is quoted as "M. M. A. Report, 1862," that of the Committee of 1887, as "M. M. A. Report, 1887," and that of the Committee of 1890, as "M. M. A. Report, 1890."

Queen's Printers' copy and the text of the statute itself, are printed in the Appendix (p. 666).

The most important substantive enactments of the Merchandiso Marks Act, 1887, are comprised in the sub-sects. (1) and (2) of sect. 2 of the Act, which enumerate the principal offences against which the Act was directed, the greater part of the remainder of the statute being directed to the definition and explanation of the terms employed in the sub-sections referred to, and the provision of machinery for the prosecution and punishment of the offences created by them. In addition to the provisions relating to these offences, the Act contains a very important provision (sect. 16) prohibiting the importation of deceptively or spuriously marked goods, and some special provisions as to marks on watches (sects. 7 and 8). Two subsidiary sections of the Act, namely, sect. 17, dealing with the statutory warranty implied by the sale of marked goods (*b*), and sect. 20, imposing a penalty for false representations as to royal warrants (*c*), are considered in other chaptors of this work.

Sect. 2 is divided into six sub-sections, which deal respectively with the offences against the Act, (1) and (2); penalties, (3) (*d*); destruction of forfeited articles, (4) (*e*); appeals against convictions, (5) (*f*); and prosecutions, (6) (*e*).

Sub-sects.(1) and (2) are as follows:—

Offences as to trade-marks and trade descriptions.

"2.—(1.) Every porson who—

"(a) forges any trade-mark; or

"(b) falsely applies to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive; or

"(c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark; or

"(d) applies any false trade description to goods; or

(*b*) Book I., Chap. XVII., p. 431.
(*c*) Below, p. 542.
(*d*) Page 513.
(*e*) Page 514.
(*f*) Page 519.

"(e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark; or

"(f) causes any of the things above in this section mentioned to be done,

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

"(2.) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark or false trade description is applied, or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

"(a) That having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade-mark, mark, or trade description; and

"(b) That on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or

"(c) That otherwise he had acted innocently;

be guilty of an offence against this Act."

Every person.]—Person means person or persons (*g*), and includes any body of persons corporate or unincorporate (*h*). According to the letter of the statute, therefore, a corporation or a private partnership, or trade society, could, as such, be convicted and fined for an offence under the statute. In modern cases, no difficulty has been felt in construing statutes so as to cast a duty, which is enforceable through

Offences by a corporation or a partnership.

(*g*) 52 & 53 Vict. c. 63, s. 1. (*h*) M. M. A., s. 3 (1).

the criminal law, upon corporations (*i*), notwithstanding the objections that a corporation cannot act except through its agents, who have no authority to do any criminal or other illegal act (*k*); that a principal is never criminally liable (*l*) for the acts of his agent, which he has not specially authorised, unless expressly made so by statute in any particular case (*m*); and that a specific criminal intent cannot be attributed to a corporation (*n*). It would be a serious curtailment of the usefulness of the Act if the limited liability companies, by which so much of the trade of the country is now carried on, could not be reached by the pecuniary penalties instituted by it, for proceedings against their officers for their own share in causing or participating in the offences charged might often be inadequate to stop the mischief aimed at by the Act (*o*).

If a corporation can be convicted under the Act and fined, there seems to be no principle upon which unincorporated bodies can be held to be outside its operation. And where all the members of a partnership are individually guilty of an offence there is no further difficulty in holding the partnership itself liable also, since its property, upon which the fine inflicted would be levied, is

(*i*) See *The Queen* v. *Tyler*, (1891) 2 Q. B. 588, and the cases there cited; and *per* Lord Blackburn in *Pharmaceutical Society* v. *London and Provincial Supply Association*, 5 App. Cas. p. 869.

(*k*) *Re The Royal British Bank, Ex parte Nicol*, 3 De G. & J. 387; 28 L. J. Ch. 257.

(*l*) It was held in *The Queen* v. *Stephens*, L. R. 1 Q. B. 702, that the owner of works carried on by agents for his profit, might be indicted for a nuisance committed by the agents without his knowledge and against his general directions, on the ground that the case was in substance a civil proceeding.

(*m*) *Chisholm* v. *Doulton*, 22 Q. B. D. 736; *Budd* v. *Lucas*, (1891) 1 Q. B. 408.

(*n*) On the general question of the liability of a corporation for crimes, see Brice's *Ultra Vires*, 3rd ed., Chap. XIII., and for torts, Chap. XII., and Buckley on the Companies Acts, 6th ed., pp. 104 and 494; *Barwick* v. *English Joint Stock Bank*, L. R. 2 Ex. 259; *Houldsworth* v. *City of Glasgow Bank*, 5 App. Cas. 317; and *British Mutual Banking Co.*, *Ld.* v. *Charnwood Forest Ry. Co.*, 18 Q. B. D. 714.

(*o*) See *per* Denman, C.J., in *The Queen* v. *Great North of England Ry. Co.*, 9 Queen's Bench Rep. 315; 16 L. J. M. C. 16.

the property of the several partners. A question may, however, arise,—if some partners establish on their own account one of the defences specified in the Act, for instance, show that they acted without intent to defraud, under sect. 2 (1), or that they complied with the provisions of sect. 2 (2), (a) and (b), while others fail to do so,—whether the partnership, and through it the innocent partners, according to their interest in its property, are liable to be fined for the offences charged, because the proceedings have been taken against the firm. The case is precisely similar to that of an offending corporation having some innocent corporators; and, it is submitted, the question must be answered in the affirmative.

Liability of servants and workmen.

As regards persons employed on behalf of others, see sect. 6 (*p*). That section does not apply to offences under the clauses in sect. 2 (1) (a), and sect. 2 (1) (e), although it is difficult to see why it should not. And as regards the acts of a servant, done in obedience to the instructions of his master, see sect. 19 (3) (*q*).

Sect. 2 (1) deals with three groups of offences: forging trade-marks, (a), (c), and (e); falsely applying trade-marks to goods, (b); and applying false trade descriptions, (d); the general clause (f) adding: causing any of the other offences to be committed.

1. Forging Trade-Marks.

Sect. 2 (1).

"(a) Forges any trade-mark;

"(c) Makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark;

"(e) Disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark."

What is a trade-mark.

Trade-mark.]—For the purposes of the Act—

"The expression 'trade-mark' means a trade-mark

(*p*) "Persons employed," p. 501. (*q*) Page 500.

"registered in the register of trade-marks kept under the Patents, Designs, and Trade-Marks Act, 1883, and includes any trade-mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of the 103rd section (*r*) of the Patents, Designs, and Trade-Marks Act, 1883, are, under Order in Council, for the time being applicable" (*rr*).

Registered trade-mark.

The register is kept under sect. 78 of the Patents, &c. Act, and the questions: What may be Registered (*s*)? and, What is the Effect of Registration (*t*)? have already been discussed at length. Any entry made on the register without sufficient cause may be expunged or varied by the Court, upon application, under sect. 90 of the Patents, &c. Act (*u*).

Proof of registration is effected by a copy of, or extract from, the register, purporting to be certified by the comptroller, and sealed with the seal of the patent office (*x*), or by a certificate purporting to be under the hand of the comptroller (*y*).

Where the trade-mark is improperly registered.

The question may arise whether registered, in the above definition, means only "actually registered," or means "properly registered." It is submitted that registered in fact is the true construction, for any other would, to a great extent, defeat the operation of the Act. It cannot have been intended that, in the summary proceedings before two justices contemplated by the Act, inquiries should be entered upon, such as those undertaken on applications under sect. 90, to remove trade-marks from the register, for instance, inquiries whether a registered trade-mark was a common mark or a descriptive mark, or whether, if registered as an old mark, it was, in fact, used as registered before the 13th of August, 1875 (*z*). A

(*r*) See Book I., Chap. XX., p. 454.

(*rr*) Sect. 3 (1).

(*s*) Sects. 62 and 64, Book I., Chap. VIII., p. 106.

(*t*) Sects. 75 and 76, Chap. XII., p. 252.

(*u*) Chap. XI., p. 218.

(*x*) Act of 1883, s. 89.

(*y*) Ibid., s. 96.

(*z*) See Book I., Chap. XI., p. 218, "Rectification of the Register."

similar question arises with regard to "the proprietor" of a registered trade-mark (*a*). By sect. 76 of the Act of 1883, the registration of a person as the proprietor of a trade-mark is *primâ facie* evidence of his right to the exclusive use of the trade-mark, and is, after the expiration of five years from the date of registration, conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of the Act. And, in civil proceedings, it has been held, under this provision, that registration after five years is conclusive, both as to the title of the proprietor and as to the propriety of the registration itself, in the absence of an application to rectify, under sect. 90 (*b*). No doubt, if a plausible claim for rectification were seriously put forward in criminal proceedings based upon a registered trade-mark, an adjournment, to enable an application to the High Court to be made under sect. 90, would be granted pending the result of such application. And the existence of such a claim might of itself, in many cases, be sufficient to negative the intent to defraud, which is an element of each of the offences under the M. M. A., sect. 2 (1), or to show that the person charged had acted innocently, within the meaning of the M. M. A., sect. 2 (2).

The M. M. A., 1862.

The Act of 1862 applied only to trade-marks as defined by the Act (*c*). No register of trade-marks existed when the Act was passed.

Unregistered trade-marks.

Unregistered trade-marks within the United Kingdom are not protected by the Act as trade-marks, but they are in many cases protected by the provisions relating to the application of a false trade description under the extension of that term contained in sect. 3 (2) and (3) (*d*). The number of such trade-marks in use is enormous, exceeding, it is said, the number of registered trade-marks (*e*); and, as

(*a*) *Infra*, p. 269.

(*b*) *Apollinaris Co.* v. *Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Pinto* v. *Badman*, 8 R. P. C. 181 (1891), C. A., above, p. 257 *et seq.*

(*c*) 25 & 26 Vict. c. 88, s. 2, set out *ante*, p. 26.

(*d*) See below, pp. 491—495.

(*e*) M. M. A. Report, 1887, evidence of Mr. Courtenay Boyle,

has been shown in the earlier part of this book, infringements of them, in general, can be restrained in actions for "passing off" (*f*), even where, under sect. 77 (*g*) of the Act of 1883, they do not form the subject of an action for infringement, properly so called.

Trade-marks in British possessions.

"British possession," in the definition of a trade-mark, means any part of her Majesty's dominions, exclusive of the United Kingdom, and where parts of such dominions are under both a central and a local legislature, all parts under the central legislature are, for the purposes of this definition, to be deemed one British possession (*h*).

By sect. 9—

Trade-mark, how described in pleading.

"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."

Forges.]—By sect. 4—

What is forging a trade-mark.

"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[1]] (*i*) 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" (*k*).

Qq. 400, 420. The bulk of the cotton marks are unregistered; evidence of Mr. Wright, Q. 3981.

(*f*) Book I., Chap. XVI., p. 379.

(*g*) *Ibid.* Chap. XII., p. 265.

(*h*) Interpretation Act, 1889, sect. 18 (2).

(*i*) [a[1]] is not in the Act.

(*k*) Below, p. 505. Cf. sect. 5 (3), p. 474.

So that the phrase covers the three distinct offences, (a), [a[1]], and (b).

At common law the offence of forgery is the making or alteration of a writing or document to the prejudice of another person's right with intent to defraud (*l*), and a trade-mark is not a writing or document within the definition (*m*). But the sale of goods under a spurious mark, which the vendor knew to be spurious, has been held in many cases to constitute obtaining money by false pretences (*n*). Forgery of a trade-mark at common law.

In *R.* v. *Smith* (*m*), where the prisoner was charged with having forged imitations of Borwick's baking powder labels, Pollock, C.B., said: "The issuing of this wrapper without the stuff within it would be no offence. In the printing of these wrappers there is no forgery; the real offence is the issuing them with fraudulent matter in them" (*o*). The offence under the M. M. A. is, however, complete, whether the forged trade-marks be applied to goods or not, unless intent to defraud is disproved. The application of a trade-mark, whether forged or genuine, to goods other than the goods of the proprietor of the trade-mark, is an offence under sects. 2 (1) (b), 2 (1) (d), and 3 (2).

(a) *The proprietor*]—is the registered proprietor (*p*), or his assignee, who is possessed of the goodwill of the business for which the trade-mark in question was acquired and used (*q*). It has been held, in civil cases, that the assignee of a registered trade-mark need not register the assignment before commencing proceedings to restrain, or obtain damages in respect of, an infringement (*r*), and the The proprietor.

(*l*) Not necessarily to defraud a particular person. 24 & 25 Vict. c. 98, s. 44; Archbold, 21st ed. p. 648.

(*m*) *R.* v. *Smith*, 8 Cox, 32; 27 L. J. M. C. 225 (1858), C. C. R.; Seb. Dig. p. 89.

(*n*) *R.* v. *Dundas*, 6 Cox, 380; *R.* v. *Ardley*, L. R. 1 C. C. R. 301; Seb. Dig. "False Pretences."

(*o*) Cf. the civil case of *Farina* v. *Silverlock*, above, p. 32.

(*p*) Act of 1883, sect. 78. Cf. *ante*, p. 60.

(*q*) *Ibid.* sect. 70, Book I., Chap. XIII., p. 272, Assignment and Devolution of Trade-marks.

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

rule will, no doubt, apply also in proceedings under the M. M. A. The question, whether a defendant charged under the Act can go behind the register and deny the title of the registered proprietor, has already been referred to (*s*).

"Proprietor" includes any body of persons, corporate or unincorporate (*t*).

Assent of the proprietor.

Without the assent of the proprietor, &c.]—The owner of goods of the kind which a trade-mark is properly used to indicate, that is to say, goods of the manufacture or selection, &c. (*u*) of the proprietor of the trade-mark, and of the class for which the trade-mark is used, is entitled to apply the trade-mark to them. He may, for instance, lawfully replace soiled labels (*x*), or refill, with the proprietor's goods, stamped bottles or cases, and he may label goods purchased in bulk, and broken up into smaller quantities, with the vendor's mark (*y*). Where such goods have been purchased of the proprietor, it is submitted, he would be estopped from denying his assent to the use of the trade-mark. In any case, such use would not be use with intent to defraud. And if it were shown that the marks made by the person charged were made solely for such use, he would not, it is submitted, be guilty of any offence under the Act. In *Farina* v. *Silverlock* (*x*), Lord Cranworth held, that the defendant, a printer, who copied the Farina Eau de Cologne labels, was not guilty of infringement if he established his allegation that he printed the copies only to replace worn-out labels properly used in connection with the plaintiff's scent, but this he, in fact, failed to do (*a*).

(*s*) *Ante*, p. 466.

(*t*) Sect. 3 (1).

(*u*) Book I., Chap. II., p. 49; Chap. XIX., p. 448.

(*x*) *Farina* v. *Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855), Wood, V.-C., and Cranworth, C.

(*y*) *Condy* v. *Taylor*, 56 L. T. 801 (1887), Kekewich, J., and *ante*, pp. 309, 310.

(*a*) 30 L. T. 242; 31 L. T. 99, Q. B.; and 4 K. & J. 650, Wood, V.-C.

[a[1]] *So nearly resembling, &c.*]—This is taken from the civil law with regard to trade-marks. Such resemblance is the test of infringement where a mark is not actually copied (*b*). The rules of comparison adopted in the Courts, have been stated in the earlier part of this work (*c*). And it has been shown that the persons whom the alleged spurious mark must be calculated to deceive are, in actions for infringement or passing off, taken to be any class of probable purchasers of the goods in connection with which the marks are to be used, whether the immediate purchasers from the manufacturers, the ultimate purchasers from the last retailers, or intermediate purchasers. Foreign purchasers are to be considered, if the marks circulate in foreign markets, and the bearing of their probable ignorance of the English language upon the question whether the resemblance between the marks before the Court is calculated to deceive is also material. There seems no ground for holding that buyers within the United Kingdom only are to be considered in the application of the Act.

Making a mark nearly resembling a trade-mark.

Where a trade description is used only so as to be brought to the notice of expert dealers in the goods to which it is applied, it is not treated by the Customs House authorities as false or falsely applied, under sect. 16 of the Act, if it does not deceive such dealers, although it might deceive the buyers who have no expert knowledge (*d*). It may be assumed that a corresponding construction would be applied in the case of marks which nearly resemble trade-marks.

The phrase "so nearly resembling," &c., appears also in sect. 2 (1) (b) and sect. 5 (3). In sect. 3 (2), the words used are "calculated to lead persons to believe that the goods (to which a false trade description is applied) are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really

(*b*) Book I., Chap. XV., p. 314.
(*c*) Pages 186 *et seq.*, 314 *et seq.*
(*d*) See below, p. 537.

"are." This is the deception a forged or false trade-mark is calculated to produce, and it is difficult to see how the more general expression "calculated to deceive" in the present and the first above-named sub-sections can have any different meaning.

Falsifying a trade-mark.

(b) *Falsifies any genuine trade-mark.*]—The assent of the proprietor (*e*) is no defence under this head, that is, unless it in fact negatives any intent to defraud.

This sub-section reproduces the substance of part of sect. 5 of the Act of 1862.

An alteration of a genuine trade-mark, such as to make it resemble another registered trade-mark, might fall under (a) or [a[1]].

The retailer of goods bearing a trade-mark might alter the mark with intent to pass off it, and the goods upon which it appeared, as his own. The use of a trade-mark so altered would fall within sect. 2 (1) (b) and sect. 5 (1) (d) as a false application of the trade-mark, and it might also amount to the application of a false trade description within sect. 2 (1) (d) and sect. 3 (2). The sub-section is probably intended to meet cases of fraudulent alterations, such as that suggested, where no use or application can be proved.

2. Falsely applying a Trade-mark to Goods.

Sect. 2 (1).

"(b) Falsely applies to goods any trade-mark (*f*), or any mark so nearly resembling (*g*) a trade-mark as to be calculated to deceive."

Goods.

Goods].—This is defined by sect. 3 (1) to mean anything which is the subject of trade, manufacture, or merchandise.

Trade-marks are registered only for definite classes of goods (*h*), and the rights of the proprietor of a trade-mark are restricted to goods of the class for which it is registered, and for which it is actually used or intended to be used.

(*e*) *Ante*, p. 470.
(*f*) Page 465, "trade-mark."
(*g*) Page 471, "So nearly resembling."
(*h*) Act of 1883, sects. 65 and 66. Book I., Chap. V., p. 87.

He can have no right in respect of its user upon goods in which he does not deal (*i*). It is submitted, upon the same principle, that it would not be an offence under this head to apply a trade-mark registered for cotton goods, for instance, to ironware, without the assent of the proprietor of the trade-mark, even if such use could be held to be a use with intent to defraud.

Applies to goods.]—By sect. 5—

Sect. 5 (1). Applying marks and descriptions.

"(1.) A person shall be deemed to apply a trade-mark or a mark or a trade description to goods who—

"(a) applies it to the goods themselves; or

"(b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture; or

"(c) places, or encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel or other thing to which a trade-mark or trade description has been applied; or

"(d) uses a trade-mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade-mark or mark or trade description.

Sect. 5 (2). Covering. Label.

"(2.) The expression 'covering' includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression 'label' includes any band or ticket.

"A trade-mark, or a mark, or trade description, shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label, reel, or other thing" (*k*).

What is a sufficient application of a spurious trade-mark

(*i*) See above, p. 256.

(*k*) For sect. 5 (3) see next page.

to goods to constitute an infringement, has already been considered (*l*).

Sub-sect. (1) (c) covers such cases as the refilling of bottles to which a trade-mark or trade description has previously been applied (*m*).

Sub-sect. (1) (d) is exceedingly general in its terms. It has been held, in cases of trade description, to extend to a description in an invoice sent with the goods (*n*). In *Starey* v. *Chilworth Gunpowder Co.* (*o*), the false trade description was painted on the barrels in which gunpowder was delivered by government contractors to the government agents.

The words "calculated to lead to the belief," &c., at the end of the sub-section, may be compared with the corresponding words "calculated to deceive," used elsewhere in the Act (*p*).

Falsely applies, &c.].—By sect. 5—

"(3.) A person (*q*) shall be deemed to falsely apply to goods (*r*) a trade-mark or mark, who without the assent of the proprietor (*s*) of a trade-mark (*t*) applies (*u*) such trade-mark, or a mark so nearly resembling it as to be calculated to deceive (*x*); 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" (*y*).

This sub-section corresponds to sect. 4 (a) (*z*), defining the offence of forging a trade-mark. The reference in it to a mark resembling a trade-mark is redundant, as to

(*l*) See above, pp. 310 and 413.

(*m*) As in *Wood* v. *Burgess*, 24 Q. B. D. 162 (1889), a case under the Act; and the earlier infringement cases, cited on p. 310, *ante*.

(*n*) *Budd* v. *Lucas*, (1891) 1 Q. B. 408, Pollock and Charles, JJ.

(*o*) 24 Q. B. D. 90 (1888), Coleridge, L.C.J., and Mathew, J.

(*p*) See above, p. 471.

(*q*) "Person," p. 463.

(*r*) "Goods," p. 472.

(*s*) "Proprietor," p. 469; "assent of the proprietor," p. 470.

(*t*) "Trade-mark," p. 465.

(*u*) "Applies to goods," p. 473.

(*x*) "So nearly resembling," p. 471.

(*y*) Below, p. 505; cf. sect. 4, p. 468.

(*z*) Page 468.

falsely apply a mark so nearly resembling a trade-mark, &c. is, by sect. 2 (1) (b), declared to be a distinct offence.

3. Applying a False Trade Description to Goods.

"(d) Applies any false trade description to goods" (*a*). Sect. 2 (1) (d).

The Act does not extend to false descriptions of quality.

The sale of goods under a false trade description may constitute an offence of cheating or obtaining goods by false pretences at common law. The application of a false trade description was made a substantive offence by the Act of 1862, from sect. 7 of which Act the provisions in the present Act under this head are substantially taken. That Act did not, and the present Act does not, extend to descriptions of quality as apart from kind, but it is the intention of the present Act, under the sections dealing with trade-marks, of which the office is to indicate the maker, vendor, or selector of the marked goods (*b*), and which are, therefore, of the nature of trade descriptions, and under the sections dealing with false trade descriptions, extended by sect. 3 (2) and (3) to marks in general which fill the office of trade-marks, to reach all false merchandise marks, other than marks of quality (*c*).

(*a*) "Goods," p. 472.

(*b*) See Book I., Chap. II., p. 49.

(*c*) *Quality.*—Adulteration, or the sale of goods not of the nature or quality demanded, or pretended, is made a criminal offence by other statutes in many special instances. By far the most important of these statutes are the Sale of Food and Drugs Acts, 1875 and 1879 (38 & 39 Vict. c. 63, and 42 & 43 Vict. c. 30), by which it is an offence to mix injurious ingredients with any article of food, or any drug, with intent that the same may be sold, or to sell the article of food or drug so mixed; to sell articles of food or drugs not of the nature, substance, and quality demanded by the purchaser; and to abstract from an article of food, with intent that the same may be sold without notice, any part of it so as injuriously to affect its quality, substance, or nature, or to sell (without notice) the article so altered. For cases under these Acts see the Law Reports Digest "Adulteration." Among other statutes may be mentioned 6 & 7 Will. 4, c. 37 (Bread); 4 Geo. 2, c. 14, 17 Geo. 3, c. 29 (Tea); 5 Geo. 1, c. 11, s. 23 (coffee); 37 & 38 Vict. c. 49, s. 14, 48 & 49 Vict. c. 51, s. 8 (beer); 32 & 33 Vict. c. 112 (seeds); 56 & 57 Vict. c. 56 (agricultural fertilizers and feeding stuffs); and the Margarine Act, 50 & 51 Vict. c. 29.

Trade description.]—By sect. 3 (1)—

What is a trade description.

"The expression 'trade description' means any description, statement, or other indication, direct or indirect,—

"(a) as to the number, quantity, measure, gauge, or weight of any goods, or

"(b) as to the place or country in which any goods were made or produced, or

"(c) as to the mode of manufacturing or producing any goods, or

"(d) As to the material of which any goods are composed, or

"(e) As to any goods being the subject of an existing patent, privilege, or copyright,

Customary trade description.

and the use of any figure (*d*), 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."

M. M. A., 1891.

And by the M. M. A. 1891, s. 1 it is provided that—

Customs entry.

"[f] the Customs entry (*e*) relating to imported goods shall, for the purposes of the M. M. A. 1887, be deemed to be a trade description applied to goods."

Verbal trade description.

It has been held by a stipendiary magistrate at Sheffield, that a false trade description within the Act may be verbal (*f*). This was decided upon the construction of sect. 5 (1) (d), which provides that a person shall be deemed to apply a trade description who uses it in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by it. But this is not the common view of the construction

(*d*) *i.e.*, numeral. *Ex parte Stephens*, 3 C. D. 660, see above, p. 165.

(*e*) See p. 486, below.

(*f*) German-made scissors were verbally described and sold as Sheffield made. The newspaper report of the case is set out in M. M. A. Report, 1890, p. 359. but there is no judgment.

of that sub-section (*g*), and Mr. Poland, Q.C., has advised that to make a verbal false statement, is not to apply a false trade description within the meaning of the Act (*h*). It is submitted that this opinion is correct, for every other part of the Act deals with marks or statements which are in writing, and sect. 5 (1) (d) itself couples trade descriptions with trade-marks and marks which cannot be verbal statements. And it is hardly consistent with the ordinary employment of the words to speak of "the use" of a verbal statement, for use suggests the idea of repetition, and therefore of permanence in the thing used. Sect. 17 of the Act, which deals with implied warranties of trade-marks and trade descriptions, seems to contrast (among other things) a trade description with a verbal statement, since it cannot have been intended that the purchaser should be able to set up a warranty upon a verbal statement, and that the vendor should be required by the section to refer to a signed writing to contradict it. And the Act throughout appears to relate to descriptions which are permanent and capable of giving information to, or deceiving, or being calculated to suggest beliefs to any persons who may see them, not merely the persons to whom they are spoken. The definition above given, by which trade description means any description, *statement*, or other indication, throws no light on the question, since statement may reasonably be understood to mean written statement. It is expressly provided that a 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 (*i*), and this sub-section can only have been drafted upon the assumption that, without it, the trade descriptions referred to in the Act would, or might, be confined to descriptions written, printed, or painted in the ordinary way.

(*g*) Cf. Mr. Hughes' evidence, M. M. A. Report, 1890, Q. 4994.

(*h*) See the case and opinion set out M. M. A. Report, p. 166.

(*i*) Sect. 5 (2), p. 473.

Frauds effected under cover of verbal false descriptions.

The non-inclusion of verbal statements leaves a large class of frauds untouched by the Act. Goods, for instance, which have passed through the Customs under cover of an explanation placed upon their coverings may be sold retail without the explanation, and with a verbal false description; as, of course, may also goods which, bearing no description at all, or no false description, could not be stopped on importation, or home-made goods. In his opinion, on the case above referred to (*k*), Mr. Poland, Q.C., expressed the view that the imitation of the crystals of Demarara sugar in beet-root sugar, and its sale as Demarara sugar, was not an offence under the Act. Sales upon such verbal false statements may, however, amount to the offence of cheating, or obtaining money by false pretences (*l*), if they are deliberate false statements of matters of fact known to the person charged, and are made in order to induce, and do actually induce, the buyer to purchase.

Imitation Demarara sugar.

Imitations of "get-up."

Goods may be passed off as those of the manufacture or merchandise of some person other than the person whose they are, without any explicit description of them as the goods of the first person, or any piracy or colourable imitation of his trade-mark or trade-name. This fraud forms the ground of a civil action (*m*). Such imitations are false trade descriptions applied to the goods under sect. 3 (2) (*n*).

Words forming part of the goods.

Words forming part of the goods upon which they appear cannot, it would seem, be taken to be a trade description applied to those goods within the meaning of the Act, although they may, in fact, give or suggest some description, statement, or other indication within the definition just cited, for the description is treated in the definition as an addition to the "goods," which are complete without it. This is the view taken by the Customs

(*k*) *Ante*, p. 477.
(*l*) *Ante*, p. 469.
(*m*) Book I., Chap. XVI., p. 379.
(*n*) *Infra*, p. 491.

authorities in the application of sect. 16 (*o*). For instance, English words in verses on Christmas cards; the title of a book; the words *fast* and *slow* upon the regulator of a watch; mottoes and words of friendship on handkerchiefs, crockery, and so forth, are not treated by the Customs authorities as indications that the goods were produced in an English-speaking country. "On *such* goods, made abroad, it has been thought" by the Customs authorities "wiser to regard (with some exceptions) English wording which goes no farther than above mentioned (that is to say, which does not go into such statements as 'printed in England,' or 'very superfine cards,' or 'London lever watch,' &c.), as part of the 'goods,' and as not, therefore, rendering the goods liable under the Act, even though the general appearance given to them may be on this account, and on account of the wording, unquestionably English" (*p*).

Trade description may be a trade-mark.

The trade description may be a trade-mark or part of a trade-mark (*q*), or may include a trade-mark (*r*); but the case of a false name or initials is dealt with specially (*s*).

Number.

(a.) *Number, &c.*]—This sub-section is directed to descriptions applied to coverings (*t*) purporting to contain a specified or indicated number, quantity, &c. of goods, as well as to descriptions attached to the goods themselves. It meets frauds, such as the practice of marking upon cotton goods the number of laps or folds by a figure so placed as to be "commonly taken" to indicate the number of yards in the marked piece, the true number of yards being in fact less than the number marked (*u*).

It has been questioned whether the words in the clause cover indications of width, dimension, and weight per unit

(*o*) See M. M. A. Report, 1890, Appendix I., p. 275, a paper handed in by Mr. Follett, Solicitor of the Board of Customs, from which the illustrations in the text are taken.

(*p*) From the paper referred to in the last note.

(*q*) Sect. 3 (1). "False trade description," p. 478.

(*r*) Sect. 3 (2), p. 491.

(*s*) Sect. 3 (3), p. 493.

(*t*) Sect. 5 (2), p. 473.

(*u*) See the evidence of Mr. Bailey, Qq. 1966 *et seq.* M. M. A. Report, 1890.

of length, which are of great importance in the textile trades; but it is submitted that they do, and it is said, that the Manchester magistrates have so construed them (*v*).

Measure.]—The description of casks of beer as *barrels* in an invoice sent with them, has been held to be a statement within the definition that the casks contain thirty-six gallons each (*x*).

Weight.]—In a civil case it has been held that goods done up in cases and supplied according to contract, the cases being marked as one pound cases, could not be forced upon a purchaser if they were actually under the weights indicated, although not deficient by more than an alleged customary allowance, on the ground that the purchaser could not sell them without committing an offence under the Act (*y*).

(b.) *Place or country.*]—This sub-section was regarded by many of the advocates of the bill as the most important clause of the definition; it is under cover of it that goods made abroad and so marked as to suggest that they are made in England, are brought within the Act, and are made liable to seizure by the Customs authorities in accordance with sect. 16 (*z*).

Place of origin.

The chief difficulty in the application of this clause of the definition arises from the fact that the clause is apparently framed on the assumption that all goods will be wholly made or produced in one place or country, whereas, in fact, many kinds of goods are worked upon in several before they are finished and ready for the market, or are made up of parts made or produced in different countries. The difficulty, however, is partly met by the definition of a false trade description as one which is false

(*v*) See note (*u*) on previous page.

(*x*) *Budd* v. *Lucas*, (1891) 1 Q. B. 408, Pollock, B., and Charles, J.

(*y*) *Hooper* v. *Balfour*, W. N. (1890) 61; 62 L. T. 646; *Green and Balfour's Arbitration*, W. N. (1890) 139, 156, Kay, J., and C. A.

(*z*) And in accordance with the agreements arrived at by the Commissioners at the International Convention, Conference of Rome, in 1886. This convention has not been ratified.

in a material respect, for this reduces it to a question of fact. No doubt any Court, in determining whether the indication of a particular country as the place of manufacture was false in this sense or not, would be guided by the custom of the trade in the goods concerned, that is, supposing it to be consistent with honesty. The description of goods, partly made in each of two countries, as made in a third, would, it may be assumed, be indefensible under any custom, unless it fell within the general saving of sect. 18 as a "conventional" or "generic" description lawfully and generally used at the passing of the Act, as, for instance, *French polish*, *American leather*, or *Indian rubber*. The last-mentioned section, however, extends to a trade description of place or country, calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, the goods not being actually made or produced in the place or country indicated or suggested, only if there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there (*a*). From this has arisen the now familiar notices, "made in Germany," "made in France," &c.

It is to be observed that the provision in sect. 18 requiring the addition of the name of the place or country of actual manufacture is only applicable where the trade description is calculated to mislead (*b*). It is not necessary, for instance, to mark *Morocco* leather or *Brussels* carpets as made in England, since the term is not calculated to lead any buyer to think the leather was made in Morocco or the carpet in Brussels.

By sect. 10 (2)—

Evidence of country of origin.

"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."

And the port of shipment is stated in the Customs

(*a*) Sect. 18, *infra*, p. 493.

(*b*) Cf. "So nearly resembling," *ante*, p. 471.

entry (*c*), which is now itself a trade description applied to the goods referred to by it (*d*).

Customs practice as to country of origin.

The practice of the Customs authorities, under sect. 16, with regard to the matters above referred to, was described by Mr. Follett, to the Committee of 1890, in the following terms (*e*): "As general rules, the board have acted on the principle that goods must (as indeed is in accordance with sect. 10 of the Act) be held *primâ facie* to have been the make or produce of the country from which they last come; and that if a qualifying description to that effect is remonstrated against on the ground that it would be untrue as to a material part, there must be a statement as to that part. For instance, if there were an importation of German cutlery with the name of an English dealer, and a qualification of *made abroad* were objected to on the ground that the handles (taking it to be knives), or the woodwork (taking it to be planes), were made in England and sent out by the dealer to be fitted, then it would be required that these should be stated, *blades (or woodwork) made in Germany*. Similarly (although as to the important part of the goods the circumstances are just reversed), it was required that if British goods were sent abroad to be finished in any respect, as, for instance, yarns to be dyed, that fact must be stated, *dyed abroad*, when they are re-imported.

Goods finished abroad.

Foreign goods finished in England.

"As regards goods coming in in an incomplete state, or merely as parts of an intended complete article, the board have felt that they could do no more than deal with them as they stand, taking care that there is no description either of the parts themselves, or of the whole goods to which they are going to be added, which can form an incorrect indication as to the make of the imported portion."

Imports from inland country.

In the case of goods imported through the ports of a country other than that of their origin, for example, Swiss goods coming through a French port, and marked as Swiss, the practice of the authorities is to detain them until a declaration by the importer, or other evidence regarded as satisfactory, is tendered to show that the goods are in fact Swiss.

(*c*) Below, p. 486.
(*d*) M. M. A., 1891, s. 1.
(*e*) *Ante*, p. 479, n.

It has recently been held in an Irish case that the description of bacon, which was killed in America and was cured by the defendant Lipton, partly in America and partly in Ireland, as "Lipton's cure," and "own cure at Lipton's market," was not a false trade description, although the magistrates and one of the judges who heard the case thought the use of the description by an Irish shopkeeper was likely to be deceptive (*ee*).

It is provided by sect. 16 (4) (*f*) that—

Goods bearing the name of an English place.

"Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom."

This provision is expressly restricted to the purposes of the section in which it occurs, that is, the section dealing with the importation of deceptively or spuriously marked goods, but the rule laid down in the clause would probably be adopted in regard to any suggested false trade description by the use upon goods of a name like the name of an English, Scotch, or Irish place. Goods marked simply "Rugby," for example, would be taken to be falsely described if made in Rugby, Tennessee.

(c.) *Mode of manufacturing, &c.*]—In the Irish case referred to above it was also held that the description in question was not an offence within this clause (*ee*).

Material.

(d.) *Material, &c.*]—In a case where goods were marked and described as "natural wool" goods, this was held by the magistrates at Leicester to be an indication within the definition that the goods were all, or substantially all, woollen, although a custom to call cheap mixtures of cotton and a little wool "natural wool" was alleged (*g*).

(*ee*) *R.* v. *Lipton*, 32 L. R. Ir. 115 (1892), Q. B. D.

(*f*) See further, p. 535, and "customs entry," p. 486.

(*g*) *Times* Newspaper, 20 Oct., 1893.

Patent.

(e.) *Existing patent.*]—By sect. 105 of the Patents, &c. Act, 1883, it is provided that—

Sect. 105 of the Act of 1883.

"(1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered when it is not so, shall be liable for every offence on summary conviction to a fine not exceeding 5*l*.

"(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered if he sells the article with the word 'patent,' 'patented,' 'registered,' or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article."

Application for a patent (*h*), or provisional protection (*i*), does not authorize the use of the words patent or patented so as to avoid the penalty of this enactment; but the acceptance of the complete specification for a patent does, for it entitles the applicant to "the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance" (*k*).

The section just cited from the Patents, &c. Act does not apply to the case of a representation in respect of an article for which a patent has at some time been granted, but which has ceased to exist by effluxion of time or otherwise; the M. M. A. is not so limited. On the other hand, the section applies to every representation within its terms, whether made with intent to defraud or not.

There is no provision similar to sub-sect. (2) of the above section in the M. M. A., and the use of the words patent or patented does not necessarily, therefore, amount to a description, statement, or other indication that the goods to which they are applied are subject to an existing patent. A false claim of patent rights contained in a trade-mark is a bar to the interference of the Court for

(*h*) So held by a magistrate in *R.* v. *Crampton*, 3 R. P. C. 367 (1886).

(*i*) So held by a magistrate in *R.* v. *Wallis*, 3 R. P. C. 1 (1885).

(*k*) Act of 1883, sect. 15.

the protection of the trade-mark, and the cases decided on this subject will, no doubt, apply, so far as they go, in the construction of the present sub-section, but they do not lay down any definite rules (*l*).

In *Gridley* v. *Swinborne* (*m*), a case under the present Act, Coleridge, L.C.J., said, that where the original patentee continued to use his old labels containing the word *patent*, there was no necessary implication of fraud, and the Court held that the defendant, who had sold goods, made from gelatine, under a patent which expired in 1847, as *Swinborne's patent refined isinglass*, was not guilty of any offence under the Act.

Custom of the trade.

Custom of the trade (*n*).]—Custom does not here mean the custom of merchants, which is part of the common law (*o*), or any of the six *consuetudines* mentioned by Coke (*p*). It is more akin to the custom or usage of a particular trade or market which is resorted to in order to import terms into commercial contracts not inconsistent with their words, or to explain the meaning of the expressions employed in them, that is, a particular custom to be established by evidence (*q*), or to the "custom of the country" imported into agricultural tenancies and leases, of which it is said it "must be applied to the approved habits of husbandry in the neighbourhood under circumstances of the like nature" (*r*). The custom is, therefore, the existing and generally recognized practice or usage of the trade, whether old or recent; but if recent, sufficiently old to have become generally recognized and followed (*s*).

The words may be compared to those used in the first

(*l*) See Book I., Chap. XV., p. 339, above.

(*m*) 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L.C.J., and Grantham, J.

(*n*) Cf. "Common repute" in sect. 7, below, p. 522.

(*o*) Blackstone, Vol. 1, p. 74.

(*p*) 2 Inst. 58.

(*q*) See *Wrigglesworth* v. *Dallison*, 1 Smith L. C. 8th ed., p. 569, and the cases cited in the notes.

(*r*) 2 Platt, 279, cited in Stroud's Dic. s. v.

(*s*) "Usage of trade is a general and prevailing course of business, and witnesses who are called to prove it should cause their minds to revolve over instances known to them of its having been acted upon." *Hall* v. *Benson*, 7 C. & P. 711.

sentence of sect. 18—"lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods" (*t*).

In judging whether an alleged trade-mark, or a mark tendered for registration as a trade-mark, is calculated to deceive by reason of its resemblance to another trade-mark or otherwise, the Civil Courts, as has already been shown, consider all the circumstances of the trade concerned, and admit the evidence of persons engaged in the trade as experts (*u*).

The evidence to prove a custom within the definition above stated, must obviously be similar to the expert evidence just mentioned, that is to say, it must be given by persons engaged in the trade, whether as manufacturers, merchants, or retailers, or by persons in the employment of such persons, or otherwise practically acquainted (for instance, as conductors of technical or trade journals), with the customs they depose to.

In a case where an alleged custom in the furniture trade, to deliver goods upon sale or return, was set up in answer to a claim under the reputed ownership clauses of the Bankruptcy Act, Cave, J. said the question was, "whether it amounted to a custom of the trade of so notorious a character that anyone making inquiry of persons cognizant of the trade might ascertain that it was a custom" (*v*).

Customs entry.

[*Customs entry.*]—The Customs entry for imported goods is a statement made up from the bill of lading (*x*) for purposes of Customs duty, and signed and declared to be true by the importer or his agent. It contains the name of the port or place from whence the goods come, and a description of the number of packages and of the quantity

(*t*) See p. 408.

(*u*) Book I., Chapter X., "Restrictions on Registration," pp. 197, 205.

(*v*) *Ex parte Nassau*, 2 T. L. R. 339 (1886).

(*x*) See Mr. Seymour's evidence, M. M. A. Report, 1890, Q. 4824.

and description of goods, in accordance with the requirements of the Official Import List. It was made a trade description under the principal Act by the Act of 1891, upon the recommendation of the Committee of 1890, and in accordance with the following passage from their report:

Report of the M. M. A. Committee of 1890 on fraudulent importations.

"The evidence given before your Committee has, in their opinion, conclusively proved that goods (notably, articles of consumption) come into this country in large quantities in an adulterated form, but cannot, according to the evidence given by the Customs authorities, be detained under sect. 3 (d) (*y*) of the M. M. A., because, in most instances, they bear no trade description, as defined by sects. 3 and 5 of the said Act. Your Committee are of opinion that much harm is being done to legitimate trade by the impunity with which spurious articles are introduced into this country. They therefore propose that the Act should be amended by making the Customs 'entry,' which must bear a description of the goods imported, a 'trade description' within the meaning of the Act. The adoption of this amendment would, in the opinion of your Committee, give the Customs power to detain goods, the 'trade description' of which is false as to the material of which they are composed."

No general obligation to mark the place of origin.

The Committee refused to recommend that it should be made compulsory to mark all goods with an indication of origin, on the ground that this "would seriously restrict trade, and virtually destroy the business of warehousemen, commission agents, and small masters."

False trade description (*z*).]—By sect. 3 (1)—

What is a false trade description.

"The expression 'false trade description' means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material

(*y*) False trade description as to the material of which any goods are composed.

(*z*) "Trade description," p. 476.

"respect, and the fact that a trade description is a trade-mark, or part of a trade-mark, shall not prevent such trade description being a false trade description within the meaning of this Act."

The last part of the definition would have been more appropriately placed in the definition a "trade description" (*a*).

The "false name or initials of a person" is specially dealt with by sect. 3 (3) (*b*), and the definition just stated is expanded by sect. 3 (2), which is set out below (*c*).

So that "false trade description" under the Act includes—

(1.) A trade description false in a material respect as regards the goods to which it is applied.

(2.) An alteration of a trade description, whether false or not, such as to make it false in a material respect.

(3.) Figures, words, or marks, or an arrangement or combination thereof, such as are reasonably calculated to lead persons to believe that the goods to which they are applied are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are (sect. 3 (2)).

(4.) A false name or initials within sect. 3 (3) (*b*).

False.]—False is construed by the Customs authorities in the application of sect. 16 to mean, not "misleading" but simply "untrue" (*d*). The expression "false description" is taken from the Act of 1862, s. 7, where it certainly means a description intended to deceive, since it is coupled with the phrase "for the purpose of falsely indicating, &c.," but the construction just mentioned seems, on the whole, to be that intended by the Act, for *false* is contrasted with *genuine* in sects. 2 (2) (a), 4 (b), 6 (c), and 17; false declarations are referred to in sect. 8 (3); and sect. 18 seems

(*a*) "Trade description," p. 476.
(*b*) Below, p. 493.
(*c*) Page 491.
(*d*) See Mr. Follett's evidence, *ante*, p. 479, n.

to contemplate that some false descriptions within its scope may not be misleading. It is doubtful, however, whether, for the purposes of the Act, there is any substantial difference in effect between the two meanings. The essence of a description is that it should suggest something, and if it suggests what is untrue, it is misleading.

In *The Patent Isinglass Case* (*e*), Coleridge, L.C.J., said that a false description within the Act meant something more than a mere inaccurate or mistaken description. There must be a criminal intent, a *mens rea* in the application; this is inferred because the Act creates criminal offences, and the construction adopted is consistent with the reference to "intent to defraud" in sect. 2 (1), and the defence that the person charged had "acted innocently," which is admitted by sect. 2 (2).

Material respect.

False in a material respect.]—This expression was chosen, after much consideration, to meet the case of descriptions which are partly false; for instance, descriptions of mixed or composite goods, referring to some or one only of their composite parts. The clause was inserted "because it was considered impossible to test the exact percentage of a particular material, the name of which was signed to the article" (*f*). Under it, the Court is left to decide as a question of fact whether it is false, for example, to describe textile goods made partly of cotton as *natural wool* (*g*); a cask containing less than thirty-six gallons of beer as a barrel (*h*); gelatine made from cod sounds as patent isinglass (*i*); or a watch with an English case and an English movement but a Swiss regulator, as an English watch (*k*); or, generally, goods partly made in the United

(*e*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888).

(*f*) See the evidence of Mr. Courtenay Boyle, assistant secretary to the Board of Trade, M. M. A. Report, 1887, Qq. 38 *et seq.*

(*g*) See *The Leicester Case*, *ante*, p. 483, *Times* Newspaper, 20 Oct., 1893.

(*h*) *Budd* v. *Lucas*, (1891), 1 Q. B. 408.

(*i*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888).

(*k*) As to watches, see sect. 7, below, p. 522. It is said that all English watches have Swiss regulators.

Kingdom and partly abroad, as made in the United Kingdom (*l*).

Materially or substantially false.

"False in a material respect" is here treated as equivalent to materially or substantially false, so that the question is one of degree, and as regards some of the attributes referred to in the definition of trade description, no other meaning could be given to it. A description of weight, for example, can only be false by being too great or too small. But, as regards some of the other attributes referred to, the phrase seems more properly to mean that the matter falsely stated is material to be truly stated to the persons concerned, that is, the probable buyers, or others to whom the description is addressed. For example, if goods go through different stages in the course of manufacture in different countries, it is conceivable that only the country where they are finished, or where any other particular stage is passed, is material to be named (*m*), and that, therefore, for the purposes of the Act, the goods may be well described only as made in that country. So, if the material of which goods are made is a metallic alloy, as the gold of commerce, it may be immaterial to state truly the nature of the baser metal (provided there is no false statement as to its absence, or its proportion in the mixture).

Limits of error allowed.

The Committee of 1890 were strongly urged to recommend the adoption, as part of the Act, of certain definite limits in regard to measure, within which a deficiency from the measure actually indicated by a trade description should not be, but beyond which it should be deemed to be, false in a material respect; but they declined to suggest the enactment as a rule of law of what they regarded as properly a matter of evidence.

The limits suggested by the Manchester Chamber of Commerce, in 1888, and adopted under the Indian Merchandise Marks Act, are set out in the Appendix (*n*).

(*l*) See p. 480, "Place or country," and *R. v. Lipton*, *ante*, p. 483.

(*m*) Cf. the case of watches, below, p. 524.

(*n*) Page 705. M. M. A. Report, 1890, p. 322. Evidence of Mr. Bailey, Q. 2024.

Alteration.]—The person who makes the alteration which causes the trade description to be false, applies the false trade description (*o*). Alteration of a trade description.

This clause of the definition relates only to alterations of the description, not to alterations of the goods described so that the description becomes false as applied to them. An alteration, for example, by the adulteration of marked goods, such as to make them cease to be the goods described, may be an offence against the Act, if, within sect. 5 (1) (c) or (d), the person making the alteration applies the description to the altered goods, since it is false as regards them.

Applies any false trade description.]—Sect. 5 defines when a person shall be deemed to apply a trade description to goods. It has been already set out (*p*).

By sect. 3—

"(2.) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods (*q*) of any such figures (*r*), words (*s*), or marks, or arrangement or combination thereof, whether including a trade-mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are."

This sub-section does not in terms refer to goods to which a false trade description has been applied, as the next and corresponding sub-sect. 3 (3) does. It is difficult to see any reason for the change of language, and, it is submitted, it makes no difference in the construction of the Act, for it is not possible to extend the definition of "application" without extending correspondingly the class of things to which the application is made.

(*o*) Cf. forgery of a trade-mark by altering a genuine trade-mark, sect. 4 (b), above, p. 468.

(*p*) Above, p. 473.

(*q*) See sect. 5, above, p. 473.

(*r*) *i.e.*, numerals. *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M.R.

(*s*) For names and initials, see sect. 3 (3), below, p. 493.

The name *Chilworth Gunpowder Co., Ld.*, placed by contractors for the supply of gunpowder to the Government, upon barrels of powder, in the place where the name of the contractor was required to be inserted, was held in *Starey* v. *Chilworth Gunpowder Co.* (*t*), to be a false trade description, the powder being imported German powder, and not the manufacture of the defendants, and it being clear, as the Court held, that, in the particular case, contractor meant manufacturer, the defendants having dealt with the Government as manufacturers only, although it is commonly a word of ambiguous meaning, capable of signifying either maker or vendor, or both. This decision must have been under sect. 3 (2), for sect. 3 (3) did not apply; but the question suggested above was not argued or referred to.

An unregistered trade-mark may be a trade description.

The sub-section makes the offence of applying a false trade description include that of forging a (registered) trade-mark, which is itself a separate offence under sect. 2 (1) (a), and also that of forging a trade-mark which is unregistered and not a trade-mark within the meaning of the Act (*u*), for the office of a trade-mark is to indicate that goods are the manufacture or merchandise of the persons with whose business or goods the trade-mark is identified by registration or use.

Names and initials.

The following sub-section deals with false names and initials. That sub-section may possibly be held to be restricted to a very small class of such names and initials (*x*), and the question may then arise whether names and initials which are so used as not to fall within it, are *words* within the present sub-section. On a strict construction it may be difficult to hold that a general word in one sub-section can include a particular meaning introduced by an appropriate word into a co-ordinate sub-section immediately following the first; but there are many cases of overlapping sections

(*t*) 24 Q. B. D. 90 (1889), Coleridge, L.C.J., and Mathew, J.

(*u*) See sect. 3 (i), above, p. 465, "trade-mark."

(*x*) See below, p. 494.

and provisions in the present Act, and, if it be necessary in order to carry out the obvious intention of the Act, it is submitted that the interpretation suggested ought to be adopted.

Calculated to lead persons to believe, &c.

Calculated to lead, &c.]—The phrase may be compared with "calculated to deceive," of sect. 2 (2) and 4 (a) (*y*), "intent to defraud" of sect. 2 (1) (*z*). The persons intended are any class of probable purchasers of, or dealers in, the goods, so that it would be no defence to prove that the immediate purchasers, the persons to whom the goods falsely described were sold, if the offence were committed upon a sale, were not in fact deceived. This is the rule adopted in infringement cases (*a*). In such cases proof of actual deception is not a necessary part of the plaintiff's case (*b*), although its unexplained absence may be significant, if the alleged deceptive mark has been long in the market (*c*); and it is no excuse for the defendant to show that the actual buyers from him of the spuriously marked goods knew whose goods they were. They generally do know, and are parties to the intended frauds (*d*).

(4.) By sect. 3—

False name or initials.

"(3.) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied (*e*), shall extend to the application to goods of any false name or initials of a person (*f*), and to goods with the false (*g*) 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,

(*y*) Above, p. 471.
(*z*) Page 507, *post*.
(*a*) See Book I., Chap. X., p. 186; Chap. XV., p. 318.
(*b*) Above, p. 316.
(*c*) Page 206.
(*d*) *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 472 (1887), C. A., cited p. 363.
(*e*) This clause is omitted from the last sub-section 3 (2).
(*f*) "Person," sect. 3 (1), p. 463.
(*g*) Cf. "false trade description," sect. 3 (1), p. 487, and "falsely apply," sect. 5 (3), p. 474.

"as applied to any goods, any name or initials of a person which—

"(a) are not a trade-mark (*h*) or part of a trade-mark, and

"(b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorized the use of such name or initials, and (*i*)

"(c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods."

This is an awkwardly drawn sub-section, not in harmony with the remainder of the Act. The insertion of the negative clause (a), for instance, is not in accord with the general plan of allowing sections creating similar and similarly punished offences to overlap, and the expression colourable imitation is in other sections represented by the phrase "so nearly resembling, &c."

The sub-section seems to be intended to extend the protection of the Act to trade-names which are protected by the civil law much in the same way as trade-marks (*j*), and also to stay frauds perpetrated by the use of "blind names" (*k*), that is, names belonging, in fact, to no one, but so used as to appear to be the names of respectable firms.

By the letter of the sub-section, a name or initials, to fall within its terms must fulfil each of the conditions (a), and (b), and (c); but it is submitted that the second *and* should be *or*, for no name can be identical with the name of a person carrying on business in connection with the goods, and at the same time be that of a person not *bonâ fide* so carrying on business (*kk*). The Courts have no

(*h*) "Trade-mark," *i.e.*, registered trade-mark, sect. 3 (1), p. 465.

(*i*) *Quære*, "or," see lower down.

(*j*) See Book I., Chap. XVI., p. 379.

(*k*) Below, p. 497.

(*kk*) The view suggested has now been adopted by the Q. B. D. in Ireland, *R.* v. *Lipton*, *infra*, p. 498.

difficulty in reading *or* for *and* where the context requires it (*l*).

Reading (b) and (c) as alternatives, the operation of the sub-section is to forbid the use of any false name or initials (not being a registered trade-mark (*m*), or part of a registered trade-mark) which is either an unauthorized copy or imitation of a trade-name or trade-initials, or is the trade-name or trade-initials of no one, or no one *bonâ fide* carrying on business, *i.e.*, is a "blind name." If this is the correct view of the sub-section, it is an offence within sect. 2 (1) (d) or sect. 2 (2), to apply to any goods any name or initials of a person other than the trade-name of a person who has authorized the application, or to sell, &c. any goods to which any name or initials of a person, other than the trade-name of a person applied with his authority, have been applied.

For the civil law relating to trade-names, see Book I., Chap. XVI., and for the right of a man to honestly use his own name in his trade, p. 420.

Name.]—"The expression 'name' includes any abbreviation of a name" (*n*).

False name or initials.]—The adjective false governs the whole sub-section. Its effect seems to be to restrict the operation of the section to names and initials which are not the personal or the trade-names or initials of the persons applying them (*o*).

(a) *Not a trade-mark.*]—Trade-mark means trade-mark registered or otherwise within sect. 3 (1) (*p*). Many trade-marks consist of or include the names of their proprietors, or of the predecessors in trade of their proprietors, and a

(*l*) As in *Townsend* v. *Read*, 10 C. B. N. S. 317; 30 L. J. M. C. 245; and see Stroud's Dictionary, "or for and."

(*m*) Or trade-mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of sect. 103 of the Act of 1883 are applied. See p. 465.

(*n*) Sect. 3 (1).

(*o*) Cf. "false," above, p. 488; and see p. 497, below.

(*p*) Page 465, "trade-mark."

trade-name, if used in connection with the goods its owner deals in, almost necessarily becomes a trade-mark if it is distinctive (*p*). The reason for excluding trade-marks and parts of trade-marks, seems to be that they are elsewhere dealt with under the heads of forgery and false application of a trade-mark (*q*); but this is not the case as regards parts of a trade-mark which do not so nearly resemble the trade-mark as to be calculated to deceive within the meaning of sect. 4 (*r*). Trade-marks which are or include names or initials, and which do not fall within the definition (*s*), are included within this sub-section if they comply with conditions (b) and [or] (c).

(b) *A colourable imitation, &c.*]—This expression is commonly used in infringement and passing off cases. It is equivalent to the phrase, used elsewhere in the Act, so nearly resembling as to be calculated to deceive (*t*), which has been already discussed.

Of the same description.]—Both trade-mark and trade-name rights are limited to the class of goods for which they are registered or used (*u*).

Proof of authority of proprietor.

Not having authorized.]—This is more generally expressed than "without the assent of the proprietor," which is the phrase used elsewhere in the Act (*v*), and already discussed, but it has probably just the same meaning.

There is no provision in the present sub-section casting the onus of proving the authority in question upon the defendant. This is probably due to an oversight.

(c) *Either those of a fictitious person or of some person not* bonâ fide *carrying on business in connection with the goods.*]—Apart from this Act it is perfectly legal, and the practice is very common, for a trader to use as his trade-name some name other than his own, and either the name of his predecessors in business, or a name chosen for some other

(*p*) See Book I., Chap. VIII., p. 114, "name-marks."

(*q*) Sect. 2 (1) (a), p. 465; and 2 (1) (b), p. 474.

(*r*) Page 468.

(*s*) Page 465, "trade-mark."

(*t*) Sect. 4 (a), p. 471.

(*u*) See Book I., Chap. V. p. 87.

(*v*) Sect. 4 (a), p. 470; sect. 5 (3), p. 474.

reason, not being such a name as to infringe the rights of any other person in respect of his trade-name (*x*). It is submitted that the Act does not make the practice illegal, but that the above sub-section, under clause (c), is directed against the application to goods of any name which is not the trade-name of the person who applies it, whether that trade-name is his personal name or not, for the whole sub-section is governed by the use of the words "false name" and "false name or initials," and the trade-name of the person using it is not a false name, nor are his trade-initials false initials (*y*). Trade-name of repute.

Evidence was given before the Committee of 1887 (*z*) of the fraudulent use of well-sounding names which were not trade-names at all, and were used, not to identify the goods to which they were applied with the person applying them, or with any other manufacturer or merchant, but to suggest that they were the manufacture or merchandise of some seemingly respectable firm. Spanish sounding names on pseudo Spanish cigars; "The Sheffield Knife Company," there being no such company, and the trade-names of defunct firms, were cited as examples of such "blind names," as they are called. Sub-sect. 3 (3) (c) seems to have been directed to stop the use of such names as these. It was stated before the Committee of 1890, that the Act had failed in this particular (*a*), but the statement was made under the assumption that the conditions (a), (b), and (c) were all required to be complied with, (b) and (c) not being treated as alternative, as is suggested above. The Committee did not think fit to recommend any alteration of the sub-section. Blind names.

Fictitious.]—The words "a fictitious or non-existing person," in sect. 7 (3) of the Bills of Exchange Act, 1882,

(*x*) Book I., Chap. XVI., p. 394.

(*y*) Cf. as to the meaning of false, p. 488, above.

(*z*) See, for instance, the evidence of Mr. Freeman, M. M. A. Report, 1887, Qq. 2871 *et seq.*; of Mr. Hughes, *Ibid.*, Q. 1805; and Mr. Lockwood, *Ibid.*, Q. 1992.

(*a*) Evidence of Mr. Hughes, M. M. A. Report, 1890, Q. 5011, and Mr. Follett, p. 277.

have been held to apply to a case where the name used, as that of the payee of a forged bill, was the name of an actual person who was known to the acceptor and accustomed to have business dealings with him, but who had not, and was never intended by the drawer to have, any interest in the bill (*b*).

The description of bacon cured by Lipton as "Tracey's cure," where Tracey was Lipton's foreman curer, has been held, in Ireland, to be an offence under sect. 3 (3) (c); although a custom was alleged for bacon dealers to describe their second quality goods by the names of their foremen curers (*bb*). No evidence of the custom was adduced.

Not bonâ fide *carrying on business, &c.*]—The name and initials of a person who is carrying on business in connection with the goods are dealt with under the preceding head, sect. 3 (3) (b).

Provisions of the Act as to false description not to apply in certain cases.

Conventional description.]—By sect. 18—

"Where at the passing of this Act (*c*), a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there" (*d*).

(*b*) *The Governor and Company of the Bank of England* v. *Vagliano Brothers*, (1891) A. C. 107.

(*bb*) *R.* v. *Lipton*, 32 L. R. Ir. 115 (1892), Q. B. D.

(*c*) 23 August, 1887.

(*d*) Cf. page 480, "place or country," and see the Madrid Convention, Art. VI., p. 665.

This general saving with regard to what are commonly called "generic descriptions," but may more accurately be termed "conventional descriptions," seems to have been suggested by a discussion which took place before the Committee of 1887, as to whether the name *Balbriggan hose* was properly applied to hosiery manufactured in Ireland, at Balbriggan only, or to hosiery of the same description made at several places in England, and in particular at Nottingham. It is based upon the fact that descriptions at first applied to, and appropriate for, a group within a class, constantly become used for the whole class, and are at length as appropriate for the rest of it as for the particular group. The case of trade-marks in this way become *publici juris* by piracy, misuse or abandonment, has been several times noticed in the preceding book (*e*). *Liebig's Extract*, *American leather cloth*, *French chalk*, *patent leather*, are examples of conventional descriptions within the section. The question whether an alleged conventional description does indicate the particular class or method of manufacture of the goods, *i.e.*, the kind of goods, is of course a question of fact to be established by evidence. It corresponds to the question whether an alleged trade-mark or trade-name of goods was the symbol or name of any goods of the kind, or the symbol or name of the plaintiff's goods of the kind only, which constantly arose for determination in trade-mark cases before the Registration Acts, and still frequently arises in trade-name and passing off cases (*f*).

It is to be noted that the section only applies to trade descriptions lawfully and generally applied at the passing of the Act.

Lawfully must mean not only so as not to be obnoxious to any then existing trade-name or trade-mark rights, or to particular statutes, such as the Cutlers Acts (*g*), but also so as not to be within the prohibitions of the Merchandise Marks Act of 1862. That Act, however, contained a

(*e*) See Chap. XIV., p. 283.
(*f*) See above, pp. 36 and 404.
(*g*) Below, p. 542.

section (sect. 9) corresponding to sect. 18, but not limited to descriptions in use at the commencement of the Act. Generally applied means, it is submitted, applied by probable purchasers and persons dealing in the goods in question.

In *The Patent Isinglass Case* (*h*), the Court held that a good defence might have been raised under this section upon the finding of the magistrate that the article in question had been known to the trade as patent isinglass, although it was made from cod sounds. But it may be doubted whether such a finding would be sufficient if it were shown that the description deceived the public, although it was understood by the trade (*i*).

4. Causing an Offence to be Committed.

Sect. 2 (1).

"(f) Causes any of the things above in this section mentioned to be done."

Master and servant.

Master and servant.]—"There is nothing in the present Act to alter the general rule of law (*k*) that a master is not criminally responsible for the unauthorized acts of his servants. There are, no doubt, certain Acts of Parliament (*l*), such as the Licensing Acts, which do introduce an exception in that respect into the general rule; but this is not one of those Acts" (*m*). Moreover, the existence of a criminal intent in the person charged is of the essence of an offence under the Act, although the onus of proving that he acted without intent to defraud, or innocently, is cast upon the defendant, and such intent must necessarily be personal.

(*h*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L.C.J., and Grantham, J. See also per Holmes, J., in *R.* v. *Lipton*, p. 498, note (*bb*).

(*i*) See *Ford* v. *Foster*, L. R. 7 Ch. 611, cited p. 37, and above, pp. 285, 286. And see *Hooper* v. *Balfour*, W. N. (1890) 61, 139, cited *ante*, p. 480, under "weight."

(*k*) *Chisholm* v. *Doulton*, 22 Q. B. D. 736 (1889), Field and Cave, JJ., a case on the Smoke Nuisances Act.

(*l*) For instance, the Food and Drugs Act, 1875. *Pain* v. *Boughtwood*, 24 Q. B. D. 353; *Brown* v. *Foot*, 61 L. J. M. C. 110; but, query, as to the master's liability if the act is in contravention of his instructions. *Newman* v. *Jones*, 17 Q. B. D. 132; *Kearley* v. *Tonge*, 60 L. J. M. C. 159. And the Adulteration Act, 6 & 7 Will. 4, c. 37; *Core* v. *James*, 7 L. R. 7 Q. B. 135.

(*m*) *Per* Pollock, B., in *Budd* v. *Lucas*, (1891) 1 Q. B. 408.

By sect. 19 (3)—

"Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master."

It seems an obvious inference from this section and from sect. 6 (*n*), relating to persons employed by others in the ordinary course of business, that servants and persons employed who do not come within the terms of the sections are to be liable for acts done in obedience to the instructions of their masters or employers (though they may, of course, be able to show that they acted without intent to defraud, or innocently). And this accords with the ordinary law that every person who either actually does, or authorizes, or procures to be done, a criminal act is guilty of the crime (*o*).

Thus, under the Pharmacy Act, 1868 (*p*), an unregistered chemist's assistant has been held liable to penalties for selling poisons on behalf of his master who was himself duly registered.

Both sect. 19 (3) and sect. 6 are restricted to cases of masters or employers resident in the United Kingdom.

Bonâ fide.]—It is difficult to attach any definite meaning to this expression in the section. It can hardly be construed to import the requirements of reasonable precaution, and having no reason to suspect the genuineness of the trade-mark or trade description, expressed in sect. 6 (b) and (c). It may mean without knowledge of the illegal character of the act, or merely that the person excepted has in reality, and not colourably only, acted as a servant and in obedience to his master's instructions. The last meaning suggested, however, would make the words mere surplusage.

(*n*) See next page.

(*o*) See Archbold, 21st ed. p. 9; and sect. 11, below, p. 504.

(*p*) 31 & 32 Vict. c. 121, s. 15. *The Pharmaceutical Society* v. *Wheeldon*, 24 Q. B. D. 683 (1890), Div. Court. An action for penalties.

On demand has given full information.]—Compare sect. 2 (2) (b), (*q*), and sect. 6 (d).

Persons employed.]—By sect. 6—

Exemption of certain persons employed in ordinary course of business.

"Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade-mark, or with falsely applying to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

"(a) That in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade-marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

"(b) That he took reasonable precautions against committing the offence charged; and

"(c) That he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade-mark, mark, or trade description; and

"(d) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade-mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence."

This section appears, in effect, to offer to any person charged with either of the offences mentioned in it the alternative of satisfying the four requirements specified in it, or of proving that he acted without intent to defraud within the meaning of sect. 2 (1) (*r*). It is probable that

(*q*) Page 512, below. (*r*) *Infra*, p. 307, "intent to defraud."

the latter will usually be the easier course, and it is submitted, although with some doubt, that in judging whether the defendant has acted without intent to defraud, the fact that he has not acted as the section indicates,—for instance, has taken no precautions,—is not to be regarded where he shows that he did not know, believe, or suspect, that the mark or description in question was forged, or false, or falsely applied.

The Bleachers' protest.

Much evidence was given before the Committee of 1887 on behalf of the Association of Bleachers, whose members are accustomed in the ordinary course of their business to mark trade-marks and descriptions upon goods, and to pack the goods according to their customers' orders, to show that from the enormous number of the marks (s) and descriptions employed in the textile trade, and the fact that many contain words in Oriental languages with which the bleachers are not acquainted, it would be a great hardship to cast upon them the duty of verifying the title to, and the genuineness of every mark furnished to them by their customers. The association presented a memorial to the chairman of the Committee protesting against the Bill under their consideration in its then form, and suggested for insertion into it a section nearly corresponding to the present section, but without the modifications (b), (c), and (d). The section was, no doubt, based upon these representations and proposals (*t*).

Clauses 2 (1) (a) (forges any trade-mark), and 2 (1) (e) (disposes of or has in his possession any die, &c. for the purpose of forging a trade-mark) are omitted from the section, and so also is sub-sect. 2 (2) (exposing, &c. for sale goods to which a forged trade-mark, &c. has been applied).

The first condition (a) is triple, so that the person charged must prove in all six propositions to bring himself within the section.

(s) 60,000 cotton marks were registered as trade-marks before 1887. There were probably many more unregistered, but in use.

(*t*) M. M. A. Report, 1687, pp. 254, 266.

Precautions:—Information.]—Clauses (b) and (c) correspond to clause (a) of sect. 2 (2); clause (d) to clause (b) of sect. 2 (2), (*u*), except that the words "on demand made by or on behalf of the prosecutor" are there inserted. Under the present section, it seems, the party charged must volunteer the information if it is not demanded, but, on the other hand, he can give it at any time down to the hearing of the charge.

Penalty.]—Compare sect. 14 (*x*). This penalty is omitted from sect. 2 (2), because the information there referred to must be given on demand as a condition of the special defence allowed by the sub-section.

Accessories.

Accessories.]—The offences dealt with by the Act are all misdemeanours, and there are, accordingly, no accessories to them. The provision of the Act of 1862 (sect. 13) making every person who shall aid, abet, counsel, or procure the commission of an offence under the Act guilty of a misdemeanour, has not been introduced into the present Act, and any such person can, consequently, only be convicted of an offence if he has committed it as a principal under sect. 2 (1) (f) (causes any of the things above in this section mentioned to be done), or under one of the special headings. Sect. 11, set out below, is not directed to the punishment of accessories generally, as the side-note wrongly suggests, but to the punishment of offences committed abroad.

Offences committed abroad.]—By sect. 11—

Punishment of accessories [to offences committed abroad].

"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

(*u*) See below, pp. 509, 511.

(*x*) Page 518, below. Similar penalties as to costs are imposed by the Margarine Act, 50 & 51 Vict. c. 29, s. 7, and the Sale of Food and Drugs Act, 38 & 39 Vict. c. 63, s. 25.

"convicted in any county or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed."

The side-note to this section in the Queen's Printers' copy (punishment of accessories) is misleading. The section is directed to meet offences committed abroad by persons in the United Kingdom. In general, offenders can only be prosecuted in the counties or districts where their offences were committed (*y*), and penal Acts are to be read, if possible, as not creating any offence to be committed outside the country for which they are enacted (*z*).

The civil courts will interfere by injunction to prevent steps being taken, or anything done within the jurisdiction, with a view to, or for the purpose of, infringing the plaintiff's trade-mark, or passing off goods as his abroad (*a*).

5. Defences under Sect. 2 (1).

The sub-section concludes with the words "shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act."

The provisions of the Act referred to are sect. 6 (*b*) (persons employed); sect. 13 (*c*) (vexatious indictments); sect. 15 (*d*) (limitation for prosecutions); and sect. 19 (3) (*e*) (servants acting under their masters' orders).

Unless he proves (*f*).]—The policy of the Act is, when once it has been established that a trade-mark has been Proof of innocence.

(*y*) See Archbold, Ch. 1, sect. 3. There are many exceptions by statute. See, in particular, as regards the places mentioned in the list at p. 657, 53 & 54 Vict. c. 37.

(*z*) *Macleod* v. *Att.-Gen. for New South Wales*, (1891) A. C. 455.

(*a*) *Rodgers and Son, Ld.* v. *Rottgen*, 5 T. L. R. 678 (1889), Kay, J.; *Société Anonyme des Verriers de l'Etoile's Tm.*, (1894) 1 Ch. 61; W. N. (1894) p. 42; 10 R. P. C. 200, 436, 11 R. P. C. 142, Stirling, J., and C. A.

(*b*) Page 502.

(*c*) Page 517.

(*d*) Page 517.

(*e*) Page 500.

(*f*) Cf. the second part of sect. (2), p. 511, and the Food and Drugs Act, 1875, 38 & 39 Vict. c. 63, s. 24, by which, if a defendant relies on any provision or exception in the Act, he must prove that he falls within it.

Proof of innocence.

made without the assent of the proprietor, or that a false description has been applied to goods, or that goods to which a forged trade-mark has been applied have been sold by the person charged, or any other thing done which, if done with such a criminal intent as is contemplated by the Act, would be an offence, to cast upon the person charged the onus of disproving the existence of such intent, and this is carried further by casting upon him also the onus of proving the assent of the proprietor (*g*), where that is material. Great stress was laid upon this feature of the Act when the bills upon which the Act was founded were before the Committee of 1887, as the almost total failure of the Act of 1862 was believed to be due to the necessity for the prosecutor in prosecutions under it to prove the intent to defraud (*h*). There are now upon the statute book a good many Acts by which the onus of proof of justification or excuse is cast on the person charged (*i*). For instance, the application of any of the marks scheduled to the Public Stores Act, 1875 (*j*), without authority (proof of which authority lies on the party accused), is a misdemeanour; and so is being found at night having in possession house-breaking implements without lawful excuse (proof of which excuse lies on the party charged) (*k*). Purchasing, or receiving, or having in possession forged bank-notes or bills, knowing them to be forged (*l*), and making or having in possession coining tools (*m*) without lawful authority (the proof of which authority lies on the party accused), are felonies. The Sale of Food and

(*g*) Sect. 4 (2); sect. 5 (3). Proof of the authority required under sect. 3 (3) (b) is not thrown on the person charged.

(*h*) M. M. A. Report, 1887. See the evidence of Messrs. Hughes, Lockwood, and Uttley. The Committee of 1862 were strongly urged to report in favour of the insertion of similar provisions as to the onus of proof in the Act of that year, but they declined to do so. M. M. A. Report, 1862, evidence of J. T. Smith, Q. 2643.

(*i*) See a paper by Mr. J. T. Smith in M. M. A. Report, 1862, p. 162.

(*j*) 38 & 39 Vict. c. 25, s. 4.

(*k*) 24 & 25 Vict. c. 96, s. 58.

(*l*) 24 & 25 Vict. c. 98, s. 13.

(*m*) 24 & 25 Vict. c. 99, s. 24.

Drugs Act, 1875 (*n*), and the Margarine Act, 1887, are other instances (*o*).

And by the common law, wherever the act charged is not indifferent, but in itself unlawful, the proof of justification or excuse in such case lies on the defendant, and on failure thereof, the law implies a criminal intent (*p*).

Intent to defraud.

Intent to defraud.]—This does not mean intent to defraud any particular person (*q*). So that an offence may be committed, although precautions are taken to prevent the immediate purchaser from the person charged being deceived, as, for example, by adding to a false trade description upon a covering a label which bears the name of the person whose manufacture or merchandise the goods within the covering really are, or which is otherwise explanatory, for the label may be intended to be removed, and the goods passed on to the ultimate purchasers with the false trade description unqualified (*r*).

The provision of the Act of 1862, s. 12, that, where in proceedings in respect of an offence under that Act it should be necessary to allege or mention an intent to defraud, it should not be necessary to allege or prove an intent to defraud any particular person (*s*), has not been reproduced, probably because the onus of proof has, in the present Act, been shifted to the person charged. It appears that the absence of the provision makes no difference to the effect of the Act.

(*n*) See sects. 5 and 8. *Betts* v. *Armstead*, 20 Q. B. D. 771.

(*o*) Cf. also the presumption of guilty knowledge from evidence of possession of recently stolen goods. Archbold, 21st ed. p. 275.

(*p*) *Per* Lord Mansfield, *R.* v. *Woodfall*, 5 Burr. 2667, note (*i*), *supra*.

(*q*) *Wood* v. *Burgess*, *infra*. Cf. forging a trade-mark, above, p. 469, n.

(*r*) *Wood* v. *Burgess*, 24 Q. B. D. 162 (1889), Coleridge, L.C.J., and Mathew, J., a case under sect. 2 (2). And cf. "so nearly resembling," sect. 4 (a), *ante*, p. 471, and "calculated to lead," sect. 3 (2), above, p. 493; and the civil law rule, above, pp. 187, 322, and *Lever* v. *Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A.

(*s*) Similar sections occur in 24 & 25 Vict. c. 98, s. 44 (forgery), 24 & 25 Vict. c. 96, s. 88 (false pretences), and 24 & 25 Vict. c. 97, s. 58 (malicious injuries to property).

"The words 'intent to defraud' in this Act mean more than an intent to cheat a customer." They apply to cases "where a person uses a particular mark without any intent in so doing to induce a buyer to accept goods which might otherwise be rejected (*t*). And in a case where the offence consisted in English manufacturers placing their name on goods manufactured by other persons, but equal in quality to their own (*t*), Coleridge, L.C.J., said: "In the present case all further controversy is superfluous when once one has ascertained with certainty what *fraud* means in the Act. I agree that if the word is used in the sense of putting off a bad article on a customer in order to get money unfairly, there is no evidence here of anything of the kind having been done. On the contrary, it is expressly found that the article supplied was as good as that contracted for. But that, I think, is not the correct meaning of the word *fraud* as used in this Act of Parliament. The Act is directed against the abuse of trade-marks, and the putting off on a purchaser of not a bad article, but an article different from that which he intended to purchase and believes he is purchasing. It would apply to cases where a particular article, manufactured by a particular person, had acquired a wide-spread reputation (as, for instance, happened in the celebrated case of the fish sauces (*u*)), and some one supplied another and a different article under that name, so as to make the purchaser take something which he did not know he was taking."

On the other hand, the Act does not apply to mere cases of inaccurate or mistaken descriptions. The charges under it are criminal charges, and, according to the ordinary rule, a criminal intent—a *mens rea* in the person charged—must be made out (*v*).

(*t*) *Per* Muthow, J., in *Starey* v. *Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889).

(*u*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675, cited p. 423.

(*v*) *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L.C.J., and Grantham, J.; *Budd* v. *Lucas*, (1891) 1 Q. B. 408.

Giving information.

Reasonable precautions.—Giving information.]—Where special defences are provided by the Act, in sect. 2 (2) (a) and (b) (*x*), and sect. 6 (*y*), the matters to be proved by the person charged include, that he took all reasonable precautions against committing an offence against the Act, and that he gave all the information in his power (*z*) with respect to the persons from whom he obtained the marked goods, or the person on whose behalf the mark or description in question was applied. No doubt it was intended by the draughtsmen of the Act to make these matters tests of innocent conduct on all charges under the Act, but it is submitted that the provisions respecting them cannot be imported into sections, as the above section, where they are not expressed. If this is so, the most ordinary evidence to show that the party charged acted without intent to defraud, or "otherwise innocently" (*a*), will be evidence of ignorance of the facts on which the charge is based: for instance, evidence that he did not know or suspect that the mark forged was a trade-mark; that the goods to which the trade description was applied were not the goods described; or evidence that he believed he had the assent or authority of the proprietor of the trade-mark in question to apply it.

Evidence of the defendant and his wife.

Evidence of the defendant.]—By sect. 10 (1) (in any prosecution for an offence against this Act)—

> "A defendant, and his wife, or her husband, as the case may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness."

Rebutting evidence.]—If the person charged gives, or calls evidence to show that he acted without intent to defraud, the prosecutor may give rebutting evidence, and, in particular, evidence of transactions similar to the offence

(*x*) Below, p. 511.
(*y*) Above, p. 501.
(*z*) See also sect. 19 (3), above, p. 504.
(*a*) Sect. 2 (2) (c), *infra*, p. 511.

charged, in which the person charged was concerned, and antecedent (but, it is said, not subsequent (*b*)) to that offence (*c*).

6. Sale or Possession of Falsely-Marked Goods.

Sub-sect. 2 (2) provides that—

"Every person (*d*) 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 (*e*) or false trade description (*f*) is applied (*g*), or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied (*h*), as the case may be, shall" (unless he establishes one of specified defences (*i*)) "be guilty of an offence against this Act."

Cases where possession or sale is an offence *primâ facie*.

Some other cases where possession is made an offence *primâ facie*, are collected at p. 506. Imitating the mark of the Birmingham Proof House for gun barrels, or knowingly selling any barrel bearing an imitation of such mark (*k*); marking the mark of a hammer on cutlery not made of hammered steel, or having in possession for the purposes of sale articles so marked; marking cutlery, or having in possession for sale cutlery marked, with a false indication of quality, or with the words *London* or *London made*, unless the cutlery were manufactured in the city of London (*l*), or within twenty miles thereof, are misdemeanours.

By the Margarine Act, 1887 (*m*), s. 6, it is provided that

(*b*) *R.* v. *Holt*, 30 L. J. M. C. 11.

(*c*) *Budd* v. *Lucas*, (1891) 1 Q. B. 408, Pollock, B., and Charles, J. Evidence of previous short deliveries. *R.* v. *Francis*, L. R. 2 C. C. R. 128, a case of false pretences. See Archbold, 21st ed. p. 251.

(*d*) Page 463.

(*e*) Pages 465, 468.

(*f*) Pages 476, 487.

(*g*) Page 473.

(*h*) Page 474.

(*i*) See next page.

(*k*) 53 Geo. 3, c. 115.

(*l*) 59 Geo. 3, c. 7. See a paper by Mr. J. T. Smith, M. M A. Report, 1862, p. 162.

(*m*) 50 & 51 Vict. c. 29.

every package, whether open or closed, and containing margarine, shall be branded or marked in a certain way, and that "if such margarine be exposed for sale, by retail, there shall be attached to each parcel thereof so exposed, and in such manner as to be clearly visible to the purchaser" a specified label. It has been held that a parcel of margarine placed behind a screen out of the sight of purchasers in a shop, and from which portions were cut for sale to them, is not (*n*), but that parcels done up in wrappers and placed in the shop so that the wrappers, but not the margarine itself, could be seen by purchasers, are, "exposed for sale" within the meaning of this section (*o*).

7. Defences under Sect. 2 (2).

Sub-sect. (2) declares the person charged, if he falls within the earlier part of the sub-section, to be guilty of an offence against the Act—

"Unless he proves—

"(a) That having taken all reasonable precautions 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 (*p*) 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 (*q*); or

"(c) That otherwise he had acted innocently."

The onus of establishing the innocence of any person charged, whose case is shown to fall within the earlier part of the section, is, therefore, as under the corresponding

(*n*) *Crane* v. *Laurence*, 25 Q. B. D. 152 (1890), Cave and Smith, JJ.

(*o*) *Wheat* v. *Brown*, (1892) 1 Q. B. 418, Lawrance and Wright, JJ.

(*p*) Page 509. Cf. sect. 6 (c), p. 502, and sect. 17, p. 431, and also "false," p. 488.

(*q*) Pages 504, 509, and 512.

sub-sect. (1) (*s*), already considered, cast upon the person charged.

The special defences (a) and (b) correspond to (b), (c), and (d) of sect. 6 (*t*), except that the information here referred to is to be given on demand, and in sect. 6 there is a special provision as to costs, which does not occur here. Rebutting evidence may be given by the prosecution to displace these defences (*u*).

Gave all the information.]—In the evidence given before the Committees of 1862 and 1887, great stress was laid upon the importance of compelling retail traders and others found in possession of spurious goods, or found offering them for sale, to give such information as should lead to the discovery of the real, or the original, offenders. For frauds by false marking can usually only be detected when the goods are offered to the general public, and the goods are then in the hands of persons who are, or may be, or may speciously pretend to be, innocent of the frauds. Mr. Hindmarch, Q.C., the draughtsman of the Act of 1862, described the provisions for disclosure as of the essence of the bill upon which the Act was founded (*x*).

Provision for disclosure in the M. M. A., 1862.

By sect. 6 of the last-mentioned Act (*y*), a person who sold, &c. any article together with a forged trade-mark, &c., was bound, upon demand in writing, by or on behalf of the persons whose trade-mark was forged, &c., and within twenty-four hours after the demand, to give full information in writing of the name and address of the person from whom, and the time when, he obtained the article. And any justice of the peace might order such information to be given. Refusal or neglect to comply with the order was punishable by a penalty of 5*l.*, and was *primâ facie* evidence of guilty knowledge at the time when he sold the article, on the part of the person refusing or neglecting.

(*s*) Page 505.
(*t*) Page 502.
(*u*) Page 509.
(*x*) M. M. A. Report, 1862, Q. 2865.
(*y*) 25 & 26 Viet. c. 88. The section is much abbreviated.

There is no provision in the present Act corresponding to this and enabling an order for disclosure to be made, or making refusal or neglect to give information evidence of guilty knowledge or intent. Proof that the person charged has given all the information in his power is made a term of the special defences under sect. 2 (2) (b), and sect. 6 (d), and under sect. 14 the Court, upon a prosecution, in making an order for costs, may have regard to the information given by, and the conduct of, the defendant and prosecutor respectively; but it is quite conceivable that a defendant might refuse to give information with impunity, except as to payment of costs, and secure an acquittal under the general defences of sect. 2 (1) (without intent to defraud), or sect. 2 (2) (c) (acted innocently). In a civil action against him, based upon the same offences, the person charged could, of course, be compelled to make the disclosure on "discovery," if it were relevant to the issues raised.

(c) *That otherwise he had acted innocently.*]—Compare "without intent to defraud," above, p. 507. Whether the defendant tenders evidence or not, and whether any of the special defences sanctioned by the Act is set up or not, the Court must, in order to convict, be satisfied that he acted with a criminal intent in doing the acts complained of (z).

8. Punishment.

By sect. 2 (3) and (4)—

"(3.) Every person guilty of an offence against this Act shall be liable—

Fine and imprisonment.

"(i.) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and

"(ii.) on summary conviction to imprisonment, with or without hard labour, for a term not exceed-

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

"ing 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

Forfeiture of the goods.

"(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."

Forfeiture and destruction (*a*).]—Sect. 21 of the Act of 1862 authorized the Court in any suit at law or in equity for forging a trade-mark, &c., to order the goods bearing the spurious marks to be destroyed; and the various sections of the Act imposing penalties contained provisions for forfeiture and destruction to the same effect as the sections set out above.

It has been shown in the earlier part of the book that the Court of Chancery would have interfered, and now the High Court of Justice interferes, independently of sect. 21 of the Act of 1862, to order the destruction of spuriously marked articles, but that if the marks can be completely removed, the Court permits this to be done without requiring the articles to be destroyed (*b*).

9. Prosecution.

By sect. 2—

"(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may

(*a*) Cf. sect. 12 (3), p. 521, by which compensation for loss may be awarded to an innocent party out of the proceeds of forfeited goods. And as to forfeiture on importation, see sect. 16, p. 526.

(*b*) Book I., Chap. XV., p. 537. *Slazenger & Sons* v. *Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

"be prosecuted, and any articles liable to be forfeited under this Act by a Court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts (*c*): Provided that a person charged with an offence under this section before a Court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly."

The Court in Scotland is the Sheriff Court (*d*), and the Summary Jurisdiction Acts there mean the Summary Procedure Act, 1864, and any Acts amending the same (*d*). In Dublin, the Summary Jurisdiction Acts are the Acts regulating the powers and duties of justices of the peace for the police district of Dublin metropolis, and, as regards the rest of Ireland, the "Summary Jurisdiction Acts" means the Petty Sessions (Ireland) Act, 1851, and any Act amending the same. The "Court of summary jurisdiction" means justices acting under those Acts (*e*).

Indictment and information.]—For forms of these, see the Appendix, p. 708.

Official prosecutions.]—It is provided by sect. 2 of the M. M. A. 1891, that—

Official prosecutions.

"2.—(1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the Merchandise Marks Act, 1887, shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament.

(*c*) 42 & 43 Vict. c. 49.

(*d*) Sect. 21.

(*e*) Sect. 22. The compromise of a prosecution is, it seems, not improper. See *Fisher* v. *Apollinaris Co.*, 10 L. R. Ch. 297 (1875), L.JJ.

"(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of her Majesty's Stationery Office.

"(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations."

This provision was made upon the recommendation of the Committee of 1890.

The regulations made by the Board of Trade under the Act (*f*) are set out in the Appendix, p. 707. The fifth of such regulations provides that the Board may, before undertaking a prosecution at the instance of any applicant, require the applicant to give security for costs on such terms and in such manner as it thinks proper.

Right to be tried by indictment.]—If notice of this right be not given to the person charged on his appearing in Court, and before the charge is gone into, the proceedings are invalid (*g*). This was so held in a case under sect. 17 of the Summary Jurisdiction Act, 1879, by which a similar duty of informing a defendant, charged with one of the offences included under the section, of his right to be tried by a jury is cast upon the court of summary jurisdiction (*h*).

(*f*) 21 May, 1892. A list of the prosecutions instituted by the Board of Trade is given in Appendix M. to the Report of the Lords' Committee on Marking of Foreign Meat, 1893, from which it appears that down to April, 1893, nine prosecutions had been instituted, and four convictions obtained.

(*g*) Cf. 38 & 39 Vict. c. 63, s. 14, under which it is a condition precedent to the right of the purchaser of adulterated goods to take proceedings, that he should have given the seller notice of his intention to have the goods analysed. *Parsons* v. *Birmingham Dairy Co.*, 9 Q. B. D. 172 (1882), Div. Court. See also *Carle* v. *Elkington*, 40 W. R. 510.

(*h*) *Re Holeton*, *Times* Newspaper, 29 June, 1885; Stone's Justices' Manual, 23rd ed. p. 508.

There are numerous special Acts comprising corresponding provisions (*i*).

Limitation of prosecutions.]—By sect. 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."

Sect. 18 of the Act of 1862 was to the same effect. The ordinary period of limitation upon the summary prosecution of offences is six months (*k*).

A question may arise as to whether the above section applies to a prosecution for the special offences created by sect. 8 or sect. 20 of the Act (*l*), since the phrase "an offence against this Act" which occurs in it, is taken from sect. 2, and does not occur in those sections. It is submitted that sect. 15 does not apply, and that, accordingly, the ordinary rule of six months' limitation holds for prosecutions under sect. 8 or sect. 20.

Vexatious Indictments Act.]—By sect. 13—

"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' (*m*), shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland."

The effect of this is, that no bill of indictment can be presented to, or found by, any grand jury for an offence under the Act, unless either the prosecutor has been bound over to prosecute or give evidence; or the person charged has been committed to or detained in custody, or has been

(*i*) See Glen's Summary Jurisdiction Acts, 6th ed. p. 126.

(*k*) Summary Jurisdiction Act, 1848, sect. 11; Stone's Justices' Manual, p. 31; Glen, pp. 39, 45.

(*l*) Sect. 8 (3) (false declaration as to watch). Sect. 20 (pretended royal warrant).

(*m*) 22 & 23 Vict. c. 17.

bound over to answer an indictment for the offence; or the indictment is preferred with the consent of a judge, the attorney-general, or the solicitor-general. And where a justice refuses to commit, or to hold to bail a person charged with an indictable offence under the Act to be tried for the same, the justice may, and must at the desire of the prosecutor, take the recognizance of the prosecutor to prosecute and transmit the recognizance, information, and depositions, if any, to the Court in which the indictment ought to be preferred, in the same manner as if he had committed the person charged for trial (*n*).

Costs.

By sect. 14—

"On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information (*o*) given by and the conduct of the defendant and prosecutor respectively."

This is subject to the special rule of sect. 6 (*p*), where the defence allowed by that section is set up.

The section gives the Court unlimited jurisdiction over the costs, without reference to the result of the prosecution, except so far as this is made a subject for consideration by the reference to conduct. It may be compared with Ord. 65, r. 1 (*q*), and sect. 5 of the Judicature Act, 1890, which deal with the costs of civil proceedings (*r*). Under Ord. 65, r. 1, it is held that a lump sum, assessed by the Court, may be awarded as costs (*s*); that a successful plaintiff may be ordered to pay the costs of the action (*t*); but that the defendant cannot be ordered to pay them

(*n*) Stone's Justices' Manual, 23rd ed. p. 549.

(*o*) See above, p. 512, "information."

(*p*) Above, p. 501.

(*q*) See the note to this in the Annual Practice, from which the cases next cited are taken.

(*r*) As to costs in actions for infringement, see Book I. Chap. XV. p. 364.

(*s*) *Willmott* v. *Barber*, 17 C. D. p. 774.

(*t*) *Harris* v. *Petherick*, 4 Q. B. D. 611; *Fane* v. *Fane*, 13 C. D. 228.

where the plaintiff had no cause of action (*u*). The discretion must, of course, be exercised judicially and on fixed principles of general application (*x*).

The ordinary rule as to the costs of summary proceedings is, that if a conviction or order is made, the justices may order the defendant to pay to the prosecutor or complainant, and if the information or complaint is dismissed, the prosecutor or complainant to pay to the defendant, such costs as they think just and reasonable (*y*).

Where a fine ordered to be paid on a conviction by a court of summary jurisdiction does not exceed five shillings, then, except so far as the Court may think fit to expressly order otherwise, an order shall not be made for payment by the defendant to the informant of any costs, and the Court shall, except so far as they think fit to expressly order otherwise, direct all fees payable or paid by the informant to be remitted or repaid to him; the Court may also order the fine or any part thereof to be paid to the informant in or towards the payment of his costs (*z*).

Under sect. 12 (3) (*a*) compensation may be awarded to an innocent party out of the proceeds realized from forfeited goods for any loss sustained by him in dealing with such goods.

Appeal.

By sect. 2 (5)—

> "If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions."

The appeal will be governed by sect. 31 of the Summary

(*u*) *Dicks* v. *Yates*, 18 C. D. 76; *Foster* v. *G. W. Ry. Co.*, 8 Q. B. D. 515.

(*x*) *Cooper* v. *Whittingham*, 15 C. D. 501; *Jones* v. *Curling*, 13 Q. B. D. 265; *The Monkseaton*, 14 P. D. 51. And see the trade-mark cases *Upmann* v. *Forrester*, 24 C. D. 231, and the *American Tobacco Co.* v. *Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, cited above, pp. 364, 366.

(*y*) Summary Jurisdiction Act, 1848, sect. 18; Stone's Justices' Manual, 23rd ed. p. 61.

(*z*) Summary Jurisdiction Act, 1879, sect. 8.

(*a*) Page 521, below.

Jurisdiction Act, 1879, and the provisions of that section must be complied with (*b*).

The decision of justices upon any point of law, or if it is alleged to be in excess of jurisdiction, may also be questioned by requiring the justices to state a case for the determination of the Queen's Bench Division (*c*); an order or conviction made by them without jurisdiction may be quashed upon a *certiorari* (*d*); and if they have refused to hear and determine a case in which they have jurisdiction they may be ordered to do so by *mandamus* (*d*).

Saving of other Proceedings.

By sect. 19 (1) and (2)—

"(1.) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

"(2.) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act (*dd*)."

Search Warrant.

By sect. 12—

Where a prosecution is pending.

"(1.) Where, upon information of an offence against this Act (*e*), 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

(*b*) See Glen's Summary Jurisdiction Acts, 6th ed. p. 148; Stone's Justices' Manual, 23rd ed. p. 645.

(*c*) 20 & 21 Vict. c. 43, s. 3; 42 & 43 Vict. c. 49, s. 33. The statement of the case must be requested in writing within seven days of the date of the proceeding to be questioned. S. J. Rule 17; Stone, p. 79.

(*d*) See Stone, p. 645. See Shortt and Mellor's Crown Office Practice.

(*dd*) Cf. sect. 23, by which rights, penalties, &c. under the M. M. A. 1862 are saved.

(*e*) Sect. 2 (1) and (2), p. 462.

"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 (*f*) under this Act (*g*).

Where the owner of the goods cannot be found.

"(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

Disposal of forfeitures, compensation

"(3.) Any goods or things forfeited under this section, or under any other provision of this Act (*f*),

(*f*) See sect. 2 (3) (iii), p. 514.

(*g*) As to search warrants generally, see Glen's Summary Jurisdiction Acts, 6th ed., p. 302, where a list of the numerous Acts authorizing the granting of them is given.

to innocent party.

"may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct, and the Court may, out of any proceeds which may be realized by the disposition of such goods (all trade-marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods."

Forfeiture without conviction.]—An offence against the Act comprises two distinct elements: first, the doing of one of the specified acts, for instance, making a trade-mark without the assent of the proprietor, applying a false trade description to goods, or having in possession for sale any goods to which a forged trade-mark is applied; and, secondly, doing this with intent to defraud, or not innocently, and without any of the special defences mentioned in the Act. The existence of the first element can be ascertained from the chattel, article, instrument, or thing by means of, or in relation to which the offence (*h*), if committed at all, has been committed; but the existence of the second can only be established in relation to the conduct of a particular person, here referred to generally as "the owner" of the goods or things. The Act, however, in almost all cases casts the onus of establishing that he acted without intent to defraud, or otherwise innocently, or a special defence upon the person charged, and in the absence of any evidence by "the owner," for the purpose of forfeiting the goods under the section, evidence supplied by inspection of the goods themselves, or otherwise given in relation to them, and the marks applied to them will be sufficient (*i*).

Marks on Watch Cases.

By sect. 7—

Application of the Act to watches.

"Where a watch case has thereon any words or marks which constitute, or are by common repute (*k*)

(*h*) Sect. 2 (3) (iii.), p. 514.
(*i*) Cf. sect. 16, below, p. 531, "such goods."
(*k*) Cf. "custom of the trade," in sect. 3 (1), *ante*, p. 485.

"considered as constituting, a description of the country (*l*) in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *primâ 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 (*m*), 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 (*m*), 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 (*n*)."

Gold or silver watch cases, whether of British make or imported into Great Britain, are required to be stamped with assay marks, of which the most important are the hall-marks, showing the standard of purity of the metal (*o*). Evidence was adduced before the Committee of 1887 to show that the English hall-mark upon a watch case containing a foreign movement was understood by buyers to be an indication that the movement was of English make, and further, that the introduction of the letter *F* into the hall-marks put upon imported watch cases, which had been provided for by the Customs Tariff Act, 1876 (*p*), was not sufficient to enable buyers to distinguish foreign from English-made cases. The section set out above, and sect. 8 of the Act, were accordingly introduced for the purpose of preventing the assay marks from leading, or being used to lead, to deception (*q*). It is said that the provisions have been successful, and have proved highly beneficial to the English watch trades (*q*).

(*l*) See sect. 3 (1), "place or country," p. 480.

(*m*) Sect. 2 (2).

(*n*) *i.e.* The "movement."

(*o*) The statutes are very numerous. See Appendix, p. 711.

(*p*) 39 & 40 Vict. c. 35, s. 1, amended by the Revenue Act, 1883, 46 & 47 Vict. c. 55, s. 10.

(*q*) See "Watches" in the indexes to the M. M. A. Reports, 1887 and 1890.

On examination, sect. 7 appears to be a special case falling within provisions elsewhere contained in the Act, for words or marks which constitute, or are by common repute considered as constituting a description of the country in which the movement was made, marked upon the case would seem to be a "trade description" within sect. 3 (1) (*r*) "applied to" the whole watch within sect. 5 (*s*), and if the movement has not, in fact, been made in the country indicated by the description, the trade description is false within sect. 3 (1) (*t*). This is another instance of overlapping, of which several cases occur in the Act. It is submitted that the construction of the wider general provisions ought not to be affected, in regard to watches, by the presence of the narrower special section here referred to (*u*).

The section applies only where the double condition that the watch case has upon it words or marks which constitute, or are by common repute considered as constituting a description, of the country where the movement was made, and that the movement bears no description of the country where it was made, is fulfilled. It does not, therefore, extend to the sale of a watch in a case marked so as to indicate that the movement was made in any country other than that where it was, in fact, made, if the movement itself is marked with a description of the country in which it was made, although a purchaser who did not notice or appreciate the conflict between the marks, might be misled by the mark on the case. But any such sale would, it is submitted, fall within the general provisions dealing with false trade descriptions of the Act.

Movements partly made abroad.

Description of the country where it was made.]—It is often difficult to say what country is the country where a movement was made, since almost, if not quite, all English movements contain foreign made parts, for instance, the chain, hair spring, and regulator, and sometimes foreign-

(*r*) Page 476.
(*s*) Page 473.
(*t*) Page 487.
(*u*) Cf. p. 492.

made movements are imported in the rough and are finished in England. In regard to the former case there was a general, but not unanimous, agreement among the expert witnesses called before the Committee of 1887 that, at any rate, if the foreign-made parts are only those mentioned, the movement may fairly be described as English made, but in regard to the latter there was a decided difference of opinion (*x*). This difficulty has already been referred to in considering what is meant by "false in a material respect" (*y*). It must be solved in each case according to the view the Court takes, having regard to such usages of the trade as are proved to exist, and as can be supposed to be familiar to the ultimate buyers.

Primâ facie be deemed.]—It is impossible to attach any sensible meaning to the words *primâ facie* in this section. They were probably intended only to enable the person charged to show that the words or marks in question do not constitute, and are not by common repute considered as constituting a description of the country in which the movement was made, as alleged, but for this they are both unnecessary and inappropriate.

Marking watch cases.]—By sect. 8—

"(1.) Every person (*z*) who after the date (*a*) 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

(*x*) See "Watches" in the index to M. M. A. Report, 1887.

(*y*) Above, p. 483. See also "place or country," p. 482, and sect. 18, p. 498.

(*z*) Sect. 3 (1), p. 463, "person."

(*a*) 28 Nov. 1887; *London Gazette*, 9 Dec. 1887.

"in such a mode as may be from time to time directed by Order in Council.

"(2.) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorized to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

"(3.) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence" (*b*).

See sect. 7, above, p. 522. The Order in Council is printed in the Appendix, p. 707.

The section is only directed to secure that foreign made cases shall bear a distinctive mark. It does not prevent English movements being put into foreign cases, or foreign movements into English cases.

Watches and clocks.

Importation of marked watches.]—By sect. 42 of the Customs Act, 1876 (*c*), the importation of clocks and watches, or any other article of metal impressed with any mark or stamp representing, or in imitation of, any legal British assay, mark, or stamp, or purporting by any mark or appearance to be of the manufacture of the United Kingdom, is prohibited.

10. Prohibition on Importation.

By sect. 16 (*d*)—

"Whereas it is expedient to make further provision for prohibiting the importation of goods which, if

(*b*) See sect. 15, p. 517, "limitation."

(*c*) 39 & 40 Vict. c. 36.

(*d*) The sub-sections are badly arranged. (4) should have been placed second.

"sold, would be liable to forfeiture under this Act; be it therefore enacted as follows:

"(1.) All such goods, and also all goods of foreign manufacture bearing any name or trade-mark being or purporting (*e*) to be the name or trade-mark of any manufacturer, dealer, or trader in the United Kingdom, unless such name or trade-mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section (*f*), shall be included among goods prohibited to be imported as if they were specified in section forty-two of the Customs Consolidation Act, 1876 (*g*). Goods liable to forfeiture under the Act, or bearing British or Irish trade-marks or names.

"(2) Before detaining any such goods or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited by this section to be imported. Customs regulations.

"(3.) The Commissioners of Customs may from time to time make, revoke and vary, regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the

(*e*) For the interpretation of "purports" in the Customs Regulations of 22 Dec. 1887, see r. 8, Appendix, p. 681.

(*f*) i.e., sub-sects (2) and (3).

(*g*) 39 & 40 Vict. c. 36. See last page.

"evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.

Names like names of places in the United Kingdom.

"(4.) Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom.

Customs regulations.

"(5.) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

"(6.) The Commissioners of Customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion, or otherwise, shall act under the control of the Commissioners of her Majesty's Treasury.

"(7.) The regulations may provide for the informant reimbursing the Commissioners of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

"(8.) All regulations under this section shall be published in the 'London Gazette' and in the 'Board of Trade Journal.'

Customs Act, 1870.

"(9.) This section shall have effect as if it were part of the Customs Consolidation Act, 1876 (*h*), and shall accordingly apply to the Isle of Man as if it were part of the United Kingdom.

(*h*) 39 & 40 Vict. c. 36, s. 42, pp. 526, 530.

"(10.) Section two of the Revenue Act, 1883 (*i*), shall be repealed as from a day (*k*) fixed by regulations under this section, not being later than the first day of January, one thousand eight hundred and eighty-eight, without prejudice to anything done or suffered thereunder."

This section is a most important part of the scheme of the Act, for it, so far as it is effective, stops at the outset a class of frauds which, according to the evidence given before the Committees of 1862 and 1887, were widely prevalent and continually increasing, to the grave detriment of English manufacturers. Its main provisions are in accordance with the legislation now adopted in most civilized countries, under the International Convention, drawn up at conference on the subject of Industrial Property and Merchandise Marks, at Paris, in 1883, and amended at the subsequent Conference at Madrid, in 1889. The terms of the several Conventions are set out in the Appendix, pp. 658—665. The International Conventions.

According to English law these terms, or the terms of any of the numerous treaties concluded between this country and other countries for the mutual protection of the trade-mark and allied rights of their respective subjects, have no application to or between subjects, and cannot be recognized as having any legal effect, except so far as they have been embodied in the municipal law of the several countries (*l*). An English Court is not competent

(*i*) 46 & 47 Vict. c. 55, s. 2, amending the last-cited section.

(*k*) 1st of Jan. 1888. Customs Regulations, of 1 Dec. 1887.

(*l*) See Art. IX. of the International Convention, Book I. Chap. XX., p. 454; and *The Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J., decided on sect. 103 of the Patents, &c. Act, 1883; and *Lauri* v. *Renad*, (1892) 3 Ch. 402. The Court may refer to a treaty, in accordance with which an Act has been passed, to ascertain the circumstances to which the Act was intended to apply, as an aid to its construction. *Re Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

to inquire into a matter involving the construction of treaties or other acts of state, or to treat them as in any way operative to create or modify rights or duties, and the Crown cannot sanction any invasion by its officers of the rights of private individuals as they exist according to the municipal law, on the ground that it is necessary in order to comply with or compel obedience to a treaty (*n*).

France was, apparently, the first country to take effective steps to stop the importation of goods made abroad, but bearing words or marks describing them as made in the country of importation (*o*); but sect. 42 of the Customs Act of 1876, amended by the now repealed section of the Revenue Act of 1883, was amply sufficient for the purpose, if it had been effectively enforced.

Sect. 42 of the Customs Act, 1876.

Sect. 42 of the Customs Act, 1876, contains a list of goods among which the goods enumerated in this section are to be considered as included, and it provides that—

> "The goods enumerated and described in the following table of prohibitions and restrictions inwards are hereby prohibited to be imported or brought into the United Kingdom, save as thereby excepted (*p*); 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" (*q*).

Only marked goods come within the prohibition.

The policy of the Act is to prevent fraudulent marking, whether by means of forged trade-marks or false trade descriptions, and this section, as the remainder of the Act, only applies to goods which bear marks bringing them within its terms. There is no general obligation to stamp

(*n*) *Walker* v. *Baird*, (1892) A. C. 491.

(*o*) See M. M. A. Report, 1887, Index, "France."

(*p*) There are no general exceptions, but only exceptions relative to particular classes of goods, none of which are here material.

(*q*) For the section dealing with the importation of watches, see p. 526.

imported goods with any indication of origin (*r*). And if the deceptive marks which make such an indication necessary under the Act appear only upon the covering or package of goods, it is considered sufficient that the qualifying indication of origin should be stamped on the covering or package only also (*s*).

All such goods.]—The goods which are liable to forfeiture under this section (*t*), in addition to those specially enumerated in sub-sect. (1), are goods which, if sold, would be liable to forfeiture under the Act, that is, by the joint operation of sect. 2 (3) (iii.) and sect. 2 (1), goods or things to which any forged trade-mark (*u*) or false trade description (*x*) is applied (*y*), or to which any trade-mark (*z*), or mark so nearly resembling a trade-mark as to be calculated to deceive (*a*), is falsely applied (*b*). It is submitted that the words "*if sold*" must here be construed to mean if sold with such guilty intent as is necessary to justify a conviction under the Act (*c*). This is in accordance with the principle of throwing upon the person charged the onus of proving that he acted without intent to defraud, or that he is protected by one of the special defences specified in the Act, or that he acted otherwise innocently (*d*). Otherwise there could be no forfeiture under this part of the section, except where an offence would have actually been committed had the goods been sold; and sale by an innocent person would not constitute an offence. The construction contended for accords with the remainder of the section, and with the older Acts, for it is plain that the forfeitures constituted by the latter part of sub-sect. (1)

(*r*) M. M. A. Report, 1890.
(*s*) See below, p. 534, n.
(*t*) See the summary in the Customs General Order of 22 Dec. 1887, rr. 6 and 11, Appendix, p. 630.
(*u*) Page 468.
(*x*) Page 487.
(*y*) Page 473.
(*z*) Page 465.
(*a*) Page 471.
(*b*) Page 474.
(*c*) The same construction is arrived at by treating sect. 2 (2) as imported without the qualifications contained in it. Cf. *Re Anglesea Colliery Co.*, L. R. 1 Ch. 555, a decision on sects. 38 and 74 of the Companies Act, 1862.
(*d*) Sect. 2 (2) (c), p. 511.

are independent of proof of guilty intention on the part of anyone, and the clauses of sect. 42 of the Customs Consolidation Act of 1876, and sect. 2 of the Revenue Act of 1883, which are replaced by this section, contained no reference to the knowledge, intention, or purposes of the importer, or of any other person in relation to the goods (*e*).

Goods bearing English words or names.

So far as can be judged from the summary of agricultural produce detained under the Act in the years 1888 and 1889, which is appended to the M. M. A. Report, 1890, a very large proportion of the goods seized upon importation is seized because they bear words or lettering in the English language (*f*).

As regards words forming parts of the goods on which they appear, see *ante*, p. 478; and as regards goods partly made in two or more countries, p. 480.

Goods from the Colonies or the United States.

The practice of the Customs House authorities in the matter was stated by Mr. Follett, in the paper already cited (*g*), to be based upon the conclusion that "the use of the English language and of English trade descriptions was misleading and *primâ facie* inadmissible on foreign goods; but that this could not be held to apply to foreign goods coming from the United States or the Colonies."

Goods bearing British or Irish trade-marks or names.

All goods of foreign manufacture, &c.]—The prohibition of this part of sub-sect. (1) is absolute (subject to the proviso contained in it) without regard to intention, or to any licence or right to use the name or trade-mark from the proprietor, and it applies where the name or trade-mark has been applied by the proprietor himself, or in accordance with his orders, for the section is intended to guard against the importation of goods which appear to be home-made, because they bear the name or trade-mark of a manufacturer, &c., in the United Kingdom, in cases where the name or trade-mark is used honestly, and in cases where it

(*e*) Cf. sect. 12, "Search warrant," and "Forfeiture without conviction," pp. 520, 522.

(*f*) See sect. 3 (1) (b), "place or country," p. 480.

(*g*) M. M. A. Report, 1890, Appendix, p. 275. As to when the officers are expected to detain offending goods without special information, see p. 680.

is used with, as well as where it is used without, the concurrence of the manufacturer (*h*). The last cases are already provided for, since the goods would be liable to forfeiture under the earlier parts of the Act.

Only manufactured goods are included.

Manufactured goods only come within this part of the sub-section, although the Act generally applies to all goods whatsoever which are the subject of trade, manufacture, or merchandise (*i*). According to the view of the Act taken by the Customs authorities, goods which have undergone any process of manufacture, for instance, ground wheat, or hides tanned in the least degree, are manufactured goods (*k*).

Bearing any name, &c.]—It is unfortunate that the expression "having applied to them," which is defined in the Act (*l*), was not here used instead of "bearing." It is doubtful whether a name or mark which is not placed upon the goods or their covering, but is otherwise used in connection with them in any manner calculated to lead to the belief that the goods are designated or described by it, would be borne by the goods within the meaning of the sub-section (*m*).

Name (*n*).]—This includes any abbreviation of a name (*o*), and, therefore, initials which are the equivalent of a name in the market, as, for instance, D. L. R. & Co. for De La Rue & Co. (*p*).

Trade-mark.]—According to the definition of the Act, trade-mark means a registered trade-mark, or a trade-mark which is protected in any British possession or foreign state to which the provisions of sect. 103 of the Patents, &c. Act, 1883, are applied (*q*); but the draughtsman of this section of the Act must have intended to include other marks, for a mark purporting to be the trade-mark of a

(*h*) See Customs General Order 5 (d), p. 473. And cf. the use of a trade-mark which constitutes an infringement, above, p. 310.

(*i*) Sect. 3 (1), "goods."

(*k*) M. M. A. Report, 1890, Evidence of Messrs. Seymour and Follett, Q. 286.

(*l*) Sect. 5, p. 473.

(*m*) This would be within sect. 32 Doc. 1887, r. 15, Appendix, p. 683.

(*n*) See "names and initials," p. 492.

(*o*) Sect. 3 (1).

(*p*) Follett, M. M. A. Report, 1890, p. 276.

(*q*) Sect. 3 (1).

manufacturer, and not being such trade-mark, could hardly be a registered trade-mark. It is probably impossible to adopt this meaning in the construction of the Act, having regard to the express words of the interpretation clause. In other parts of the Act marks nearly resembling trade-marks are specially mentioned (*r*).

Customs register of names and marks.

To enable the Customs officers to carry out the provisions of the section prohibiting the importation of goods marked with the names or trade-marks of manufacturers, dealers, or traders within the United Kingdom, registers of the names and trade-marks of such persons as choose to avail themselves of them are kept at the various ports of the United Kingdom in accordance with rules 13—15 of the Customs General Order of 22nd December, 1887 (*s*).

"Made in Germany."

Indication of the country, &c.]—The particular country must be indicated. The Committee of 1890 refused to recommend that the words "made abroad" be accepted as sufficient to pass the goods instead of the words "made in Germany," &c., at present required, where, without the statement as to origin, the goods marked would fall within the section (*t*).

An indication which can readily be removed, for instance, words on a label attached by a string, is not accepted as sufficient to take the goods out of the section (*u*). It is, of course, a question of fact whether the explanation does accompany the objectionable name or trade-mark, and a merely pretended accompanying would be of no account. Rule 7 of the Customs General Order of 22nd December,

(*r*) *e.g.*, sect. 4 (a), and sect. 5 (3).

(*s*) Appendix, p. 682. See the form of declaration on registration, p. 686.

(*t*) Cf. the case of goods bearing English words, p. 482. Where a trade description suggesting an English origin has to be explained, and it does not fall within sect. 16 (1), the qualification "made abroad" is sufficient.

(*u*) M. M. A. Report, 1890, Q. 1953. The Lords' Committee on the Marking of Foreign Meat (1893) have recently reported that: "Traders complain that importers are only compelled by the M. M. Act to apply the mark of foreign origin to the package, and that the contents are systematically branded by English importers with English titles." Report, p. x.

1887, requires the Customs House officers, in cases falling within it, to 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 (which makes the qualifying name of the foreign country or place necessary), and in close proximity to it (*x*).

Importation.]—This includes transit (*y*), and, in spite of a strong appeal from shipping agents and other traders, whose businesses were said to be adversely affected by the working of the Act, the Committee of 1890 refused to recommend any alteration in this respect. Goods in transit.

Name of place in the United Kingdom.]—Sub-sect. (4), dealing with offences effected by false trade descriptions as to place or country (*z*), is more stringent than the proviso of sect. 18, since that only applies where the use of the name of a place or country is calculated to deceive.

Cases under this sub-section include cases—(a) where the name is intended to refer to the place in the United Kingdom of which it is the name, and to that alone; (b) where the name is that of a foreign place to which it is intended to refer, for instance, Boston; (c) where the name has originally been taken from the place in the United Kingdom, but is used to describe the goods or their process of manufacture, without any reference to the place being intended.

(a) Goods supplied according to an order from an English trader to a foreign manufacturer requiring the latter to put the address of the former on goods manufactured for him, would come under the first class, and so also would goods bearing such inscriptions as "A present from Brighton," as well as goods expressly marked *English*,

(*x*) Appendix, p. 681. Cf. General Order of 1 Feb. 1889, r. 7, as to qualifying marks added as a condition of release. *Ibid.*, p. 703.

(*y*) See Customs Order of 1887, r. 27, Appendix, p. 686. Under the Madrid Convention of 1891, the authorities are not bound to effect the seizure of goods in transit.

(*z*) Sect. 3 (1) (b), "place or country," p. 480; sect. 18, p. 498.

Irish, *London-made*, or with any similar express misstatements (*a*); (b) the second class is unimportant; (c) Kidderminster carpets, Windsor soap, Balbriggan hose, Shetland shawls (*b*), and Cheddar cheese, are examples of the third class. The saving contained in sect. 18 with regard to conventional or generic descriptions (*c*) does not apply to sect. 16 (4), for the words of the latter are precise, that the name shall be treated as if it were the name of a place in the United Kingdom, and therefore not a description of the goods. In any case, however, the proviso of sect. 18 requires the name of the place or country where the goods were actually made or produced to be added, if the description includes the name of a place or country, and is calculated to mislead.

Customs regulations.]—The general orders (*d*) and other regulations (*d*) issued by the Customs authorities under the Acts are set out in the Appendix. The regulations provide, in accordance with the Act, that where goods are detected by the officers to be such as are prohibited to be imported, they are to be detained (*f*). They do not, however, contemplate that the officers will be competent of their own knowledge to detect the attempted infringement of the Act in all cases, or in all classes of cases (*g*); and accordingly they make provision for the officers to act upon information (*h*) given by private persons, for instance, by the owners of trade-marks or names which are likely to be wrongly used on imported goods, and in certain cases they require the informants to give security (*i*), or to make a deposit of money (*k*), as a condition of the detention of

(*a*) Cf. Customs General Order of 22 Dec., 1887, rr. 6 and 10. Appendix, p. 680.

(*b*) These examples are given in the Customs General Order, r. 9.

(*c*) Above, p. 498.

(*d*) Appendix, pp. 678 *et seq.*

(*f*) Pages 680, 690.

(*g*) General Order of 22 Dec., 1887, rr. 6, 16, and 17.

(*h*) Regulations 2 and 3. Form of notice to Customs officer, p. 692. General Order of 22 Dec., 1887, rr. 19 to 23.

(*i*) Form of bond, p. 693. Regulations 3, 4, 7, and 29.

(*k*) General Order of 22 Dec., 1887, r. 24.

the goods. The register of names and trade-marks for the use of Customs officers has already been referred to (*l*).

Special regulations as to particular goods have been made in some cases, besides the general regulations just referred to. The earliest of these relate to watches (*m*). The others exempt from detention under the Act packing cases (containing goods) having the name of a port or place of destination applied to them in which the goods are clearly not intended to be sold or exposed for sale (*n*); inscriptions applied to goods by labels or tickets, or to boxes, &c. containing goods, for the convenience of dealers and shopkeepers, and not specially intended to attract the eye of the customer (*o*); Swedish iron bearing the words Lancashire Swedish (*p*); packages of natural flowers, fresh fruit, vegetables, and potatoes bearing address marks such as *Wm. Evans, Leeds*, and such packages coming from the Channel Islands, Malta, Gozo, and Gibraltar, and bearing, in addition to the address marks, any words in the English language describing the goods (*q*); sardines from places other than France bearing the trade description *Sardines d l'huile* (*r*); grain imported in bulk and transferred into marked sacks on board the importing ship (*s*); and bales of wool imported from New Zealand and the Australian and Cape Colonies marked with the names of the station upon which the wool was grown, which are identical with the names of towns or districts in the United Kingdom (*t*). And by the General Order of the 1st of February, 1889 (*u*), discretionary powers were conferred on collectors, inspectors, and surveyors, without a special order, to admit goods within the letter of the Act which are either articles, not dutiable, sent to an individual as

Special regulations as to particular goods.

Marks not intended to reach purchasers.

Lancashire Swedish iron.

Addresses on fruit, &c.

Sardines.

Grain in bulk.

Colonial wool.

Goods for private use.

(*l*) Page 534; General Order of 22 Dec., 1887, rr. 13—15. Form of declaration, p. 686.

(*m*) G. O., 18 Jan., 1888, p. 693, and the last section of the G. O. next cited.

(*n*) G. O., 4 Feb., 1888, p. 697.

(*o*) G. O., 10 Mar., 1888, p. 698.

(*p*) G. O., 24 Mar., 1888, p. 699.

(*q*) G. O., 9 April, 1888, p. 699.

(*r*) G. O., 18 Dec., 1888, p. 700.

(*s*) G. O., 31 Dec., 1888, p. 700.

(*t*) G. O., 25 Jan., 1890, p. 703.

(*u*) Page 701.

Goods for repair.

Samples.

Returns.

presents or for personal use; articles, not new and manifestly private property, and old, used, or damaged articles sent into the United Kingdom for repairs; returned samples of no value, made by competing firms in the United Kingdom; certain foreign samples imported for purposes of manufacture or comparison, or British returned goods, not dutiable, or in respect of which no drawback could have been received.

Practice of the Customs authorities.

The authorities when they have seized goods as contravening the Act, either forfeit and destroy or sell them, or release them upon receiving satisfactory explanations, or upon the removal or qualification of the objectionable marks, and, in some instances, upon the payment of fines (*x*). The officers are directed to take care that, in all cases where the Board allow qualifying words to be added before the delivery of goods, such words are applied in characters clear, conspicuous, and as indelible as the marks requiring qualification, and in close proximity to those marks (*y*).

Proceedings against the Customs authorities.

Any proceedings taken against the Customs authorities or their officers, in respect of anything done or omitted in execution or intended execution of their duties under the Act, fall within the Public Authorities Protection Act, 1893 (*z*), so that the proceedings must be commenced within six months; judgment for the defendant carries costs between solicitor and client; the defendant may plead a tender of amends, and if the plaintiff does not recover more than the amount tendered, the defendant is entitled to costs (but this provision is not to affect costs on any injunction in the action); and if, in the opinion of the Court, the plaintiff has not given the defendant a sufficient opportunity of tendering amends before the commencement

(*x*) See the return of goods detained in transit down to March, 1890, M. M. A. Report, 1890, Appendix, p. 326.

(*y*) G. O., 1 Feb. 1889, r. 7, p. 703.

(*z*) 56 & 57 Vict. c. 61, which has repealed 39 & 40 Vict. c. 36, ss. 267 to 272, and 40 & 41 Vict. c. 13, s. 4.

of the proceedings, the Court may award to the defendant costs as between solicitor and client (*a*).

It has been held that an officer is not liable in trespass for detaining goods while in doubt whether they ought to be detained or not, and until the Commissioners of Customs had given directions concerning them, although he might, it was said, have been liable in damages for so detaining them for an unreasonable time (*b*). In an earlier case, it was held that for a wrongful refusal, except upon payment of an excessive amount of duty, to sign a bill of entry in order to enable goods to pass, an officer might be sued (*c*). The orders of his superior officer do not afford any defence for an officer who has acted illegally to the prejudice of any British subject (*d*).

(*a*) This replaces the old requirement of one month's notice of action.

(*b*) *Jacobsohn* v. *Blake*, 6 M. & G. 919; 7 Scott, N. R. 772 (1844).

(*c*) *Barry* v. *Arnaud*, 10 Ad. & Ell. 670 (1839).

(*d*) See *Walker* v. *Baird*, (1892) A. C. 491; *Sands* v. *Child*, 3 Lev. 352 (1693), and *Entick* v. *Carrington*, 19 State Trials, 1043 (1765).

CHAPTER II.

MISCELLANEOUS MATTERS.

False representation as to grant of patent or registration of design or trade-mark.]—By sect. **105** of the Patents, &c., Act, 1883—

Penalty on falsely representing articles to be patented.

"(1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction (*a*) to a fine not exceeding five pounds.

"(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word 'patent,' 'patented,' 'registered,' or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article."

The offences here dealt with are applications of false trade descriptions (*b*), but the liability to punishment under the Merchandise Marks Act would afford no answer to a prosecution under the above section (*c*).

And an infringement of the section is no bar to an

(*a*) As to the Isle of Man, see Act of 1883, sect. 112; and as to Ireland, ibid. sect. 117.

(*b*) See M. M. A., 1887, s. 3 (*a*), above, pp. 476, 484.

(*c*) M. M. A., sect. 19 (1), above, p. 520.

application for the registration of the trade-mark which has been wrongly described as registered (*d*).

Sub-sect. (2), if taken literally, makes the use of "patent" unlawful in cases where, apart from its provision, the use of the word would not have been held to amount to a false or misleading claim of a patent right, as, for example, where no patent has ever existed but the word has become part of the trade-name of the goods and has been used by the manufacturer in his description of them (*e*). It also prohibits the use of such ordinary names of commerce as "patent leather" and "patent medicine" (*f*). It is submitted that some limitation must be placed upon the literal meaning of the enactment which will exclude these cases from the section (*ff*).

Falsification of the Register of Patents, Designs, and Trade-marks.]—By sect. 93 of the above-mentioned Act of 1883—

"If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor." Falsification of entries in registers.

False declaration as to country or place where a watch case was made.]—By sect. 8 (3) of the Merchandise Marks Act, 1887—

"Every person (*g*) who makes a false declaration False declara-

(*d*) *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.; see above, p. 345.

(*e*) *Edelsten* v. *Vick*, 11 Hare, 78 (1858), Wood, V.-C., (*Taylor and Co.'s Patent Solid-headed Pins*); see further, Book I. Chap. XV. p. 339; *Gridley* v. *Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Div. Court, *Swinborne's Patent Refined Isinglass.* held not to be a false trade description, see the last Chapter, p. 484.

(*f*) See above, p. 341.

(*ff*) Application for a patent, or provisional protection, does not authorize the use of the word patent; but, it is submitted, the acceptance of the complete specification of a patent does. See above, p. 484.

(*g*) "Person" includes corporation and partnership, above, p. 463; as to limitation of time for proceedings, see above, p. 517; for sect. 8, see p. 525.

tion as to watch case.

"for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction, to a fine not exceeding 20*l.* for each offence."

False representation as to Royal warrant.]—By sect. 20 of the Merchandise Marks Act of 1887—

False representation as to Royal warrant.

"Any person (*h*) 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 (*i*), to a penalty not exceeding 20*l.*"

Unauthorized assumption of Royal arms.]—By sect. 106 of the Patents, &c. Act of 1883—

Penalty on unauthorised assumption of Royal arms.

"Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any government department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction (*k*) to a fine not exceeding twenty pounds."

The Cutlers' Marks Act, 1819.

Cutlery marks.]—By the Act 59 Geo. 3, c. 7, it is forbidden to mark cutlery and the other goods mentioned in the Act with the figure of a hammer, unless the goods have been wrought or forged, or to place false marks of quality upon such goods, or to falsely mark them as London made; and the offences created by the Act extend to selling, or having in possession for the purposes of sale, such goods marked in breach of the Act. The material provisions of the Act (*l*) may be summarised as follows:—

(*h*) See note (*g*), above.

(*i*) In Scotland, in the Sheriff Court (sect. 21); and in the Dublin police district, the courts of the justices under the Petty Sessions Act, 1851 (sect. 22).

(*k*) As to the Isle of Man, see Act of 1883, sect. 112; and as to Ireland, ibid. sect. 117.

(*l*) Sect. 17 has been repealed by

1. Where any knives, knife-blades, forks, razors, razor-blades, scissors, shears, and other articles of cutlery, edge tools and hardware requiring a cutting edge, of wrought steel, or of iron and steel, are made by means of the hammer, the maker may mark the figure of a hammer upon them before they are ground. Hammer marks.

3. No one may mark such figure on any of the goods enumerated not so made, before the *bonâ fide* sale of the goods to the user, or have in his possession for the purpose of sale, or sell any such goods not so made, and being marked with such figure, under penalty of forfeiture of the goods and a fine of 5*l.* for every dozen.

4. No one may mark on any of the goods enumerated, whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, "any word or words which shall or may denote or indicate the quality of such articles to be otherwise than the real and true quality thereof," or have in his possession for the purpose of sale, or sell any such goods so marked, under penalties as aforesaid. Quality marks.

5. No one may mark on any of the goods enumerated, whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, the word or words *London* or *London made*, or any word or words having any similitude thereto, unless the goods were made in the City of London, or within twenty miles distance therefrom, or have in his possession, &c., or sell (as before) under a penalty of forfeiture and fine of 10*l.* a dozen articles. London made.

7. Any one having in his possession for the purposes of sale, or selling any of the goods aforesaid contrary to the Act, who shall, before information or complaint laid against him, prove satisfactorily by oath before one or more justice or justices that he purchased the goods with the marks thereon without knowing they were marked Innocent purchasers.

the Stat. Law Rev. Act, 1873, and sect. 2 by the Stat. Law Rev. Act, 1874, sects. 8–10 in part, and sects. 11–13 and 15 wholly, repealed by 47 & 48 Vict. c. 43, s. 4.

contrary to the Act, and shall discover to two or more justices the name of the person from whom he bought, so that the latter shall be prosecuted to conviction, shall not be liable to penalties himself (*m*), but shall be entitled to two-thirds of the penalty recovered from his vendor, as any other informer.

Counterfeiting Sheffield corporate marks.

The Cutlers' Co. Act of 1814 contains a provision inflicting penalties upon any person who counterfeits or imitates assigned corporate marks; and by sect. 81 (13) of the Patents, &c. Act of 1883, this provision has been extended to any mark entered in the Sheffield Register (*n*). The section of the first-mentioned Act is as follows (*o*):—

> "If any member or members of the Cutlers' Company, or any other person or persons using, exercising, or carrying on any of such arts or trades as aforesaid within the said lordship or liberty, or six miles compass of the same, shall at any time after the passing of this Act strike, engrave, impress or use, or cause or procure to be stricken, engraved, impressed or used upon his or their goods, wares, or manufactures, any mark, device, stamp, or impression, with intent to counterfeit or imitate any mark or device assigned, or which may hereafter be assigned, by the said master, wardens, or searchers and assistants of the said company, to be used by any other person, the person or persons so offending shall, for every such offence, forfeit and pay (in lieu of the penalty imposed by the said last recited Act (*p*)) any sum not exceeding 20*l.*, one moiety whereof shall be paid to the person whose mark shall have been so counterfeited or imitated, and the other moiety to the said master and wardens of the said company; and the provisions in the said last recited Act (*p*) contained for the recovery and application of the penalty thereby imposed shall

(*m*) Cf. M. M. A., sect. 2, "unless he proves," above, p. 505.

(*n*) Above, p. 101.

(*o*) 54 Geo. 3, c. 110, sect. 5, (local).

(*p*) The Cutlers' Co. Act of 1791, see above, p. 92.

"be used, applied, and put in force for the recovery and application of the penalty hereby made payable, as fully and effectually as if the same provisions were in this Act severally and separately repeated and re-enacted."

The sections of the Cutlers' Co. Act of 1791 (*q*), which are referred to and incorporated by the last-mentioned section, provide (sect. 26) that the penalties may be sued for by the company, or (sect. 27) recovered summarily before a justice or justices of the West Riding of York, or of the county of Derby, who shall have power to award costs, and to issue a distress warrant, or, if the goods of the offender are insufficient, to commit him to the House of Correction for one month to enforce payment of the penalty. Sect. 28 contains a form of conviction, and sect. 29 gives an appeal to quarter sessions.

Statutes relating to particular goods.

A number of statutes of little general importance, requiring special marks to be placed upon particular classes of goods, are summarized in the Appendix, p. 710.

(*q*) 31 Geo. 3, c. 58, (local).

CONTENTS OF THE APPENDIX.

PART I.

No.		Page.
1.	The Patents, Designs, and Trade-Marks Act, 1883, as amended by the Act of 1888, so far as it relates to Trade-Marks	547
2.	The Patents, Designs, and Trade-Marks Act, 1888 ..	579
3.	The Trade-Marks Registration Acts, 1875—1877 (now repealed)	587
4.	The Rules of 1890	595
	Table of fees	606
	Schedule of forms	607
	Classes of goods	618
5.	Instructions to persons who wish to register Trade-Marks	624
6.	Precedents of forms on an opposed application to register a Trade-Mark and on appeal	635
7.	Notice of motion to rectify the register	642
8.	Precedents of pleadings in actions for infringement and passing off	643
9.	Forms of orders in Trade-Mark cases and cases analogous thereto	648
10.	Foreign States and British Possessions to which sect. 103 of the Act of 1883 is applied	656
11.	The International Convention	658

PART II.

12.	The Merchandise Marks Act, 1887	666
13.	The Merchandise Marks Act, 1891	677
14.	General orders under the Merchandise Marks Act ..	678
	Order in Council as to marks on watch-cases ..	695
15.	Errors in trade descriptions of measure allowed under the Indian Merchandise Marks Act	705
16.	Regulations under the Act of 1891 as to prosecutions by the Board of Trade	707
17.	Forms of indictment and informations	708
18.	Statutes requiring particular classes of goods to be marked in a specified manner	710

APPENDIX.

No. 1.

THE PATENTS, DESIGNS, AND TRADE-MARKS ACT, 1883,

As amended by the Act of 1888 (*a*).

ARRANGEMENT OF SECTIONS.

SECTION

PART I.—Preliminary.

1. Short title.
2. Division of Act into parts.
3. Commencement of [the Acts].

PART IV.—Trade-Marks.

Registration of Trade-Marks.

62. Application for registration.
63. Limit of time for proceeding with application.
64. Conditions of registration of trade-mark.
65. Connexion of trade-mark with goods.
66. Registration of a series of marks.
67. Trade-marks may be registered in any colour.
68. Advertisement of application.
69. Opposition to registration.
70. Assignment and transmission of trade-mark.
71. Conflicting claims to registration.
72. Restrictions on registration.
73. Further restriction on registration.
74. Saving for power to provide for entry on register of common marks as additions to trade-marks.

Effect of Registration.

75. Registration equivalent to public use.
76. Right of first proprietor to exclusive use of trade-mark.
77. Restrictions on actions for infringement, and on defence to action in certain cases.

[77a. Certificate as to exclusive use and costs thereon.]

Register of Trade-Marks.

78. Register of trade-marks.
79. Removal of trade-mark after fourteen years unless fee paid.

Fees.

80. Fees for registration, &c.

Sheffield Marks.

81. Registration by Cutlers' Company of Sheffield marks.

(*a*) These Acts have been printed from Mr. Lewis Edmunds' "Patents, &c. Acts, Consolidated," by his permission.

PART V.—GENERAL.

Patent Office and Proceedings thereat.

SECTION
82. Patent Office.
83. Officers and clerks.
84. Seal of Patent Office.
85. Trust not to be entered in registers.
86. Refusal to grant patent, &c. in certain cases.
87. Entry of assignments and transmissions in registers.
88. Inspection of and extracts from registers.
89. Sealed copies to be received in evidence.
90. Rectification of registers by court.
91. Power for comptroller to correct clerical errors.
92. Alteration of registered mark.
93. Falsification of entries in registers.
94. Exercise of discretionary power by comptroller.
95. Power of comptroller to take directions of law officers.
96. Certificate of comptroller to be evidence.
97. Applications and notices by post.
98. Provision as to days for leaving documents at office.
99. Declaration by infant, lunatic, &c.
100. Transmission of certified printed copies of specifications, &c.
101. Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.
102. Annual reports of comptroller.
[102a. Proceedings of Board of Trade.]

International and Colonial Arrangements.

103. International arrangements for protection of inventions, designs, and trade-marks.
104. Provision for colonies and India.

Offences.

105. Penalty on falsely representing articles to be patented.
106. Penalty on unauthorized assumption of Royal arms.

Scotland; Ireland; &c.

107. Saving for courts in Scotland.
108. Summary proceedings in Scotland.
109. Proceedings for revocation of patent in Scotland.
110. Reservation of remedies in Ireland.
111. General saving for jurisdiction of courts.
112. Isle of Man.
[112a. Jurisdiction of Lancashire Palatine Court.]

Repeal; Transitional Provisions; Savings

113. Repeal and saving for past operation of repealed enactments, &c.
114. Former registers to be deemed continued.
115. Saving for existing rules.
116. Saving for prerogative.

General Definitions.

117. General definitions.

The FIRST SCHEDULE.—Forms of application, &c.
The THIRD SCHEDULE.—Enactments repealed.

46 & 47 Vict. c. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade-Marks. [25th August, 1883.]

51 & 52 Vict. c. 50.

An Act to amend the Patents, Designs, and Trade-Marks Act, 1883. [24th December, 1888.]

*** The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in square brackets. The amending Act and section are quoted in the margin.

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.—Preliminary.

Short title.

1. This Act may be cited as the Patents, Designs, and Trade-Marks Act, 1883.

By Act 1888, s. 29, the principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade-Marks Acts, 1883 to 1888.

The Acts of 1885 and 1886, do not relate to trade-marks.

Division of Act into parts.

2. This Act is divided into parts, as follows:—

Part I.—Preliminary.
II.—Patents.
III.—Designs.
IV.—Trade-Marks.
V.—General.

Commencement of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

Act, 1888, s. 28.

[The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.]

What Act applied to pending registrations, p. 111.

PART IV.—Trade-Marks.

Registration of Trade-Marks.

Application for registration.

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

The comptroller, p. 53, and sect. 32.
Discretion to refuse registration, although the mark tendered is within sect. 64, p. 63.
Registration of trade-marks, Chap. IV., p. 58.
Person includes firm or partnership (Rule 7, p. 596), and body corporate, sect. 117.
Proprietor, see as to who may apply to register, p. 60.
Procedure on application to register, p. 68.
Application by agent, p. 62. The agent must be authorised to the satisfaction of the comptroller. Rule 9, p. 596.

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

Act, 1888, s. 8.

Form of application, p. 68, Form F., p. 608.
Address of the Patent Office, p. 53; Instructions 8, p. 628; Rule 8, p. 596.
Applications in classes 23. 24, or 25, go to the Manchester Branch Office, Chap. VII., p. 103; Instructions 8, p. 628; Rule 8, p. 596.
As to Sheffield marks, see Chap. VI., p. 91, sect. 81, Rules 56—59, p. 604.

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

Representations, Instructions 9, 15 and 16, p. 623; Rules 14 and 15, p. 597.
Classes of goods, Chap. V., p. 87; list of classes, p. 618.

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

Discretion to refuse, p. 63.
Applicant is entitled to be heard before the refusal, p. 67, sect. 94, Rule 17 and 18, p. 597.
Appeal to Board of Trade, p. 78; Forms, pp. 610, 637; Rules 20 to 26, p. 598.
Registration subject to conditions, p. 83. See also sect. 69 (3).

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

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

Reference of the appeal to the Court, p. 80.
No direct appeal to the Court, p. 80.
The Court, p. 81, sect. 117 (1).
Summons or notice of motion, p. 81; Forms, p. 635 *et seq.*
Costs, p. 85.
An order of the Court allowing an appeal must be served on the comptroller, Rule 46, p. 602.

[(6.) Where an applicant for the registration of a trade-mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.] Act, 1888, s. 8.

Page 82, cf. opponent's address, sect. 69 (6).
International convention, Chap. XX., p. 454, sect. 103. The convention is printed at p. 658.
As to applications to rectify where the registered proprietor is resident abroad, see p. 240.

63. Where registration of a trade-mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned* [the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned]. Limit of time for proceeding with application.
Act, 1888, s. 9.

Abandonment of application, pp. 69, 235.
It is no bar to a subsequent application by the same person and in respect of the same mark, p. 69.

64. (1.) *For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:* Conditions of registration of trade-mark.

(*a*) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or* Repealed. Act, 1888, s. 10.

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

(*c*) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

Fancy word, p. 142.
Not in common use, p. 149.

(2.) There may be added to any one or more of these particulars any letters words or figures, or combination of letters words or figures, or of any of them.

(3.) Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade-mark under this part of this Act.

Conditions of registration of trade-mark.

Act, 1888, s. 10.

64. [(1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:

As to what marks may be registered as trade-marks, see Chap. VIII., p. 106.

As to what Act applies to pending registrations, p. 111, Act of 1883, sect. 113; Act of 1888, sect. 27, p. 586.

For comparison with repealed sections, see p. 109.

Essential particulars, pp. 112, 167.

Additions, p. 113, sect. 64 (2). Additions common to the trade, p. 169, sect. 74.

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

Name marks, p. 114; trade-name, 392.
Mere name in nominative case, p. 115.
Particular and distinctive manner, pp. 116, 118.

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

Signature, p. 117.

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

Distinctive, pp. 118—127; loss of distinctiveness, p. 285.
Descriptive marks, pp. 36, 127, 145.
The mark must be distinctive, apart from colour, pp. 129, 163.
Distinctiveness is an essential element of a trade-mark, apart from the Acts, Chap. II., p. 35.
Device, p. 128; copyright design, p. 78, n.; words not a device, p. 129.
Mark, p. 132.
Brand, p. 133.
Heading, p. 135; line headings, 198.
Label, p. 137; disclaimer of words in, pp. 138, 172.
Ticket, p. 139.

(d) An invented word or invented words; or

Word marks, p. 140.
Invented word, p. 152.

(e) A word or words having no reference to the character

or quality of the goods, and not being a geographical name.]

Page 153. Descriptive words, pp. 36 *et seq.*, 145 *et seq.*
Secondary distinctive meaning of word *primâ facie* descriptive, pp. 36, 127, 147.
Geographical names, pp. 141, 147.
Name of a person, p. 149.

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

Additions and disclaimers, Chap. IX., p. 164.
Effect of disclaimer, p. 173.
Addition of matter common to the trade, sect. 74, p. 169.
Disclaimer of person's own name, see next sub-section.
"Figures" means "numerals," *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M.R.
Essential particulars, pp. 112, 167.

[(3.) Provided as follows:

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

Page 167.
As to a trader's right of monopoly in his trade-name, see p. 168, Chap. XVI., pp. 384, 391; and as to the right of anyone to trade honestly under his own name, pp. 420 *et seq.*

(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade-mark under this part of this Act.]

Registration of old marks, p. 153.
"Figure" means "numeral," *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M.R.
13th August, 1875, date of commencement of first Registration Act.
Special and distinctive, p. 154; cf. distinctive in sub-sect. (1) (c), pp. 118—127.
Used as a trade-mark, p. 158, and Chap. II., p. 24. The mark must have been used as it is to be registered, p. 160.
Alteration of registered old mark under sect. 92, p. 248.

Connection of trade-mark with goods.

65. A trade-mark must be registered for particular goods or classes of goods.

Classification of goods, Chap. V., p. 87; list of classes, p. 618.
A trade-mark is assignable only in connection with the goodwill of the business concerned in the goods for which it is registered, sect. 70.
Registration for part of a class, pp. 68, 181.

Registration of a series of marks.

66. When a person claiming to be the proprietor of several trade-marks which, while resembling each other in the material particulars thereof, yet differ in respect of (*a*) the statement of the goods for which they are respectively used or proposed to be used, or (*b*) statements of numbers, or (*c*) statements of price, or (*d*) statements of quality, or (*e*) statements of names of places, seeks to register such trade-marks, they may be registered as a series in one registration. A series of trade-marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade-marks composing a series shall be deemed and treated as registered separately.

Series of marks, p. 90; Representations, Rules 14 and 30, pp. 597, 599; Instructions 17, p. 630.

Trade-marks may be registered in any colour.
Act, 1888, s. 11.

67. A trade-mark may be registered in any colour [or colours], and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour [or colours].

Colour, p. 102. The mark must be distinctive, apart from colour, p. 129.

Advertisement of application.
Act, 1888, s. 12.

68. Every application for registration of a trade-mark under this part of this Act shall *as soon as may be* after its receipt be advertised by the comptroller, [unless the comptroller refuse to entertain the application].

Advertisement, p. 69; Rules 27 to 30, p. 598; Instructions 20 to 27, p. 630.
Notice of refusal is to be given to the applicant, Rule 19, p. 598; see further, as to refusal, sect. 62 (4).

Opposition to registration.
Act, 1888, s. 13, sub-ss. 1, 2.

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

Opposition, pp. 71—78; Rule 31; Instructions 32, p. 632: Summary of procedure, p. 75; Forms, pp. 635 *et seq.*
Opposition is limited to the grounds stated in the notice, p. 76; amendment, p. 76.

Act, 1888, s. 13, sub-s. 3.

(2.) Within *two months* [one month] after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter statement in

duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Counter-statement, Form, p. 636.
Abandonment: cf. abandonment of application, sect. 63. Apparently the abandonment of the opposition would not estop the opponent from applying to remove the mark from the register under sec. 90, see *Arbenz's application*, 35 C. D., at p. 257; 4 R. P. C. p. 145, (1887) C. A.
Enlargement of time, p. 76.

(3.) *If the applicant sends such counter statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.*

Repealed. Act, 1888, s. 13, sub-s. 4.

The requirement of security from an opponent was abandoned at the suggestion of Lord Herschell's Committee, Report of 1888, xiii.

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*

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

Act, 1888, s. 13, sub-s. 4.

Appeal to Board of Trade and to the Court, pp. 78—85; cf. sect. 62 (4) and (5).
Costs, p. 85.
Forms, pp. 635 *et seq.*
Modification of application on appeal, p. 83.
Registration subject to conditions, p. 83, and see limitation of the registration and variation in its form, p. 235; and registration with a note, pp. 54, 90, (class of goods), p. 103, (colour), and p. 182 (use).

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

See last note.
An order of the Court, disallowing an opposition, must be served on the comptroller, Rule 46, p. 602.

[(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.]

The power to give costs in respect of an abandoned application was conferred, at the suggestion of Lord Herschell's Committee, with a view to spare owners of registered trade-marks the expense of contesting unwarrantable applications to register marks which would prejudice their rights.

There is no power to give costs, in respect of proceedings before the comptroller, against an opponent: *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.; *Brandreth's Tm.*, 9 C. D. 618 (1878), Jessel, M.R.

[(6.) Where the opponent is out of the United Kingdom, he shall give the comptroller an address for service in the United Kingdom.]

Page 82.

Assignment and transmission of trade-mark.

70. A trade-mark, when registered, shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Classes of goods, sect. 65. Registration is restricted to the goods for which the mark is registered, p. 256; and trade-mark rights are limited by the actual signification of the trade-marks, that is, to the goods of the original proprietor, or his successor in business, upon which it has been used, pp. 31, 256, 304.

Assignment and devolution, Chap. XIII., p. 272.

Assignment where a mark has been registered in the wrong name, pp. 62, 236.

Registration of assignments and transmissions, sects. 78 and 87, Rules 36 to 40, p. 601. Form of request for the registration of a subsequent proprietor, Form K., p. 611. Such registration is not essential in order to enable the subsequent proprietor to sue for infringement: *Ihlee* v. *Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J.

Determination of trade-mark rights, Chap. XIV., p. 283.

Conflicting claims to registration.

71. Where each of several persons claims to be registered as proprietor of the same trade-mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court.

Page 177, Rules 44 and 45, p. 602. The comptroller may require a written or oral explanation from any of the claimants in regard to his claim, Rule 43, p. 603. Old marks, up to three, which have existed independently as trade-marks, are allowed to be registered; if there are more than three, they are treated as common marks: see the "three marks rule," pp. 172, 177, and sect. 74 (3).

An old mark may be registered although a similar mark has been on the register for five years: *Jackson* v. *Napper*, p. 326.

Restrictions on registration.

72. (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade-mark, the comptroller shall not register in

respect of the same goods or description of goods a trade-mark identical with one already on the register with respect to such goods or description of goods.

Duplicate marks, Chap. X., p. 176.
"Except, &c.," refers to sect. 71.
Same goods or description of goods, 180.
An order of the Court, allowing registration under this section, must be served on the comptroller, Rule 46, p. 602.

(2.) [Except as aforesaid] the comptroller shall not register with respect to the same goods or description of goods a trade-mark *so nearly resembling* [having such resemblance to] a trade-mark already on the register with respect to such goods or description of goods as to be calculated to deceive. Act, 1888, s. 14.

See last note.
Mark resembling a registered mark, Chap. XII., pp. 182 to 209.
Comptroller's direction, p. 63.

73. It shall not be lawful to register as part of or in combination with a trade-mark any words the *exclusive* use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design. Further restriction on registration. Act, 1888, s. 15.

Deceptive marks, Chap. XIII., pp. 209 to 217.
"Exclusive" was omitted as misleading, at the suggestion of Lord Herschell's Committee, Report of 1888, p. xiii.
Cf. sect. 86, which forbids the registration of a trade-mark, the use of which would, in the comptroller's opinion, be contrary to law or morality.

74. (1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade-mark— Saving for power to provide for entry on register of common marks as additions to trade-marks.

(a) In the case of an application for registration of a trade-mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

(b) In the case of an application for registration of a trade-mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

Additions and disclaimers, Chap. IX., p. 164; cf. sect. 64 (2).
"Distinctive" means *primâ facie* distinctive: *Burland* v. *Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889); for its meaning in sect. 64, see pp. 118—127.

"Common to the trade" means open to the trade, p. 171; see the case last cited.

Clause (a), dealing with old marks, is wider than clause (b), because the policy of the Acts is to register old marks exactly as they were used: p. 170; *Phillips' Tm.*, (1891) 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

Repealed. Act, 1888, s. 16.

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*

Act, 1888, s. 16.

[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

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

The amendment is in accord with that of sect. 64 (2) and (3) (i), p. 166. Right to honestly trade under one's own name, pp. 167, 420 *et seq.*

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

The "three mark rule," pp. 172, 177.

13th of August, 1875, is the date of commencement of the first Registration Act.

Effect of Registration.

Registration equivalent to public use. Act, 1888, s. 17.

75. *Registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark.*

[Application for registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.]

Page 254.

Effect of registration, Chap. XII., p. 252. As to the acquisition of trade-marks by user, see Chap. II., p. 24.

Date of application. It was the practice, from the first, to register the

entry as of the date when the application was received by the registrar, see Rule 20 of the Rules of 1876, and Rule 32 of the Rules of 1883. The amendment was made to give this practice statutory authority; report of Lord Herschell's Committee, p. xiii.

Entry post-dated, *Hayward's Case*, p. 235.

76. The registration of a person as proprietor of a trade-mark shall be primâ facie evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act.

Right of first proprietor to exclusive use of trade-mark.

Page 255. Registration is evidence of title, conclusive only after five years, pp. 304, 324.

Rectification of the register after five years, pp. 229, 258.

Test of infringement where the registered mark is actually copied, p. 312.

See note to sect. 71.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade-mark unless, in the case of a trade-mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade-mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Restrictions on actions for infringement, and on defence to action in certain cases.

Registration as a condition precedent to an action for infringement, p. 260.

The prohibition does not affect actions for passing off, pp. 265, 382. It applies to foreigners, pp. 264, 300.

13th of August, 1875, is the date of commencement of the first Registration Act.

Certificate, p. 264; Rule 60, p. 605; Instructions 35, p. 633; Form of application, Form L., p. 611; Fee 1*l.*

[**77a.** In an action for infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.]

Certificate as to exclusive use and costs thereon. Act, 1888, s. 18.

Page 370.

This section was added on the precedent of sect. 31, which applied to patent actions only.

Register of Trade-Marks.

Register of trade-marks.

78. There shall be kept at the patent office a book called the Register of Trade-Marks, wherein shall be entered the names and addresses of proprietors of registered trade-marks, notifications of assignments and of transmissions of trade-marks, and such other matters as may be from time to time prescribed.

Cf. sect. 87.

The register, Chap. III., p. 52. The date of the application for registration, and such other particulars as the comptroller thinks necessary, are to be entered, Rule 34, p. 601.

An application to the Court has been allowed under this section where the comptroller refused to register an assignment, p. 280; *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J.

Quære, whether an abandoned mark can be removed under the section, p. 291.

Removal of trade-mark after fourteen years, unless fee paid.

79. (1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade-mark, the comptroller shall send notice to the registered proprietor that the trade-mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee: and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

Page 292. The cause of the removal is to be entered, Rule 47, p. 602.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

Fee *ll.*, Form X., p. 616.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may without removing such trade-mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

Additional fee, 10*s.*, Form Y., p. 616.

(4.) Where after the said three months a trade-mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade-mark to the register on payment of the prescribed additional fee.

Additional fee, 1*l.*, Form Z., p. 617.

(5.) Where a trade-mark has been removed from the register for non-payment of the fee or otherwise, such trade-mark shall nevertheless for the purpose of any application for registration during *the five years* [one year] next after the date of such removal, be deemed to be a trade-mark which is already registered [unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade-mark.] Act, 1888, s. 19, sub-s. 1. Act, 1888, s. 19, sub-s. 2.

Page 293.

Fees.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees for registration, &c.

List of fees, p. 606.

Sheffield Marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect: Registration by Cutlers' Company of Sheffield marks.

Sheffield marks, Chap. VI., p. 91, Rules 56 to 59, p. 604.
"Metal goods" is defined in sub-sect. (14).

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade-marks (in this Act called the Sheffield register):

(2.) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade-marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade-Marks Registration Act,* 1875, *belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade-marks* Act, 1888, s. 20, sub-s. 1.

which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade-Marks Registration Act, 1875:

Act, 1888, s. 20, sub-s. 1.

[(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade-marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade-Marks Registration Act, 1875, or in the register of trade-marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers:]

38 & 39 Vict. c. 91.

Act, 1888, s. 20, sub-s. 2.

(3.) An application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge* [on metal goods] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6.) Upon the registration of a trade-mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade-marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day:

(7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade-marks, the effect of such registration, and the assignment and transmission of rights in a registered trade-mark shall apply in the case of applications and registration in the Sheffield register; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register:* Act, 1888, s. 20, sub-s. 3.

[(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade-marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade-marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the comptroller, the Patent Office, and the 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:] Act, 1888, s. 20, sub-s. 3.

(8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge* [on metal goods], he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company: Act, 1888, s. 20, sub-s. 2.

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade-marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned:

(10.) A person may (notwithstanding anything in any Act

relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade-marks:

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade-mark or trade-marks:

(12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm reverse or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court:

Person aggrieved, cf. sect. 90, p. 221.

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register:

See pp. 92 and 544.

Act, 1888, s. 20, sub-s. 4.

[(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.]

[(15.) For the purpose of legal proceedings in relation to trade-marks entered in the Sheffield register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.]

Certificate of the comptroller, sect. 96, Rule 60, p. 605.

PART V.—General.

Patent Office and Proceedings thereat.

Patent Office.

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

As to the Patent Office, Trade-Marks Branch, see Chap. III., p. 52.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registra-

tion of designs and trade-marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade-marks, who shall act under the superintendence and direction of the Board of Trade.

Pages 53, 67.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade-marks, and so many examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of patent office.

84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence.

Cf. sect. 89, sealed and certified copies of the registers; and sect. 96, the certificate of the comptroller to be evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied, or constructive.

The section does not forbid the entry of a note upon the register stating the effect of an undertaking limiting the right of user of the trade-mark, see pp. 54, 90 (class of goods), 163 (colour), 182 (use of mark), 235 (note entered under sect. 90).

By reason of this section, and sect. 87, the registered proprietor can make a good title to any purchaser of the trade-mark and of the goodwill of the business concerned (sect. 70), who has no notice of any equitable rights in the trade-mark or goodwill existing in any third person.

Refusal to grant patent, &c., in certain cases.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade-mark, of which the use would, in his opinion, be contrary to law or morality.

Cf. sect. 73.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade-mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade-mark, in the register of patents, designs, or trade-marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade-marks, as proprietor of a patent, copyright in a design or trade-mark as the case may be, shall, subject to [the provisions of this Act and to] any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade-mark may be enforced in like manner as in respect of any other personal property.

Act, 1888, s. 21.

Assignment and devolution of trade-marks, Chap. XIII., p. 272. Registration of assignments, p. 278, Rules 36 to 40, p. 601.

Licence to use a trade-mark, p. 281. Licensee cannot sue, pp. 282, 302. Licence as a defence in an infringement action, p. 333.

Inspection of and extracts from registers.

Act, 1888, s. 22.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to [the provisions of this Act and to] such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Inspection, searches and indexes, pp. 55, 56. Hours of inspection, Rule 52, p. 603. Searches, Instructions 7, p. 628. Fees, for inspection or searching, 1*s.* for every quarter of an hour; for office copy of documents, for every 100 words (but never less than 1*s.*), 4*d.*; for certifying office copies, MS. or printed, 1*s.*

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Cf. sect. 84, seal of the patent office; and sect. 96, the certificate of the comptroller.

Fees, see sect. 88.

Rectification of registers by Court.

Act, 1888, s. 23.

90. (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person [or of any other particulars] from any

register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

Rectification of the register, Chap. XI., p. 218. As a defence, p. 338.
An entry may be rectified after five years' registration, notwithstanding sect. 76, p. 258.
Costs, p. 244. Security for costs by a foreigner, p. 241.
Procedure, p. 237. Four clear days' notice of the application must be given to the comptroller, Rule 49, p. 603.
Forms, p. 642. Fee, 10*s*.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

Damages, p. 243.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

An office copy of the order, with a notice in Form N., p. 612, must be left at the patent office forthwith, Rule 46, p. 602. Publication of the order, Rule 50, p. 603.

Power for comptroller to correct clerical errors.

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

(a) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade-mark; or

Pages 70, 76. The comptroller has a general power to amend documents and correct irregularities in procedure under Rule 54, p. 71.
Fee on request to amend application, 5*s*. Form Q., p. 613.

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

Page 246. Form of request, Q., p. 613. Fee 5*s*. Alteration of address, Rule 48, p. 603. Form N., p. 612. Fee 5*s*. Fee on entry of a rectification or alteration other than of alteration of address, or cancellation of the entry or part of it at the owner's request, 10*s*.

(c) Cancel the entry or part of the entry of a trade-mark on the register: provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on

the register as the proprietor of the said trade-mark.

Page 246. Statutory declaration, Rules 61, 32, p. 605. Form P., p. 613. Form of request, O., p. 612. Fee 5*s*.

Act, 1888, s. 24.

[(d) Permit an applicant for registration of a design or trade-mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade-mark to be registered.]

Page 71. The sub-section was added to allow an applicant to disclaim any right to use the mark for some of the goods in the register class or classes to which his application refers, in order, for instance, to avoid opposition by the proprietors of trade-marks used or registered for the disclaimed goods. Report of Lord Herschell's Committee, p. xiv. Form of request, Q., p. 613. Fee 5*s*.

Alteration of registered mark.

92. (1.) The registered proprietor of any registered trade-mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Alterations in non-essential particulars, p. 247.
Alterations of old marks, p. 248.
Procedure, p. 250.
Forms, p. 642. Fee 10*s*.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant; and the comptroller shall be entitled to be heard on the application.

Fourteen days' notice of the application must be given to the comptroller, and if the application is granted representations of the trade-mark as altered must be sent to him, Rule 61, p. 603.

(3.) If the Court grants leave, the comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

An office copy of the order with a notice in Form N., p. 612, must be left at the patent office forthwith, Rule 46, p. 602. Publication of the order, Rule 50, p. 603.

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Exercise of discretionary power by comptroller.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to

the applicant for a patent, or for amendment of a specification, or for registration of a trade-mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Pages 66, 79. The course of events laid down by the rules is as follows:—Notice by the comptroller to the applicant of his objection; application by the applicant to be heard, Form E., p. 608, within one month; ten days' notice by the comptroller of a time when the applicant may be heard; notice by the applicant to the comptroller whether he desires to be heard or not, within five days; Rules 17 to 19, p. 597. Fees on hearing by the comptroller, by the applicant, and by the opponent respectively, 1*l.*

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

See p. 53, note (f).

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 authorized by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Page 57, Rule 60.

Cf. sect. 84, seal of the patent office, and sect. 89, sealed and certified copies to be evidence.

Request for certificate for use in obtaining registration abroad, Form R.; for use in legal proceedings, Form S.; for other general certificates, Form T.; form of general certificate, U.; request for copy of official notification of registration, Form V., pp. 614, 615.

Fees for the various certificates, p. 606.

Applications and notices by post.

97. (1.) Any application, notice, or other document authorized or required to be left, made, or given at the patent office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or

to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

The comptroller has a general power to enlarge the times prescribed by the rules, Rule 55, p. 604.

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.

Declarations, Rules 61, 62, p. 605.

The comptroller has a general power to dispense with any act or thing required to be done by the rules, or any document or declaration or evidence to be signed, made, or produced, Rule 53, p. 603.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.

101. (1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(a) For regulating the practice of registration under this Act:

(b) For classifying goods for the purposes of designs and trade-marks:

(c) For making or requiring duplicates of specifications, amendment, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the

Board of Trade think fit, of specifications, drawings, amendments and other documents:

(e) For securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies and institutions at home and abroad:

(g) Generally for regulating the business of the patent office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

The forms prescribed by the rules of 1890 are printed at pp. 607 *et seq.* They must be used in all cases to which they are applicable, Rule 5, p. 595.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

The Rules of 1890 are printed at p. 595. They repeal all former rules, Rule 63.

"Prescribed," where it occurs in the Act, means prescribed by any of the schedules to the Act, or by general rules under or within the meaning of the Act, sect. 117.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Annual reports of comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which

each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Proceedings of Board of Trade.

Act, 1888, s. 25.

[**102a.** (1.) All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.]

[(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.]

[(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.]

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade-marks.

Act, 1885, s. 6.

103. (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade-marks, or any of them, then any person who has applied for protection for any invention, design, or trade-mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade-mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the *date of the protection obtained* [date of the application] in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade-mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade-mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade-mark in this country, as the case may be.

Registration of foreign and colonial trade-marks, Chap. XX., p. 454.

The International Conventions of 1883 (signed at Paris, 20th March, 1883; ratified 6th June, 1884) and 1891 (signed at Madrid, 14th April, 1891; ratified 15th June, 1892) are printed at p. 658, and the list of foreign states to which the section is applicable, at p. 656.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade-mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade-mark:

This seems to be surplusage so far as regards trade-marks, see p. 458.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade-mark under this section, must be made in the same manner as an ordinary application under this Act: provided that, in the case of trade-marks, any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

Page 459.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Provision for colonies and India.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade-marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time by Order in Council to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

Registration of foreign and colonial trade-marks, Chap. XX., p. 454.
List of British Possessions to which the section is applicable, p. 656.
Definition of British Possession, sect. 117.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied

to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Pages 345, 484, 540, and cf. the application of a false trade description under the M. M. A., pp. 476, 483.

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Page 542.

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.

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. Reservation of remedies in Ireland.

An entry registered in the name of an Irish proprietor can be rectified under sect. 90 by the English Courts; *Re King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350; Kekewich, J., and C. A., pp. 237, 240.

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. General saving for jurisdiction of Courts.

See note to sect. 110.

(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.

112. This Act shall extend to the Isle of Man, and— Isle of Man.

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade-mark competent to those Courts;

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

[**112a.** The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding Jurisdiction of Lancashire

Palatine Court. Act, 1888, s. 26.

in relation to trade-marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.]

Repeal, Transitional Provisions, Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(a) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade-mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

As to which Act applied to the registration of a trade-mark where the application was pending at the date of commencement of a new Act, see p. 111. And see sect. 27 of the Act of 1888, p. 586.

Former registers to be deemed continued.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2.) The registers of designs and of trade-marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade-marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration

or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

"Law officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller General of Patents, Designs, and Trade-Marks:

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

Section 62.

FORM F.

FORM OF APPLICATION FOR REGISTRATION OF TRADE-MARK.

See Form F., Trade-Marks Rules, 1890, p. 608.

Section 113.

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.

No. 2.

PATENTS, DESIGNS, AND TRADE-MARKS ACT, 1888.

(51 & 52 Vict. c. 50.)

*** The several sections of this Act are printed and annotated together with the principal Act above; they are printed here for convenience of reference.

An Act to amend the Patents, Designs, and Trade-Marks Act, 1883. [24th December, 1888.

Whereas it is expedient to amend the Patents, Designs, and Trade-Marks Act, 1883, hereinafter referred to as the principal Act: 46 & 47 Vict. c. 57.

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:

Register of patent agents.

1.—(1.) After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2.) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4.) If any person knowingly describes himself as a patent

agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5.) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Amendments of 46 & 47 Vict. c. 57. s. 7, as to applications.

2. For section seven of the principal Act the following section shall be substituted, namely:—

"7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

"(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

"(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

"(4.) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

"(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

s. 9, as to disclosure of reports of examiners.

3. In sub-section five of section nine of the principal Act the words "other than an appeal to the law officer under this Act" shall be omitted.

s. 11, as to opposition to grant of patent.

4. In sub-section one of section eleven of the principal Act the words from "or on the ground of an examiner" to "a previous application," both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, "or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification."

s. 18, as to amended specifications.

5. For sub-section ten of section eighteen of the principal Act the following sub-section shall be substituted, namely:—

"(10.) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending."

s. 52, as to inspection of designs.

6. After sub-section one of section fifty-two of the principal Act the following words shall be added; namely,

"Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered."

s. 58, as to piracy of registered designs.

7.—(1.) In section fifty-eight of the principal Act the words "or cause to be applied" shall be added after the word "apply."

(2.) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

s. 62, as to application for registration.

8.—(1.) In sub-section two of section sixty-two of the principal Act for the words "the patent office in the prescribed manner" shall be substituted the words "such place and in such manner as may be prescribed."

(2.) To the same section of the principal Act the following sub-section shall be added:—

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

s. 63, as to limit of time for proceeding with application.

9. In section sixty-three of the principal Act for the words "the application shall be deemed to be abandoned" shall be substituted the words "the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned."

s. 64, as to fancy words.

10.—(1.) For section sixty-four of the principal Act the following section shall be substituted, namely—

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

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

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

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

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

"(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."

s. 67, as to colours of trade-marks.

11. In section sixty-seven of the principal Act the words "or colours" shall be added after the word "colour" in each place where that word occurs.

s. 68, as to advertisement of applications.

12. In section sixty-eight of the principal Act after the word comptroller shall be added the words "unless the comptroller refuse to entertain the application."

s. 69, as to opposition to registration.

13.—(1.) In sub-section one of section sixty-nine of the principal Act for the words "two months" shall be substituted the words "one month or such further time, not exceeding three months, as the comptroller may allow."

(2.) In the same sub-section the word "first" shall be omitted.

(3.) In sub-section two of the same section for the words "two months" shall be substituted the words "one month."

(4.) For sub-sections three and four of the same section the following sub-sections shall be substituted; namely,

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

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

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

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

"(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom."

s. 72, as to restrictions on registration.

14. In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of the sub-section, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

s. 73, as to restriction on registration.

15. In section seventy-three of the principal Act the word "exclusive" shall be omitted.

s. 74, as to additions to trade-marks.

16. For sub-section two of section seventy-four of the principal Act the following sub-section shall be substituted; namely,

"(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

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

s. 75, as to effect of registration.

17. For section seventy-five of the principal Act the following section shall be substituted; namely,

"Application for registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one

"thousand eight hundred and seventy-six to have been, the date of the registration."

Certificate as to exclusive use and costs thereon.

18. After section seventy-seven of the principal Act the following section shall be added and numbered 77A; namely,

"In an action for infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

Amendments of 46 & 47 Vict. c. 57.

s. 79, as to removal of trade-mark from the register.

19.—(1.) In sub-section five of section seventy-nine of the principal Act, for the words "the five years" shall be substituted the words "one year."

(2.) To the same sub-section the following words shall be added; namely, "unless it is shown to the satisfaction of the comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade-mark."

s. 81, as to Sheffield marks.

20.—(1.) For sub-section two of section eighty-one of the principal Act the following sub-section shall be substituted:

"(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade-marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade-Marks Registration Act, 1875, or in the register of trade-marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

38 & 39 Vict. c. 91.

(2.) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For sub-section seven of the same section the following sub-section shall be substituted:

(7.) The provisions of this Act and of any general rules

made under this Act with respect to the registration of trade-marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade-marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly, with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade-Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.

(4.) To the same section the following sub-sections shall be added; namely,—

(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

(15.) For the purpose of legal proceedings in relation to trade-marks entered in the Sheffield register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.

s. 87, as to entry of assignments, &c.

21. In section eighty-seven of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 88, as to inspection.

22. In section eighty-eight of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 90, as to rectification of register.

23. In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars."

s. 91, as to correction of errors.

24. To section ninety-one of the principal Act the following sub-section shall be added; namely,

"(d) Permit an applicant for registration of a design or trade-mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade-mark to be registered."

Proceedings of Board of Trade.

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely,

"(1.) All things required or authorised under this Act to

"be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

"(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

"(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified."

Jurisdiction of Lancashire Palatine Court.

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely,

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade-marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Commencement of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade-Marks Act, 1888, and this Act and the Patents, Designs, and Trade-Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade-Marks Acts, 1883 to 1888.

No. 3.

THE TRADE-MARKS REGISTRATION ACTS, 1875—77.

THE TRADE-MARKS REGISTRATION ACT, 1875.

38 & 39 Vict. c. 91.

An Act to establish a Register of Trade-Marks.

[13th August, 1875.]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—

Registration of trade-marks.

1. *A register of trade-marks as defined by this Act, and of the proprietors thereof shall be established under the superintendence of the Commissioners of Patents, and from and after the first day of July one thousand eight hundred and seventy-six a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by this Act until and unless such trade-mark is registered in pursuance of this Act.*

Characteristics of registered trade-mark.

2. *A trade-mark must be registered as belonging to particular goods, or classes of goods; and when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in such particular goods or classes of goods, and shall be determinable with such goodwill, but subject as aforesaid registration of a trade-mark shall be deemed to be equivalent to public use of such mark.*

Title of first proprietor of a trade-mark.

3. *The registration of a person as first proprietor of a trade-mark shall be* primâ facie *evidence of his right to the exclusive use of such trade-mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence of his right to the exclusive use of such trade-mark, subject to the provisions of this Act as to its connection with the goodwill of a business.*

Title of proprietor claiming by transmitted proprietorship.

4. *Every proprietor registered in respect to a trade-mark subsequently to the first registered proprietor shall, as respects his title to that trade-mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor.*

Rectification of register.

5. *If the name of any person who is not for the time being entitled to the exclusive use of a trade-mark in accordance with this Act, or otherwise in accordance with law, is entered on the register of trade-marks as a proprietor of such trade-mark, or if the registrar refuses to enter on the register as proprietor of a trade-mark the name of any person who is for the time being entitled to the exclusive use of such trade-mark in accordance with this Act, or otherwise in accordance with law, or if any mark is registered as a trade-mark which is not authorised to be so registered under this Act, any person aggrieved may apply in the preseribed 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 preseribed manner, register in respect of the same goods or classes of goods a trade-mark identical with one which is already registered with respect to such goods or classes of goods, and the registrar shall not register with respect to the same goods or classes of goods a trade-mark so nearly resembling a trade-mark already on the register with respect to such goods or classes of goods as to be calculated to deceive.*

It shall not be lawful to register as part of or in combination with a trade-mark any words the exclusive use of which would not, by reason of their being calculated to deceive or otherwise, be deemed entitled to protection in a Court of Equity; or any scandalous designs.

Establishment of registry and general rules.

7. *Subject as aforesaid, a register office shall be established from and after such time (not being later than the first day of January one thousand eight hundred and seventy-six), in such manner and with such officers, and at such salaries, to be paid out of moneys provided by Parliament, as the Lord Chancellor may, with the consent of the Treasury, direct; and the Lord Chancellor may from time to time, with the assent of the Treasury as to fees, make, and, when made, alter, annul, or vary, such general rules as to the registry of trade-marks, and as to notices to be given by advertisement before the registration of trade-marks, and as to the classification of goods for the purposes of this Act, and as to the registration of first and subsequent proprietors of trade-marks, and as to the fees to be charged for registration, and also for the continuance of a trade-mark on the register or otherwise, and as to the removal from the register of any trade-mark, as to notices, and as to the persons entitled to inspect the register, and as to any proceedings to be taken to obtain the judgment or leave of the Court in any matter in which the judgment or leave of the Court is required to be obtained under this Act, and generally for the purpose of carrying into effect this Act, as he may deem expedient.*

Any rules made in pursuance of this section shall be laid before both Houses of Parliament if Parliament be then sitting, or if not then sitting, then within ten days from the then next assembling of Parliament, and shall be of the same validity as if they had been enacted by Parliament; provided that if either House of Parliament resolve, within one month after such rules have been laid before such House, that any of such rules ought not to continue in force, any rule in respect of which such resolution has been passed shall, after the date of such resolution, cease to be of any force, without prejudice, nevertheless, to the making of any other rule in its place, or to anything done in pursuance of any such rules before the date of such resolution.

Certificate of registrar to be evidence.

8. *The certificate of the registrar as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be evidence of such entry having been made, and of the contents thereof, and of such matters and things having been done or left undone.*

Provision as to Cutlers' Company and Sheffield corporate marks.

9. *With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called "the Cutlers' Company"), and the marks or devices (in this Act called "Sheffield corporate*

"marks") assigned or to be assigned by the master, wardens, searchers, and assistants of that company, be it enacted as follows:—

(1.) *Within the prescribed time and in the prescribed manner the Cutlers' Company shall at their own expense deliver to the registrar under this Act copies of all Sheffield corporate marks in force at the time of such delivery:*

(2.) *When any person, after the passing of this Act, applies to the said master, wardens, searchers, and assistants to assign to him any mark or device, notice of such application, with a copy of such mark or device, shall, within the prescribed time and in the prescribed manner, be delivered to the registrar under this Act; and such mark or device shall not be assigned until after the expiration of the prescribed period from the giving of such notice. In like manner, when any person applies for the registration under this Act of a trade-mark as belonging to any goods or class of goods specified in section two of the Cutlers' Company's Act of* 1860, *notice of such application, with a copy of such trade-mark, shall, within the prescribed time and in the prescribed manner, be delivered to the Cutlers' Company; and such trade-mark shall not be registered until after the expiration of the prescribed period from the giving of the last-mentioned notice:*

(3.) *Upon the assigning of any such mark or device, or the registration of any such trade-mark as aforesaid, notice of the assignment or registration shall, within the prescribed time and in the prescribed manner, be given to the registrar under this Act, or to the Cutlers' Company, as the case may be:*

(4.) *The registrar under this Act, without the special leave of the Court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with respect to which a Sheffield corporate mark shall have been assigned and actually used, and of which mark a copy or description or notice of the assigning whereof shall have been delivered or given to the registrar as aforesaid, register a trade-mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive:*

(5.) *The master, wardens, searchers, and assistants of the Cutlers' Company, shall not assign to any person a mark or device identical with any trade-mark registered under this Act, and notice of the registration whereof shall have been given to the Cutlers' Company as aforesaid, or so nearly resembling the same as to be calculated to deceive:*

(6.) *Any person to whom a Sheffield corporate mark legally belongs shall be entitled to have the same mark registered also as a trade-mark under this Act, in respect of any particular goods or classes of goods, in the same manner and upon the same terms and conditions in and upon which he might have registered the same if it were not a Sheffield corporate mark:*

(7.) *Nothing in this Act shall prejudice or affect the rights and privileges of the Cutlers' Company, nor, save as is otherwise in this Act expressly provided, shall any of the provisions of this Act apply to or in the case of any Sheffield corporate mark.*

10. *For the purposes of this Act—* Definitions (*a*).

A trade-mark consists of one or more of the following essential particulars; that is to say,

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.

11. *This Act may be cited for all purposes as the Trade-Marks Registration Act*, 1875. Short title of Act.

(*a*) See sect. 64 of the present Act, *ante*, p. 552.

THE TRADE-MARKS REGISTRATION AMENDMENT ACT, 1876.

39 & 40 Vict. c. 33.

An Act for the Amendment of the Trade-Marks Registration Act, 1875. [24th July, 1876.]

38 & 39 Vict. c. 91.

Whereas by the Trade-Marks Registration Act, 1875, *in this Act referred to as the principal Act, it is provided that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by the principal Act until and unless such trade-mark is registered in pursuance of that Act:*

And whereas by reason of the number of trade-marks, and especially by reason of the difficulties attending the registration of trade-marks in relation to textile fabrics, it has been found impossible to complete the registration of existing trade-marks within the time specified by the said section; and it is therefore expedient to prolong the time for the completion of such registration as aforesaid, and otherwise to amend the principal Act:

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Amendment of s. 1 of the principal Act.

1. *There shall be repealed so much of section one of the principal Act as provides that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by that Act until and unless such trade-mark is registered in pursuance of that Act, and in place thereof be it enacted that—*

From and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade-mark as defined by the principal Act until and unless such trade-mark is registered in pursuance of that Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade-mark before the passing of the principal Act, registration thereof as a trade-mark under the principal Act shall have been refused as hereinafter is mentioned.

Saving of marks and devices not capable of being

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.

registered under Act.

3. *This Act may be cited for all purposes as the Trade-Marks Registration Amendment Act*, 1876.

Short title.

THE TRADE-MARKS REGISTRATION EXTENSION ACT, 1877.

40 & 41 Vict. c. 37.

An Act for extending the Time for the Registration of Trade-Marks, in so far as relates to Trade-Marks used in Textile Industries. [6th August, 1877.]

Whereas by section one of the Trade-Marks Registration Amendment Act, 1876, *it is provided that from and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade-mark as defined by the Trade-Marks Registration Act*, 1875 (*referred to in such Amendment Act and in this Act as the principal Act*), *until and unless such trade-mark is registered in pursuance of the principal Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade-mark before the passing of the principal Act, registration thereof as a trade-mark under the principal Act shall have been refused, as is in the said Act thereafter mentioned:*

39 & 40 Vict. c. 33.

38 & 39 Vict. c. 91.

And whereas by reason of the difficulties attending the registration of trade-marks used in the textile industries it has been found impossible to complete the registration of such trade-marks within the time specified by the said section, and it is therefore expedient to prolong such time as aforesaid:

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. *In so far as relates to the registration of trade-marks used in the textile industries, but not further or otherwise, section one of the Trade-Marks Registration Amendment Act*, 1876, *shall be construed as if for the words "from and after the first day of July one thousand eight hundred and seventy-seven" there were*

Extension of time for registration of trade-marks used in textile industries.

substituted the words "from and after the first day of January one thousand eight hundred and seventy-eight, or such further time as Her Majesty may by Order in Council determine."

Definition of "trade-marks used in the textile industries."

2. *The expression in this Act "Trade-marks used in the textile industries" means the trade-marks relating to goods comprised in classes* 23 *to* 35, *both inclusive, of the First Schedule to the rules under the Trade-Marks Registration Acts,* 1875—76, *dated September,* 1876.

Short title of Act.

3. *This Act may be cited for all purposes as "The Trade-Marks Registration Extension Act,* 1877," *and this Act and the Trade-Marks Registration Amendment Act,* 1876, *and the Trade-Marks Registration Act,* 1875, *may be cited together as "The Trade-Marks Registration Acts,* 1875—77."

No. 4.

TRADE-MARKS RULES, 1890.

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 shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

3. The fees to be paid in pursuance of the said Acts, so far as they relate to trade-marks, shall be the fees specified in the First Schedule hereto. Fees.

Forms.

4. The Form F in the First Schedule to the Patents, Designs, and Trade-Marks Act, 1883, shall be altered or amended by the substitution therefor of the Form F in the Second Schedule to these Rules. Forms.

5. (1) An application for registration of a trade-mark shall be made in the Form F in the Second Schedule to these Rules; (2) the remaining forms in such schedule may be used in all cases to which they are applicable.

Classification of Goods.

6. For the purposes of trade-marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller.

Application for Registration.

Application by firm.

7. An application for registration of a trade-mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be.

If the application be made by a body corporate it may be signed by the secretary or other principal officer of such body corporate.

Address of application.

8. Where a trade-mark for registration of which application is made is in classes 23, 24 or 25 of the Third Schedule to these Rules, the applicant shall address and send his application to the Manchester Trade-Marks Branch, 48, Royal Exchange, Manchester. Other applications (except applications which under Section 81 of the said Acts should be made to the Cutlers' Company) shall be addressed and sent to the Patent Office, Trade-Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

Agency.

9. An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.

Acknowledgment of application.

10. On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

11. Where application is made to register a trade-mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application.

Size, &c., of documents.

12. Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the Comptroller or to the Cutlers' Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Representations of trade-mark.

13. Subject to any other directions that may be given by the Comptroller, three representations of each trade-mark, except in the case of marks applied for in classes 23 to 35 inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half sheets. In the case of trade-marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap.

In the case of marks applied for in classes 23 to 35 inclusive, the applicant shall supply four representations of each mark for each class.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade-mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may, if dissatisfied with the representation of a trade-mark, require a fresh representation, either before he proceeds with the application or before he registers the trade-mark.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade-mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

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 section 66 of the said Acts, a representation of each trade-mark of the series shall be made or affixed upon the form of application and also upon each of the separate half-sheets of paper aforesaid.

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.

Mode of sending notices, &c.

16. Any application, statement, notice, or other document authorized or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Exercise of Discretionary Powers.

Hearing by Comptroller.

17. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for registration of a trade-mark, the Comptroller shall (if so required by the applicant within one month from the date of the Comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

Notice of wish to be heard

18. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall

before Comptroller. notify to the Comptroller whether or not he intends to be heard upon the matter.

Notification of decision. 19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Appeal to the Board of Trade.

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

Grounds of appeal to be stated. 21. The notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

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

Directions by Board. 23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

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

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

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

Advertisement of Application.

Advertisement of application. 27. Every application shall be advertised by the Comptroller in the official paper, during such times and in such manner as the Comptroller may direct, unless he refuse to entertain the application.

If no representation of the trade-mark be inserted in the official paper in connection with the advertisement of an application, the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade-mark is deposited for exhibition.

Definition of official paper.

28. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Means of advertising trade-mark to be supplied to official paper.

29. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade-mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade-mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

Advertisement of series.

30. When an application relates to a series of trade-marks differing from one another in respect of the particulars mentioned in section 66 of the said Acts, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade-marks constituting the series; and the Comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade-marks differ from one another.

Opposition to Registration.

Notice of opposition.

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

Opposition of 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 Comp-

troller may allow from the date of the advertisement of the application, the opponent shall leave at the Patent Office, Trade-Marks Branch, such evidence by way of statutory declaration as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.

Applicant's evidence.

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

Evidence in reply.

Closing of evidence.

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

Applications for leave to adduce further evidence.

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

Appointment of time for hearing.

(7.) On the completion of the evidence the Comptroller shall, upon application by either party, upon Form E in the Second Schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Disallowance of opposition in certain cases.

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

Decision to be notified to parties.

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

Register of Trade-Marks.

Time of registration of trade-marks.

32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the

* 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.

Comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, enter the name, address, and description of the applicant in the Register of Trade-Marks as the registered proprietor of the trade-mark in respect of the particular goods or classes of goods described in his application.

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

33. In case of the death of any applicant for a trade-mark after the date of his application, and before the trade-mark applied for has been entered on the register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

Entries to be made in register.

34. Upon registering any trade-mark the Comptroller shall enter in the register the date on which the application for registration was received by the Comptroller, and such other particulars as he may think necessary.

Notice of registration.

35. The Comptroller shall send notice to the applicant of the registration of his trade-mark, together with a reference to the advertisement of such trade-mark in the official paper.

Request by subsequent proprietor.

36. Where a person becomes entitled to a registered trade-mark by assignment, transmission, or other operation of law, a request for the entry of his name in the register as proprietor of the trade-mark shall be addressed to the Comptroller, and left at the Patent Office, Trade-Marks Branch.

Signature of request.

37. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised in like manner.

Contents of request.

38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade-mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade-mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade-mark has been registered.

Declaration to accompany request.

39. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several

statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade-mark as claimed by such request.

Further proof of title if required.

40. The claimant shall furnish to the Comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction.

Body corporate.

41. A body corporate may be registered as proprietor by its corporate name.

Definition of applicant.

42. The term "applicant" in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade-mark.

Comptroller may require statement from rival claimants.

43. Whether all such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by section 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Submission to Court of conflicting claims.

44. Where each of several persons claims to be registered as proprietor of the same trade-mark, and the Comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the Comptroller, or if the Comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

Settlement of special case.

45. Where the special case is to be submitted by the parties it may be agreed to by them, or if they differ, may be settled by the Comptroller, on payment of the prescribed fees.

Order of Court.

46. Where an order has been made by the Court in either of the following cases, viz.:—

(*a*) allowing an appeal under section 62 of the said Acts;
(*b*) disallowing an opposition to registration under section 69; or,
(*c*) under the provisions of sections 72, 90, or 92 of the said Acts,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office, Trade-Marks Branch, an office copy of such order. The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Removal of mark from register.

47. Where a trade-mark has been removed from the register for nonpayment of the prescribed fee or otherwise, under the

provisions of section 79 of the said Acts, the Comptroller shall cause to be entered in the register a record of such removal and the cause thereof.

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. Alteration of address in register.

49. Four clear days' notice of every application to the Court under section 90 of the said Acts, for rectification of the register, shall be given to the Comptroller. Notice to Comptroller of applications to rectify 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. Publication of rectification or variation of register.

51. Whenever the registered proprietor of any trade-mark intends to apply for the leave of the Court to add to or to alter such trade-mark, under section 92 of the said Acts, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the Comptroller such a number of representations of the trade-mark as altered as he may deem sufficient. Notice to Comptroller of order of Court for alteration of trade-mark under section 92 of Acts.

Inspection of Register.

52. The Register of Trade-Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week day, between the hours of ten and four, except on the days and at the times following:— Hours of inspection.

(*a*) Christmas Day, Good Friday, the day observed as Her Majesty's Birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

(*b*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(*c*) Times when the register is required for any purpose of official use.

Power to Dispense with Evidence.

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 Dispensing with evidence.

such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Amendments.

Amendment of documents.

54. Any document or drawing or other representation of a trade-mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which in the opinion of the Comptroller may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and on such terms as he may direct.

Enlargement of Time.

Comptroller may enlarge time.

55. The time prescribed by these rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Cutlers' Company.

Sheffield applications in duplicate.

56. All applications to the Cutlers' Company for registration of a trade-mark, under section 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

Notice to Comptroller.

57. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade-mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Time within which Comptroller may object to application made at Sheffield.

58. (1.) The time within which the Comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said company shall be one month from the date of the receipt by the Comptroller of the notice from the said company of the making of the application.

Advertisement of application made at Sheffield.

(2.) If no such objection is made by the Comptroller, the Cutlers' Company shall require the applicant to send the Comptroller a wood block or electrotype as the Comptroller may direct, and the Comptroller shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

Manner of notifying to Cutlers' Company applica-

(3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-section 8 of section 81 of the said

Acts shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application. tion received by Comptroller.

59. The provisions of these rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon. Similarity of proceedings at London and at Sheffield.

Certificates.

60. The Comptroller, when required to give a certificate as to any entry, matter, or thing which he is authorized by the said Acts or any of these rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate; but every certificate of registration shall have specified on the face thereof whether the same is to be used in legal proceedings or for the purpose of obtaining registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country. Certificate by Comptroller.

Declarations.

61. The statutory declarations required by the said Acts and these rules, or used in any proceedings thereunder, shall be made and subscribed as follows:— Manner in which, and persons before whom, declaration is to be taken.

(*a*) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(*b*) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorized by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

62. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorized to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration. Notice of seal of officer taking declaration to prove itself.

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 registrar a trade-mark for one or more articles included in one class	0	5	0
2. For registration of a trade-mark for one or more articles included in one class	1	0	0
3. For registering a series of trade-marks, for every additional representation after the first in each class	0	5	0
4. On appeal from Comptroller to Board of Trade—by appellant	1	0	0
5. On notice of opposition for each application opposed—by opponent	1	0	0
6. On hearing by Comptroller—by applicant and by opponent respectively	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
8. For every additional mark assigned or transmitted at the same time	0	2	0
9. For continuance of mark at expiration of 14 years	1	0	0
10. Additional fee where fee is paid within three months after expiration of 14 years	0	10	0
11. Additional fee for restoration of trade-mark where removed for nonpayment 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 section 91	0	5	0
16. For certificate of refusal to register a trade-mark under section 77	1	0	0
17. For certificate of refusal at the same time for more than one trade-mark, for each additional trade-mark after the first	0	10	0

	£	s.	d.
18. For certificate of registration to be used in legal proceedings	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
20. For certificate of Comptroller under section 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country	0	5	0
21. For copy of notification of registration	0	2	0
22. Settling a special case by Comptroller	2	0	0
23. For inspecting register, for every quarter of an hour	0	1	0
24. For making a search amongst the classified representations of trade-marks, for every quarter of an hour	0	1	0
25. For office copy of documents, for every 100 words (but never less than one shilling)	0	0	4
26. For certifying office copies, MS. or printed	0	1	0
27. In cases where the wood block or electrotype of the trade-mark exceeds 2 inches in breadth or depth, or in breadth and depth—for every inch or part of an inch over 2 inches in breadth	0	2	0
For every inch or part of an inch over 2 inches in depth	0	2	0
28. Manchester Trade-Marks Office	Same as above		
29. Sheffield Marks	Same as above		
30. On appeal from Cutlers' Company, Sheffield, to Comptroller	1	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

Approved,

FRANK MOWATT,
Assistant Secretary for the
Lords Commissioners of Her Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

	PAGE
Form of Application for Hearing by Comptroller	608
,, Application for Registration	608
,, Additional Representation of Trade-Mark	609
,, Appeal to Board of Trade	610
,, Transmission of Registration Fee	610
,, Notice of Opposition	610
,, Request to enter Name of Subsequent Proprietor of Trade-Mark	611
,, Request for Certificate of Refusal	611
,, Notice of Application for Alteration of Address	612
,, Notice of Order of Court for Rectification of Register	612
,, Application to Cancel Entry on Register	612
,, Declaration in support of Application to Cancel Entry	613
,, Request to Comptroller for Correction of Clerical Error, or for Permission to Amend Application under section 91	613
,, Request for Certificate of Registration for use in obtaining Registration Abroad	614
,, Request for Certificate of Registration for use in Legal Proceedings	614
,, Application for Settlement of a Special Case	614

PAGE
Form of Request for General Certificate of Comptroller..... 615
" General Certificate of Comptroller 615
" Request for Copy of Notification of Registration..... 615
" Appeal from Cutlers' Company 616
" Application for Continuance on Register 616
" Transmission of Additional Fee 616
" Application for Restoration to Register 617
" Application for Registration of old Corporate Trade-Mark.. 617

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM E.

Form of Application for Hearing by the Compiroller.

In Cases of Opposition, &c.

SIR,

of (*a*) hereby apply to be heard in reference to and request that I may receive due notice of the day fixed for the hearing.

Sir, your obedient Servant,

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Here insert full address.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM F.

Application for Registration of Trade-Mark.

One representation to be fixed within this square, and two others to be sent on separate half sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed thereto.

You are hereby requested to register the accompanying Trade-Mark in

Class , in respect of (*a*) in the name of (*b*) who claims to be the proprietor thereof (*c*).

The essential particulars of the Trade-Mark are the following (*d*) and disclaim any right to the exclusive use of the added matter.

(Signed) ——(*e*).

Dated the day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

[Or where the application is for a mark in Classes 23, 24, or 25.]

To the Comptroller, Manchester Trade Marks Branch, 48, Royal Exchange, Manchester.

NOTE.—If the Trade-Mark has been in use in respect of the goods since before August 13th, 1875, state length of such user.

(*a*) Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

(*b*) Here insert legibly the full name, address, and description of the individual firm or company. Add trading style (if any).

(*c*) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

(*d*) See sub-sections (2) and (3) of section 64 of the Acts.

(*e*) To be signed by the applicant or by an agent duly authorized.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

FORM G.

Additional Representation of Trade-Mark, to accompany Application for Registration.

One representation of the Trade-Mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed thereto.

TWO of these ADDITIONAL REPRESENTATIONS of the Trade-Mark must accompany *each* Form of Application.

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.) FORM H.

Form of Appeal from the Comptroller to the Board of Trade.

I, (*a*) of (*a*) hereby give notice of my intention to appeal to the Board of Trade from (*b*) of the Comptroller of the day of 18 , whereby he (*c*) .

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

(Signed) ——.

Dated day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London, and to
[*Name of Respondent to Appeal.*]

(*a*) Here insert full name and address of appellant.
(*b*) Here insert "the decision" or that part of the decision as the case may be.
(*c*) Here insert the decision complained of.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM I.

Fee for Registration of a Trade-Mark.

SIR,

In reply to your request I hereby transmit the prescribed fee for the registration of the Trade-Mark No. in Class .

I am, Sir, your obedient Servant,

——.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM J.

Notice of Opposition to Application for Registration.

[*To be accompanied by an unstamped duplicate.*]

In the matter of an application, No. by of .

I, (*a*) hereby give notice of my intention to oppose the registration of the Trade-Mark advertised under the above number for Class in the Trade-Marks Journal of the day of 18 , No. , page .

The grounds of opposition are as follows:— (*b*)

(Signed) ——.

Dated the day of 18 .

Address for service:—

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Here state full name and full address.
(*b*) See pp. 78 and 635.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM K.

Request to Enter Name of Subsequent Proprietor of Trade-Mark upon the Register, with Declaration in support thereof.

I, (*a*) hereby request that you will enter (*b*) name (*c*) in the Register of Trade-Marks as proprietor of the Trade-Mark No. in Class .

(*d*) entitled to the said Trade-Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade-Mark is registered.

(*e*)

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said Trade-Mark as above claimed.

(*f*) And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*g*)——.

Declared at this day of 18 .

Before me,

(*h*)——.

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) *Or* we. Here insert name, full address, and description.
(*b*) My *or* our.
(*c*) *Or* names.
(*d*) I am, *or* we are.
(*e*) Here state whether Trade-Mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof as *e. g.*, "by deed dated the day of 18 , made between So-and-So of the one part."
(*f*) This paragraph is not required when the declaration is made out of the United Kingdom.
(*g*) To be signed here by the person making the declaration.
(*h*) Signature and title of the authority before whom the declaration is made.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM L.

Request for Certificate of Refusal to Register a Trade-Mark in use before 13th August, 1875.

In the matter of an application for registration of an old Trade-Mark, No. in Class .

SIR,

I, , of , the applicant in the above matter, hereby request you to furnish me with your Certificate of Refusal to Register the said Trade Mark.

(*a*)——.

Dated this day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Signature of applicant.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form M.

Notice of Application for Alteration of Address on Register of Trade-Marks.

In the matter of the Trade-Mark, No. registered in Class .

SIR,

NOTICE is hereby given that I , of , the registered proprietor of the Trade-Mark numbered as above, desire that my address on the Register of Trade-Marks be altered to

Dated this day of , 18 .

(a) ——.

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(a) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form N.

Notice of Order of Court for Alteration or Rectification of Register of Trade-Marks.

In the matter of the Trade-Mark, No. , registered in Class , in the name of

SIR,

NOTICE is hereby given that by an Order of the Court made on the day of , 18 , it was directed that the entry on the Register of Trade-Marks in respect of the Trade-Mark numbered as above should be rectified in the manner therein specified.

An office copy of the Order of the Court is enclosed herewith.

Dated this day of , 18 .

(a) ——

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(a) To be signed by the person interested or his agent.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form O.

Form of Application by Proprietor of Registered Trade-Mark to Cancel Entry on Register.

Trade-Mark No. , Class , advertised in Trade-Marks Journal No. , page .

Name of registered proprietor or firm , place of business .

I, the undersigned, , of , [*or* I, the undersigned, , a

member of the firm of , of , on behalf of my said firm] apply that the entry upon the Register of the Trade-Marks in Class of the Trade-Mark No. may be cancelled.

The day of , 18 .

(Signed) ——.

This is the statement marked "O" referred to in the Declaration of , made before me the of , 18 .

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

Form P.

Form of Declaration in support of Application for Cancellation of Trade-Mark by Owner.

I, of ; [*or* I, , a member of the firm of , of], do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows:—

(1) The application signed by me, and dated the day of , 18 , and marked with the letter "O," and shown to me at the time of making this Declaration, is true.

(2) I am the person whose name appears on the Register of Trade-Marks as the proprietor of the Trade-Mark referred to in the said application marked with the letter "O."

[*or* My said firm is the firm whose name appears on the Register of Trade-Marks as the proprietor of the Trade-Mark referred to in the said application marked with the letter "O."]

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(Signed) ——.

Declared at , this day of , 18 .
Before me, .

If the declaration be made before a Commissioner to administer oaths it will require to be stamped with a 2*s*. 6*d*. impressed Inland Revenue stamp.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form Q.

Form of Request for Correction of Clerical Error or for Permission to amend Application under Section 91.

SIR,

I HEREBY request that .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form R.

Request for Certificate of Registration of Trade-Mark for use in obtaining Registration abroad.

In the matter of the Trade-Mark, No. , registered in Class , in the name of .

SIR,

I, , of , the registered proprietor of the above Trade-Mark, hereby request you to furnish me with your Certificate of Registration for use in obtaining registration of the same in (*a*) .

(*b*) ——.

Dated this day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Here state name of country in which registration is to be sought.
(*b*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form S.

Request for Certificate of Registration of Trade-Mark to be used in Legal Proceedings.

In the matter of the Trade-Mark, No. , registered in Class , in the name of .

SIR,

I, , of , the registered proprietor of the above Trade-Mark hereby request you to furnish me with your Certificate of Registration to be used in legal proceedings.

(*a*) ——.

Dated this day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

[TRADE-MARKS.] Form T.

Application for Settlement of a Special Case on Application to Register a Trade-Mark.

In the matter of the application of and of the application of .

SIR,

NOTICE is hereby given that I, , of , and I, , of , are unable to agree upon the facts on which the opinion of the Court is to be taken, and that we request you to fix a day on which we may

attend before you and obtain your finding on the matters of fact to be submitted to the Court as settled.

(*a*) ——.

Dated this day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) To be signed by both parties.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

[TRADE-MARKS.] Form T 1.

Request for General Certificate of Comptroller (other than Certificate for use in Legal Proceedings or for use in obtaining Registration Abroad).

In the matter of the Trade-Mark No. , in Class .

SIR,

I, , of , hereby request you to furnish me with your certificate that (*a*) .

(*b*) ——.

Dated this day of , 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Here set out the particulars which the Comptroller is requested to certify.

(*b*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

[TRADE-MARKS.] Form U.

General Certificate of Comptroller (other than Certificate for use in Legal Proceedings or for use in obtaining Registration Abroad).

Patent Office, Trade-Marks Branch, London, , 18 .

I, , Comptroller-General of Patents, Designs, and Trade-Marks, hereby certify .

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

[TRADE-MARKS.] Form V.

Request for Copy of Official Notification of Registration of Trade-Mark.

In the matter of the Trade-Mark, No. , registered in Class .

SIR,

I, , of , the registered proprietor of the Trade-Mark above named hereby request that you will furnish me with a copy of the official notification of the registration of the same.

(*a*) ——.

Dated this day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM W.

Form of Appeal from Cutlers' Company at Sheffield to Comptroller.

[*To be accompanied by an unstamped duplicate.*]

SIR,

I HEREBY give notice of appeal against the decision of the Cutlers' Company of Sheffield in regard to my application for registration of a Trade-Mark No. in Class for and I beg to submit my case (*a*) for your decision accordingly.

(*b*)————.

Dated this day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

(*b*) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM X.

Continuance of Mark at Expiration of Fourteen Years from the date of Registration.

SIR,

In pursuance of the notice received from you, I hereby transmit the prescribed fee of 1*l.* for continuance on the Trade-Marks Register of the Trade-Mark No. , in Class .

Dated the day of 18 .

(*a*)————.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM Y.

Additional Fee of 10*s.* *to accompany "Continuance Fee" (Form X), within Three Months after Expiration of Fourteen Years.*

SIR,

In pursuance of the notices issued by you, and of the provisions of sect. 79 (3), of the above Acts, I hereby transmit the additional fee of 10*s.* (along with Form X) for the continuance on the Trade-Marks Register of the Trade-Mark No. in Class .

Dated the day of 18 .

(*a*)————.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*a*) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) FORM Z.

Restoration of Trade-Mark where Removed for Nonpayment of Fee.

(*To accompany Form X.*)

SIR,

In pursuance of the notices issued by you, and of the provisions of sect. 79 (4), of the above Acts, I hereby transmit the additional fee of 1*l.* (along with Form X) for restoration to the Trade-Marks Register of the Trade-Mark No. in Class

Dated the day of 18 .

(*a*)———.

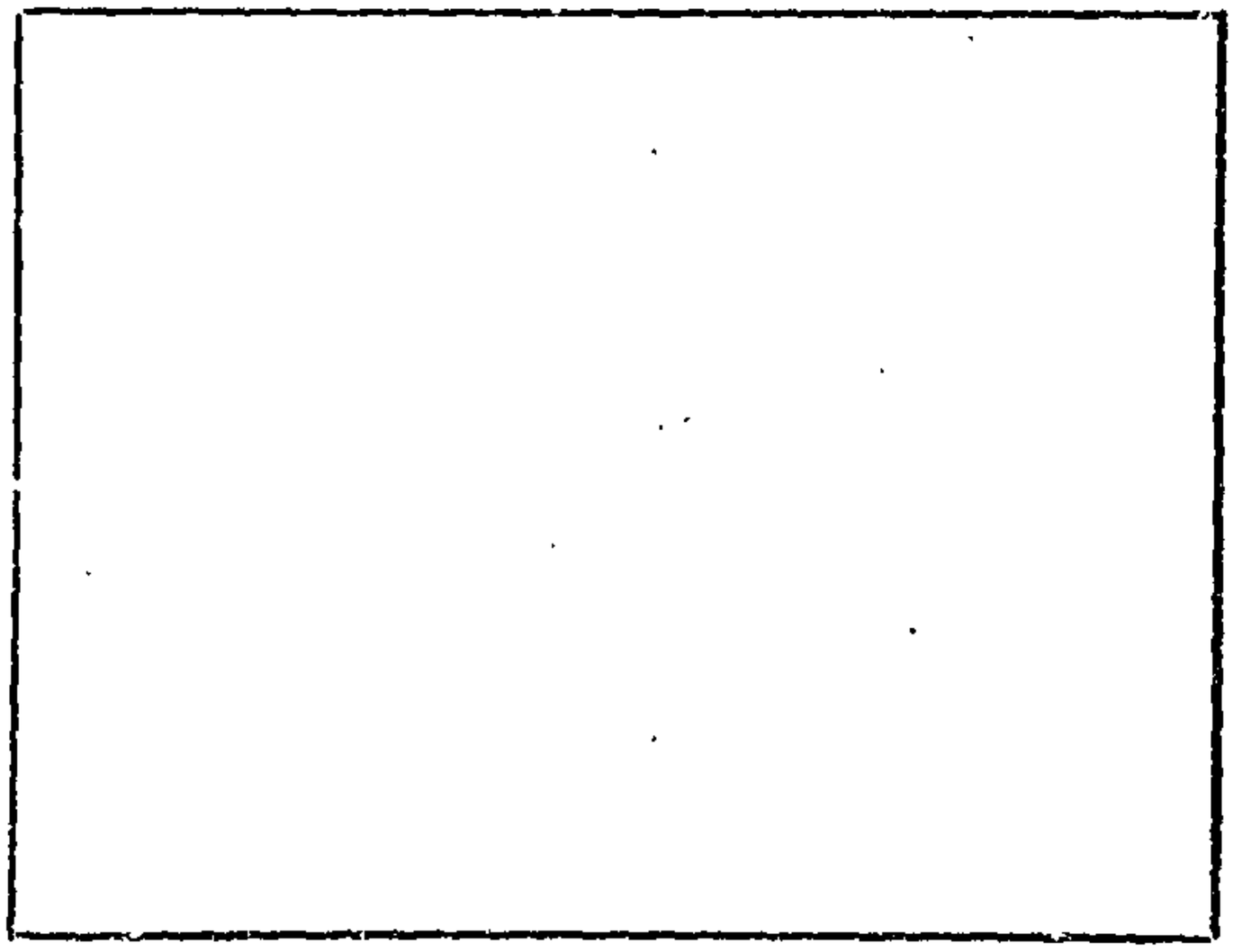
To the Comptroller, Patent Office, Trade-Marks Branch, 25, Southampton Buildings, London.

(*a*) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

Application for Registration of Old Corporate Trade-Mark.

(CORPORATE TRADE-MARK.)



You are hereby requested to register the accompanying old Corporate Trade-Mark in Class , in respect of , in the name of , who claims to be the proprietor thereof.

(Signed) ———.

Dated the day of 18 .

To the Cutlers' Company, Cutlers' Hall, Sheffield.

M. E. HICKS-BEACH,
President of the Board of Trade.

THIRD SCHEDULE.

General Note.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the comptroller may desire.

CLASSIFICATION OF GOODS (*a*).

	Illustrations.
	Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.
Class 1.	
Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.	Such as— Acids, including vegetable acids; alkalies; artists' colours; pigments; mineral dyes.
Class 2.	
Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.	Such as— Artificial manure; cattle medicines; deodorisers; vermin destroyers.
Class 3.	
Chemical substances prepared for use in medicine and pharmacy.	Such as— Cod liver oil; medicated articles; patent medicines; plasters; rhubarb.

(*a*) See Chap. V. p. 87.

By rule 6, "If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the comptroller."

An alphabetically arranged list comprising a great number of kinds of goods with references to their proper register classes, is published by authority, and is called the "Guide to the Classification of Goods under the Patents, &c. Acts, 1883—1888." It is prefaced by the following direction:—

"If any person intending to apply for registration of a Trade-Mark is, on examining the following enumeration of goods, uncertain as to the class to which his goods belong, he should send to the Comptroller-General a letter addressed—

"The Comptroller-General,
"The Patent Office, Trade-Marks Branch,
"25, Southampton Buildings, Chancery Lane, London, W.C.

"giving a full description of the goods and of the purposes for which they are used. He will then be informed by the Comptroller-General what class he should name in his application."

CLASS 4.	
Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.	Such as— Resins; oils used in manufactures and not included in other classes; dyes, other than mineral; tanning substances; fibrous substances (*e. g.*, cotton, hemp, flax, jute); wool; silk; bristles; hair; feathers; cork; seeds; coal; coke; bone; sponge.
CLASS 5.	
Unwrought and partly wrought metals used in manufacture.	Such as— Iron and steel, pig or cast; iron, rough; iron, bar and rail, including rails for railways; iron, bolt and rod; iron, sheet, and boiler and armour plates; iron, hoop; lead, pig; lead, rolled; lead, sheet; wire; copper; zinc; gold, in ingots.
CLASS 6.	
Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.	Such as— Steam engines; boilers; pneumatic machines; hydraulic machines; locomotives; sewing machines; weighing machines; machine tools; mining machinery; fire engines.
CLASS 7.	
Agricultural and horticultural machinery, and parts of such machinery.	Such as— Ploughs; drilling machines; reaping machines; thrashing machines; churns; cyder presses; chaff cutters.
CLASS 8.	
Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.	Such as— Mathematical instruments; gauges; logs; spectacles; educational appliances.
CLASS 9.	
Musical instruments.	
CLASS 10.	
Horological instruments.	
CLASS 11.	
Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.	Such as— Bandages; friction gloves; lancets; fleams; enemas.
CLASS 12.	
Cutlery and edge tools.	Such as— Knives; forks; scissors; shears; files; saws.

Class 13.	
Metal goods not included in other classes.	**Such as—** **Anvils; keys; basins (metal); needles; hoes; shovels; cork-screws.**
Class 14.	
Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.	**Such as—** **Plate; clock cases and pencil cases of such metals; Sheffield and other plated goods; gilt and ormolu work.**
Class 15.	
Glass.	**Such as—** **Window and plate glass; painted glass; glass mosaic; glass beads.**
Class 16.	
Porcelain and earthenware.	**Such as—** **China; stoneware; terra cotta; statuary porcelain; tiles; bricks.**
Class 17.	
Manufactures from mineral and other substances for building or decoration.	**Such as—** **Cement; plaster; imitation marble; asphalt.**
Class 18.	
Engineering, architectural, and building contrivances.	**Such as—** **Diving apparatus; warming apparatus; ventilating apparatus; filtering apparatus; lighting contrivances; drainage contrivances; electric and pneumatic bells.**
Class 19.	
Arms, ammunition, and stores not included in Class 20.	**Such as—** **Cannon; small arms; fowling pieces; swords; shot and other projectiles; camp equipage; equipments.**
Class 20.	
Explosive substances.	**Such as—** **Gunpowder; gun-cotton; dynamite; fog-signals; percussion caps; fireworks; cartridges.**
Class 21.	
Naval architectural contrivances and naval equipments not included in Classes 19 and 20.	**Such as—** **Boats; anchors; chain cables; rigging.**
Class 22.	
Carriages.	**Such as—** **Railway carriages; waggons; railway trucks; bicycles; bath chairs.**

CLASS 23.	
(*a*) Cotton yarn, and sewing cotton not on spools or reels.	
(*b*) Sewing cotton on spools or reels.	
CLASS 24.	
Cotton piece goods of all kinds.	Such as— Cotton shirtings; long cloth.
CLASS 25.	
Cotton goods not included in Classes 23, 24, or 38.	Such as— Cotton lace; cotton braids; cotton tapes.
CLASS 26.	
Linen and hemp yarn and thread.	
CLASS 27.	
Linen and hemp piece goods.	
CLASS 28.	
Linen and hemp goods not included in Classes 26, 27, and 50.	
CLASS 29.	
Jute yarns and tissues, and other articles made of jute not included in Class 50.	
CLASS 30.	
Silk, spun, thrown, or sewing.	
CLASS 31.	
Silk piece goods.	
CLASS 32.	
Other silk goods not included in Classes 30 and 31.	
CLASS 33.	
Yarns of wool, worsted, or hair.	
CLASS 34.	
Cloths and stuffs of wool, worsted, or hair.	
CLASS 35.	
Woollen and worsted and hair goods not included in Classes 33 and 34.	
CLASS 36.	
Carpets, floor-cloth, and oil-cloth.	Such as— Drugget; mats and matting; rugs.
CLASS 37.	
Leather, skins unwrought and wrought, and articles made of leather not included in other classes.	Such as— Saddlery; harness; whips; portmanteaus; furs.

CLASS 38. Articles of clothing.	Such as— Hats of all kinds; caps and bonnets; hosiery; gloves; boots and shoes; other ready-made clothing.
CLASS 39. Paper (except paperhangings), stationery, and bookbinding.	Such as— Envelopes; sealing wax; pens (except gold pens); ink; playing cards; blotting cases; copying presses.
CLASS 40. Goods manufactured from india-rubber and gutta-percha not included in other classes.	
CLASS 41. Furniture and upholstery.	Such as— Paperhangings; papier-mâché; mirrors; mattresses.
CLASS 42. Substances used as food, or as ingredients in food.	Such as— Cereals; pulses; olive oil; hops; malt; dried fruits; tea; sago; salt; sugar; preserved meats; confectionery; oil cakes; pickles; vinegar; beer clarifiers.
CLASS 43. Fermented liquors and spirits.	Such as— Beer; cyder; wine; whisky; liqueurs.
CLASS 44. Mineral and aërated waters, natural and artificial, including ginger-beer.	
CLASS 45. Tobacco, whether manufactured or unmanufactured.	
CLASS 46. Seeds for agricultural and horticultural purposes.	
CLASS 47. Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches; and starch, blue, and other preparations for laundry purposes.	Such as— Washing powders; benzine collas.
CLASS 48. Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).	

CLASS 49.	
Games of all kinds and sporting articles not included in other classes.	Such as— Billiard tables; roller skates; fishing nets and lines; toys.
CLASS 50.	
Miscellaneous— (1.) Goods manufactured from ivory, bone, or wood, not included in other classes. (2.) Goods manufactured from straw or 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, rickcloths, rope, twine. (8.) Buttons of all kinds, other than of precious metal or imitations thereof. (9.) Packing and hose of all kinds. (10.) Goods not included in the foregoing classes.	Such as— Coopers' wares.

(Signed) M. E. HICKS-BEACH,
President of the Board of Trade.

No. 5.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE-MARKS.

Preliminary.

1. All communications relating to trade-marks, not being marks in Classes 23, 24, or 25, or Sheffield marks, should be addressed to the Comptroller, Patent Office, Trade-Marks Branch. 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.)

2. The fees in relation to trade-marks registration cannot be received at the Patent Office. They should be paid in exchange for the *stamped forms* required, which may be obtained at the following places:—

(a) The Inland Revenue Office, Royal Courts of Justice, London (Room No. 6).

(b) The following Post Offices in London:—

The General Post Office, E.C.
District Post Office, Lombard Street, E.C.
" 195, Whitechapel Road, E.
" 239, Borough High Street, S.E.
" Charing Cross, W.C.
" 28, Eversholt Street, Camden Town, N.W.
Post Office, 12, Parliament Street, S.W., or

(c) The Chief Post Office of the undermentioned cities and towns:—

In England and Wales.

Accrington.	Bolton.	Carlisle.
Altrincham.	Bradford.	Chatham.
Ashton-under-Lyne.	Brighton.	Chester.
Barnsley.	Bristol.	Clitheroe.
Barrow-in-Furness.	Bromsgrove.	Congleton.
Bath.	Burnley.	Coventry.
Bedford.	Burslem.	Crewe.
Beverley.	Burton-on-Trent.	Croydon.
Birkenhead.	Bury.	Darlaston.
Birmingham.	Cambridge.	Derby.
Blackburn.	Cardiff.	Dewsbury.

IN ENGLAND AND WALES—*continued.*

Doncaster.	Macclesfield.	Scarborough.
Dorchester.	Manchester.	Sedgley.
Driffield.	Middlesbrough.	Sheffield.
Droitwich.	Nantwich.	Southampton.
Dudley.	Newcastle.	Stafford.
Durham.	Newport (Mon.)	Stalybridge.
Exeter.	Northallerton.	Stockport.
Gateshead.	Northampton.	Stoke-on-Trent.
Goole.	Nottingham.	Stourbridge.
Greenwich.	Nuneaton.	Stourport.
Guildford.	Oldbury.	Sunderland.
Halifax.	Oldham.	Swansea.
Hartlepool.	Patrington.	Tamworth.
Huddersfield.	Plymouth.	Truro.
Hull.	Pontefract.	Tunstall.
Ipswich.	Portsmouth.	Wakefield.
Keighley.	Prescot.	Walsall.
Kendal.	Preston.	Warrington.
Kidderminster.	Reading.	Wednesbury.
Knaresbro'.	Redditch.	West Bromwich.
Knutsford.	Richmond (Yorks.)	Whitby.
Lancaster.	Ripon.	Widnes.
Leamington.	Rochdale.	Wigan.
Leeds.	Rotherham.	Wolverhampton.
Leicester.	Rugby.	Wolverton.
Lichfield.	Salford.	Woolwich.
Lincoln.	St. Helens.	York.
Liverpool.		

IN SCOTLAND.

Aberdeen.	Glasgow.	Leith.
Dumbarton.	Greenock.	Paisley.
Dundee.	Inverness.	Perth.
Edinburgh.	Lanark.	Renfrew.

IN IRELAND.

Belfast.	Dundalk.	Londonderry.
Cork.	Galway.	Waterford.
Dublin.	Limerick.	Wexford.

NOTE.—*Arrangements have also been made by which any of the forms required may be ordered at any Money Order Office in the United Kingdom not included in the above List.*

3. The following is a list of the stamped forms under the Patents, Designs, and Trade-Marks Acts, 1883-1888, which relate to trade-marks, and which may be obtained at the places mentioned above:—

TRADE-MARKS.

Letter.	Title of Form.	Fee.
		£ s. d.
E	Application for hearing by comptroller	1 0 0
F	Application for registration of trade-mark	0 5 0
G	Additional representation form	No stamp.

TRADE-MARKS—*continued.*

Letter.	Title of Form.	Fee. £ s. d.
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 sect. 91	0 5 0
R	Request for certificate of registration for use abroad.	0 5 0
S	Request for certificate of registration for use in legal proceedings	1 0 0
T	Application for settlement of a special case	2 0 0
T¹	Request for general certificate of comptroller	0 5 0
V	Request for copy of official notification	0 2 0
W	Appeal from Cutlers' Company at Sheffield to comptroller	1 0 0
X	Fee for continuance of trade-mark at expiration of fourteen years	1 0 0
Y	Additional fee where fee is paid within three months after expiration of fourteen years	0 10 0
Z	Additional fee for restoration of trade-mark where removed for non-payment of fee	1 0 0

Of the above forms, those bearing the letters F, G, and I, are kept in stock at the various offices named in paragraph 2. Any of the others when required must be bespoken.

If it should not be convenient to apply in person at any of the above offices, the forms may be ordered by persons in this country or abroad *by post* from the Controller of Stamps, Room No. 7, Inland Revenue Office, Somerset House, London, W.C.

An application by post for forms must be accompanied by a banker's draft, or by a Money Order or Postal Order, payable to the Commissioners of Inland Revenue, and crossed "Bank of England," for the value of the stamp together with the cost of the postage and of the *registration* of the letter in which the forms will be forwarded to the applicant.

SALE OF OFFICIAL PUBLICATIONS.

4. The Patents, Designs, and Trade-Marks Acts, 1883-1888, and the Trade-Marks Rules, 1890, should be carefully studied. Copies of the Acts and of the Rules can be purchased at the Sale Branch of the Patent Office, 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 payable by a person making a search amongst the classified representations of trade-marks is 1*s.* for each quarter of an hour. The fee for a formal application 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 section 66 of the Acts, the comptroller is empowered to register under one registration a series of trade-marks which, whilst they resemble each other in the material particulars, differ from each other in respect of 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 section 74 of the Acts, sub-section 3, for definition of common marks.

Classification of Goods.

19. A guide to the classification of goods under the Trade-Marks Rules can be obtained on application at the Patent Office, Trade-Marks Branch, and should be asked for if the applicant feels any difficulty in determining to which of the classes set out in the Third Schedule to the Rules the goods for which he uses his mark belong.

Advertisement in the Trade-Marks Journal.

20. A trade-mark cannot in any case be entered upon the register until one month after its advertisement in the official paper.

21. A wood-block or electrotype must be furnished for each mark in each class claimed, except in the case of Class 23A (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 section 66 of the Acts, a wood-block or electrotype must be furnished for each mark in the series, for each class claimed.

23. The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

24. The largest space available for the insertion of any single block or electrotype is five and a half inches broad by seven and a half inches deep.

When a block or electrotype *exceeds two inches in depth or breadth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch in depth or breadth beyond the two inches.

25. The 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," "copyright," "entered at Stationers' Hall," "to counterfeit this is forgery," will not be registered under the Acts, and should not, therefore, appear upon the representations of trade-marks forming part of an application.

30. The following will not be registered as trade-marks, or as prominent parts of trade-marks, unless the marks have been used before 13th August, 1875:—

The royal arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of Her Majesty the Queen, or of any member of the Royal Family.

Representations of the Royal Crown.

The National Arms or Flags of Great Britain.

31. When there appears on the face of a trade-mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of *those goods only*.

Oppositions.

32. Notice of opposition to the registration of a trade-mark (Form J) must be filed within one month (or such further time, not exceeding three months, as the comptroller may allow) from the date of advertisement of the mark in the *Trade-Marks Journal*.

The applicant's counter-statement must be filed within one month from the date of receipt of the opponent's notice of opposition.

The opponent's evidence, in support of the opposition, must be filed within two months after the expiration of one month (or such further time, not exceeding three months, as the comptroller may allow) from the date of advertisement of the mark in the *Trade-Marks Journal*, and a copy forthwith sent to the applicant.

The applicant's evidence must be filed within one month from the delivery of the opponent's evidence, and a copy forthwith sent to the opponent.

The opponent's evidence in reply must be filed within seven days from the delivery of the applicant's evidence, and a copy forthwith sent to the applicant.

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:—

Pa[illegible], Designs, and Trade-Marks Acts, 1883–1888.

Trade-Marks.

In the matter of an application No.
and of the opposition thereto No.

In reply to the notice of opposition in this matter by of , I give notice by way of counter-statement that I rely for my application on the following grounds:—

(To be dated and signed by the *applicant* or his *solicitor*.)

To the Comptroller,
Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

Outlers' Company.

33. By section 81 of the Acts, application for the registration of trade-marks used on metal goods shall, if made by

a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company. *See* Rules 56 to 59.

Applications made to the Cutlers' Company in pursuance of section 81 of the Acts should be made on Form F, the address in the left-hand corner to be, "To the Cutlers' Company, Sheffield," instead of "To the Comptroller," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on foolscap paper. *See* Rule 56.

Applications sent by post should be addressed—

The Law Clerk to the Cutlers' Company,
The Cutlers' Hall,
Sheffield.

Manchester Office.

34. For the convenience of merchants and manufacturers engaged in the cotton trade, and for the purpose of facilitating the recording of trade-marks used in respect of cotton goods, an office is open at 48, Royal Exchange, Manchester, where searches can be made, on payment of 1*s.* for each quarter of an hour, for marks in classes of textiles from Class 23 to Class 35.

Certificates.

35. The comptroller's certificate in relation to a trade-mark is of four kinds, viz.:—

(i.) For use in legal proceedings.
(ii.) For use in applying for registration in foreign countries.
(iii.) Of any application made and of proceedings thereon.
(iv.) A certificate of refusal of a mark in use before 13th August, 1875, and not registerable.

36. A person desirous of obtaining any of the above certificates should forward Form S, Form R, Form T[1], or Form L (*see* paragraph 3), as the case may be, to the comptroller, giving the comptroller's official number of the mark, and stating whether the certificate is required for use in legal proceedings, or for use in applying for the registration of the mark in a foreign country, or for what other purpose.

37. In every case where a certificate is required in respect of a cotton mark, or in respect of any trade-mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the mark must be supplied, agreeing *in*

every respect with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the comptroller.

Registration of subsequent Proprietors of Registered Trade-Marks.

38. The request and declaration to be made by a subsequent proprietor on application for the registration in his name of a registered trade-mark must be made on Form K (*see* paragraph 3).

H. READER LACK,
Comptroller.

No. 6.

PRECEDENTS OF FORMS UPON AN OPPOSED APPLICATION TO REGISTER A TRADE-MARK AND ON APPEAL (*a*).

PAGE

1. Application for registration 608
2. Notice of opposition 635
3. Counter-statement 636
4. Evidence in support 637
5. Application for hearing 608
6. Appeal to the Board of Trade 610
7. Case on appeal 637
8. Reference by the Board of Trade to the Court 640
9. Notice of motion for the determination of the appeal 640

1. Application for Registration.

(Form F., above, p. 608.)

2. Notice of Opposition.

(Form J., above, p. 610.)

(*Grounds of opposition.*)

1. We are the registered proprietors of a trade-mark in Class , for [*describing the goods*] registered on the of 18 , and numbered 1,234, and we use, and since the of , 18 , we have extensively used, the said mark as a trade-mark in our business as [*describing the business*].

2. We also use, and since the of , 18 , we have extensively used, a mark consisting of [*describing it*] for [*describing the goods*] as a trade-mark, and also in our advertisements and price lists, in our said business.

3. The mark which the applicants by their application above referred to are seeking to register has such resemblance

(*a*) See Chap. IV., p. 58.

to our said registered trade-mark, numbered , and also to our said trade-mark in paragraph 2 hereof referred to, as to be calculated to deceive.

(For other grounds of opposition, see pp. 63, 78; Chap. VIII., p. 106, "What marks may be registered as trade-marks"; Chap. X., p. 175, "Restrictions on registration" (*b*).)

---

3. Counter-statement.

(In answer to the Notice of Opposition, No. 2.)

[*Heading as in the Form*, p. 632.]

1. We [*the applicants*] deny that the mark which is the subject of our application has such resemblance to either of the marks referred to in the notice of opposition herein as to be calculated to deceive.

2. [*Describing the principal differences between the applicants' mark, and the opponent's registered mark No.* 1,234].

3. [*Describing the principal differences between the applicants' mark, and the mark referred to in paragraph 2 of the notice of opposition.*]

4. The last-mentioned mark is not a trade-mark, and the opponents have not used the same as a trade-mark. If our said mark bears any undue resemblance to the said mark of the opponents (which we deny) the opponents will not in any way, nor will any right of which they are possessed, or to which they are entitled, be prejudiced by the registration of our said mark.

5. Our said mark has been used by us as a trade-mark in connection with the goods to which our application relates since the of , 18 , before the opponents had commenced to use either of their said marks, and if it bears any undue resemblance to the last-mentioned marks or either of them (which we deny), the said marks, or whichever of them our said mark so resembles, have or has been used as a trade-mark, if at all, and the opponents' alleged trade-mark, numbered 1,234, has been registered, in derogation of our rights, and our application to register ought not to be prejudiced by reason of such user or registration.

(Signed) ———.

To the Comptroller,
Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(*b*) See also *Kutnow's Tm.*, 10 R. P. C. 403.

4. Evidence in Support of the Application or Opposition (*c*).

The formal parts of the declarations are as follows:—

[*Heading as in the counter-statement*, p. 632.]

We do solemnly and sincerely declare as follows: [*setting out the evidence of the declarants*].

And we make this declaration conscientiously believing the same to be true and by virtue of the Statutory Declarations Act, 1835.

Declared at in the City of London this of 18 , before me, A commissioner for oaths. } (Signed) ——.

---

5. Application for Hearing by the Comptroller.

(Form E., above, p. 608.)

---

6. Form of Appeal from the Comptroller to the Board of Trade.

(Form H., above, p. 610.)

---

7. Statement of Case (*d*).

[*Heading as in the counter-statement*, p. 632.]

1. The appellants, , are manufacturers and vendors of indiarubber hose covered with steel wire, which is wound helically round it by a process protected by certain patents. The opponents, , are vendors of indiarubber hose covered with steel wire, wound round it by a process which is different to that employed by the appellants.

2. On or about the of , 18 , the appellants

(*c*) This is given by statutory declaration. Rule 31 (3), (4), p. 73, and Rules 61, 62, p. 605. As to the comptroller's power to dispense with evidence, see Rule 53, p. 603; and as to cases of infancy, lunacy, or other incapacity, sect. 99, p. 573.

(*d*) This is substantially the case made use of in *The Sphincter Co.'s Tm.*, 10 R. P. C. 84.

published a circular containing (*inter alia*) a representation of the device which they now seek to register as a trade-mark. The said circular and representation were registered at Stationers' Hall on the of , 18 , in the names of the appellants, and the copyright in the same is now and always has been vested in the appellants.

3. The said device consists of [*describing it*]. The said device was drawn on the instructions of the appellants, and was entirely novel in design, and it is a distinctive device. The appellants have extensively published and circulated the said circular and the said representation and device amongst persons concerned in the indiarubber and hose trade, and amongst their customers and others from the said of , 18 , to the present time.

4. By their application, numbered , the appellants sought to register the said device as a trade-mark in Class 50, for use in connection with the hose manufactured or sold by them. The said application was opposed on the grounds following: that the opponents are the proprietors of a trade-mark in Class 50, for hose, registered on the of , 18 , under No. ; and that they had (as they alleged) used for a considerable time past a device consisting of [*describing it*] as an advertisement and description of their hose in price lists, circulars, &c.; and that the mark for which the appellants are applying for registration had (as was alleged) such a resemblance to their said registered trade-mark and advertisement as to be calculated to deceive.

5. The trade-mark of the opponents consists of [*describing it*]. It is totally different in design and appearance from the said device of the appellants, and the said device bears no resemblance whatever to it,

6. It is untrue that the opponents have ever used any device similar to or resembling the said device of the appellants, or such as could be mistaken for or confounded with the said device referred to in the appellants' application, or such that the registration of the latter as a trade-mark would be calculated to deceive.

7. The opponents exhibited to their declaration in opposition certain copies of price lists and advertisements, and among them a price list marked , containing a figure numbered No. 1. The said price list and figure were first issued and published on the of , 18 , as an advertisement, that is to say, years after the appellants had commenced to issue and publish their said device. The said figure No. 1 consists of [*describing it*]. The said figure is quite different in design and appearance from the said device of the appellants, and the said device bears no resemblance whatever to it.

8. The application was heard before the learned registrar

sitting for the comptroller, and on the of , 18 , he gave his decision, and refused to allow the said device of the appellants to be registered.

9. The appellants crave leave to refer, for the purposes of their appeal, to all the evidence used at the hearing of their said application and of the opposition (*e*), and also to the written decision of the learned registrar.

The appellants submit that, under the circumstances hereinbefore stated, the decision of the learned registrar should be reversed, and the appellants' device No. above mentioned should be admitted to registration, on the following grounds:—

Grounds of appeal.

(1.) Because the said device is a distinctive device which the appellants are entitled to use and register as a trade-mark under the above-mentioned Acts.

(2.) Because the learned registrar was wrong in holding that it has been the custom in the hose trade to advertise pictures of hoses resembling the said device, whereas no such custom was established by the evidence, and such custom, if established, would not be a good ground of objection to the registration of the said device.

(3.) Because the learned registrar was wrong in holding that the said device resembles the said trade-mark of the opponents numbered No. , whereas the said device does not resemble the said trade-mark at all, or (alternatively) not so nearly as to be calculated to deceive.

(4.) Because the learned registrar was wrong in holding that the said device resembles the said figure No. 1, and such resemblance, if it existed, would not be a good ground of objection to the registration of the said device.

The matters with which this appeal is concerned are of great importance to the appellants, and they are desirous that the same may be referred to the decision of the Court under sect. 69 of the above-mentioned Act (*f*).

(Signed)

(*e*) See Rule 26, p. 598.

(*f*) If the Board of Trade see no reason for differing from the decision of the comptroller, they generally refer the appeal at once to the Court, and so save a step.

8. Form of Reference of the Appeal to the Court by the Board of Trade.

7, Whitehall Gardens, S.W.
———, 18 .

Dear Sirs,

[The application of , No.]
and
[The opposition of , No.].

Referring to the notice of appeal by in this matter dated the , I am instructed to inform you that the Board of Trade have deemed it expedient to refer this appeal to the Court by virtue of the provisions of sub-sect. 4 of sect. 69 of the Patents, Designs, and Trade-Marks Acts, 1883 and 1888, and have, pursuant to Rule 23 of the Trade-Marks Rules, 1890, directed the appellants to make application by motion, summons, or otherwise, as they may be advised, to the Chancery Division of the High Court of Justice to hear and determine the said appeal, and that notice of such application be served upon the Comptroller-General of Patents, Designs, and Trade-marks, and upon [*the opponents*], and that [*the opponents*], in default of being served within two months from this date with notice of any such application as aforesaid by the appellants, be at liberty to apply to the Chancery Division of the High Court of Justice as they may be advised. And that upon the hearing of any such application as aforesaid, the appellants, the said [*the opponents*], and the Comptroller-General be respectively at liberty to adduce such evidence as they respectively may be advised.

I am, dear Sir, yours truly,
(Signed) ———,
Solicitor, Board of Trade.

---

9. Notice of Motion for the Determination of the Appeal.

18 , No. .

In the High Court of Justice,
Chancery Division,
Mr. Justice .

[*Heading as in the Counter-statement above, p.* 632.]

Take notice that the Court will be moved before the Honourable Mr. Justice at 10.30 in the forenoon on the of , 18 , or so soon thereafter as counsel can be heard by counsel on behalf of the above-mentioned

applicants , that the appeal of the applicants from the decision of the Comptroller-General of Patents, Designs, and Trade-marks upon their above-mentioned application (which has been referred by the Board of Trade to the Court) may be heard and determined: And for an order directing the Comptroller-General of Patents, Designs, and Trade-marks to proceed with the registration of the trade-mark referred to in the said application.

Dated this of , 18 .

(Signed) ———

Solicitors for the above-named .

To the Comptroller-General of Patents,
Designs, and Trade-marks,
and
To [*the opponents*].

No. 7.

NOTICE OF MOTION TO RECTIFY THE REGISTER.

18 . No. .

In the High Court of Justice,
Chancery Division,
Mr. Justice .

In the matter of a Trade-mark numbered ,
And in the matter of the Patents, Designs, and Trade-Marks Acts, 1883-1888.

TAKE NOTICE that this Court will be moved before the Honourable Mr. Justice , on the of 18 , at 10.30 in the forenoon, or so soon thereafter as counsel can be heard, by counsel on behalf of (*the applicant*) of (*address*), for an order that the register of trade-marks kept under the above-mentioned Acts may be rectified (*as follows*):—

(1.) By the removal of the mark therein registered for class , and numbered .

(2.) By limiting the registration of the mark therein registered (&c.) for use in connection with part of the goods comprised in the said class only, namely,

(3.) By expunging from the said register part of the said mark No. , namely,

(4.) By adding to the entry therein of the said mark No. , a disclaimer of any right on the part of the registered proprietor of the said mark to the exclusive use of part of the said mark, that is to say, the words (*a*),

Or that such other order for the rectification of the said register may be made as to the Court shall seem fit.

(Signed) ——.

To (*the registered proprietor*),
and
To the Comptroller-General of Patents, Designs, and Trade-Marks.

(*a*) For other forms of rectification see above, p. 231. For forms of orders, see Seton, 6th ed. vol. 3, p. 1987.

No. 8.

PRECEDENTS OF PLEADINGS IN ACTIONS FOR INFRINGEMENT AND PASSING OFF (*a*).

1. Indorsement of Writ.

The plaintiff's claim is for—

(1.) An injunction to restrain the defendant, his servants, and agents, from infringing the plaintiff's registered trade-mark, No. 1234, and from passing off goods not of the plaintiff's manufacture as or for the goods of the plaintiff (*b*).

(2.) An account or damages.

(3.) Delivery up of the marked goods.

2. Statement of Claim.

1. The plaintiff and defendant are both manufacturers of hoes, shovels, and other hardware goods, carrying on business in Birmingham and also in London.

The plaintiff's registered trade-mark.

2. The plaintiff is the proprietor of a trade-mark consisting of the device of a circle and a triangle with a dagger placed between them, and the word "dagger" printed beneath the said device. The said trade-mark was registered, as an old mark, in the register of trade-marks, under No. 1234, by the plaintiff, as the proprietor thereof, on the 1st of January, 1890, in Class 13 for hoes and shovels.

Use of the trade-mark.

3. The plaintiff, and his predecessors in the business carried on by the plaintiff as aforesaid, have extensively used the said trade-mark and also the said word "dagger" as a trade-mark upon hoes and shovels manufactured and sold by them

(*a*) For the Forms given in the Appendix to the Rules of the Supreme Court, see p. 372. The first set of pleadings here given relate to an action for the infringement of a registered trade-mark, and also for passing off goods by the use of a trade-name and imitation of get-up. The paragraphs referring to each of the combined causes of action are readily distinguishable. The second set relate to an action for the infringement of an unregistered trade-mark.

(*b*) See a fuller form, p. 644, and other precedents, p. 648 *et seq.*

since the year 1850, and the plaintiff continues to extensively use the said trade-mark and word in his said business.

Plaintiff's goods known as "dagger" hoes.

4. By reason of the user alleged in the last paragraph, the plaintiff's hoes and shovels marked with the said trade-mark and word have become known to purchasers or intending purchasers as "dagger" hoes and shovels; and "dagger" hoes, and "dagger" shovels in the hardware trade mean respectively the hoes and shovels made and sold by the plaintiff.

Get-up of the plaintiff's goods.

5. The plaintiff is accustomed to paste upon the hoes and shovels manufactured and sold by him a number of small triangular labels arranged in the form of a circle and coloured alternately red and green, and hoes and shovels sold in the market and bearing triangular labels so arranged and coloured are known to purchasers or intending purchasers as, and are bought by them as and for, the goods of the plaintiff.

The infringing mark.

Imitation of the get-up.

6. The plaintiff has recently discovered, as the fact is, that the defendant is selling hoes and shovels not of the plaintiff's manufacture, bearing a mark consisting of the device of an oval and a square with a dagger placed between them, and having pasted upon them a number of small square labels arranged and coloured similarly to the labels used by the plaintiff, and referred to in paragraph 5 hereof.

Use of "dagger" by the defendant.

7. The plaintiff has also recently discovered, as the fact is, that the defendant has advertised and has invoiced and sold hoes and shovels, not of the plaintiff's manufacture, as "dagger" hoes and shovels.

Infringement of the registered trade-mark.

8. The use of the said device in paragraph 6 mentioned, and also of the word "dagger," as in paragraph 7 mentioned, is an infringement of the plaintiff's said trade-mark No. 1234.

Imitation of get-up.

9. The employment of the said square labels by the defendant is an unlawful imitation of the get-up of the plaintiff's goods referred to in paragraph 5 hereof.

Passing off goods: profits.

10. By reason of the unlawful acts aforesaid the defendant has sold and passed off, and has caused to be sold and passed off, large quantities of goods not of the plaintiff's manufacture as and for the plaintiff's goods, and has thereby gained large profits.

The plaintiff claims—

(1.) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade-mark, No. 1234, and from passing off goods not of the plaintiff's manufacture as or for the goods of the plaintiff. And in particular to restrain him and them from selling, offering for sale, or disposing of any hoes or shovels, not of the plaintiff's manufacture, bearing the device of a circle and a square with a dagger between them, or any other device colourably resembling the plaintiff's said trade-mark, or under the name "dagger"

hoes or shovels, or having fixed upon them square labels arranged in a circle, or any other labels in imitation of the get-up of the plaintiff's goods, in paragraph 5 hereof mentioned (*c*).

(2.) An account of the profits made by the plaintiff in selling or disposing of any hoes or shovels not of the plaintiff's manufacture, sold under the device in paragraph 6 hereof mentioned, or as "dagger" hoes or shovels, or bearing square labels arranged and coloured as in paragraph 8 hereof mentioned.

(3.) Delivery up to the plaintiff by the defendant upon oath of all hoes and shovels not of the plaintiff's manufacture, in the defendant's possession or under his control, marked with the device, or bearing the said labels, and of all price lists, copies of invoices, and other documents, and of all advertisement-blocks in the defendant's possession or under his control, bearing the words "dagger," for erasure or cancellation of the devices, labels, and words, or for destruction.

(4.) Costs.

---

3. Defence

(In answer to the above Statement of Claim No. 2).

Traverses of the allegations in the statement of claim.

1. The defendant admits that the plaintiff is registered as the proprietor of the alleged trade-mark, No. 1234 in class 13, but he denies that the said mark is a trade-mark, and that the plaintiff is properly registered as the proprietor of the same. The said mark was not used by the plaintiff or by his predecessors in business as a trade-mark before the 13th of August, 1875.

2. The defendant denies that the said mark and that the word "dagger" is, or at any material time has been, used as a trade-mark for hoes or shovels, and that the plaintiff's hoes or shovels are known as "dagger" hoes or shovels, and that "dagger" hoes or shovels mean, or are understood to mean, hoes or shovels made or sold by the plaintiff, and that hoes and shovels sold in the market and bearing labels arranged and coloured as stated in paragraph 5 of the statement of claim are known to purchasers or intending purchasers as, or are bought as or for the goods of the plaintiff.

Devices and word common to the trade.

3. The devices of a circle or an oval and a triangle, and the word "dagger," and the device of a dagger, are, and each of them is, common to the trade in hoes and shovels. The word "dagger" and the device of a dagger are commonly employed in the hardware trade to indicate a particular pattern of hoe

(*c*) See other forms of injunction, *post*, p. 648.

or shovel, namely, a hoe or shovel having an unusually narrow blade.

Get-up used for a long time by the defendant.

4. The business of the defendant as a manufacturer of hoes and shovels has been established since the year 1860, and the said business is much larger than that of the plaintiff. The defendant and his predecessors in the said business have for many years, and since the year 1870 at least (as the plaintiff has since the year last mentioned been well aware), used upon the hoes and shovels manufactured and sold by them a number of small square labels coloured red and green, and arranged in the form of a circle.

Acquiescence and waiver.

5. If the use by the defendant of the said square labels as aforesaid was at any time an infringement of any right of the plaintiff (which the defendant denies), the plaintiff has acquiesced in the same, and has long since forfeited any claim to interfere with such use.

Get-up of defendant's goods is not deceptive.

6. The said square labels arranged and coloured as aforesaid are not an imitation of the plaintiff's triangular labels, but are, and are well known to dealers in and purchasers of hoes and shovels to be, distinct from the same, and to indicate the goods of the defendant.

Denial of infringement.

7. The defendant denies that he has infringed the plaintiff's alleged trade-mark, or imitated the get-up of the plaintiff's goods. He admits that he has sold hoes and shovels, as he lawfully might, bearing some of the common marks aforesaid, namely, the devices of an oval, a square, and a dagger. Save as herein expressly admitted, he denies each of the allegations in paragraphs 6, 7, 8, and 9 of the statement of claim.

Denial of passing off and of profits.

8. The defendant denies that he has sold or passed off, or caused to be sold or passed off, any goods not of the plaintiff's manufacture as or for the plaintiff's goods, and that (if he has done so, which he denies) he has made any profits thereby.

---

4. Statement of Claim (*d*).

("Common Law Trade-Mark.")

1. The plaintiffs have for many years been manufacturers of belting for driving machinery, and have extensively advertised, and sold the belting made by them under the styles of "Camel," "Camel Brand," and "Camel Hair." In consequence thereof, belting called "Camel," "Camel Brand," or "Camel Hair," has become to be known in all parts of the world where belting is used as belting of the plaintiffs' manufacture, as the defendants well know.

2. The defendants have lately commenced the business of

(*d*) *Reddaway & Co.* v. *Bentham Hemp Spinning Co.*, 9 R. P. C. 503. This and the following pleading are taken from the report, and are probably somewhat abbreviated from the forms actually used.

belting manufacturers, and in order to obtain for themselves the reputation acquired by the plaintiffs, and to pass off their belting as that of the plaintiffs, and to deceive purchasers thereof, have adopted the words "Camel," "Camel Brand," and "Camel Hair," so used by the plaintiffs as aforesaid, and have sold belting under the same designation, and have advertised for sale belting manufactured by them as "Camel," "Camel Brand," and "Camel Hair Belting."

3. The use of the words "Camel," "Camel Brand," and "Camel Hair," by the defendants as aforesaid, is calculated to deceive purchasers of belting into the belief that they were buying belting of the plaintiffs' manufacture, and many persons have been so deceived (*e*).

---

5. Defence

(In answer to the above-printed Statement of Claim, No. 1).

1. The defendants deny that belting called "Camel," "Camel Brand," and "Camel Hair Belting," has become to be known in all parts of the world where belting is used as belting of the plaintiffs' manufacture; and, if it has, they deny that the defendants were aware of the fact.

2. The defendants and their predecessors have long carried on the business of hemp spinning, and some time ago commenced the manufacture of various kinds of belting in connection with and as a branch of their said business.

3. Amongst other materials used by the defendants in the manufacture of belting was yarn made of camels' hair; and the defendants have, as they lawfully may, described and sold the said belting as the "Bentham Solid Woven Camel-Hair Belting." The defendants have applied to the said belting manufactured and sold by them their distinctive trade-mark.

4. Save as aforesaid, the defendants deny that they have sold or advertised their belting manufactured by them as "Camel," "Camel Brand," and "Camel Hair."

5. The defendants deny that the use of the words "Camel," "Camel Brand," and "Camel Hair," would be calculated to deceive persons into the belief that they were buying goods of the plaintiffs' manufacture. The plaintiffs have no prescriptive or distinctive right to the use of the said words.

6. The defendants deny that the use of the words "Camel Hair," as used by them, was calculated to deceive purchasers of belting manufactured by the defendants into the belief that they were buying belting of plaintiffs' manufacture. The defendants deny that any persons have been so deceived.

(The defendants also denied that the plaintiffs had been damnified, and alleged that their competition with the plaintiffs was fair trade competition.)

(*e*) For forms of claim, see pp. 644 and 648 *et seq.*

No. 9.

FORMS OF ORDERS IN TRADE-MARK CASES AND CASES ANALOGOUS THERETO (*a*).

PAGE

1. Morison *v.* Moat (*Morison's Universal Medicine*) 648
2. Farina *v.* Silverlock (*Eau de Cologne*) 649
3. Seixo *v.* Provezendo (*Crown Seixo Wine*) 649
4. Wotherspoon *v.* Currie (*Glenfield Starch*) 649
5. Ford *v.* Foster (*Eureka Shirts*) 650
6. Orr-Ewing *v.* Johnston (*Two Elephant Yarn*) 650
7. Massam *v.* Thorley (*Thorley's Cattle Food*) 650
8. Hendriks *v.* Montagu (*Universal Life Assurance Co.*) 651
9. Read *v.* Richardson (*Dog's Head Beer*) 652
10. Lever *v.* Goodwin (*Self-Washer and Sunlight Soap*) 652
11. Melachrino *v.* The Melachrino, &c. Co. (*Melachrino Cigarettes*) .. 653
12. Apollinaris Co. *v.* Herrfeldt (*Apollinis Water*) 653
13. Jay *v.* Ladler (*Lady and Bear Furs*) 654
14. Montgomery *v.* Thompson (*Stone Ales*) 654
15. Wilkinson *v.* Griffith (*Red Medal Polish*) 654
16. Paine *v.* Daniels (*John Bull Beer*) 655

---

1. Morison *v.* Moat (*b*), 20 L. J. Ch. 529 (1851), Turner, V.-C.

Trade Secret.

Injunction against use of name of plaintiff's goods; against use of trade secret.

An injunction to restrain the defendant, his agents, servants, and workmen, from selling, or causing or procuring to be sold, under the title or designation of "*Morison's Universal Medicine*," any medicine made or manufactured by him, the said defendant, or by or under his order or direction; and also to restrain the defendant, his agents, servants and workmen, from making or compounding any medicines according to the secret in the said bill mentioned, and from in any manner using the secret of compounding the said medicines or any part thereof.

(*a*) The forms are taken from the reports cited; in some cases they give only the substance of the orders actually drawn up. For fuller forms and the formal parts of orders, see Seton, 6th ed., Vol. I., p. 634 *et seq.* A large number of orders have been collected by Mr. Sebastian, and are printed in his book, 3rd ed., p. 510.

(*b*) The Lords Justices required the plaintiffs to give an undertaking as to damages; 21 L. J. Ch. 248.

2. FARINA *v.* SILVERLOCK, 24 L. J. Ch. 632 (1855), Wood, V.-C.

Trade-Mark.

To restrain the defendant from printing or selling any labels similar to those in use by the plaintiff, or containing copies of his signature, or address, or flourish, seal or stamps, or other marks invented and used by the plaintiff, or marks merely colourably differing therefrom, intended to represent that Eau de Cologne prepared by other parties was Eau de Cologne prepared by the plaintiff.

Injunction against printing or selling labels; or passing off.

---

3. SEIXO *v.* PROVEZENDE, L. R. 1 Ch. 194 (1865), Cranworth, L.C.

Trade-Mark and Passing off.

An injunction to restrain the defendants from affixing, or causing to be affixed, to any casks of wine shipped to their orders, the brand or mark of a crown and the word *Seixo*, or any other combination of marks or words so contrived, as by colourable imitation or otherwise, to represent the marks or brands of the plaintiff, and from employing any marks or words which should be so contrived as to represent, or induce the belief, that such wines were Crown *Seixo*, or the produce of the Quinta *do Seixo*, or otherwise using the word *Seixo* without clearly distinguishing the same from the wines produced by the Quinta *do Seixo*.

Injunction against use of trade-mark; or of trade-name of the plaintiff's goods.

---

4. WOTHERSPOON *v.* CURRIE, L. R. 5 H. L. p. 523 (1872).

Trade-Name of Goods, Passing off.

Injunction restraining the respondent, his servants and agents, from using the word "Glenfield" in or upon any labels affixed to packets of starch manufactured by or for him, and from in any other way representing the starch manufactured by or for him to be "Glenfield Starch," and from selling or causing the same to be sold as "Glenfield Starch," and from doing any act or thing to induce the belief that starch manufactured by or for him, the respondent, is "Glenfield Starch" or starch manufactured by the appellants.

Injunction against use of name; and passing off.

---

5. FORD *v.* FOSTER, L. R. 7 Ch. p. 634 (1872), L.JJ.

Trade-Mark.

Injunction against use of trade-mark.

To restrain the defendants from applying the mark or title "*Eureka*" to any shirts manufactured by them, or to any shirts sold by them, unless manufactured by the plaintiffs, and from selling any shirts already marked with the mark and title "*Eureka*," unless such mark or title has been applied with the sanction of the plaintiff; and from issuing any boxes or packages on which the mark or title of "*Eureka*" shall be applied to shirts not of the plaintiff's manufacture; and from affixing or using any label or card or other mark containing the word "*Eureka*" to or upon any shirts not of the plaintiff's manufacture (there was also an order for an account limited to the period since the filing of the bill).

---

6. ORR-EWING & Co. *v.* JOHNSTON & Co., 13 C. D. p. 450 (1880), Fry, J., and C. A. (*c*).

Trade-Mark and Trade-Name.

Injunction against use of an infringing mark;

or any similar mark without distinguishing, &c.

To restrain the defendants, Robert Johnston & Co., their servants, workmen, and agents, from affixing or causing to be affixed to any Turkey red yarn not dyed by the plaintiffs, Archibald Orr-Ewing & Co., the ticket marked B, and from using two elephants on any tickets used on Turkey red yarn, without clearly distinguishing such tickets from the plaintiffs' ticket marked A, *and from employing any mark or words which would be calculated to cause any Turkey red yarn not dyed by the plaintiffs to be known in Bombay as "Bhé Hathi" yarn, or to* (*c*) (or so as to) represent or induce the belief that any of the said yarn was dyed by the plaintiffs; with an order for an account of profits and costs.

---

7. MASSAM *v.* THORLEY'S CATTLE FOOD COMPANY, 14 C. D. p. 762 (1880), C. A.

Trade-Name and Passing-off.

Injunction against passing off;

An injunction to restrain the defendant company, their servants, workmen, agents and travellers, and representatives respectively, from selling, exporting, or shipping, or causing, or procuring, or allowing to be sold, shipped, or exported, and from in any manner representing, or causing, or procuring to be represented, any goods manufactured by the defendant

(*c*) The words in italics were struck out by the House of Lords. 7 App. Cas. p. 234.

company as the manufacture or goods of the late *Joseph Thorley*, or of the plaintiffs, his trustees and successors in business; and also from in any manner representing, or causing, or procuring to be represented, or doing anything which shall lead to the belief that the defendant company have been or are carrying on the business of the late *Joseph Thorley*, or are the successors in business of the late *Joseph Thorley*; and also from affixing or permitting, or causing to be affixed to any goods or articles manufactured or bought, or procured, or sold, or shipped, or exported by the defendant company, or otherwise using or employing, or permitting to be used or employed, any labels, wrappers, or marks used by the late *Joseph Thorley* and the plaintiffs, his trustees and successors in business, or so contrived and prepared as to represent or lead to the belief that the goods or articles manufactured, or sold, or shipped, or exported by the defendant company are the goods or manufacture of the late *Joseph Thorley*, or of the plaintiffs; and also from employing, using, or circulating, or causing to be employed, used, or circulated, any circulars, pamphlets, notices, or advertisements of the late *Joseph Thorley* or of the plaintiffs, or which shall in any manner represent or lead to the belief that the defendant company have been or are carrying on the business of the late *Joseph Thorley*, or that they are his successors in business.

against pretence that defendants' business is the plaintiff's;

against imitation of marks and get-up.

Circulars and advertisement.

(The Court refused to prohibit the defendants using the name Thorley in a way not calculated to mislead the public.)

---

8. HENDRIKS *v.* MONTAGU, 17 C. D. p. 638 (1881), C. A.

Company's Trade-Name.

"An injunction to restrain the defendants from applying to the Registrar of Joint Stock Companies in *England* for registration, under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses, representing that a company is to be incorporated pursuant to the *Companies Act*, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any other such name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid."

Injunction against registration of company with name like plaintiff's name;

against advertising company with name like plaintiff's name;

or carrying on business under such name.

---

9. READ *v.* RICHARDSON, 45 L. T. N. S. p. 69 (1881), C. A.

Trade-Mark.

Undertaking as to damages.

The plaintiffs by their counsel undertaking to abide by any order this Court may make as to damages, in case this Court shall hereafter be of opinion that the defendants have sustained any by reason of this order which the plaintiffs ought to pay, this Court doth order that the defendants, E. Richardson & Co., their servants and agents, be restrained from using the figure of a dog's head upon any labels, tickets, or wrappers affixed or applied to bottles of beer or stout sold for exportation, or exported by the defendants to any of the Australian colonies or New Zealand, and from selling for exportation, or exporting, any bottles of beer or stout having affixed or applied thereto any such label, ticket, or wrapper, until judgment in this action, or further order: and it is ordered that the plaintiffs' costs of this motion be their costs in the action.

Interim injunction against use of trade-marks on goods for exportation.

Costs.

---

10. LEVER *v.* GOODWIN, 4 R. P. C. p. 503 (1886), Chitty, J., and C. A.

Trade-Mark and Passing off.

Trade-mark action dismissed.

Injunction against use of particular wrapper;

"This Court doth order that this action, so far as the same claims protection in respect of the trade-mark, No. 39,714, stand dismissed out of the said Court. And it is ordered, that the defendants, Goodwin Bros., their agents and servants, be restrained from selling, offering for sale, or disposing of any soap, not being manufactured for or by the plaintiffs, in the wrapper, *or* of the form of any one of the three exhibits admitted in this action to have been issued by the defendants, and marked J.S.S.1, J.S.S.4, and B.B.1, or in any wrapper or in any form calculated or intended to pass off, or to enable others to pass off, such soap as or for the goods of the plaintiffs. And it is ordered that the following account be taken, that is to say, an account of the profits made by the defendants in selling or disposing of soap, made by or for the defendants, in any wrapper such as that contained in the exhibits marked J.S.S.1, J.S.S.4, and B.B.1, and in the form of those exhibits. And it is ordered that the defendants, Goodwin Bros., do within fourteen days after the date of the chief clerk's certificate, to be made pursuant to this order, pay to the plaintiffs, Lever & Co., the amount which, upon taking such account, shall be certified to be payable by the defendants to the plaintiffs. And it is ordered that it be referred to the taxing master to tax the costs of the plaintiffs of this action, up to and including the trial, except so far as

against passing off.

Account.

Payment of amount found due.

Costs.

the same have been incurred by their claim for protection in respect of the trade-mark aforesaid. And it is ordered that it be referred to the taxing master to tax the costs of the defendants of the action, so far as the same have been incurred by the plaintiffs setting up the said claim for protection in respect of the said trade-mark, and the costs of the plaintiffs, when so taxed, are to be set off against the said costs of the defendants, when taxed, and the taxing master is to certify to whom, after such set-off, the balance is due. And it is ordered that the party from whom such balance shall be certified to be due do pay the amount thereof to the other party. And the question of the costs of this action incurred subsequent to the trial are reserved, and either of the parties are to be at liberty to apply as they may be advised."

Costs of account reserved.

---

11. MELACHRINO *v.* THE MELACHRINO EGYPTIAN CIGARETTE CO., 4 R. P. C. 225 (1887), Chitty, J.

Trade-Mark and Trade-Name.

An injunction to restrain the defendant *Poulides*, his agents and servants, from carrying on at No. 10, Pall Mall, the business carried on by him there under the name of *The Melachrino Egyptian Cigarette Co.*, or of *Melachrino & Co.*, and to restrain the defendants respectively, and their respective agents and servants, until judgment or further order, from selling or offering for sale cigarettes not of the plaintiffs' manufacture or merchandise, in boxes or packages having affixed thereto or connected therewith the labels, exhibits A11 and A12, or any other label being a colourable imitation of the plaintiffs' label.

Interim injunction against use of name for a particular business; and use of particular labels.

---

12. THE APOLLINARIS CO. *v.* HERRFELDT, 4 R. P. C. 488 (1887), C. A.

Trade-Marks.

That the defendants, Messrs. Herrfeldt and Campbell, their servants, agents, and workmen, be restrained, until judgment in this action or further order, from using the word "*Apollinis*," or any other word only colourably differing from the word "Apollinaris," upon any labels or corks used by them in the course of their trade in any mineral water, and also from offering for sale, or selling, or otherwise disposing of any mineral water in bottles bearing the word "*Apollinis*."

Interim injunction against use of infringing word; and sale of marked goods.

---

13. JAY *v.* LADLER, 6 R. P. C. 138, 140 (1888), Kekewich, J.

Trade-Mark and Passing Off.

Injunction against infringement by circulars or advertisements; against the use of a particular device.

To restrain the defendant from infringing the plaintiff's trade-mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade-mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats, or otherwise using the said trade-mark in that connection (and also from using the device of a lady and a bear so as to deceive the public).

---

14. MONTGOMERY *v.* THOMPSON, 41 C. D. 47 (1889), Chitty, J., and C. A. (*d*).

Trade-Name, Passing off.

Interim injunction against the use of the plaintiffs' trade-name; and against passing off.

An injunction restraining the defendant until judgment or further order from carrying on the business of a brewer at *Stone*, under the title of "*Stone Brewery*," or "*Montgomery's Stone Brewery*," or under any other title so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling or causing to be sold any ale or beer not of the plaintiffs' manufacture, under the term "*Stone Ale*" or "*Stone Ales*," or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture.

---

15. WILKINSON *v.* GRIFFITH BROS. & Co., 8 R. P. C. 376 (1891), Romer, J.

Trade-Name and Passing off.

Injunction against the use of a particular label.

Inquiry as to damages.

Costs.

An injunction restraining the defendants, their agents and servants, from selling, or offering for sale, any French polish not of the plaintiffs' manufacture with the label complained of upon it, or so labelled or marked as to induce the public to believe that it is of the plaintiffs' manufacture. An inquiry as to the amount of damages suffered by the plaintiffs by the wrongful acts of the defendants. The defendants to pay the costs of the action up to and including the trial. The subsequent costs to be reserved, with liberty to apply. The costs which the defendants are ordered to pay to include the costs of the counterclaim which was not insisted upon.

(*d*) The injunction was made perpetual, and was upheld by the House of Lords; (1891) A. C. 217.

16. Paine & Co. *v.* Daniells & Sons' Breweries, (1893) 2 Ch. 581, C. A.

Trade-Mark and Passing off.

Restrain the defendants, their servants, and agents, from using the label marked "F." in the labels referred to in the plaintiffs' interrogatories, and from otherwise infringing the plaintiffs' registered trade-marks aforesaid, and from doing any act calculated to pass off ale or beer made by the defendants as ale or beer made by the plaintiffs.

Injunction against use of trade-mark; and against passing off.

No. 10.

ORDERS IN COUNCIL APPLYING THE PROVISIONS OF SECT. 103 OF THE PATENTS, ETC. ACT OF 1883 TO BRITISH POSSESSIONS AND FOREIGN STATES.

COLONIAL ARRANGEMENTS.

Colony.	Date of Order in Council.	London Gazette.
Queensland	17 Sept., 1885.....	22 Sept., 1885, p. 4429.
New Zealand	8 Feb., 1890	11 Feb., 1890, p. 727.

INTERNATIONAL ARRANGEMENTS.

Foreign State.	Date of Order in Council.	London Gazette.
Belgium	26 June, 1884	1 July, 1884, p. 2993.
Brazil	26 June, 1884	1 July, 1884, p. 2993.
Dominican Republic..	21 Oct., 1890	28 Oct., 1890, p. 5661.
Ecuador	16 May, 1893	19 May, 1893, p. 2899.
France	26 June, 1884	1 July, 1884, p. 2993.
Guatemala	26 June, 1884	1 July, 1884, p. 2993.
Italy	26 June, 1884	1 July, 1884, p. 2993.
Mexico	28 May, 1889	31 May, 1889, p. 2954.
Netherlands	26 June, 1884	1 July, 1884, p. 2993.
Netherlands (East Indian Colonies)	17 Nov., 1888	23 Nov., 1888, p. 6412.
Netherlands(Curaçoa and Surinam)	17 May, 1890	20 May, 1890, p. 2891.
Paraguay	24 Sept., 1886.....	28 Sept., 1886, p. 4726.
Portugal	26 June, 1884	1 July, 1884, p. 2993.
Roumania	5 Aug., 1892	12 Aug., 1892, p. 4554.
Servia	26 June, 1884	1 July, 1884, p. 2993.
Spain	26 June, 1884	1 July, 1884, p. 2993.
Sweden and Norway..	9 July, 1885	10 July, 1885, p. 3173.
Switzerland	26 June, 1884	1 July, 1884, p. 2993.
Tunis	26 June, 1884	1 July, 1884, p. 2993.
United States	12 July, 1887	15 July, 1887, p. 3827.
Uruguay	24 Sept., 1886.....	28 Sept., 1886, p. 4725.

Places under British Jurisdiction.

Penalties on British subjects committing offences against the Patents, &c. Acts, 1883 to 1888 (*b*).

Places.	Date of Order in Council.	London Gazette.
Africa (Madagascar and certain other parts)	15 Oct., 1889	22 Oct., 1889, p. 5557.
Brunei	22 Nov., 1890	28 Nov., 1890, p. 6671.
Morocco	28 Nov., 1889	13 Dec., 1889, p. 7163.
Persia	13 Dec., 1889	24 Dec., 1889, p. 7417.
Persian Coast	13 Dec., 1889	24 Dec., 1889, p. 7459.
Somali Coast	13 Dec., 1889	24 Dec., 1889, p. 7467.
Zanzibar	16 May, 1893	19 May, 1893, p. 2899.

(*b*) Orders in Council issued under 41 & 42 Vict. c. 67, now replaced by 53 & 54 Vict. c. 37.

No. 11.

THE INTERNATIONAL CONVENTION (*a*).

INTERNATIONAL CONVENTION BETWEEN THE GOVERNMENTS OF BELGIUM, BRAZIL, SPAIN, FRANCE, GUATEMALA, ITALY, NETHERLANDS, PORTUGAL, SALVADOR,* SERVIA, AND SWITZERLAND, FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

Signed at Paris, March 20, 1883.

[*Ratifications exchanged at Paris, June* 6, 1884.]

(Translation.)

ART. I.—THE Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador,* Servia, and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

ART. II.—The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models; trade-marks and trade-names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

* Salvador withdrew from this Convention by notice dated September 6, 1886.

(*a*) Further articles were agreed upon at the Conference at Rome in 1886 (see Parliamentary Paper, C.—4837), but were never ratified. The articles printed below, p. 664, were agreed upon at the Conference at Madrid in 1889, and they have been duly ratified by Great Britain, Spain, France, Switzerland, and Tunis. There are numerous other Treaties and arrangements existing between this country and foreign States for the protection of the trade-marks of each other's subjects. See Parliamentary Papers (1888), Commercial, No. 12, and (1872) C.—633.

ART. III.—Subjects or citizens of States not forming part of the Union, who are domiciled, or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

ART. IV.—Any person who has duly applied for a patent, industrial design or model, or trade-mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

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.

ART. V.—The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ART. VI.—Every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

ART. VII.—The nature of the goods on which the trade-mark is to be used can, in no case, be an obstacle to the registration of the trade-mark.

ART. VIII.—A trade-name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade-mark.

ART. IX.—All goods illegally bearing a trade-mark or trade-name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper public department or the interested party, pursuant to the internal legislation of each country.

ART. X.—The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade-name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

ART. XI.—The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade-marks, for articles exhibited at official or officially recognized international exhibitions.

ART. XII.—Each of the high contracting parties agrees to establish a special government department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade-marks.

ART. XIII.—An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the governments of all the Contracting States, shall be placed under the high authority of the central administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

ART. XIV.—The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end conferences shall be successively held in one of the Contracting States by delegates of the said States. The next meeting shall take place in 1885 at Rome.

ART. XV.—It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present Convention.

ART. XVI.—States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

ART. XVII.—The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ART. XVIII.—The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other contracting parties.

[*Here follow the Signatures.*]

Final Protocol.

On proceeding to the signature of the Convention concluded this day between the governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed as follows:—

1. The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognized by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade-mark shall be excluded from protection in any state of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, 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 organization of the special department for industrial property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2,000fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely :—

1st class	.. ..	25 units.
2nd ,,	.. ..	20 ,,
3rd ,,	.. ..	15 ,,
4th ,,	.. ..	10 ,,
5th ,,	.. ..	5 ,,
6th ,,	.. ..	3 ,,

These co-efficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense :—

1st class	.. France, Italy.
2nd ,,	.. Spain.
3rd ,,	.. Belgium, Brazil, Portugal, Switzerland.
4th ,,	.. Holland.
5th ,,	.. Servia.
6th ,,	.. Guatemala, Salvador.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The International Office will centralize information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement which will be distributed to all the administrations. It will interest itself in all matters of common utility to the Union,

and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said administrations, or by societies or private persons, will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The administration of the country in which the next Conference is to be held will make preparation for the transactions of that Conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the Conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present final protocol, which shall be ratified together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as, the said Convention.

[*Here follow the signatures.*]

Accessions and Withdrawals (*b*).

Dominican Republic acceded December 8, 1884.
Equator acceded December 21, 1883; but withdrew February 27, 1886.
Salvador, a signatory party, withdrew September 6, 1886.
Sweden acceded June 18, 1885.
United States acceded May 30, 1837.

(*b*) See the list printed at p. 656.

Arrangement between Great Britain, Spain, France, Switzerland, and Tunis, for the Prevention of False Indications of Origin of Goods (*a*).

Signed at Madrid, April 14, 1891.

[*Ratifications exchanged at Madrid, June* 15, 1892.]

(Translation.)

The undersigned Plenipotentiaries of the States hereinafter enumerated,

In view of Article XV. of the International Convention of the 20th March, 1883, for the protection of industrial property,

Have mutually concluded the following arrangement, subject to ratification :—

Art. I.—All goods bearing a false indication of origin, in which one of the Contracting States, or a place situated therein, shall be directly or indirectly indicated as being the country or place of origin, shall be seized on importation into any of the said States.

The seizure may also take place either in the State where the false indication of origin has been applied, or in that into which the goods bearing the false indication may have been imported.

If the law of any State does not permit seizure on importation, such seizure shall be replaced by prohibition of importation.

If the law of any State does not permit seizure in the interior, such seizure shall be replaced by the remedies assured in such case to natives by the law of such State.

Art. II.—The seizure shall take place at the request either of the proper government department, or of an interested party, whether individual or society, in conformity with the domestic law of each State.

The authorities are not bound to effect the seizure of goods in transit.

Art. III.—The present stipulations are not intended to prevent the vendor from indicating his name or address upon goods coming from a country other than that where the sale takes place; but in such case the address or the name must be accompanied by a clear indication in legible characters of the country or place of manufacture or production.

(*a*) Parliamentary Paper, Treaty Series, No. 13 (1892).

ART. IV.—The tribunals of each country will decide what appellations, on account of their generic character, do not fall within the provisions of the present arrangement, regional appellations concerning the origin of products of the vine being, however, not comprised in the reserve provided for by the present article.

ART. V.—States which are parties to the Union for the Protection of Industrial Property, and who have not adhered to the present arrangement, shall be allowed to accede on demand in the manner prescribed by Article XVI. of the Convention of the 20th March, 1883, for the Protection of Industrial Property.

ART. VI.—The present arrangement shall be ratified, and the ratifications shall be exchanged at Madrid within six months at the latest.

It shall come into force one month after the exchange of ratifications, and have the same force and duration as the Convention of the 20th March, 1883.

In witness whereof the plenipotentiaries of the States hereinafter enumerated have signed the present arrangement at Madrid, 14th April, 1891.

[Signed on behalf of Brazil, Spain, France and Tunis, Great Britain, Guatemala, Portugal, and Switzerland, but Brazil, Guatemala, and Portugal did not ratify.]

No. 12.

MERCHANDISE MARKS ACT, 1887 (*a*).

(50 & 51 Vict. c. 28.)

ARRANGEMENT OF SECTIONS.

Section.
1. Short title.
2. Offences as to trade-marks and trade descriptions.
3. Definitions.
4. Forging trade-mark.
5. Applying marks and descriptions.
6. Exemption of certain persons employed in ordinary course of business.
7. Application of Act to watches.
8. Mark on watch case.
9. Trade-mark, how described in pleading.
10. Rules as to evidence.
11. Punishment of accessories.
12. Search warrant.
13. Extension of 22 & 23 Vict. c. 17, to offences under this Act.
14. Costs of defence or prosecution.
15. Limitation of prosecution.
16. Prohibition on importation.
17. Implied warranty on sale of marked goods.
18. Provisions of Act as to false description not to apply in certain cases.
19. Savings.
20. False representation as to Royal Warrant.
21. Application of Act to Scotland.
22. Application of Act to Ireland.
23. Repeal of 25 & 26 Vict. c. 88.

An Act to consolidate and amend the Law relating to Fraudulent Marks on Merchandise. [23rd August, 1887.]

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the same, as follows:

Short title.

1. This Act may be cited as the Merchandise Marks Act, 1887.

Offences as to trade-marks and trade descriptions.

2.—(1.) Every person who—

(a) forges any trade-mark (pp. 465 to 472); or

(b) falsely applies to goods any trade-mark or any mark so

(*a*) See Book II., p. 460.

nearly resembling a trade-mark as to be calculated to deceive (pp. 472 to 475); or

(c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark (pp. 465 to 472); or

(d) applies any false trade description to goods (pp. 475 to 498); or

(e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark (pp. 465 to 472); or

(f) causes any of the things above in this section mentioned to be done (p. 500),

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud (pp. 505 to 509), be guilty of an offence against this Act.

(2.) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark or false trade description is applied, or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

(a) That having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade-mark, mark, or trade description; and

(b) That on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or

(c) That otherwise he had acted innocently;

be guilty of an offence against this Act (pp. 510 to 513).

(3.) Every person guilty of an offence against this Act shall be liable (p. 513)—

(i.) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and

(ii.) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and

(iii.) in any case, to forfeit to her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

(4.) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit (p. 514).

(5.) If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions (p. 519).

(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts: Provided that a person charged with an offence under this section before a court of summary jurisdiction shall, on appearing before the court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly (p. 514).

42 & 43 Vict. c. 49.

Definitions.

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 the one hundred and third section of the Patents, Designs, and Trade-Marks Act, 1883, are, under Order in Council, for the time being applicable (p. 465):

46 & 47 Vict. c. 57.

The expression "trade description" means any description, statement, or other indication, direct or indirect,

(a) as to the number, quantity, measure, gauge, or weight, of any goods, or

(b) as to the place or country in which any goods were made or produced, or

(c) as to the mode of manufacturing or producing any goods, or

(d) as to the material of which any goods are composed, or

(e) as to any goods being the subject of an existing patent, privilege, or copyright,

and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act (pp. 476 to 487):

The expression "false trade description" means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect, and the

fact that a trade description is a trade-mark, or part of a trade-mark, shall not prevent such trade description being a false trade description within the meaning of this Act (pp. 487 to 491):

The expression "goods" means anything which is the subject of trade, manufacture, or merchandise (p. 472):

The expressions "person," "manufacturer, dealer, or trader," and "proprietor" include any body of persons corporate or unincorporate (p. 463):

The expression "name" includes any abbreviation of a name (p. 495).

(2.) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods of any such figures, words, or marks, or arrangement or combination thereof, whether including a trade-mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are (p. 491).

(3.) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment the expression false name or initials means as applied to any goods, any name or initials of a person which—

(a) are not a trade-mark, or part of a trade-mark, and

(b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of such name or initials, and

(c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods (pp. 493 to 498).

Forging trade-mark.

4. A person shall be deemed to forge a trade-mark who either—

(a) without the assent of the proprietor of the trade-mark makes that trade-mark or a mark so nearly resembling that trade-mark as to be calculated to deceive; or

(b) falsifies any genuine trade-mark, whether by alteration, addition, effacement, or otherwise;

and any trade-mark or mark so made or falsified is in this Act referred to as a forged trade-mark.

Provided that in any prosecution for forging a trade-mark the burden of proving the assent of the proprietor shall lie on the defendant (p. 468).

Applying marks and descriptions.

5.—(1.) A person shall be deemed to apply a trade-mark or mark or trade description to goods who—

(a) applies it to the goods themselves; or

(b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture; or

(c) places, encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade-mark or trade description has been applied; or

(d) uses a trade-mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade-mark or mark or trade description (p. 473).

(2.) The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression "label" includes any band or ticket.

A trade-mark, or mark, or trade description, shall be deemed to be applied, whether it is woven, impressed, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label. reel, or other thing (p. 474).

(3.) A person shall be deemed to falsely apply to goods a trade-mark, or mark, who without the assent of the proprietor of a trade-mark applies such trade-mark, or a mark so nearly resembling it as to be calculated to deceive, but in any prosecution for falsely applying a trade-mark or mark to goods the burden of proving the assent of the proprietor shall lie on the defendant (p. 474).

Exemption of certain persons employed in ordinary course of business.

6. Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade-mark, or with falsely applying to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

(a) That in the ordinary course of his business he is employed on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade-marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

(b) That he took reasonable precautions against committing the offence charged; and
(c) That he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade-mark, mark, or trade description; and
(d) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade-mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence (pp. 501 to 504).

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 *primâ facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for sale, or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly, and for the purposes of this section the expression "watch" means all that portion of a watch which is not the watch case (p 522).

Mark on watch case.

8.—(1.) Every person who after the date fixed by Order in Council sends or brings a watch case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom), and in such a mode as may be from time to time directed by Order in Council (pp. 525, 695).

(2.) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorized to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council (p. 696).

(3.) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence (p. 541).

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 (p. 468).

Rules as to evidence.

10. In any prosecution for an offence against this Act,—

(1.) A defendant, and his wife or her husband, as the case may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness (p. 509).

(2.) In the case of imported goods, evidence of the port of shipment shall be *prima facie* evidence of the place or country in which the goods were made or produced (p. 481).

Punishment of accessories.

11. Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any county or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed (p. 504).

Search warrant.

12.—(1.) Where, upon information of an offence against this Act, a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture under this Act.

(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to

the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

(3.) Any goods or things forfeited under this section, or under any other provision of this Act, may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct, and the Court may, out of any proceeds which may be realized by the disposition of such goods (all trade-marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods (pp. 520 to 522).

Extension of 22 & 23 Vict. c. 17, to offences under this Act.

13. The Act of the session of the twenty-second and twenty-third years of the reign of her present Majesty, chapter seventeen, intituled "An Act to prevent vexatious indictments for certain misdemeanours," shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland (p. 517).

Costs of defence or prosecution.

14. On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively (p. 518).

Limitation of prosecution.

15. No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens (p. 517).

Prohibition on importation.

16. Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act; be it therefore enacted as follows (pp. 526 to 539):

(1.) All such goods, and also all goods of foreign manufacture bearing any name or trade-mark being or purporting to be the name or trade-mark of any manufacturer, dealer, or trader in the United Kingdom, unless such name or trade-mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were specified in section forty-two of the Customs Consolidation Act, 1876 (pp. 531 *et seq*). 39 & 40 Vict. c. 36.

(2.) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited by this section to be imported (p. 536).

(3.) The Commissioners of Customs may from time to time make, revoke and vary, regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence (p. 536).

(4.) Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom (p. 483).

(5.) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

(6.) The Commissioners of Customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion, or otherwise, shall act under the control of the Commissioners of her Majesty's Treasury.

(7.) The regulations may provide for the informant reimbursing the Commissioners of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

(8.) All regulations under this section shall be published in the "London Gazette" and in the "Board of Trade Journal."

(9.) This section shall have effect as if it were part of the Customs Consolidation Act, 1876, and shall accordingly apply to the Isle of Man as if it were part of the United Kingdom.

46 & 47 Vict. c. 55.

(10.) Section two of the Revenue Act, 1883, shall be repealed as from a day fixed by regulations under this

section, not being later than the first day of January one thousand eight hundred and eighty-eight, without prejudice to anything done or suffered thereunder.

Implied warranty on sale of marked goods.

17. On the sale or in the contract for the sale of any goods to which a trade-mark, or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade-mark and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee (p. 431).

Provisions of Act as to false description not to apply in certain cases.

18. Where, at the passing of this Act, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there (p. 498).

Savings.

19.—(1.) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

(2.) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act.

(3.) Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master (p. 520).

False representation as to royal warrant.

20. Any person who falsely represents that any goods are made by a person holding a royal warrant, or for the service of her Majesty, or any of the Royal Family, or any government department, shall be liable, on summary conviction, to a penalty not exceeding twenty pounds (p. 542).

Application of Act to Scotland.

21. In the application of this Act to Scotland the following modifications shall be made:—

The expression "Summary Jurisdiction Acts" means the Summary Procedure Act, 1864, and any Acts amending the same.

The expression "justice" means sheriff.

The expression "Court of Summary Jurisdiction" means the Sheriff Court, and all jurisdiction necessary for the purpose of this Act is hereby conferred on sheriffs.

Application of Act to Ireland.

22. In the application of this Act to Ireland, the following modifications shall be made:—

The expression "Summary Jurisdiction Acts," means, so far as respects the police district of Dublin metropolis, the Acts regulating the powers and duties of justices of the peace of such district, and as regards the rest of Ireland means the Petty Sessions (Ireland) Act, 1851, and any Act amending the same.

14 & 15 Vict. c. 93.

The expression "Court of Summary Jurisdiction" means justices acting under those Acts.

Repeal of 25 & 26 Vict. c. 88.

23. The Merchandise Marks Act, 1862, is hereby repealed, and any unrepealed enactment referring to any enactment so repealed shall be construed to apply to the corresponding provision of this Act; provided that this repeal shall not affect—

(a) any penalty, forfeiture, or punishment incurred in respect of any offence committed against any enactment hereby repealed; nor

(b) the institution or continuance of any proceeding or other remedy under any enactment so repealed for the recovery of any penalty incurred, or for the punishment of any offence committed, before the commencement of this Act; nor

(c) any right, privilege, liability, or obligation acquired, accrued, or incurred under any enactment hereby repealed.

No. 13.

MERCHANDISE MARKS ACT, 1891.

(54 Vict. c. 15.)

An Act to amend the Merchandise Marks Act, 1887.

[11th May 1891.]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Customs entry to be trade description.

1. The customs entry relating to imported goods shall, for the purposes of the Merchandise Marks Act, 1887, be deemed to be a trade description applied to the goods (p. 486).

50 & 51 Vict. c. 28.

Official prosecutions.

2.—(1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the Merchandise Marks Act, 1887, shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament.

(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of Her Majesty's Stationery Office.

(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations (pp. 515, 707).

Short title.

3. This Act may be cited as the Merchandise Marks Act, 1891, and the Merchandise Marks Act, 1887, and this Act may be cited together as the Merchandise Marks Acts, 1887 and 1891.

No. 14.

THE GENERAL ORDERS ON THE MERCHANDISE MARKS ACT (*a*).

PAGE
A. Circular calling attention to the Act (coverings) 678
B. Statement of objects, and summary of the effect of the Act; statement as to when Customs officers are expected to act without information; registration of names and marks 680
C. Declaration on registration of name or mark 686
D. Bond accompanying request for detention of goods 687
E. Regulations under M. M. A., sect. 16; information, deposit, and notice to ensure detention of goods 688
F. Notice and bond on detention of goods in accordance with information 692
G. Circular drawing attention to the Order as to Watch Case Marks 693
H. Order in Council as to marks on watch case 695
I. Names on packing cases not shown to purchasers 697
J. Names applied to packages for the information of dealers only; name of port of unshipment 698
K. Lancashire Swedish iron 699
L. Address-marks on flowers, fruit, and vegetables 699
M. Sardines à l'huile 700
N. Grain in sacks 700
O. Discretionary powers for officers to allow goods to pass: articles for private use, or private property, or sent for repair; returned samples; foreign samples; British returned goods .. 701
P. Colonial wool 703
Q. Notice to registered owner of infringed name or mark 703
R. Saumur champagne 704

A.—General Order 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," section 3.
"Applied," section 5; sub-sections 1 and 2.
"Falsely applied," section 5; sub-section 3.

(*a*) The Order dated 1st February, 1889, and those preceding it, are published in the 32nd and 33rd Reports, Commissioners of Customs. I am indebted to the courtesy of the Board of Customs for copies of the remaining Orders.

"Trade-mark"
"Trade description"
"False trade description"
"Person"
"Manufacturer"
"Dealer" or "Trader"
"Proprietor"
"Name"
"Name or initials"

} Section 3.

You will also especially note, as applying to imported goods, the provisions of section 10, sub-section (2), and section 18 of the Act.

You will observe that by section 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."

Coverings. 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.

Watch cases. There is, however, on this point one article to be specially noticed, viz., "watch cases;" and, as to this, your attention is called to section 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 section 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 section 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.

B.—General Order 99/1887.

Custom House, London,
22nd December, 1887.

Sir,

1. As a sequel to G. O. 81/1887 you will receive herewith a copy of the regulations made by the Board under section 16 of the Merchandise Marks Act, 1881, 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 guidance is necessary.

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).

As to the scope of the Act with reference to "British marks."

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.

Reference to particular provisions as to place or country of origin.

5. You will observe that names or trade-marks of British manufacturers, dealers, or traders on imported foreign goods (section 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 section 18 of the Act, as regards lawful and general "trade descriptions," which include the name of a place or country.

Classification of goods specially indicated for detection without information.

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.:—

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 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 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 (*b*).

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

2. 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

(*b*) See G. O. 26/1888, below.

calculated to mislead.

calculated to mislead" mean such terms as Kidderminster carpets, Windsor soap, "Balbriggan" on hosiery, or "Shotland" 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 (*b*).

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 summarized 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 subject 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 (*c*).

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

(*b*) See G. O. 26/1888, below.

(*c*) As to notice to the owner of a registered name or mark when goods are detained, see G. O. 50/1893, below.

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 authorized 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 recognize, 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 his goods, and prove (also by declaration) the appointment of such agent.

See paragraph 32.

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.

* As to copyright, this instruction in no way affects the practice under sections 42 and 44 of "The Customs Consolidation Act, 1876."

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, 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 British possessions or Foreign States.

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 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 (*d*).

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 examination generally.

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

(*d*) See list, p. 656.

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.

As to security where detention ordered.

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.

Enquiries as to sufficiency of sureties.

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 enquiries in the usual way, and have the bond completed as in other transactions.

As to goods after security taken, and as to delivery up of security.

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.

Supply of forms.

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.

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,

The collector , at . E. Goodwyn.

C.—Merchandise Marks Act, 1887.

(50 & 51 Vict. c. 28.)

Declaration on Registration under Paragraph 13 *of General Order* 99/1887.

Port of .

I* , hereby declare that† ,‡ the proprietor , of§ , viz., , which‖ expect to be applied to goods imported, from time to time, at this port; and that‖

have appointed Mr.¶ of , to be** agent, to give authority for the delivery of such goods.

I make this solemn declaration conscientiously believing the same to be true, and by virtue of the Statutory Declaration Act, 1835.

(Signed) ——.

Declared this day of , 188 , at ,

Before me ,

A commissioner to administer oaths, &c.

N.B.—Registration in pursuance of this declaration is subject to the provisions of the Act which forbid the importation, by a registered proprietor, even of his own goods which bear, in name or mark, any statement or indication, direct or indirect, of make or produce in the United Kingdom unless qualified as the Act requires.

* Full name and address of declarant.

† "I," or "I and my partners, trading as Messrs. ," or "such and such a company, of which I am the representative official," or "so and so, of such and such a place abroad, whom I represent in this country."

‡ "Is" or "are."

§ "The following name as a trade description," or "the following trade-mark," or "the following name as a trade description and trade-mark."

‖ "I" or "we."

¶ This portion as to appointment of agent may be erased, where such appointment is not desired.

** "My" or "our."

D.—Bond accompanying request for the Detention of Goods.

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 eighty .

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 section 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 bo and remain in full force and virtue.

Signed, sealed and delivered .

E.—Regulations made by the Commissioners of Customs under section 16 of the Merchandise Marks Act, 1887 (*e*).

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 Acts, 1883," and the law of indicated British possessions and foreign states:

And after defining the expression "trade description" as any description, statement or other indication, direct or indirect, as to number, quantity, measure, gauge, or weight, of goods, as to place or country in which any goods were made or produced, as to the mode of manufacturing or producing any goods, or as to the material of which any goods are composed, or as to any goods being the subject of any existing patent privilege, or copyright:

And after defining the expressions "false trade description" and "goods," "apply," and "falsely apply,"

(*e*) London Gazette, 1887, p. 6729.

It is provided by section 16, that—

(i.) All such goods as above mentioned, and

(ii.) All goods of foreign manufacture, bearing any name or trade-mark, being or purporting to be, the name or trade-mark of any manufacturer, dealer, or trader in the United Kingdom, unless such name or mark be accompanied by definite indication of the country in which such goods were made or produced,

shall be prohibited to be imported, and, subject to the provisions of the said section, shall be included among goods prohibited to be imported, as if they were specified in section 42 of "the Customs Consolidation Act, 1876":

And whereas by section 18 of the Act, after 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 section 16, that the Commissioners of Customs (hereinafter called "the Commissioners"), may, from time to time, make, revoke, and vary regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited as hereinbefore mentioned, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of the said section, and the mode of verification of such evidence:

And it is further provided by the said last-mentioned section:

That before detaining goods or taking proceedings with a view to the forfeiture thereof under the law relating to the Customs, the commissioners may require that such regulations as aforesaid shall be complied with, and satisfy themselves as to the liability of the goods to forfeiture:

That such regulations may apply to all goods, the importa-

tion of which is prohibited by the said section, or different regulations may be made respecting different classes of such goods:

And also that the regulations may provide for the informant reimbursing the commissioners all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention:

And it is also provided, by the said section, that section 2 of the Revenue Act, 1883, shall be repealed from a day to be fixed by regulations under the said reciting sections, such day not being later than the first day of January, 1888, without prejudice to anything done or suffered thereunder:

And whereas section 2 of the Revenue Act, 1883 is the law under, and by virtue of which, goods of foreign manufacture infringing the proprietary rights of British subjects in names, addresses, and trade-marks, or bearing or having upon them, under certain conditions, the name of a place in or a part of the United Kingdom, are, at the present time, detected and stopped by officers of Customs acting on their own observation and responsibility, under directions laid down by the commissioners, and without the requirement of previous information, security, or other conditions:—

Now, therefore, the commissioners under and by virtue of the hereinbefore recited power in that behalf, hereby make and require to be complied with the following regulations, viz.,

Goods to be detained.

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.

Information to ensure detention.

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 informer, 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 a court of justice, then on such completion of forfeiture.

If the forfeiture is not completed, then

If the goods are released by the commissioners, and no action or suit has been commenced against them, or any of their officers, in respect of the detention, then at the expiration of three months from the time of detention; or, if the goods are released for failure of proceedings taken for the forfeiture and condemnation thereof upon information under section 207 of "The Customs Consolidation Act, 1876," and no action or suit has been commenced against the commissioners, or any of their officers, in respect of the detention, then at the expiration of three months from the trial of such information.

If within such periods as aforesaid any such action or suit as aforesaid has been commenced, then upon the ultimate conclusion of such action or suit, and the fulfilment of the purpose for which the security was given.

8. These regulations apply to transhipment and transit goods as well as to goods landed to be warehoused, or for home consumption.

9. The 1st day of January, 1888 is, by these "regulations," fixed as the day from which section 2 of the "Revenue Act, 1883," shall be repealed, subject to the terms of the recited Act; and these regulations will take effect from the date of such repeal.

CHARLES DU CANE
H. MURRAY
HORACE SEYMOUR. } Commissioners of H. M. Customs.

Custom House,
1st December 1887.

F.—SCHEDULE.

(NOTICE.)

The Merchandise Marks Act, 1887.

To the Collector, Superintendent, or Chief Officer of Customs at the Port [*or* Sub-Port] of .

I hereby give you notice that the undermentioned goods, that is to say,* are about to be imported into your port on or about the day of next, in the† .

That such goods are liable to detention and forfeiture being‡ .

That Mr. of and Mr. of are prepared to become my sureties in such bond as may be required upon detention of the goods.

And I request that the said goods may be detained and dealt with accordingly.

Dated this day of 188 .

A. B.
[*or* agent for] .

NOTE.—Mr. refers to his bankers [*or* solicitors], and Mr. to his bankers [*or* solicitors] as to his sufficiency for the penalty of the bond.

* Describe the goods, number of packages, marks used, and any other particulars necessary for their identification.

† Describe the ship, and give name or indication.

‡ State how the goods infringe the Act, and if the infringement is one as to a forged trade-mark protected in a British possession or foreign state, state the possession or state, or if the infringement is one as to place or country of origin, state the name of the place or country falsely used.

(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 abovenamed A. B. has by a notice dated the day of informed the collector of customs at that the undermentioned goods, that is to say, were about to be imported into the port of contrary to section 16 of the Merchandise Marks Act, 1887, and requested that the said goods should be detained and dealt with accordingly. And whereas the said goods duly arrived in the said port on the day of last, and are now detained pursuant to the said notice. Now the condition of this obligation is such that if the said A. B. his executors or administrators, shall well and effectually indemnify, save harmless, and keep indemnified, her Majesty, her heirs and successors, and all her and their officers of customs, and their executors or administrators, from and against all loss or damage, payment or payments, and all costs and expenses which her said Majesty, her heirs or successors, and her and their officers of customs, their executors or administrators, shall or may sustain or incur by reason or on account of any detention of the said goods following upon the information contained in such notice and any proceedings consequent upon such detention, then this obligation shall be void, or otherwise shall be and remain in full force and virtue.

Signed, sealed, and delivered.

G.—GENERAL ORDER 9/1888.

CUSTOM HOUSE, LONDON,
18th January, 1888.

SIR,

In accordance with paragraph 33 of General Order 99/1887, I now transmit to you the directions of the Board, to enable you to deal with watch cases and watches, under the Merchandise Marks Act; the latter term, watches, meaning as provided by section 7 of the Act, "all that portion of a watch which is not the watch case."

Your attention has already, by G.O. 81/1887, been called to the position in which watch cases, under this section, stand in relation to watches; and the consequent importance of the assay mark on watch cases, which mark, by virtue of section 3 (1) of the Act, would be deemed a trade description as to place or country of origin.

You will note, in addition, that by section 8 (1) of the Act, provision is made for preventing foreign-made watch cases

from obtaining the mark placed on a watch case made in the United Kingdom: and it is enacted that a different mark shall be placed on foreign watch cases of such pattern, and in such mode as directed by Order in Council.

An Order in Council to this effect, dated the 28th of November last, was published in the "London Gazette" of 9th December last, and a copy of this order, together with sheets 1 and 2 of Appendix to Schedule II. therein referred to, which contain diagrams of the required new marks, are sent to you herewith.

You will carefully study these sheets, and note how the marks apply variously to the different assay offices in the United Kingdom.

The directions to be observed by you in applying this new law will relate to—

(a) Watch cases with assay marks imported alone.
(b) Like watch cases imported with the watches, that is to say watches of foreign manufacture in them.

(a) *Watch Cases with Assay Marks imported alone.*

If the cases are wholly unmarked, or are duly marked in accordance with the Order in Council, or with a foreign assay mark, and there is not, in addition, any wording on any part of the case proper, or on the dome, indicating make or produce in the United Kingdom, the goods may be delivered. If, on the other hand, there is any such wording, the goods must be detained and the matter referred to the Board.

If the cases are marked with a British Hall Mark as placed on watch cases made in the United Kingdom, you will detain the goods unless they are entered as "British goods brought back," in which case they may be admitted under the usual regulations.

(b) *Watch Cases imported with the Watches in them.*

If the cases are wholly unmarked, or are marked either
In accordance with the Order in Council, or
With a foreign assay mark, or
With a British assay mark as placed on a watch case made in the United Kingdom, and with an equally conspicuous statement either above or below the assay mark, that the watch is of foreign make;

And if there is no wording either as an addition on the case or 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 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

H.—ORDER IN COUNCIL AS TO ASSAY MARKS ON WATCH CASES (*f*).

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 and 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.

(*f*) London Gazette, 9 Dec., 1887, p. 6862.

(2.) The declaration may be made before an officer of an assay office appointed in that behalf by the office (which officer is hereby authorized to administer such a declaration) or before a justice of the peace or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

(3.) Every person who makes a false declaration for the purposes of this section shall be liable on conviction or indictment to the penalties of perjury, and, on summary conviction, to a fine not exceeding twenty pounds for each offence.

Now, therefore, her Majesty, by and with the advice of her Privy Council, and in exercise of the powers vested in her by the above-recited provisions of the said Act, is pleased to order and declare, and doth hereby order and declare, that where it appears by such declaration that such watch cases have been made in some country or place out of the United Kingdom, then the following authorities, that is to say:—

The Wardens and Commonalty of the Mystery of Goldsmiths of the City of London;

The Guardians of the Standard of Wrought Plate, Birmingham;

The Company of Goldsmiths of the City of Chester;

The Guardians of the Standard of Wrought Plate, Sheffield;

The Incorporation of Goldsmiths of the City of Edinburgh;

The Goldsmiths' Company of the City of Glasgow;

The Fraternity or Company of Goldsmiths of the City of Dublin;

shall respectively cause to be placed on such watch cases the marks more particularly described and delineated in Schedule II. hereunto annexed, and no other mark or marks, and such marks are hereby authorized accordingly.

And it is hereby further ordered and declared that the declaration to be made shall be in the form set forth in Schedule I. hereunto annexed.

This order shall come into operation on the first day of January, one thousand eight hundred and eighty-eight.

C. L. Peel.

SCHEDULE I.

Form of Declaration.

I * do hereby declare that the [watch case] *or* [watch cases] [brought] *or* [sent] by me this day to the Assay Office

at in number and in a parcel marked [was] [were] made in †.

Declared at this day of , 18 .

Before me ‡.

Officer of the aforesaid Assay Office appointed in that behalf *or*, Justice of the Peace for *or*, Commissioner having power to administer oaths in the Supreme Court of Judicature in England.

[Supreme Court of Judicature in Ireland].

[Court of Session in Scotland].

* Here insert name and address of declarant.

† Signature of declarant.

‡ Signature and title of person before whom the declaration is made.

SCHEDULE II. (*g*).

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 (*g*).

I.—General Order 14/1888.

Custom House, London,
4th February, 1888.

Sir,

Names on packing cases not shown to purchasers.

With reference to paragraph (b) of the 5th section 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 (*h*).

I am, sir, your obedient servant,

To the Collector. E. Goodwyn.

(*g*) The figures referred to are shown in the London Gazette, 9 Dec., 1887, p. 6862.

(*h*) See G. O. 26/1888, below.

J.—General Order 26/1888.

Custom House, London,
10th March, 1888.

Sir,

Names applied to packages for the information of dealers only.

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 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,

Name of port of unshipment.

I am further to acquaint you that the last clause of General Order 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.

K.—General Order 33/1888.

Custom House, London,
24th March, 1888.

Sir,

With reference to paragraph 33 of the General Order 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. Lancashire Swedish iron.

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,

To the Collector. R. T. Prowse.

L.—General Order 44/1888.

Custom House, London,
9th April, 1888.

Sir,

With reference to section 33 of the General Order 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 14 and 26/1888 apply, and are not to be detained under the Merchandise Marks Act on account of such marks only. Address marks on flowers, fruit, and vegetables.

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,

To the Collector. R. T. Prowse.

M.—By Board's Order on No. 37366/1888.

Sardine Trade.

Sardines from Spain and Portugal imported into this country, *marked with names of French places or in the French language*, but without the qualification required by the Merchandise Marks Act, 1887, may be delivered, up to the 30th of June, 1889 (inclusive). After that date, sardines which are not imported from France will not be admitted to this country unless duly qualified, when they bear upon them the names of places in France or descriptions in the French language other than the trade description "sardines à l'huile," which will be admissible on sardines from whatever part of the world they may be imported.

By order,
(Signed) E. Goodwyn.

Custom House, London,
18th December, 1888.

N.—General Order 147/1888.

Custom House, London,
31st December, 1888.

Merchandise Marks Act.

Grain.

The Board direct that grain, of a description which is grown in the United Kingdom, imported in sacks, be delivered without reference to the marks upon them, for a period of six months from the 1st proximo, provided such marks constitute correct descriptions and do not include the name of a place in the United Kingdom. The Board make this concession with the view of allowing importing merchants time in which to add to the marks on their sacks an indication that the grain is of foreign production.

The officers are informed that descriptions of grain which are not grown in this country, including linseed and rapeseed, do not require to have an indication merely of British origin qualified by an indication that the grain is of foreign production, nor are descriptions in the English language on grain from English-speaking countries, including India, to be considered open to objection, provided they are correct descriptions and do not include the name of a place in the United Kingdom.

The officers are also informed that on and after the 1st July next the name *and address* of a merchant in this country, on grain sacks, will be dealt with as an indication that the grain is of British origin.

The Board have directed that, in the case of grain imported in bulk and transferred into sacks on board the importing ship, the marking of the sacks need not be qualified with a statement of the foreign origin of the grain.

By order, R. T. Prowse.

9.—General Order 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.) 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 (2.) Used articles either private property or sent for repairs.

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 the 6th section 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.) Abandoned detained goods.

(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. (7.) Qualifying marks.

By order, E. Goodwyn.

To the Collector.

P.—General Order 8/1890.

Custom House, London,
25th January, 1890.

Merchandise Marks Act.

As to marking of imported Bales of Wool.

The officers are informed that wool imported from New Zealand and the Australian and Cape Colonies, in bales marked with the names of the Stations upon which the wool is grown, or the breed of sheep, such as "Bridgwater," "Cheviot," "Lincoln Slipes," &c., and which are often identical with the names of towns or districts in the United Kingdom, need not, until further orders, be detained for want of an accompanying indication of the country of origin.

By order of the Board,
R. T. Prowse.

Q.—General Order 50/1893.

Custom House, London,
12th July, 1893.

Merchandise Marks Act, 1887.

The Proprietor of a Registered Mark to be apprized when goods have been detained for an infringement of such Mark.

With reference to the provisions contained in the regulations made by the Commissioners of Customs under section 16 of the Merchandise Marks Act of 1887, and to those of General Order 99/1887, the Board direct that, when goods are detained on account of names or marks which have been registered in

this department, care be taken in every case that, in addition to the usual notice of seizure required under section 207 of the Customs Consolidation Act, information of the detention, and of the cause of such detention, be at once given in writing to the person who has so registered his name or mark, or to the representative appointed by him to authorize delivery of the goods, who is at the same time to be called upon to enter into the required security without delay, and informed that unless immediate attention is given to the matter the goods will be released.

If, at the end of four days, the collector (or other principal officer concerned) does not receive a reply he will release the goods; but the collectors will observe that the limit to the time of detention here laid down does not apply in cases where the marks are such as to render the goods liable to detention irrespective of the question of registration; and in such cases the above clause intimating an early release of the goods in the absence of due attention being paid to the matter is to be omitted from the notice given to the owner of the mark or his representative.

By order of the Board,
JOHN COURROUX.

R.—GENERAL ORDER 68/1893.

CUSTOM HOUSE, LONDON,
31st August, 1893.

Merchandise Marks Acts.

Saumur Champagne.

The Board, having had their attention recently called to the marks on French sparkling wines, hereby inform officers for their guidance, that on and after the 1st October next, the words "Saumur Champagne," or the like words, when applied as a description to sparkling wines of Saumur, will not be admissible under the provisions of the Merchandise Marks Acts. Any such importations marked descriptively with expressions involving the word "Champagne," or otherwise than merely "Saumur," "Saumur Mousseux," "Sparkling Saumur," or the like, must therefore, on and after the date above named, be detained for the Board's directions.

By order of the Board,
JOHN COURROUX.

No. 15.

ERRORS IN TRADE DESCRIPTIONS OF MEASURE ALLOWED UNDER THE INDIAN M. M. A.

NOTIFICATION.—No. 1118.—Simla, 13th August, 1889.

In the exercise of the power conferred by section 16 of the Indian Merchandise Marks Act, IV. of 1889, the Governor General in Council directs that criminal courts, in giving effect to the provisions of the Act in respect of trade descriptions of quantity, measure, or weight of the goods specified hereunder, shall observe the following instructions:—

I. A trade description of length stamped on *grey*, *white*, or *coloured cotton piece goods* shall not be deemed to be false in a material respect unless—

(a) Where a single length is stamped, the description exceeds the actual length by more than—

4 inches in pieces stamped as 10 yards long and under;
5 " " above 10 yards and up to 23 yards long;
7 " " " 23 " " 36 "
9 " " " 36 " " 47 "
18 " " " 47 yards long;

provided that the average length of the goods in question shall not be less than the stamped length.

(b) Where a maximum and a minimum length are stamped, the described maximum length is greater than the actual length by more than—

9 inches in piece goods under 35 yards long;
18 " " 35 yards and up to 47 yards long;
36 " " above 47 yards long;

provided that no such piece shall measure less than the minimum stamped length.

II. A trade description of width stamped on *grey*, *white*, or *coloured cotton piece goods* shall not be deemed to be false in a material respect unless the description exceeds the actual width by—

$\frac{1}{4}$ inch in pieces stamped as 40 inches or less in width;
$\frac{1}{2}$ " " over 40 inches or under 59 inches in width;
1 " " 59 inches or more in width;

provided that the average width of the goods in question shall not be less than the stamped width.

III. A trade description of count or number, length or weight, applied to *grey cotton yarn* shall not be deemed to be false in a material respect unless—

(a) The described count or number is greater or less than the actual count or number by more than 5 per cent.; or

(b) The average length of the whole number of hanks in a bundle of such yarn is less than 840 yards; or

(c) In a bundle described as being 10 lbs. in weight, the number of knots or *moras* of 10 hanks each is not the same as, and the number of knots or *moras* of five hanks is not double, the described count or number of the yarn.

IV. A trade description of count or number applied to a bundle of *dyed cotton yarn* shall be accepted as indicating length only, the hank being taken to measure 840 yards, and it shall be deemed to be false in a material respect if it exceeds the actual length by more than 5 per cent.;

Provided that the average length of the whole number of hanks in the yarn in question shall not be less than the described length.

V. A trade description of length applied to *thread of any kind* (of cotton, wool, flax, or silk) shall not be deemed to be false in a material respect unless it exceeds the actual length by more than 1 per cent.

VI. The dimensions of goods on which their length or width is stamped shall be determined by measurement in imperial yards of 36 inches.

A. P. MacDonnell,
Secretary to the Government of India.

No. 16.

REGULATIONS made by the Board of Trade with the Concurrence of the Lord Chancellor under Section 2 of the Merchandise Marks Act, 1891, with regard to the Prosecution of Offences under the Merchandise Marks Act, 1887 (*a*).

1. The prosecution of offences under the Merchandise Marks Act, 1887, shall, subject to the condition hereinafter prescribed, be undertaken by the Board of Trade in cases which appear to the Board to affect the general interests of the country, or of a section of the community, or of a trade.

2. Every application to the Board to undertake a prosecution shall be accompanied by the following documents:

(a) A statement showing the nature and circumstances of the case, and sufficient to enable the Board to form an opinion whether the case affects the general interests of the country, or of a section of the community, or of a trade.

(b) A statement showing the facts which, if the Board undertake the prosecution, will be capable of proof, and setting out the proofs and names of the witnesses available to prove such facts.

The Board may require the above statements to be supplemented, or additional evidence to be furnished.

3. If, on the evidence, the Board is of opinion that there is no reasonable prospect of a conviction being obtained, the Board will not, unless it thinks fit, undertake the prosecution.

4. If the Board is of opinion that the prosecution would be better or more properly conducted under some other Act of Parliament other than the said Act, the Board will not undertake the prosecution.

5. The Board may, before undertaking a prosecution, require the applicant to give security for costs on such terms and in such manner as it thinks proper.

6. For the purpose of carrying these regulations into effect, the Board may, from time to time, prescribe the use of such forms and give such directions as it may deem expedient.

21st May, 1892.

M. E. Hicks-Beach,
President of the Board of Trade.

I concur,
Halsbury, C.

(*a*) Statutory Rules and Orders, 1892, p. 973.

No. 17.

FORMS OF INDICTMENT AND INFORMATION.

Form of Indictment.

Middlesex } The jurors for our Lady the Queen upon their
to wit. } oath present that C. D. before and on the day of was the proprietor of a certain trade-mark duly registered in the register of trade-marks kept under the Patents, Designs and Trade-Marks Act, 1883, and in the said register numbered ( )(*a*); and that A. B. on the day of , the said C. D. then being the proprietor of the said trade-mark as aforesaid, did unlawfully, and with intent to defraud, apply the said trade-mark to certain goods, to wit [*describing them*], without the assent of the said C. D., contrary to the Merchandise Marks Act, 1887;

And the jurors aforesaid, upon their oath aforesaid, do further present that C. D., before and on the day of , was the proprietor of a certain trade-mark duly registered in the register of trade-marks kept under the Patents, Designs, and Trade-Marks Act, 1883, and in the said register numbered ( )(*a*), and that A. B., on the day of , the said C. D. then being the proprietor of the said trade-mark as aforesaid, did unlawfully, and with intent to defraud, and without the assent of the said C. D., apply to certain goods, to wit [*describing them*], a certain mark, to wit [*describing it*], so nearly resembling the said trade-mark as to be calculated to deceive, contrary to the Merchandise Marks Act, 1887.

Information for an Offence against the Merchandise Marks Act, 1887 (*b*).

In the County of , Petty Sessional Division of .

The information of C. D. [*address and description*], who, upon oath, states that A. B. [*address and description*] on the day of did [*here state the offence, as below*].

Taken before me,
J. P.,
Justice of the Peace for the county of aforesaid.

(*a*) If the date of the offence charged is more than one year before that of the presentation of the indictment, add, "and that the said C. D. first discovered the commission of the offence herein charged after the of ." See sect. 15.

(*b*) Summary Jurisdiction Act, 1879, s. 31; the information must be for one offence only, Summary Jurisdiction Act, 1848, s. 10.

Statement of Offences.

Unlawfully and with intent to defraud forge a certain trade-mark duly registered in the register kept under the Patents, Designs and Trade-Marks Act, 1883, and therein numbered , of which trade-mark one C. D. was then the proprietor, within the meaning of the Merchandise Marks Act, 1887, contrary to the said Act.

Unlawfully and with intent to defraud falsely apply to certain goods, to wit [*describing them*], a certain trade-mark duly registered [*as above*], of which [*as above*], within the meaning of the Merchandise Marks Act, 1887, contrary to the said Act.

Unlawfully and with intent to defraud apply to certain goods, to wit, gelatine (on the day of , sold by the said A. B. to), a false trade description as to the materials of which such goods were composed, by which description the said goods were falsely indicated to be isinglass (*c*), contrary, &c.

Unlawfully and with intent to defraud sell or expose for sale certain goods, to wit, gelatine (on the day of , sold by the said A. B. to), to which had been applied a false trade description as to the materials of which such goods were composed, whereby the goods were falsely indicated to be isinglass (*c*), contrary, &c.

Unlawfully and with intent to defraud apply a false trade description, whereby the said goods were falsely described to be subject to an existing patent (*c*), contrary, &c.

Unlawfully sell [or expose for sale] (*d*) goods, to wit [*describing them*], to which a false trade description had been applied (*c*), contrary, &c.

At the parish of Saint Michael in the said city, on the 16th of January, 1890, unlawfully apply a certain false trade description, namely, "barrel," to certain goods, to wit, a certain cask of beer, false as to the measure or gauge thereof, contrary to the provisions of the Merchandise Marks Act, 1887 (*e*).

On the 7th and 11th of February, 1889, at Purfleet, in the parish of , and the county of , unlawfully apply [or cause to be applied] (*d*) a false trade description, to wit, the letters, figures. and words "Gunpowder, Chilworth Gunpowder Company, R.L.G.4," to certain goods, viz., gunpowder, contrary to the statute 50 & 51 Vict. c. 28, s. 2 (*f*).

(*c*) See *Gridley* v. *Swinburne*, 52 J. P. 791.

(*d*) Summary Jurisdiction Act, 1879, s. 31; the information must be for one offence only, Summary Jurisdiction Act, 1848, s. 10.

(*e*) *Budd* v. *Lucas*, 55 J. P. 550.

(*f*) *Stacey* v. *Chilworth Gunpowder Co.*, 54 J. P. 436.

No. 18.

STATUTES REQUIRING PARTICULAR CLASSES OF GOODS TO BE MARKED IN A SPECIFIED MANNER (*a*) IN ENGLAND (*b*).

ANCHORS AND CHAIN CABLES.]—Manufacturer to place his name or initials and the number and weight of the anchor on every anchor (17 & 18 Vict. c. 104, s. 483); contract for sale of chain cable to imply a warranty of testing and stamping; no chain cable or anchor of greater weight than 168lbs. to be sold unless tested and stamped according to the statute 37 & 38 Vict. c. 51

BREAD.]—Penalty for making or exposing for sale any bread made wholly or partially of peas, beans, potatoes (not including potato-yeast), or any sort of corn or grain other than wheat, unless it be marked with a Roman M. The Act applies only beyond ten miles from the Royal Exchange, London. 6 & 7 Will. 4, c. 37, s. 10.

BUTTER.]—Imitations of butter to be sold only as "margarine." *See* "Margarine."

BUTTONS (metal).]—Penalties for marking, ordering, or exposing for sale any words or marks denoting quality on metal buttons, or any words or marks on the undersides thereof, unless the buttons be silver-plated or gold-gilt; only the marks, gilt, plated, double or treble gilt to be marked; penalties for falsely marking buttons; Act not to extend to buttons of gold, silver, tin, pewter, lead, tin and lead, tinned iron, Bath metal, white metal, any of these metals inlaid with steel, or buttons plated on shells. 36 Geo. 3, c. 60.

CARDS.]—Playing cards (except toy cards) to be sold in stamped wrappers. 25 & 26 Vict. c. 22, ss. 1, 2, 23, 36; 27 & 28 Vict. c. 56, s. 6. So as to foreign cards. 16 & 17 Vict. c. 107, ss. 114—116; 39 & 40 Vict. c. 36, s. 286.

CHAIN CABLES.]—*See* "Anchors."

(*a*) A more detailed summary of all or most of these statutes will be found in Mr. Safford's "Law of Merchandise Marks," Appendix D., and in Mr Sebastian's "Trade-Marks." I am indebted to the former book for the suggestion of many of the classes of goods referred to, and to the Official Index to Statutes for 1892 for reference to the statutes mentioned under the different heads. Statutes (as the Copyright Acts, for example) which require marks to be put upon particular goods in order to secure some right or privilege (as copyright in designs, for instance) are not here included. They would naturally be sought for in works devoted to the law regarding the rights or privileges in question.

(*b*) The Scotch and Irish statutes are given by Mr. Safford.

CHICORY AND COFFEE.]—Imitations of coffee and coffee mixtures not to be sold, except in packets containing one or more quarters of a pound, each packet bearing a label showing the amount of duty, and a label showing the constituents of the mixture. 45 & 46 Vict. c. 41, s. 6.

CLOCKS.]—Bearing marks implying manufacture in the United Kingdom not to be imported. 39 & 40 Vict. c. 36, s. 42.

CUTLERY.]—See above, p. 542, and Sheffield marks, p. 91.

GOLD.]—*See* "Plate."

GUNPOWDER.]—If sold in quantities greater than 1lb., to be packed in closed packages and labelled "Gunpowder." 38 & 39 Vict. c. 17, s. 32.

HOPS.]—Bags to be marked with the name of the owner, the parish and county where they were grown, and the date, number, and weight; penalty for false marking. 54 Geo. 3, c. 123, s. 1; 29 & 30 Vict. c. 37, s. 2. Implied warranty that the marks are genuine. 29 & 30 Vict. c. 37, s. 18.

LINEN.]—Penalties for affixing counterfeit marks to linen. 17 Geo. 2, c. 30; 18 Geo. 2, c. 24. English linen for exportation to be marked with name and place of abode of the maker and of the exporter, the year and number and length. 18 Geo. 2, c. 24, s. 2.

MARGARINE.]—All imitations of butter to be sold, and marked, when exposed for sale, as "margarine." 50 & 51 Vict. c. 29, ss. 3—7. Penalties for dealing in, selling, or exposing for sale any margarine contrary to the Act. *Ibid.* s. 7.

MEDALS (Exhibition).]—Penalties for false representations as to grants of medals or certificates of the Exhibitions of 1851 or 1861. 26 & 27 Vict. c. 119.

PLATE.]—The rules regulating the marking and standards of fineness required and allowed in respect of gold and silver goods are contained in the statutes referred to below (c). They require to be marked on the goods the first letters of the christian and surnames of the worker (12 Geo. 2, c. 26, s. 5), and the *assay mark* of the town where the goods were made, or (if they were not made in an assay town) marked (2 Hen. 6, c. 17, London; 12 & 13 Will. 3, c. 4, York (*d*), Exeter, Bristol (*e*), Chester, and Norwich (*d*); 1 Anne, c. 3, Newcastle-on-Tyne; 13 Geo. 3, c. 52, Sheffield; 5 Geo. 4, c. lii. s. 1, *local*, Birmingham), the variable or date mark to show the year of marking (12 & 13 Will. 3, c. 4, s. 3; 12 Geo. 2, c. 26, s. 5). And, in addition, on gold

(c) These statutes are summarized by Mr. Sebastian, p. 602, and Mr. Safford, p. 204.

(d) The marks for these towns are now discontinued.

(e) Bristol never exercised its right to mark: Sebastian, 3rd ed., p. 603.

wares of twenty-two or eighteen carats fineness, the *standard* and *quality* marks of a crown and 22 (7 & 8 Vict. c. 22, s. 15), or a crown and 18 (38 Geo. 3, c. 69, s. 2) respectively; and on silver wares of 11 ozs. 10 dwts. and 11 ozs. 2 dwts. fineness, the standard marks of Britannia and a lion *passant* respectively (6 Geo. 1, c. 11, s. 41; 12 Geo. 2, c. 26), and a *duty* mark (*f*) of the king's head. (24 Geo. 3, sess. 2, c. 53, s. 5.)

Before 1854, gold wares were required to be of either twenty-two or eighteen carats fineness (38 Geo. 3, c. 69); but her Majesty was authorized, under an Act of that year (17 & 18 Vict. c. 96), by Order in Council, to allow any standard for gold plate not being less than one-third part of the whole in fine gold, and to approve any instrument for stamping or marking the wares, setting forth in figures the actual fineness thereof according to the standard declared. The new inferior standard gold wares were declared not to be liable to duty. Under this Act, the nine, twelve, and fifteen carat gold standards have been authorised.

Silver wares must all be of either the 11 ozs. 10 dwts. or 11 ozs. 2 dwts. of silver to the pound, troy standard. (6 Geo. 1, c. 11.)

The following wares are exempted from marking:—chains, necklace heads, lockets, filigree work, shirt buckles or brooches, stamped medals, or spouts to china, stone, or earthenware tea-pots, or any of them, of any weight; tippings, swages, or mounts, or any of them, not exceeding 10 dwts. of silver each, except only necks and collars for castors, cruets, or glasses, appertaining to any sort of stands or frames; silver goods not weighing 5 dwts., except necks, collars, and tops for castors, cruets or glasses appertaining to any sort of stands or frames, buttons to be affixed or set on any wearing apparel, solid sleeve buttons, and solid studs, not having a bissiled edge soldered on, wrought seals, blank seals, bottle tickets, shoe clasps, patch boxes, salt spoons, salt shovels, salt ladles, tea-spoons, tea-strainers, caddy ladles, buckles (shirt buckles or brooches before mentioned excepted), and pieces to garnish cabinets, or knife cases, or tea-chests, or bridles, or stands, or frames. (30 Geo. 3, c. 31.) Gold wedding rings are to be marked as gold plate. (18 & 19 Vict. c. 60, s. 1.)

Imported foreign plate, except ornamental plate, made before 1880 (5 & 6 Vict. c. 56, s. 6), is to be marked as English plate (5 & 6 Vict. c. 47, s. 59), and with the figure F. on an oval shield. (39 & 40 Vict. c. 35.)

Penalties for counterfeiting assay marks and connected offences are provided by 7 & 8 Vict. c. 22.

(*f*) The duty on plate is now abolished: 53 Vict. c. 8, s. 10.

The importation of clocks and watches, or any other article of metal impressed with any mark or stamp, representing or in imitation of any legal British assay mark or stamp, or purporting by any mark or appearance to be of the manufacture of the United Kingdom, is forbidden (39 & 40 Vict. c. 36, s. 42).

Watch cases of foreign manufacture brought for essay to any assay-office in the United Kingdom are to be marked as directed by the Order in Council of the 28th of November, 1887 (p. 695), made under the Merchandise Marks Act, 1887, s. 8, that is to say, with the word "foreign," and a shield which is cross-shaped for gold and octagon-shaped for silver (p. 522).

PLATED GOODS.]—Makers of plated goods in Sheffield, or within 100 miles thereof, are authorized to strike on their goods their surnames, or the names of their firm, with a mark (not being an imitation of an assay-mark) which is approved by the guardians of the assay office and registered (24 Geo. 3, sess. 2, c. 20, ss. 2 and 3).

SILVER.]—*See* "Plate."

STORES (PUBLIC).]—The marks enumerated below to denote that stores to which they are affixed are her Majesty's property; the marks not to be applied by unauthorized persons; obliterating the marks with intent to conceal her Majesty's property in the stores is a felony; regimental necessaries, &c., issued to soldiers, militiamen, or volunteers are excepted from the Act (38 & 39 Vict. c. 25; 44 & 45 Vict. c. 58, s. 156).

Stores.	Marks.
Hempen cordage and wire rope..	White, black, or coloured worsted threads laid up with the yarns and wire respectively.
Canvas, fearnought, hammocks, and seamen's bags.	A blue line in a serpentine form.
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.

TOBACCO.]—Cavendish and negro-head tobacco to be delivered for home consumption in separate packets not

exceeding 1 lb. or less than 1 oz. in weight, and wrapped in a wrapper and label approved by the Commissioners of Customs; not to be sold, or had in possession, except wrapped and labelled as aforesaid; penalties for forging labels (26 & 27 Vict. c. 7, ss. 3—8).

WEIGHTS AND MEASURES.]—To be marked with proper indicating marks: see the Acts 41 & 42 Vict. c. 49; 52 & 53 Vict. c. 21.

YARN.]—Penalty for reeling short lengths of yarn, 17 Geo. 3, c. 11 (ss. 17—19, 24, in part repealed by the S. L. Rev. Act, 1861; ss. 12, 22, repealed in part; and ss. 20, 23, repealed by 47 & 48 Vict. c. 43, s. 4).

INDEX.

NOTE.—*A collection of words and names of marks occurring in trade-marks considered in the decided cases has been inserted in the Index, with the names of the cases in which they occur, in order to facilitate reference to cases of which the names have been forgotten.*

"A" See *Mitchell's Tm.*

ABANDONMENT OF APPLICATION TO REGISTER, 69.
costs, 86.

ABANDONMENT OF TRADE-MARK, 285, 286, 289.
by adoption of new mark, 290.
old corporate mark, by failure to register, 101, 291.
abandoned mark no obstacle to subsequent registration, 126, 293.
mark removed from the register, 291.

ABROAD,
use of old mark, 161.
goods made, 482, 483, 534.
offences committed, 504, 657.

ACCESSORIES TO OFFENCES UNDER THE M. M. A., 504.

ACCOUNT OF PROFITS,
in infringement action, 360—363.
costs of taking, 363.
refused because of delay, 362.
discovery in aid, 375.
undertaking to keep, 355.

ACQUIESCENCE AS A DEFENCE, 332.
mere delay is not, 333.
on application to rectify, 225, 226.

ACQUISITION. See *Title.*

ACTION,
rectification by, 238.
infringement, Chap. XV., 295. See *Infringement.*
passing off, Chap. XVI., 379. See *Passing off.*
trade libel, Chap. XVIII., 438.
unconscientious use of trade-secret, Chap. XIX., 448.

ADDITION,
of descriptive words, 171, n.
of common matter, 169.
to infringing mark, inconspicuous, 322.
use of registered mark with, 331.

ADDITIONS AND DISCLAIMERS, Chap. IX., 164.

ADDRESS,
of Comptroller, 53, 628.
of applicant for registration, 68.
where applicant or opponent is abroad, 82.
imitation of trade address, 402.
cypher addresses, unconscientious use of, 453.
alteration of, on the register, 603.
on packing-case not shown to purchaser, 697, 698.
on imported flowers, fruit, or vegetables, 699.
on imported grain sacks, 701.

ADULTERATION,
infringement by adulterating marked goods, 310.
applying a false trade description by, 491.
statutes restraining, 475.

ADVERTISEMENT,
marks only used as, not trade-marks, 29, 33, 47.
of application to register, 69, 598, 630.
resembling mark tendered for registration, 126.
of order to rectify, 243, 250, 603.
infringement by, 39, 310, 651.
fraudulent representation by, 388.
imitation of, 426.
pending action, may be contempt of Court, 443.
unconscientious use of book of, 451.
in the Trade-Marks Journal, 630.
injunction restraining, 651, 654.

"AEILYTON." See *Ex p. Stephens.*

AGENT,
claim of principal's mark by, 50, 224.
application for registration by, 62, 596.
registration in agent's name, 62, 236.
infringement by, 306.
false pretence of agency, 43, 323.
breach of confidence by, 452.
offence by agent of corporation, 464.
liability under the M. M. A. for offences, 501.

"AGENT FOR," 43, 323.

AGREEMENT,
to allow mark to remain on the register, 228. See also *Note on Register.*
to condone infringement, 330.

"AINSWORTH'S THREAD," 386.

"ALBION." See *Harrison's Tm.*

ALBUM, trade-name of, 407, n.

ALIEN. See *Foreigner.*

"ALPINE EMBROIDERY," 143.

ALTERATION,
registered mark in use, 195, 331.
entry in non-essential particular, 247.
entry, in consequence of assignment, 260.
falsifying a trade-mark, 468, 472.
trade description, 491.

AMENDMENT,
application, 71.
notice of opposition, 76.
allowed by the Comptroller, 604.

AMERICAN AUTHORITIES, 131.

"ANATOLIA LIQUORICE." See *McAndrew* v. *Bassett.*

ANCHOR MARKS, 123, n., 197.

ANCHORS, marks required to be put on, 710.

"ANCHOVIES," essence of. See *Burgess* v. *Burgess*, 424.

"ANCROSS." See *Thewlis & Blakeley's Tm.*

"ANGOSTURA BITTERS." See *Siegert* v. *Findlater.*

ANIMAL marks on the register, 122.

"APOLLINIS." See *Apollinaris Co.* v. *Herrfeldt.*

APOLOGY,
for infringement, publication, plaintiff is not entitled to, 365, n.
not unlawful, 443.

APPEAL,
from the Comptroller to the Board of Trade and the Court, 78—86, 598.
to the Court of Appeal, 84.
to the House of Lords, 81, n.
from the Cutlers' Company to the Comptroller, 100, 616.
from order under sect. 90...245.
in infringement action, costs, 368.
hearing advanced, 371.
against conviction under M. M. A., 519.

APPENDIX, contents of, 546.

APPLICANT, meaning of, in the Rules, 602.

APPLICATION,
to register, Chap. IV., 58, 628.
equivalent to public use of mark, 254.
amendment, 71.
abandonment, 68, 86.
of trade-mark to goods, 29.
of trade-mark under M. M. A., 473.
falsely applies, 474.
of false trade description, 491.

ARMS, FAMILY, infringement by use of crest, 325, n.

ARMS, ROYAL,
not registered, 64.
unauthorized assumption of, 542.

ARTIST'S NAME, warranty of, 433.

ASSAY MARKS,
on watch cases, 522, 525, 694.
on plate, 711.

ASSENT OF PROPRIETOR, under M. M. A., 1887...470.

ASSIGNMENT OF TRADE-MARK,
Chap. XIII., 272.
registration of, 278.
not under sect. 90...236.
not necessary before action, 280.
alteration of mark on, 280.

"ATHENA." See *Lyndon's Tm.*

AUTHOR'S NAME, imitation of, 410.

AUTHORITIES,
bearing on fact of infringement, 322.
American, 131.

AVERAGE ENGLISHMAN TEST, 145.

"B. B. H." See *Hall* v. *Barrows.*

"BAFFLE SAFES." See *Talbot* v. *Webley.*

BAILEE,
of infringing goods, 358, 364.
of falsely marked goods, 510.

"BALBRIGGAN HOSE," 498.

"BANK OF ENGLAND SEALING WAX." See *Hyde & Co.'s Tm.*

BANKRUPTCY,
sale of trade-marks on, 278, 329.
sale of trade-name, 419.

"BEATRICE SHOES." See *Harris's Tm.*

BEER,
same description of goods as rum, 181.
adulteration of, 475, n.

BELGRAVIA magazine case, 33.

"BEN LEDI WHISKY." See *Ainslie & Co.'s Tm.*

"BLACKWELL'S PICKLES." See *Blackwell* v. *Crabb.*

BLANKS IN LABELS, 139, 174.

BLEACHERS' protest against the M. M. A., 1887...503.

"BLIND NAMES," 497.

BOARD OF TRADE,
when consulted by Comptroller, 53, 67.
appeal from Comptroller to, 79, 598, 637.
evidence as to proceedings before, 572.

BODEGA wine shops, 415.

"BÖKOL." See *Davis* v. *Stribolt.*

BOND,
on entry of name or mark in Customs register, 686.
on detention of goods by Customs officers, 693.

BOOK, imitation of title of, 410.

BOTTLES,
use of marks on, 159.
using marked bottles, 310, 474.
BOXES,
use of marks on, 29, 159.
using marked boxes, 310.
"BRAIDED FIXED STARS." See *Palmer's Tm.*
BRAND,
in sect. 64...118, 132.
on corks, 30, 135.
"BRAND'S ESSENCE OF BEEF." See *Dence* v. *Mason*, 394.
BREACH OF CONFIDENCE, Chap. XIX., 448.
BREAD,
adulteration of, 475, n.
marks on, 710.
"BRITANNIA." See *Hodgson* v. *Sinclair*.
BRITISH POSSESSION, 468.
registration of trade-marks of, Chap. XX., 454.
list of possessions to which sect. 103 applies, 656.
"BRYMBO." See *Batts' Tm.*
"BURGUNDY," not a possible trade-mark, 45.
BUTTER, marks on, 710.
BUTTONS (metal), marks on, 710.

"CALCULATED TO DECEIVE." See *Deception* and *Resemblance*.
"CAMEL HAIR BELTING," 405, 646. See *Reddaway* v. *Bentham Co.*
CANCELLATION of entries under sect. 91...246, 612, 613.
CARDS (playing), marks on, 710.
"CARLSBAD SALTS," 214. See *Kutnow's Tm.*
"CARNIVAL." See *Lloyd & Son's Tm.*
"CARRIAGE BAZAAR," 401, 414. See *Boulnois* v. *Peake*.
CASE,
on appeal to the Board of Trade, 80, 637.
special, for determination of rival claims for registration, 177, 602.
"CASTLE ALBUM." See *Schove* v. *Schmincke*.
CAUSING offence against the M. M. A., 1887...500.
"CAVITÉ." See *Compagnia Général de Tobacos* v. *Rehder*.
CERTIFICATE,
of the Comptroller is evidence, 57.
kinds of, 633.
of refusal to register, 70, 264.
of registration, 257.
of master of the Cutlers' Company, 102.
that title to the trade-mark came in question, 370.
of Board of Trade, 572.
applications and forms, 607.

CHAIN CABLES, marks on, 710.
CHAMPAGNE, Saumur, 704.
CHICORY, marks on, 711.
CHILWORTH gunpowder, 492.
"CHLORODYNE." See *Browne* v. *Freeman*.
CIRCULARS,
fraudulent representation by, 388.
imitation of, 426.
injunction restraining use of, 654.
CIRCUMSTANCES of the trade to be considered in comparing marks, 197.
CLASS,
classification of goods, Chap. V., 87.
of goods to which trade-mark extends, 32, 87, 308.
cotton classes, 103.
sect. 72 not limited by register classes, 180.
use for part of register class, 87, 181.
infringement on goods within class for which the plaintiff's right exists, 308.
table of register classes, 618.
CLERK, breach of confidence by, 451.
CLOCKS, importation of marked, 526, 711.
COFFEE,
adulteration of, 475, n.
marks on, 711.
COIN MARK, 162, n.
"COKER CANVAS." See *Hayward's Tm.*
COLLATERAL MISREPRESENTATION, 336.
COLLIERY CASE, 406.
COLMAN'S mustard, name not disclaimed, 115, n.
COLONIAL,
trade-mark, Chap. XX., 454.
colonies to which sect. 103 is applied, 656.
COLOUR,
registration in colours, 162.
bearing on deceptive resemblance, 163.
restriction of use to one colour, 163.
as an element in infringement, 319.
COLOURABLE IMITATION, 314—323.
COMBINATION DEVICE, 130.
word, 140, 152, n.
COMMIT,
delay in application to, 356.
for contempt by publication pending action, 443, 445.
COMMITTEE (Lord Herschell's), citations from their report, doubtful marks to be rejected, 11.

COMMITTEE (LORD HERSCHELL'S)—*continued.*
name-marks derived from expired patent, 42.
Manchester branch office, 105, n.
registration of names with marks, 115.
descriptive devices, 131.
brands, 133.
registration of line headings, 136.
phrases and proverbs, 137.
word-marks, 141.
geographical words, 147.
additions and disclaimers, 164, 168.
the three mark rule, 178.
the comparison of marks, 188.

COMMITTEE OF 1862...6, 512.

COMMITTEE OF 1890 on Merchandise Marks, 20.

COMMITTEE OF EXPERTS, 104.

COMMON ADDITIONS not part of the trade-mark, 173.

COMMON LAW TRADE-MARK, 260.
definition, 24.
practically protected against infringement, 266.
See Chap. XVI., "Action for Passing Off," 379.

COMMON TO THE TRADE,
what marks are, 122, 124.
marks, bearing of, on distinctiveness of new marks, 122.
additions, 169.
words, in trade-mark, no monopoly in, 170.
words, in label, not to be disclaimed, 172.
elements in contrasted marks not to be disregarded, 192, 199.
trade-mark, may become. See Chap. XIV., 283.
words, may be an element in "get up," 408.

"COMMON USE," 149.

COMPANY,
may apply for registration, 60, 101.
trade-name of, 395, 651.
using trade-name of promoter, 400.
offences by, under the M. M. A., 1887...463.

COMPARISON OF MARKS,
under sect. 72 (2), 188—205.
in infringement actions, 318.

COMPENSATION to innocent purchasers under the M. M. A., 1887... 514, 526.

COMPOUND word, when an invented word, 152.

COMPROMISE,
of application to rectify, 228.
publication of terms of, 443.
of prosecution under the M. M. A., 1862...515, n.

COMPTROLLER, 53, 564.
may consult the Board of Trade, 53, n.
to give certificates, 57, 70, 257, 264.

COMPTROLLER—*continued.*
discretion to register, 63—68.
amendments and enlargements of time by, 76.
appeal from, 78—85.
notice of appeal, 82.
not ordered to pay costs, 85, 244.
costs before, 86.
appeal to, from the Cutlers' Company, 101.
notice of rectification to, 239, 243, 250.
correction and cancellation of entries by, 246.
appearance by, on application under sect. 92...250.
deputy for, 565.

CONCURRENT RIGHT,
registration of duplicate marks, 176.
limitation of registration by, 305.
a defence in infringement action, 325.

"CONDI SANITAS." See *Sanitas Co. v. Condy.*

CONFIDENCE, breach of, Chap. XIX., 448.

CONFLICTING CLAIMS to registration, 177, 602.

CONFUSION, PROBABLE,
of marks, an objection to registration, 181.
of names, may amount to passing off, 414.
See *Deception.*

CONNECTION,
with proprietor indicated by a trade-mark, 49.
with old business may be advertised, 387.
pretence of, with plaintiff's business, 387.

CONSIGNEE,
trade-mark of, 51.
registration in name of, 237.
action by sole consignee, 302.
must not export infringing goods, 364, n.

CONTEMPT OF COURT,
breach of injunction, 355.
by publication of statement pending action, 443.

CONVENTION, International. See *International Convention.*

CONVENTIONAL TRADE DESCRIPTION, 481, 498, 665.

COPY,
of register is evidence, 57.
of trade-mark, when an infringement, 32, 312.

"COPYRIGHT,"
not registered, 216.
may be a false trade description, 476.

COPYRIGHT,
trade-mark is not analogous to, 2.
gives no title to registration, 131.
device adopted as trade-mark, 78, n.
no excuse for infringement, 327.

CORKS, use of mark on, 30, 135.

CORPORATE MARKS, Chap. VI., 91.
grant, assignment, 93.
register closed, 94.
abandonment by non-registration, 101, 291.
counterfeiting, 544.
application to register, 617.
CORPORATION,
may apply for registration, 60, 101.
offences by, under M. M. A. 1887...463.
CORRECTION of the register, 246. See *Alteration* and *Amendment*.
COSTS,
application to register:
security for costs by opponent abolished, 76.
before Comptroller, 86.
on appeal, 85.
motion to rectify:
under sect. 90...244.
as between solicitor and client, 243.
security for, by foreign respondent, 241.
in action for infringement, 370.
under sect. 92...251.
action for infringement, 364—371.
no lien for, 358.
against innocent infringer, 359, 364.
in trivial cases, 366.
refused to successful party, 366—368.
higher scale, 369.
as between solicitor and client, 370.
of motion to rectify, 370.
of taking account of profits, 363, 652.
of appeal, 368.
order as to, and set-off of, 653.
of prosecution under M. M. A., 518.
COTTON MARKS,
the repealed rules, 103.
application for registration, 104.
Manchester office for, 104, 633.
COUNTERCLAIM for rectification, 238.
COUNTER-STATEMENT, 72, 73.
forms, 632, 636.
COUNTRIES to which sect. 103 is applied, 656.
COUNTRY OF ORIGIN,
name of, when a trade-mark, 44.
not a fancy word, 147.
not an invented word, 152.
may be an old mark, 157.
mark registered in, 456.
trade description as to, 480.
goods partly made abroad, 482.
no general obligation to indicate, 487.
"made abroad," 482, 534.
"made in Germany," 481, 534.
in the international convention, 659.

COUNTY COURT, jurisdiction, 298.
COURT,
reference of appeal to, 78—86, 598.
meaning of, in Act of 1893...81, 237.
in Lancashire, 105.
to try action for infringement, 298.
COVERING,
use of trade-mark on, 20.
meaning in the M. M. A. 1887...473.
CREST, infringement by use of, 325, n.
CRIMINAL LAW OF FALSE MARKING, 6, 17.
under the M. M. A. 1887, Book II., 460.
offences committed abroad, 504, 657.
CUSTOM,
for shippers to own trade-marks, 301.
trade description allowed by, 476, 485, 498.
trade, 485.
CUSTOMERS,
names not to be disclosed, 374.
of former business, soliciting, 418, n.
See *Purchaser*.
CUSTOMS,
actions against officers, 538.
practice as to detention of goods, 538. See *Detention*.
register of names and marks, 534, 683.
regulations, 527, 536, 678—704.
CUSTOMS ENTRY, 476, 486.
CUTLERS' COMPANY, 91, 604.
marks, Chap. VI., 91.
their rights preserved, 94.
opposition to registration by, 94, n.
duties in regard to registration, 96.
CUTLERY,
marks, penalties for counterfeiting, 543.
"London made," 543.
CYPHER ADDRESS,
imitation of, 402, n.
unconscientious use of, 452.

"DAIRY MAID MILK," 200. See *Anglo-Swiss Condensed Milk Company* v. *Metcalf*.
DAMAGES,
under sect. 90...243.
undertaking as to, 354.
for infringement, 359, 360.
in lieu of profits, 360.
special, need not be proved, 4, 359.
for passing off, 415.
in trade libel cases, 441.

DATE OF REGISTRATION,
is date of application, 254.
variation of, 230 n., 235.
DEALERS, infringement, though they are not deceived, 187.
DEATH,
of applicant for registration, 70, 601.
action for infringement does not abate, 303.
action for trade libel does not abate, 447. See *Devolution*.
DECEPTION, PROBABILITY OF,
evidence as to, 205.
evidence of actual deception, 206, 313, 316.
by similar mark in another class, 210.
intent to deceive, 316.
comparison of resembling marks, 188--209, 316—323.
the test of infringement, 314.
in passing off cases, 414.
DECEPTIVE MARKS,
word either descriptive or deceptive, 153.
not to be registered, 209—217.
are outlawed, 336.
DECEPTIVE USE of mark, not presumed, 214, 349.
DECLARATION,
evidence by, 73, 605.
verified by affidavit for use in Court, 83.
false, as to watch marks, 541.
in cases of incapacity, 570.
forms, 613, 637.
on entry of name or mark in Customs register, 686.
as regards watch cases brought to be marked, 696.
DEFENCES,
action for infringement, 295, 323—348.
passing off, 380, 416—427.
forms, 645, 647.
under the M. M. A., 1887...505, 511.
notice of, 502, 504, 518.
DEFINITION,
of a trade-mark, Chap. II., 24.
in sect. 64 is merely restrictive, 112.
DELAY,
in application to rectify, 229.
in suing for infringement, 333.
may cause determination of trade-mark, 286, 290.
bearing on the evidence, 206, 335.
a bar to an injunction, 351, 353.
account of profits, 362.
in application to commit, 356.
DELIVERY UP of marked goods, 357.
DEMARARA SUGAR, 478.
"DEMON RACQUETS," 358. See *Slazenger* v. *Feltham*.
DENTIST CASE, 388.
DESCRIPTION. See *Trade description*.

DESCRIPTIVE,
marks, not distinctive, 36, 48, 127.
devices, 131.
words, not fancy words, 145.
not invented words, 152.
descriptive or deceptive, 153.
no monopoly in, 397.
name derived from trade-mark, 201.
trade-name of goods, 404. See also *Common to the trade* and *Secondary distinctive meaning*.

DESIGN, trade-mark copyright design, 78 n. See *Device*.

DESIGNER may register new mark, 110.

"DESTINACION." See *Pinto* v. *Badman*.

DESTRUCTION,
of infringing goods, 7, 357.
of goods under the M. M. A., 1887...514, 521.

DETENTION OF IMPORTED GOODS, 527, 690.
when officers act without special information, 680, 684, 690.
security in respect to, 686, 691.
bond for, 687, 693.
information to procure, 690, 692.
discretionary powers of officers as to, 701.
notice of, 703.

DETERMINATION of trade-mark rights, Chap. XIV., 283.

DEVICE,
in sect. 64...128—132.
combination, 130.
cases of contrasted devices, 207.
copyright design, 78 n.

DEVOLUTION,
of trade-marks, Chap. XIII., 272.
of trade-name, 391.
of goodwill, 417.

"DIAMOND CAST STEEL." See *Spencer's Tm.*

"DIAMOND GUNPOWDER." See *Curtis and Harvey* v. *Pape*.

DICTIONARY WORD, 152 n.

DIFFERENCES between trade-marks,
bearing of, on resemblance, 192, 320.
inconspicuous, or easily removed, 322.
colourable, 414.

DISABILITY, evidence where person is under, 570.

DISCLAIMER, Chap. IX., 164.
part of distinctive label, 138.
to be included in application, 166.
applicant's name or address, 167.
effect, 173.
offer, upon application to rectify, 223.
entered under sect. 90...234.

DISCLOSURE of real offender under M. M. A., 1887...504, 509, 512.

DISCOVERY,
on application to rectify, 242.
in infringement action, 374.
in aid of account, 375.
See *Disclosure*.
DISCRETION,
to refuse registration, 63—67.
Cutlers' Company, none, as to old marks, 96.
of Court, to refuse to remove mark, 226, 232.
DISTINCTIVE,
trade-mark must be, 35.
meaning in sect. 64...119—128.
sect. 74...171.
character, how lost, 285.
"DOG HEAD BEER." See *Read* v. *Richardson*.
"DOG, TOWER, AND HARP LINEN." See *Speer's Tm.*
"DOME BLACK LEAD." See *James' Tm.*
DOUBTFUL new marks to be rejected, 11, 211.
DUPLICATE marks not to be registered, 176—182.

EDITION, false statement as to number, 347.
EDMUNDS, LEONARD, evidence before Committee of 1862...7.
EFFECT OF REGISTRATION, Chap. XII., 252.
"ELECTRIC VELVETEEN," 143. See *Leaf's Tm.*
"ELECTROID ANTI-FOULING COMPOSITION." See *Hannay's Tm.*
ELEPHANT CASE. See *Johnston* v. *Orr-Ewing*.
"ELISE (Madame)." See *Chatteris* v. *Isaacson*.
"EMOLLINE, EMOLLIO CREAM." See *Grossmith's Tm.*
"EMOLLIORUM," 151. See *Talbot's Tm.*
"EMU." See *Burgoyne's Tm.*
ENGLISH WORDS on imported goods, 532.
ENGLISHMEN, "fancy word," addressed to, 145.
"ENTERED AT STATIONERS' HALL," 126, 216, 327.
ENTRIES ON THE REGISTER, 53.
"EQUAL TO," 323.
ERASURE of infringing marks, 357.
ERRORS,
correction of, 246.
allowed in trade description, 490, 705.
ESSENCE OF ANCHOVIES, 424.
ESSENTIAL PARTICULARS, 112.
to be specified in the application, 68, 166.
to be regarded in comparing marks, 196.
not to be altered under sect. 92...247.
of old mark, 248.
copying, an infringement, 313.

ESTOPPEL,
on application to rectify, 225.
defence in infringement action, 330.
ETCHINGS, publication of catalogue, 450.
"ETON CIGARETTES," 155. See *Wood* v. *Butler*.
"EUREKA," 37. See *Ford* v. *Foster*.
EVIDENCE,
certificates and copies of the register, 57.
on application to register, 73, 74.
power to dispense with, 570, 603.
on appeal to the Board of Trade, 80.
on appeal to the Court, 83.
use of old mark, 161.
probability of deception, 205.
actual deception, 266, 313, 316.
intent to deceive, 316.
cumulative resemblances, 408, 413.
expert, 205, 378.
on application to rectify, 241.
of title, registration is, 255, 304.
registration, 257.
in action for infringement, 376.
register books, 378.
of defendant and wife under M. M. A. 1887...509.
rebutting, evidence of innocent intention, 509.
proceedings before Board of Trade, 572.
"EXACTLY TWELVE YARDS," 48.
"EXCELSIOR SPRING MATTRESS." See *Chorlton and Dugdale's T'm.*
"EXCELSIOR WHITE SOAP." See *Braham* v. *Bustard*.
"EXCELSIOR WHITE SOAP," 48.
"EXCLUSIVE USE," 209.
EXECUTORS,
registered on death of applicant, 70.
can sue for infringement, 303.
trade libel, 447.
See *Devolution*.
EXHIBITION medal, pretence of, 711.
EXPERT,
evidence, 205, 378.
committee of experts, 104.
EXPORTATION of infringing goods, 365, n.
EXPORTER,
trade-mark of, 51, 301.
may be a "person aggrieved," 223.
EXPUNGE, mark, discretion to refuse under sect. 90...226.

FACTORY, name of, 401.
"FALSE," in the M. M. A. 1887...488.
FALSE PRETENCES, sale under spurious mark may be, 469.

"FALSE TRADE DESCRIPTION" in the M. M. A. 1887...487—498.

"FALSELY APPLIES," in M. M. A. 1887...472, 474.

FALSIFICATION,
of the register, 55, 541.
of a trade-mark, 472.

"FAMILY SALVE," 135. See *Reinhardt* v. *Spalding*.

FAMILY USE, importation for, 307.

FANCY NAME, no right to use any, 423.

"FANCY WORD NOT IN COMMON USE," 142—152.
list of words in decided cases, 151, 152.

FEEDING STUFFS, adulteration of, 475.

FEES,
list of, 606.
payment of, 624.

FERTILIZERS, adulteration of, 475.

FIGURE,
in Registration Acts means "numeral," 165, n.
may be an old mark, 154.

FILTER CASE, 48.

"FILTERED BLUE," 153. See *Edge's Tm.*

"FILTRE RAPIDE," 171, n.

FIRM. See *Partnership*.

FIVE YEARS' REGISTRATION,
effect of, 255, 258, 304.
similar mark registered, after, 180.
rectification after, 258.

"FIXED STARS." See *Palmer's Tm.*

FLOWERS, imported, address on, 699.

FOOD AND DRUGS ACTS, 475.

FOREIGN
words, 145.
user of old mark, not sufficient, 161.
trade-marks, registration, Chap. XX., 454.
manufactures, deceptively marked, 532.

FOREIGNER,
probability of deception of, 187.
may be a "person aggrieved," 223.
respondent to application to rectify, 240.
service out of the jurisdiction, 299.
may sue for infringement, 21, 300.

FORFEITURE of goods under M. M. A. 1887...514, 521.

FORGERY of a trade-mark, 465, 468—472.

FORMS,
in the schedule to the Rules, 607.
on opposed application to register, 635.
notice of motion to rectify, 642.
pleadings in actions, 643.
orders in actions, 643.
indictment and information under the M. M. A. 1887...703.

"FORREST (LONDON)," 216. See *Hill's Tm.*

FRAUD,
proof of, not necessary in infringement action, 4, 14, 316, 349.
or passing off action, 14, 269, 384.
unfounded charge, costs refused, 368.
new case of, at trial, 383.
badges of fraud, 414.
intent to defraud under M. M. A. 1887...507.

FRAUDULENT,
use of mark tendered for registration, 161.
not presumed, 214, 349.
mark not to be registered, 161, 216.
is outlawed, 336.
trade, no action to protect, 346.

"FRIEDRICKSHALL." See *Apollinaris Co.'s Tm.*

"FRIGI-DOMO." See *Edgington's Tm.*

"FROM," 323, 387.

FRUIT, imported, address on, 699.

"FRUIT SALT," 65, 211. See *Eno* v. *Stephens*; *Eno* v. *Dunn.*

"GEM." See *Arbenz's Tm.*

GENERAL ORDERS UNDER THE, M. M. A., 1887...678.

GENERIC TRADE-DESCRIPTION, 481, 498, 665.

GEOGRAPHICAL NAMES, 44, 141.
may be fancy words, 147.
not invented words, 152.
may be old marks, 44, 157.

GET-UP, 411.
difference of, in infringement, 321.
imitation of, 411.
common words in, 403.
common to the trade, 411.
when a false trade description, 476.

"GLENFIELD STARCH," 46. See *Wotherspoon* v. *Currie.*

GOLD (PLATE) marks on, 711.

"GOLDEN FLEECE," 180. See *Australian Wine Importers' Tm.*

GOODS,
to which trade-mark right extends, 32, 87, 308.
classification of goods, Chap. V., 87.
mark comprising reference to particular goods, 89, 216, 632.

GOODS—*continued.*
series of marks for different, 90.
same goods, or description of goods, 180.
registration limited by use on, 256.
delivery up of infringing, 357.
meaning of, in M. M. A., 1887...472.
the register classes, 618.
detention of imported. See *Detention.*

GOODWILL,
trade-mark assignable with, 272, 287.
assignment with part of, 277.
lease of, 281.
temporary separation from, 288.
on dissolution of partnership, 387, n., 418, 420.
purchaser takes the trade-name, 417.
vendor may solicit old customers, 418, 420.

"GRANOLITHIC STONE." See *Stuart* v. *Scottish Paving Co.*

GRAIN imported, marks on, 700.

"GRASS BLEACH." See *Reiss' Tm.*

GREAT MOGUL playing cards, 2.

"GROSVENOR LIBRARY," 398. See *Hoby* v. *The Grosvenor Library Co., Limited.*

"GUANO CASE." See *Native Guano Co.* v. *Savage Manure Co.*

"GUINEA COAL," 427, n. See *Lee* v. *Haley.*

GUNPOWDER, marks on, 711.

"HABANA," 347. See *Newman* v. *Pinto*; *Hargreaves* v. *Freeman.*

HALLAMSHIRE (Sheffield Marks), Chap. VI., 91.

HALL MARKS, on plate, 711.

HAMMER MARKS, 543.

"HAND GRENADE FIRE EXTINGUISHER." See *Harden Star, &c., Co.'s Tm.*

"HARNESS COMPOSITION." See *Beddow* v. *Boyd.*

"HARVEY'S SAUCE." See *Lazenby* v. *White.*

"HAVANA." See *Habana.*

HEADINGS,
in sect. 64...135.
line headings, 198.

HEARING by Comptroller, 67.

"HERBALIN." See *Humphries* v. *Taylor's Drug Co.*

HINDMARCH, evidence before committee of 1862...7, 512.

HOLIDAYS, PUBLIC,
last day for doing any act expiring on, 569.

HOLLOWAY'S PILLS, 337.

"HOMEWASHER." See *Ralph's Tm.*
"HOOP L IRON." See *Heaton's Tm.*
"HORSE BLISTER." See *James* v. *James.*
HOUSE, name of, when protected, 401.
HOUSE OF LORDS, order remitted to Ch. Div., 81.
"HOUSEHOLD WORDS." See *Bradbury* v. *Dickens.*
"HOWQUA MIXTURE." See *Pidding* v. *How.*
HUNTSMAN'S cherry brandy, 190.
"HUNYADI JANOS." See *Apollinaris Co.'s Tm.*

IDEA OF MARK with regard to resemblance...130, 188, 319.
IDENTICAL MARKS for the same goods, 176—182.
IGNORANT. See *Innocent.*

IMITATION OF TRADE-MARK,
by copying, 312.
colourable, 314—322.
"imitations prosecuted," 215.

IMPORTATION,
fraudulent, 487.
of watches and clocks, 526.
of deceptively marked goods, prohibited, 527, 530.

IMPORTER,
when proprietor, 61.
action for infringement by sole, 302.

INDEMNITY to purchaser of marked goods, 359, 437.

INDEXES to the register, 56.

INDIAN,
trade-marks, 456.
M. M. A., errors allowed under, 490, 705.

INDICTMENT,
right to trial by, 516.
form of, 708.

INFANT,
infringer, costs against, 366.
declaration or act to be made or done by, 570.

INFERIORITY of infringing goods, 4, 34, n., 306, 385.

INFORMATION,
as to real offender under M. M. A., 1887...504, 509, 512.
to procure detention of imported goods, 690, 692.
when officers act without, 680, 684, 690.
in criminal proceedings, forms of, 708.

INFRINGEMENT,
action for, Chap. XV., 295.
specialization of the action, 5.
in respect of what goods, 31, 308, 448.
registration, a condition precedent, 260, 268.
of unregistered trade-mark, 268, 383.
comparison with action for passing off, 297, 381.
definition of, 305.
what constitutes, 305—323.
single act of, 306.
connection with spurious goods, 310.
by claim of registered trade-mark, 313.
question for jury, 315.
displaying infringer's name, 320.
with different get up, 321.
unintentional, 361, 364—366.
warning against, 300, 439.
INITIALS, false, 493.
INJUNCTION,
in infringement action, 348—356.
interim, 352.
forms, 652, 653.
refused because of delay, 353.
doubtful title, 352, n.
limited to particular market, 351.
enforcement, 355.
choice of new mark, 356.
in passing off action, 428.
in trade libel cases, Chap. XVIII., 438.
in trade secret cases, Chap. XIX., 448.
precedents of, 648—655.
INNOCENT,
misrepresentation as to maker of goods, 386.
infringer, 361, 364—366.
inception of infringement, 384.
purchaser, compensation to, under M. M. A., 1887...514, 521.
proof of innocence under the M. M. A., 1887...505, 513.
INQUIRY as to damages, 360.
INSPECTION,
of the register, 55.
in trade-mark actions, 375.
INSTRUCTIONS to persons who wish to register trade-marks, 624.
INTENT TO DEFRAUD
under M. M. A., 1887...507.
See *Fraud* and *Fraudulent*.
INTERNATIONAL,
arrangements, Chap. XX., 454, 21.
convention, 18, 457, 529.
text, 658, 664.
list of countries and possessions affected, 656.
INTRODUCTION,
of new goods, 42.
of defendant's mark into plaintiff's market, 328.

INVENTOR,
proprietor of new mark, 60.
of goods, name of, 41, 406.
portrait of, 129.
name used by, 37—43.

IRISH,
party on appeal from Comptroller, 82.
respondent under sect. 90...241.

"ISINGLASS (PATENT)." See *Gridley* v. *Swinborne.*

ISSUE of fact under sect. 90...567.

"JOHN BULL BEER," 185, 226, 313. See *Paine* v. *Daniells.*

JOINT TRADE-MARK, 51, 301.

"JUBILEE." See *Towgood* v. *Pirie.*

JURISDICTION,
in Lancashire, 105.
to rectify the register, Chap. XI., 218.
Court under Act of 1883...237.
Scotch and Irish Courts, 238.
in infringement action, 298.
service out of, 240, 299.
offences committed abroad, 504, 657.

JURY,
right to, 298.
questions for, 315.
on prosecution under M. M. A., 1887...516.

"KEY BRAND GENEVA." See *Meeus' Application.*

"KOKOKO," 146, n., 185. See *Jackson Co.'s Tm.*

"L L WHISKY." See *Kinahan* v. *Bolton.*

LABEL,
in sect. 64...136—139.
must be distinctive, 113, 137.
containing common words of another, 139.
blanks, 139, 174.
disclaimer of words in, 138, 172.
replacing worn out, 32, 448.
in M. M. A., 1887, includes band and ticket, 473.

LANCASHIRE, jurisdiction of Palatine Court, 105.

"LANCASHIRE SWEDISH" IRON, 699.

"LATE," 387.

"LATE OF," 323.

"LAWFORD," 148, 152.

LAWN TENNIS RACQUETS, 358.

LEASE of goodwill, 282.

LEATHER CLOTH CASE, 47.

LECTURES, publication of, 451.

LETTER,
not a device, 129.
may be an old mark, 153.

LETTERS,
addressed to plaintiff, opening, 388.
publication, restrained, 451.

LIABILITY cast by use of another's name, 418.

LIBEL (TRADE), Chap. XVIII., 438.

LICENCE,
to use a trade-mark, 281.
action by licensee, 282, 302.
to infringe, 333.

"LICENSED VICTUALLERS' RELISH." See *Cotton* v. *Gillard*.

LIEBIG'S EXTRACT, 41.

LIEN on infringing goods, 358.

"LIMETTA." See *Rose* v. *Evans*.

LIMITATION,
of registration by note on register, 163 n, 182, 184, 235.
by use of mark, 256.
of injunction, 328, 351.
of prosecution under the M. M. A., 1887...517.

"LIMITED" added to registered mark, 248.

LINE HEADINGS, 136.

LINEN, marks on, 711.

LINOLEUM, 43, 311.

"LION MATCHES." See *Baschiera's Tm.*, 196.

LIQUORICE (ANATOLIA), 45.

LOCAL,
repute of trade-name, 399.
use of trade-mark, 184.

"LONDONDERRY WALLSEND COAL," 335.

"LONDON MADE" CUTLERY, 543.

"LONDON MANURE Co." See *Purser* v. *Brain*.

"LONDON PICKLES." See *Hammond* v. *Malcolm Brunker & Co.*

"LONDON RELISH." See *Powell's Tm.*

"LOUISE (MADAM)." See *Isaacson* v. *Thompson*, 394, n.

LUNATIC, declaration or act to be made or done by, 570.

M. AND C. CHAMPAGNE, 426.

M. M. A., 461, n. See *Merchandise Marks Act*.

"MADE ABROAD," 482, 534.

"MADE IN GERMANY," 481, 534.

MADRID CONVENTION, text, 664.

MAGAZINE,
goodwill of, 410.
trade-name of, 33, 410.
MANCHESTER BRANCH OFFICE, 104.
"MANOR TIN PLATES." *Thompson's Tm.*, 151.
MANUFACTURE,
description of mode not a trade-name, 404.
imported, bearing English names, 532.
MARGARINE, 475, 711.
MARK,
in sect. 64...132.
no general obligation to mark goods, 20, 487, 530.
required for particular goods, 710—714.
See *Trade-Mark*.
MARKET,
use of trade-mark in, 33.
use in different, 184.
limitation to particular, 182, 184.
foreign, 187.
infringement must be in plaintiff's, 307.
introduction of mark to new, 328.
injunction limited to particular, 328, 351.
MASTER AND SERVANT under the M. M. A. 1887...500.
"MATERIAL RESPECT," false in a, 489, 490.
MATERIAL, trade description as to, 483.
MEASURE,
trade description as to, 480.
limits of error, 490, 705.
MEDALS (exhibition), false representation of grant, 416, n., 711.
"MELROSE HAIR RESTORER." See *Van Duzer's Tm.*, 143.
MERCHANDISE MARKS ACT, 1862...7, 16, and xlvii.
MERCHANDISE MARKS ACT, 1887,
summary, 19.
the subject of Book II., Chap. 1...460.
text, 666.
defences, 500, 501, 505, 511.
intent to defraud, 507.
customs regulations, 536, 678 *et seq.*
See *Detention*.
MERCHANDISE MARKS ACT, 1891,
text, 677.
Order in Council under, 707.
METAL GOODS,
defined, 102.
marks for, in Hallamshire, 96—102.
"MEXICAN BALSAM." See *Perry* v. *Truefitt*.
MIDDLEMEN,
deceptive mark may not deceive, 187.
differences removable by, 322.
infringement leading to frauds by, 363.

"MILK MAID BRAND." See *Anglo-Swiss Co.* v. *Metcalf*, 200.
"MINERVA HABANA (LA)." See *Lloyd & Sons Tm.*, 145.
MISREPRESENTATION,
as to origin of goods, 216.
estoppel by reason of, 336—347.
collateral, 337.
subsequent to action, 347.
costs refused by reason of, 367, 368.
"MIXTURE" (tobacco). See *Hargreaves* v. *Freeman*.
"MOGUL PLAYING CARDS." See *Blanchard* v. *Hill*, 2.
"MONOBRUT." See *Vignier's Tm.*
"MONOPOLE." See *Richards* v. *Butcher*.
MONOPOLY,
none in type of goods, 41.
name of goods, 43.
common parts of label, 138.
common additions, 173.
disclaimed matter, 173.
descriptive name, 378.
elements of get up, 408.
name or address of non-trader, 2, 415.
trade-secret, Chap. XIX., 448.
attempt to secure under trade-name, 204.
"MONTSERRAT LIME JUICE." See *Evans* v. *Smith*, 352.
MORISON'S UNIVERSAL MEDICINE, 450.
MOROCCO LEATHER, 481.
MORTGAGEE,
of trade-mark, cannot sue, 303.
of infringing goods, retains his charge, 358.
MOTION OR SUMMONS,
procedure by, 81.
notice of motion on appeal from Comptroller, 81, 640.
on application to rectify, 239, 642.
MUSTARD CASE. See *Farrow's Tm.*, 193, and *Colman's Tm.*, 115, n.

NAME,
no monopoly in, unless trade-name or trade-mark, 2, 389, 393, 415.
right to honest use of one's own, 17, 330, 420—427.
descriptive, not a trade-mark, 36—47.
of pattern, 37.
of goods made under expired patent, 42.
of new article, 43.
of place of origin, 44.
geographical names, 44, 141, 147, 152, 157.
name-marks, 114.
sect. 64 (1) (a), 114.
in possessive case, 115, 168.
of common mark not a fancy word, 146.
of natural product not a fancy word, 148.
of person, not a fancy word, 149.
derived from mark, bearing on resemblance, 199—204.

NAME—*continued.*
of opponent's goods suggested by applicant's mark, 211, 212.
alteration of proprietor's, under sect. 90...236.
in mark under sect. 92...248.
assignment of trade-mark comprising, 274, 276.
derived from plaintiff's mark, an infringement, 320.
infringement displaying infringer's, 320.
of non-trader, 389, 415.
of repute may be trade-name, 394.
of repute, right to honest use of, 425.
under M. M. A. 1887...497.
of company, 395.
of promoter, 400.
cannot be sold, 401, 425.
of business house or factory, 401.
of newspaper, 391, 403, 410.
trade-name of business, 392.
of goods, 402.
of author, 410.
of book, &c., 410.
of secret preparation, Chap. XIX., 448.
of English place, imports bearing, 483, 535.
"name or initials" in M. M. A. 1887...493, 495.
blind, 497.
Customs register of names and marks, 534.
English, on imported goods, 532.
See *Trade-name.*

"NATIONAL SPERM." See *Re Price's Patent Candle Co.*

NATURAL WOOL, 483.

"NE PLUS ULTRA." See *Beard* v. *Turner.*

NEIGHBOURHOOD, setting up in the same, 427.

"NEPTUNE." See *Edwards* v. *Dennis.*

NEW MARKS,
may be registered, 109, 254.
doubtful, to be rejected, 11.

NEWSPAPER, name of, 391, 403, 410.

NONSUIT, 371.

NOTE ON REGISTER, 54.
limiting class of goods, 90.
as to colour, 163.
limiting use of mark, 182.
entered under sect. 90...235.

NOTICE,
of action, unnecessary, 300.
of opposition, 76, 610, 635.
of appeal to Board of Trade, 80, 610.
of motion, on appeal from Comptroller, 81, 640.
to rectify the register, 239, 642.
to be sent by post, 57.
of defence under M. M. A. 1887...502, 504, 518.
See *Detention.*

"NOURISHING STOUT." See *Raggett* v. *Findlater*, 48.

NUMBER, trade description as to, 479.

OFFENCES,
under the M. M. A. 1887...462.
committed abroad, 504, 657.

OFFER,
to modify mark applied for, 83.
of complete redress for infringement, 364.

OFFICIAL PUBLICATIONS, 626.

"OLD-ESTABLISHED," 388.

"OLD INNISHOWEN." See *Watt* v. *O'Hanlon*.

OLD MARK, 153—162.
primâ facie descriptive, 155.
used alone as a trade-mark, 160.
three mark rule, 172, 177.
registered, although similar mark registered for five years, 180.
alteration of, on the register, 248.

"OLD WAVERLEY." See *Mason* v. *Queen*.

OMNIBUS CASE. See *Knott* v. *Morgan*, 408.

"OOMOO." See *Burgoyne's Tm.*, 146.

OPPOSITION TO REGISTRATION, 71—78.
notice of, 76.
grounds of, 77.
forms, 635.

"OR OTHERWISE," in sect. 73...217.

ORDERS,
to rectify the register, 231—237.
in infringement action, 348—364, 648.
passing off, by executing orders meant for another, 388.
under the M. M. A. 1887, for forfeiture, 514.
notice of, to Comptroller, 602, 603.
precedents of, in trade-mark and analogous cases, 648.
Orders in Council applying, sect. 103...656.
and general orders of, under the M. M. A. 1887...678.
under the M. M. A. 1891...707.

ORIGIN OF GOODS, misrepresentation as to, 216.
See *Country of Origin*.

"ORIGINAL," 44.

"OSMAN TOWEL." See *Barlow* v. *Johnson*.

"OWL." See *Jackson Co.'s Tm.*

OYSTERS, ("native"), 409.

PACKING CASES,
use of mark on, 30, 159.
name of place on, not shown to purchaser, 697, 698.

"PAIN KILLER." See *Perry Davis* v. *Harbord*, 157.

PALATINE COURT, jurisdiction, 105.

PALL MALL guinea coal company, 427, n.

"PARAFFIN," 43, n.
"PARCHMENT BANK." See *Pirie* v. *Goodall.*
PART,
of trade-mark,
Court cannot direct registration of, 85.
infringement of, 313.
of class,
use of trade-mark for, 181.
registration limited to, 88, 181, 182, 235.
"PARTICULAR AND DISTINCTIVE MANNER," 116.
PARTICULARS,
on application to rectify, 243.
in infringement action, 373.
See *Essential Particulars.*
PARTNERSHIP,
"person" includes, 60.
mark of, registered in one partner's name, 236.
devolution of mark on dissolution, 274, 278, 329.
late partner may advertise his former connection, 386, 419.
trade-name on dissolution, 417.
comprising name of late partner, 274, 418.
fraudulent partnership imitating name of known firm, 330, 424.
offences under the M. M. A. by, 463.
PASSING OF,
action for, Chap. XVI., 379.
not affected by sect. 77...265.
compared with infringement, 297, 381.
PATENT,
name of goods made under, 42.
not to be struck out of old mark, 249, 342.
misleading claim of patent right, 339—342, 368.
"patent cups," an infringement, 313, n.
false trade description by claim of, 476, 484.
offence under the Act of 1883 by use of the word, 483, 484, 540.
"PATENT ISINGLASS," 485.
"PATENT KITCHENER." See *Flavel* v. *Harrison*, 340.
PATENT OFFICE, Trade-marks Branch, Chap. III., 52.
"PATENT SOLID HEADED PINS." See *Edelsten* v. *Vick*, 340.
"PATENT THREAD." See *Marshall* v. *Ross*, 341.
PATTERN,
mark, not a trade-mark, 37, 159.
name of, not trade-name, 404.
"PENJ DEH," a possible fancy word, 147.
PERIODICAL, name of, 410.
PERSON,
includes body corporate and partnership, 60, 463.
aggrieved, who is, 221—225.
"PESSENDEDE." See *Gout* v. *Aleploglu*, 129, n.
PHONETIC equivalent, 141.

PHOTOGRAPH,
of inventor, a common mark, 129.
publication of, restrained, 451.

PHRASES and proverbs as trade-marks, 137.

PICTURE,
of the goods, not a trade-mark, 131, 132.
warranty of artist, 433.

PILL CASE (*Clark* v. *Freeman*), 389.

PIRACY,
may make mark common, 286.
See *Infringement* and *Passing Off*.

"PIRIE'S PARCHMENT BANK," 115.

PLACE,
name of, as a trade-mark or trade-name, 44, 404.
series of marks containing different names, 90.
not fancy word, 147.
not invented word, 152.
may be an old mark, 157.
of origin, mark registered in, 456, 459.
trade description as to, 480.
no general obligation to indicate, 487, 530.
goods bearing name of English, 483, 535.
partly made abroad, 482.
made abroad, 482, 534.
made in Germany, 481, 534.
under British jurisdiction, 657.

PLAINTIFF,
foreigner may be, 300.
title of, 301, 303.

PLATE, marks on, 711.

PLEADINGS,
in infringement action, 372.
forms, 643. See *Precedents*.

"PLUMBAGO CRUCIBLES." See *Morgan* v. *McAdam*.

PORTRAIT of inventor, a common mark, 129.

POSSESSION, offence by, under M. M. A., 1887...510.

POST, notices and documents sent by, 57, 569.

"POST-OFFICE DIRECTORY." See *Kelly* v. *Byles*, 407.

PRECEDENTS,
application to register, opposition and appeal, 635.
application to rectify, 642.
pleadings in actions for infringement and passing off, 643.
orders in trade-mark and analogous cases, 648.
indictment and information under M. M. A., 1887...708.

PREDECESSOR, trade-mark comprising name of, 274.

PRICE,
list, use of mark in, 29, 126.
series of marks containing different prices, 90.

PRINCIPLES on which trade-marks and trade-names are protected,
James, L.J., 1, 393.
Abbot, C.J., 4.
Jessel, M.R., 13.
Lord Selborne, 15.
And see Chap. II., 24.

PRINTING,
labels, infringement by, 32.
injunction, 649.
imitation of, 411.
may be forgery of a trade-mark, 468.

PROCEDURE,
application to register, 68.
opposition, 75.
appeal, 79—84.
Sheffield mark, 98—102.
application for leave under sect. 71...177.
to rectify under sect. 90...237—241.
under sect. 92...250.
in infringement action, 372.

PRODUCER, trade-mark of, registered by importer, 61.

PRODUCTION of marked goods, 376.
search warrant, 520.

PROPERTY in trade-mark or trade-name, 2, 4, 384, 391, n., 393, n.

PROPRIETOR,
of trade-mark, 60, 469.
assent of, under M. M. A., 1887...470.
authority to use name, under M. M. A., 1887...496.

PROSECUTION,
under the M. M. A. 1887...514, 517, 677, 707.
limitation of, 517.

PUBLICATION,
trade-name of, 410.
of apology for infringement, 365, n., 443.
of statement, pending action, 443.
of foreign trade-mark, 458.

PUBLICI JURIS, when trade-marks become, 37, 285.

PUFFING ADVERTISEMENT, not a trade libel, 441.

PUNISHMENT of offences under the M. M. A. 1887...513.

PURCHASER,
ultimate, deceived, 3, 187, 318.
of infringing goods without notice, 358, 361, 365.
of goodwill, 391, 417.
name on packing case, not shown to, 697, 698.

QUALITY,
series of marks for different qualities, 90.
inferiority of, of infringing goods, 4, 34 n., 306, 385.
false trade descriptions as to, 475.
marks on cutlery, 543. See *Descriptive*.

QUESTIONS for the jury, 315.

"RADSTOCK COAL." See *Braham* v. *Beachim*, 408.
"READING BISCUITS." See *Huntley & Palmer* v. *Reading Biscuit Co.*, 424, n.
"READING SAUCE." See *Cocks* v. *Chandlers*, 44.
RECTIFICATION,
of the register, Chap. XI., 218.
under sect. 90, 220—245.
discretion of the Court, 226.
new entries not made, 231.
reasons for removal, 232.
after five years' registration, 229, 258, 259.
procedure, 237.
notice of motion, 239, 642.
not by counterclaim, 238.
in infringement action, 324.
under sect. 91...246.
under sect. 92...247—251.
"RED MEDAL POLISH." See *Wilkinson* v. *Griffith*, 204.
"RED STAR GLASS." See *Société de l'Etoile's Tm.*, 163.
"RED, WHITE AND BLUE." See *Hanson's Tm.*, 162.
REFUSAL to register,
reasons for, 63.
certificate of, 70, 264.
old marks, 263.
REGISTER,
of trade-marks, Chap. III., 52.
establishment of, 8.
object of, 8, 252, 262, n.
entries on, 53.
note on, limiting registration, 54, 163, n, 182, 184, 235.
inspection and searches, 55.
copies of, evidence, 59, 377.
books, when evidence, 378.
falsification of, 541. See *Rectification* and *Registration*.
REGISTERED,
"registered" not registered, 216, 346.
"registered at Stationers' Hall," 78, n., 127, 216, 327.
"registered shape," 346.
"registered trade-mark," when a misrepresentation, 345, 353.
may create an infringement, 313.
meaning of, in M. M. A., 1887...467.
when the use of the word, is an offence, 540.
See *Unregistered Trade-marks*.
REGISTRATION ACTS, 547—594.
REGISTRATION OF ASSIGNMENT, 278.
not necessary before action, 280, 304.
REGISTRATION OF TRADE-MARKS,
application to register, Chap. IV., 58.
Sheffield mark, Chap. VI., 91.
cotton marks, Chap. VII., 103.
what may be registered, Chap. VIII., 106.
restrictions on, Chap. X., 175, 631.

REGISTRATION OF TRADE-MARKS—*continued.*
effect of, Chap. XII., 252.
introduction of, and summary of Acts, 5—12.
object of, 8, 252, 262, n.
trade-mark, rights acquired by, 51, 253.
discretion to refuse, 63—67.
how effected, 70.
for part of class, 89, 181, 235.
series of marks, 90.
duplicate, or identical marks, 176.
resembling registered marks, 182.
numerous marks of the same kind, 197.
deceptive marks, 209.
rectification, 218.
in the wrong name, 236.
limited by actual use, 31, 256, 309.
condition precedent to infringement action, 260, 264.
not to acquisition of trade-mark, 265.
evidence of title, 255—258, 304, 324.
expunging, where right determined, 291.
proof of, 303, 376, 377.
of defendant's mark, 327.
false assertion of registration, 345, 476, 540.
allegation of, in pleadings, 373.
forms, on opposed application and appeal, 635.
See *Unregistered Trade-Marks*, and *Note on Register.*

REGULATIONS,
under M. M. A. 1887...536, 678 *et seq.*
M. M. A. 1891 (prosecutions), 707.

REMOVAL of mark from the register,
under sect. 90, reasons for, 232.
when abandoned or determined, 288, 291.
for non-payment of fees, 291.

REPORT,
of committees on trade-marks and merchandize marks, 7, 10, 19, 20.
M. M. A. Report, 1862, 1887 and 1890...461, n.
See *Committee.*
of action, may be a trade libel, 442.
contempt of Court, 443.

REPRESENTATION,
of goods, not a trade-mark, 131.
that defendant's business is plaintiff's, 386, 419.
that defendant is plaintiff's successor, 387, 419.
in good faith, passing off by, 386.
of Royal warrant, false, 542.
of trade-mark on application to register, 596, 609, 629,
See *Misrepresentation.*

REPUTATION,
of connection of trade-mark or trade-name with the proprietor, 33, 49, 390.
evidence, 34, 390.
of type of goods, no monopoly in, 41.

RESEMBLANCE CALCULATED TO DECEIVE,
Chap. X., 175.
sect. 72 (2)...182—208.
bearing of colour on, 163.
not sufficient for infringement, may prevent registration, 183.
marks in different markets, 184.
persons to be considered, 186.
rules of comparison, 188—204, 318—320.
evidence in regard to, 205.
examples, 207, 208.
the test of infringement, 314.
importance of differences, 320—323.
cumulative evidence of, 408, 413.
in passing off cases, 414.
RESIDENT ABROAD,
applicant or opponent, address for service, 68, 82.
notice to respondent, 82, 240.
service out of the jurisdiction, 240, 299.
RESTORATION,
of mark removed from the register, 292.
form of application, 617.
RESTRICTIONS ON REGISTRATION, Chap. X., 175, 631.
RETAILER,
trade-mark of, 50.
deceptive mark may not deceive, 187.
differences removable by, 322.
infringement leading to frauds by, 363.
RETURNED GOODS, British, not detained under M. M. A. 1887...702.
"REVERSI." See *Waterman* v. *Ayres*, 144.
"RICHTER CONCERTS." See *Franke* v. *Chappell*, 395.
RIGHT,
nature of trade-mark right, 1, 24—51.
conferred by registration, 51, 253.
limitation of, 163, n., 182, 184, 235.
acquired by use of mark, 24—51, 228, 265.
limited by actual use, 256, 309.
concurrent right to use of mark, 325.
name, 417.
to honest use of one's own name, 420—427.
ROYAL ARMS,
not to be registered, 64.
unauthorized assumption of, 542.
ROYAL WARRANT, false representation as to, 542.
"RUGBY CEMENT." See *Rugby Co.* v. *Rugby & Newbold Co.*, 311, 407.
RULES,
of 1890...595.
repeal of earlier rules, 606.
repealed cotton rules, 103.

SALE,
of goods with trade-mark attached, 33.
account of sales, 363, 652.
discovery as to sales, 374.
of name, 401, 425.
offence by, under M. M. A. 1887...510.

"SAME DESCRIPTION OF GOODS," 180.
SAMPLES, returned, 702.
"SANITANT." See *Sanitas Co.* v. *Condy*, 208.
SARDINES, imported, marks on, 700.
"SATININE." See *Meyerstein's Tm.*, 152.
SCIENTER,
when an element in passing off action, 386.
infringer without notice, 361, 364—366.
SCOTCH,
party on appeal from Comptroller, 82.
respondent under sect. 90...241.
SEAL OF PATENT OFFICE, 57.
SEARCH,
in the register, 55, 628.
warrant, 375, n., 520.
SECONDARY DISTINCTIVE MEANING,
makes descriptive word a trade-mark, 36.
will not support a new mark, 127.
does not make word a "fancy word," 147.
will support an old mark, 155—158.
of trade-name, 404.
SECRET,
trade, Chap. XIX., 448.
recipe, goods made according to, 448.
preparation, name of, 449.
SECURITY FOR COSTS,
of opposition, abolished, 76.
of motion to rectify, by foreigner, 241.
of prosecution by Board of Trade, 707.
SECURITY ON DETENTION of goods by Customs officers, 686, 687.
SEEDS, adulteration of, 475, n.
SEIZURE of imported goods. See *Detention*.
SELECTOR, trade-mark of, 50.
"SELF-WASHER." See *Lever* v. *Goodwin*, 412.
SERIES OF MARKS, 90.
SERVANT,
infringement by, 306.
breach of confidence by, 452.
offence under the M. M. A. 1887, by, 465, 500.
SERVICE, address for, 68, 82.
SERVICE OUT OF THE JURISDICTION,
application to rectify, 240.
infringement action, 299.
SET-OFF OF, costs, order for, 653.
SHEFFIELD,
marks, Chap. VI., 91.
register, 96.
marks, counterfeiting, 545.

SHOP,
name over, 388.
name of, 401.
SHOW CARDS, imitation of, 426.
SIGNATURE MARKS, 117.
not altered under sect. 92...118.
assignment and devolution of, 274.
SILVER (plate), marks on, 711.
SIMILARITY. See *Resemblance calculated to Deceive.*
"SINGER" CASES, 38.
SINGLE act of infringement, 306.
SIZE,
of marks, 194.
false trade description of measure, 480, 490.
of documents, for use on application, &c., 596.
SLANDER OF TITLE to trade-mark, Chap. XVIII., 438.
SMALL LETTERS, explanations in, 323.
SOLE,
importer is not proprietor of marks, 61, 302.
licensee, cannot sue, 282.
purchaser from proprietor cannot sue, 302.
proprietor, plaintiff need not be, 303, 360.
concurrent right, 325, 417—427.
"SOMATOSE," 152.
"SPECIAL AND DISTINCTIVE," 154.
SPECIAL CASE to determine rival claims, 177, 614.
SPECIAL DAMAGE, when necessary, 4, 359, 415.
"SPORTSMAN'S" cherry brandy, 190.
"STANCH." See *Jelley's Application*, 208.
"STANDING BY," when a defence, 331—334.
"STAR GLASS." See *Société de l'Etoile's Tm.*, 163.
"STAR TOBACCO MARK." See *Dexter's Application* and *Wills' Tm.*, 203.
STATIONERS' HALL, registered at, 78, n., 127, 216, 327.
"STATION HOTEL," 401, n.
STATUTES,
Table of, xlvii.
Registration Acts, text of, 547—595.
M. M. A. 1887 and 1891, text of, 666.
STATUTORY DECLARATION. See *Declaration.*
STAY,
of execution of order to rectify, 245.
of proceedings for infringement, 366.
"STONE ALES." See *Montgomery* v. *Thompson*, 227.
STORES, public, marks on, 713.

"STRATHMORE." See *Blair* v. *Stock*, 202, n.

SUBMISSION,
offer of, after infringement, 364.
stay of proceedings on, 366.
of rival claims, to the Court, 177, 602.

SUBSEQUENT PROPRIETOR, registration of, 601, 611.

SUCCESSION,
trade-marks pass to successors of original firm, 25, 272.
pretence of, to plaintiff's business, 387, 418.
registration of subsequent proprietor, 601, 611.

SUMMONS OR MOTION,
appeal from Comptroller, 81.
rectification, 239.

"SUNLIGHT SOAP." See *Lever* v. *Goodwin*, 412.

SURROUNDINGS OF MARKS, to be regarded, 197.

SWEDISH IRON, 699.

"SWIFT'S SPECIFIC." See *Swift Specific Co.'s Tm.*

"SYKES' PATENT." See *Sykes* v. *Sykes*, 3.

"SYRUP OF FIGS," 458.

"TAENDSTIKKER." See *Christiansen's Tm.*, 191.

TEA, adulteration of, 475, n.

TELEGRAPHIC CYPHER ADDRESS,
imitation of, 402, n.
unconscientious use of, 452.

TEST CASE, costs, 86.

TEXTILE GOODS, Manchester office, 104.

"THE" prefixed, does not make "fancy word," 150.

"THORLEY'S CATTLE FOOD," 424.

THREATS,
in mark may be deceptive, 215.
of infringement, necessary for injunction, 349.
action, none in respect of trade-mark, 438.

THREE-MARK RULE, 172, 177.
does not apply to new mark, 179.

TICKET, 139.

TIME,
enlargement, by Comptroller, 71.
summary of times on opposed application, 75.
for appeal to Court of Appeal, 245.
expiring on public holiday, 569.

TITLE,
proof of, before Registration Acts, 6.
acquired by use of mark, Chap. II., 24—51, 228, 265.
conferred by registration, 54, 228, 253.
concurrent right to mark or name, 325, 417.
of book or publication, 410. See *Registration.*

TOBACCO, marks on, 713. See *Habana* and *Mixture.*

TOBACCO,
mark for cigars, 89.
fraudulent use of "Habana," 347.
"TOD." See *Rotherham's Tm.*
"TOWER TEA." See *Great Tower Tea Co.* v. *Smith*, 136.
TRADE DESCRIPTION,
what it means in M. M. A., 1887...476—487.
verbal, 476.
trade-mark may be, 479.
customary, "conventional," "generic," 481, 498.
as to patent, 483.
custom as to what is, 485.
what is a false trade description, 487.
errors allowed in, 490.
applying a false trade description, 491.
alteration of, 491.
TRADE LIBEL, Chap. XVIII., 438.
mere puff is not, 441.
survives to executors, 447.
TRADE-MARK,
general sketch of the law, Chap. I., 1.
definition, Chap. II., 24.
assignment and devolution, Chap. XIII., 272.
determination, Chap. XIV., 283.
warranty, Chap. XVII., 431.
foreign and colonial, registration, Chap. XX., 454.
early cases, 2.
unregistered trade-marks,
very numerous, 12, 261, n.
practically protected, 12, 266.
are an objection to mark applied for, 124.
in the M. M. A., 1887...467, 479.
restricted to particular goods, 31.
implication and function of, 49.
joint, 51, 301.
requirements for good, 118.
part common to the trade, 129.
"used as a trade-mark," 158—162.
one trader may have several, 159.
comprising reference to particular goods, 89, 216, 632.
representation of goods, not, 131.
belonging to several proprietors, 303.
And see *Concurrent Right.*
description of, in pleadings, 372.
"common law," 383.
See *Unregistered Trade-marks* above.
expunged, use of, 407.
in the M. M. A., 1887...465.
unregistered, 467, 479.
description of, in indictment, &c., 468.
trade-description may be, 479.
customs register of names and marks, 534.
See *Registration.*
referring to part of mark, deceptive, 214, 342.
when struck out of old mark, 249.
And see *Table of Contents*, p. vii.

TRADE-NAME, 393.
passing off, Chap. XVI., 379.
trade libel, Chap. XVIII., 438.
trade secret, Chap. XIX., 448.
and trade-mark distinguished, 13, 384.
of business, 16, 392.
assignment, 391.
property in, 384, 391, n., 393, n.
owned by several persons, 394.
name of repute, 394.
of company, 395, 651.
of goods, 402.
on dissolution of partnership, and bankruptcy, 417—419.
on sale of goodwill, 417—419.
use on the proprietor's goods, 413, 448.
concurrent right to use, 417—427.
injunctions against imitations of, 648 *et seq.*
to be protected, under convention, without registration, 659.
See *Name*.

TRADE SECRET,
Chap. XIX., 448.
order in *Morison* v. *Moat*, 648.

TRANSIT, goods in, within M. M. A., 1887, s. 16...20, 535.

TRANSLATED,
words, 141.
foreign words in mark to be, 597.

TRAP laid to induce infringement, 306.

TRIAL. See *Court* and *Prosecution*.

TRIVIAL CASES of infringement, 306, 366.

TRUSTS,
not to be registered, 54.
but notes limiting the registration may be, 54, 163, n., 182, 184, 235.

"TWO D. CASE." See *Leahy* v. *Glover*, 306, 403.

"TWO ELEPHANT CASE." See *Johnston* v. *Orr-Ewing*, 122, 190.

ULTIMATE PURCHASERS, likely to be deceived, 3, 187, 318.

"UNCO GUID WHISKY." See *Loftus' Tm.*, 139.

UNDERTAKING,
entered on the register, 54.
limiting use of colour, 163.
to particular goods, 182.
to particular market, 184.
not to vary mark in use, 196.
as to damages, 354.
to keep account, 355.

UNREGISTERED TRADE-MARKS,
very numerous, 12, 261, n.
practically protected, 12, 266.
form an objection to mark applied for, 125.
"common law trade-mark," 383.
may be trade descriptions, 467, 479, 492.

USE,
as a trade-mark, 24, 28, 158—162.
on the goods, 29—32.
no definite period necessary, 34.
applicant for registration must use or intend to use, 110, 255.
of old mark, as a trade-mark, 158—162.
on bottles, cases, corks, &c., 30, 159.
temporary cessation of, 161.
fraudulent, 161, 336.
in United Kingdom, 161.
in different markets, 184.
resemblance in actual, 193, 319.
alteration of registered mark in, 195.
is lawful, 331.
undertaking not to alter in, 196.
right to exclusive, 209.
registration, equivalent to, 254.
limits the right conferred, 256.
abandonment of, Chap. XIV., 283.
what constitutes infringement, 307.
family use, 307.
plaintiff must use, 308, 415.
deceptive, not presumed, 349.
private, imported marked articles, for, 701.
used goods, marked, imported, 701.

"VALVOLEUM." See *Horsburg's T'm.*, 139.

"VALVOLINE." See *Leonard & Ellis' T'm.*, 139.

VARIATION,
of mark in actual use, 195, 331.
undertaking against, 196.
under sect. 90...235.
of name of proprietor, 236.
in non-essential particulars, 247.

VEGETABLES, imported, address on, 699.

"VENDIBLE CHARACTER," mark must give, 30, 120.

VENDOR OF BUSINESS may solicit old customers, 418, 420.

VERBAL TRADE DESCRIPTION, 476.

"W. R. CORSETS." See *Rosenthal* v. *Reynolds*.

"WARNER'S SAFE CURE," 421.

WARNING,
plaintiff not bound to give, 331.
bonâ fide, not actionable, 439.

WARRANTY OF TRADE-MARK, Chap. XVII., 431.
of artist's name, 433.

"WASHERINE." See *Burland* v. *Broxburn Oil Co.*, 124.

WATCH CASES,
marks on, 522.
Customs regulations as to, 694.
order in council as to assay marks on, 695.

WATCHES, importation of, 526, 694.

"WAVERLEY HOTEL," 402.

WEIGHT,
plea, that plaintiff gave false, 346.
trade description as to, 476, 480.

WEIGHTS AND MEASURES, marks indicating, 714.

WHARFINGER holding infringing goods, 358, 365.

"WHITSTABLE OYSTERS." See *Free Fishers* v. *Elliot*, 409.

WINES AND SPIRITS, same description of goods, 180.

WITNESSES,
scientific, higher scale of costs, 369.
expert, 205, 378.

WOOL, imported, marks on, 703.

"WORCESTER SAUCE." See *Birmingham Vinegar Co.* v. *Liverpool Co.*, 394.

WORD-MARKS, 9, 140—153.
examples of old, 158.
contrasted, 208.

WORDS,
when a device, 129.
as trade-marks, 140.
taken from opponent's or plaintiff's mark, 199—204, 314.
cases of contrasted, 208.
forming part of goods, 478.
English, on imported goods, 532.

"WORTH'S CORSETS." See *Bradley's Tm.*, 113.

WRAPPER,
use of trade-mark on, 29, 310.
included in covering in M. M. A., 1887...473.
imitation of, (get up), 411, 412.
order in *Lever* v. *Goodwin*, 652.

YARN, 714.

"YORKSHIRE RELISH." See *Powell's Tm.*, 222.

"ZEPHYR PIPE." See *Friedlander's Tm.*, 151.

LONDON: PRINTED BY C. F. ROWORTH, GREAT NEW STREET, FETTER LANE, E.C.