

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 which are not trade-marks, ought to be regarded—in judging whether a mark tendered for registration is distinctive—is unsettled.

Other trade-marks, registered or unregistered.

Where any marks already in use are trade-marks, whether registered or unregistered, it is clear that they are obstacles to the registration of any mark which so closely resembles them as to be calculated to deceive, unless the applicant has an independent trade-mark right in the mark he puts forward (*r*). This is expressly enacted by sect. 72, in regard to registered trade-marks (*s*); 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 (*t*). 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, or that the goods sold under it are the goods of another person, cannot be distinctive in accordance with the explanations of the term given in the judgments cited above (*u*). In the very extraordinary circumstances of the case of *Mouson v. Boehm* (*x*), 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

name *Oval Blue*. Kekewich, J., held that the name had not fallen into common use, although the oval shape had been used by three other persons, but he also held that the plaintiff failed owing to his neglect to enforce his rights against the other users—a result tantamount to holding the shape to be common. On an appeal the case was settled: 14 R. P. C.

944.

(*r*) Cf. Chap. XV., pp. 384 *et seq.*, Infringement.

(*s*) Chap. X., p. 211.

(*t*) Page 253.

(*u*) See below, Deceptive Marks, pp. 253 *et seq.*

(*x*) 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J. The facts are stated below, p. 385.

on the Register, on the ground that the later mark had been registered in good faith and in ignorance of the earlier unregistered mark, and had remained unchallenged on the Register for two years, during which time it had been extensively used in its proprietor's business; but the case was treated as exceptional, and the earlier trade-mark was admitted upon the Register also.

But an abandoned unregistered trade-mark is, as such, no obstacle to the registration of a similar mark (*y*), that is, unless it has become a common mark in the trade.

Abandoned
trade-mark.

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 (*z*), 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 in question had

Marks used in
advertisements.

(*y*) See the last case and *Paine & C. A., (John Bull beer)*.
Co. v. Daniells & Sons' Breweries, (z) *The Sphincter Co.'s Tr.,* 10 R.
 (1893) 2 Ch. 567; 10 R. P. C. 217, P. C. 81 (1893).

been employed as an advertisement by the 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 (a). 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 (b).

Secondary distinctive meaning.

It has never been decided 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 (c), 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* (d) the mark *Stone Ale* was removed from the Register on the ground that there was no evidence of its separate user as a trade-mark before the date mentioned, although its secondary meaning was not only fully established, but was the basis of the injunction granted against the defendant in the case.

Descriptive Marks.

Descriptive marks.

According to the construction placed upon the Acts, a descriptive mark cannot be distinctive. So that any mark which describes the goods, their quality, or the purpose to which they are to be applied, is not registrable, and this rule has been applied far more strictly than that which rejected

(a) Page 224.

(b) Cf. below, pp. 238, 239.

(c) Chap. II., p. 36.

(d) *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. 187,

mere descriptive words as trade-marks before the Acts (*e*). The subject is discussed under the head of Word-Marks, below (*f*).

Device.

Devices have been registrable under all the Acts. They are the oldest, and, in many ways, they form the most valuable kind of trade-marks. Before the description of shops and factories by street and number became the common and convenient method of identification, every trader had his characteristic "sign," and it was an obvious and natural step to transfer the sign from the shop to goods which it was desired to show had come out of it. And this was done in very early days. Fragments of classic pottery bear the potter's mark of their maker, and, to come to later times, the early editions of the Aldine Classics bear the device of a dolphin wound round an anchor (*g*). 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.

Devices as trade-marks.

It was decided under the Act of 1875, which did not, except in the case of old marks, provide for the registration of words, that a collection of English letters (*h*), or a single

Word or letter is not a device.

(*e*) Chap. II., p. 36.

(*f*) Pages 156 *et seq.*

(*g*) Salaman on Trade-Marks, p. 1.

(*h*) *Exp. Stephens*, 3 C. D. 659; 46 L. J. Ch. 46 (1876), Jessel, M. R., (*Acilyton*).

letter (*i*), could not, but that a word printed in Oriental characters might, be registered as a device (*k*).

Colour.

The device must be distinctive, irrespective of the colours in which it is printed (*l*), although a trade-mark may be registered in any colour or colours, and such registration confers on the owner the exclusive right to use it in that or any other colour or colours (*m*).

Portrait of inventor.

The portrait of a person, for instance the portrait of the manufacturer of the goods in question, may be a distinctive device, and as such capable of registration (*n*). But a particular portrait may be common to the trade, for instance if it is that of the inventor of a process of manufacture which is open to the public, and if goods made according to the process are known and described by reference to the inventor. Thus in *Anderson's Case* (*o*) 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 (*p*), and that the portrait of the inventor of the goods was descriptive of the goods. In this case, Chitty, J., found (*q*) that it was a common practice for those engaged in trade to place a photograph of the inventor on the particular article in order to show that he

(*i*) *Mitchell's Tm.*, 7 C. D. 36; 46 L. J. Ch. 876 (1877), Hall, V.-C., application to register A., as an old mark for pens, refused.

(*k*) *Rotherham's Tm.*, 11 C. D. 250; 14 C. L. 585; 49 L. J. Ch. 511 (1878), Bacon, V.-C., and C. A., (*Tod* in Arabic). Cf. *Gout v. Aleploglu*, 6 Beav. 69 n. (1833), (*Pessendele* (*i.e.*) warranted in Turkish).

(*l*) *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., (*red, white, and blue* label).

(*m*) Sect. 67, below, p. 194, and *Société Anonyme's Tm.*, (1894) 1 Ch. 61, and 2 Ch. 26; 10 R. P. C. 436, and 11 R. P. C. 142, Stirling, J., and C. A., where a trade-mark having been registered for a star, it was held that the mark *Red Star*

Brand, subsequently registered for the same goods, ought to be removed as being too near the other.

(*n*) *Rowland v. Mitchell*, (1897) 1 Ch. 71; 13 R. P. C. 457; 14 R. P. C. 37, Romer, J., and C. A.

(*o*) 26 C. D. 409; 53 L. J. Ch. 664, Chitty, J., and on appeal, 54 L. J. Ch. 1084 (1885); see *Liebig, &c. Co. v. Anderson*, 55 L. T. 206, Chitty, J.

(*p*) So held in *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T. n. s. 298 (1867).

(*q*) Basing his finding on the judgment of the Court of Appeal, and particularly of Cotton, L. J., in an action of *Liebig's Extract of Meat Co., Id. v. Anderson*, 55 L. T. 206.

was the inventor, or to show in the particular case that the article was made according to his invention. But it would appear that having regard to *Rowland v. Mitchell* (r), if such a practice is relied on to show that a portrait is not distinctive, it must be proved to exist in the particular trade. Registration of a portrait as a trade-mark would only confer on the proprietor the right to stop the use of another portrait as being an infringement, if there was not a substantial difference between the two portraits (s).

The question whether something included in the registration is matter added to the essential particulars or to the mark, or is, on the other hand, part of the mark, is a very important one having regard to the existing provisions as to disclaimer. The subject will be found discussed at a later stage (t), but it may be noticed here that there is no express provision in the Acts for disclaimer, except disclaimers of certain added matter and of certain additions. In *Baker v. Rawson* (u), where a lighthouse, surrounded by two concentric circles, with initials and a date between them, had been registered in 1877 as a new mark, although the circles were in fact common to the trade, an application was made to remove the mark from the Register. North, J., held that the circles ought not to have been registered, but as the whole mark had been used for a number of years, instead of ordering its removal, he directed a note, stating that the circles were common to the trade, to be put upon the Register. It will be noticed that the mark had been registered under the Act of 1875, which contained no provision for disclaimer at all, but under which registration with disclaimer had been approved (v). Common matter can now be registered as an addition to a registered mark, under sect. 74, with a disclaimer of the exclusive right to use it, if the whole mark was used as a trade-mark before 13th August, 1875. In the case of marks not so used, additions expressly authorized are

Part of mark common to the trade.

(r) See judgment of Lindley, L. J., (1897) 1 Ch. 74; 14 R. P. C. 44.

(s) See note (n), *ante*, p. 142.

(t) Chap. IX., p. 197.

(u) 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. 204.

(v) By Jessel, M. R., in *Kuhn's Tm.*, 53 L. J. Ch. 238 n. (1878).

confined to words and combinations of words (*x*). The question what are additions within this section has recently been considered by Kekowich, J., and the Court of Appeal in *Clement et Cie.'s Trade-Mark* (*y*).

Furthermore, under sect. 64 as amended by the Act of 1888, to one or more essential particulars, any letters, words, or figures, or combination of letters, words, or figures, or of any of them, may be added subject to disclaimer (*z*).

Combination
device.

A combination of devices which are common to the trade may form a new and distinctive device (*a*). 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 (*b*). 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 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."

(*x*) Chap. IX., p. 206, Additions and Disclaimers.

(*y*) (1900) 1 Ch. 114; 16 R. P. C. 173 and 611; see below, p. 201.

(*z*) See *Clement et Cie.'s Tm.*, *supra*, and Chap. IX., p. 198.

(*a*) The mark must be looked on as a whole: see Chap. X., p. 230, and below, p. 152, "Label," and, for an instance, where a number of common and some distinctive ele-

ments combined together did not form, as wholes, distinctive combinations: see *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479; and Lord Cairns' judgment, p. 484 (quoted above, p. 122); 48 L. J. Ch. 707, 708 (1879); and see the order made, 4 App. Ca. p. 503.

(*b*) Report of 1888, p. ix. The passage follows that upon the "idea of a trade-mark," cited at p. 227.

It has been held, in the case of word-marks, that descriptiveness is inconsistent with distinctiveness, and it would seem to follow generally, that marks which are descriptive of the goods to which they are to be applied are not within the Acts. In the opinion of Lord Herschell's Committee (*c*), 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* (*d*), 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 (*e*). Lindley, L. J., said: "I cannot see why, according to English law, a fish may not be a distinctive mark for a fishing-line, though I can understand that a picture of a fish may not be a distinctive mark of that particular kind of fish. Why a pig should not be, according to English law, a distinctive mark for lard, or something made out of a pig, I do not know. Supposing you tanned a pigskin into leather, I do not know why a pig should not be a good trade-mark for tanned pig's hide." Lopes, L. J., took the same view of the facts; but in the course of his judgment he asked: "Why is it (the mark) the less a distinctive device or mark because it represents the thing upon which it appears?" The sugges-

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

(*d*) 31 C. D. 340; 55 L. J. Ch. 915 (1885). It also accords with a number of American decisions: see Sebastian, 4th ed., p. 36. The Court of Appeal, however, thought that

little assistance was to be obtained from the American cases; 33 C. D. 392; 3 R. P. C. 340.

(*e*) 33 C. D. 392; 3 R. P. C. 340. The appeal was heard *ex parte*, the respondents not appearing.

tion 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 (*f*).

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 (*g*).

Device representing name of goods.

In a case in which the word *Magnolia* had been registered as a trade-mark, and also a representation of a magnolia flower as another trade-mark, and the word at the time of its registration was the name of the alloy in respect of which it was registered, and that registration was therefore bad, it was held that nevertheless the registration of the flower was good (*h*).

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.

(*f*) See *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893), Kekewich, J.; and cf. *Ripley v. Bandy*, 14 R. P. C. 591 and 944 (1897), Kekewich, J., and C. A., where Kekewich, J., held the plaintiff to have established that *Oval Blue* meant his laundry blue, which was of an oval shape. In the Court of Appeal the case was settled.

(*g*) The question was discussed,

but not decided, in *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893). The Comptroller refuses to accept for registration as trade-marks, pictorial representations of goods to which the marks are to be applied; see Appendix, p. 731.

(*h*) *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265, 621, Kekewich, J., and C. A.

The Comptroller refuses to register certain devices of a national character as trade-marks or prominent parts of new trade-marks (*i*).

Mark.

This word is sufficiently wide in its meaning, if it stood alone, to cover not only all the other symbols specified in 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 registrable 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 (*k*); 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 (*l*), because the words were geographical words.

Lord Herschell's Committee said, in their report (*m*): **Brand.**
 "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

(*i*) See Instructions 30, printed below in the Appendix, p. 728.

(*k*) 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.

(*l*) *Ibid.*, Q. 3294.

(*m*) Report of 1888, p. xi.

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 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* (n). 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* (m) 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 (o) could only be registered when they came within those parts of the section (64) which expressly relate to words, and consequently that they could not be registered as *brands* (p).

(n) (1892) 1 Ch. 35; 9 R. P. C. 17.

(m) The mark had been registered under the Act of 1883.

(o) That is, marks consisting of a word or words, not headings, labels, or tickets, which comprise words.

(p) Cf. Lord Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. p. 295; and the judgments in *Holt's Tm.*, 13 R. P. C. 16 and 118; (1896) 1 Ch. 711, C. A., as to words that are also names.

In *Paine's Case* (q), the words *John Bull Brand*, registered in 1885 as a trade-mark for beer, were ordered to be removed. An attempt was made to support the mark as a brand, but Kekewich, J., pointed out that the mark claimed was the three words, not the first two, and that the addition of the last word did not make the whole a brand. Some question was raised in the cases 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 (r), and its use to denote a class of some kinds of goods, as cigars, for instance, is very common; but these uses seem to have nothing to do with its meaning in the Act.

Heading.

The meaning of this term is not at all clear. The word is ordinarily used of a sentence or words placed at the top of a document either as a title or to describe the matter contained in it; and it has been held that the words *Family Salve*, printed thus, *Reinhardt's Celebrated Family Salve*, at the top of a wrapper used for patent medicine bottles, formed a distinctive heading (s). But it was held also, under the Act of 1875, which did not provide for the registration of words, that the single word *Valvoline* did not form a heading, on the ground that word-marks were specially provided for in the Act (t). If the first decision can be relied on, and if it

(q) W. N. (1892), p. 56; and 9 R. P. C. 130, Kekewich, J. The action in which the question arose is further reported: *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

(r) Sebastian, 4th ed. p. 33; *Milington v. Fox*, 3 My. & Cr. 338 (1838); *Seiro v. Provezende*, L. R. 1 Ch. 192 (1865).

(s) *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.

(t) *Leonard & Ellis's Tm.*, 26 C. D. p. 295 (1884), C. A.; see the judgment of Selborne, L. C.

indicates the whole significance of the word in the section, the operation of the section under this head is very limited, for documents attached to the goods or their envelope can themselves be registered as labels.

Line 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 (*u*); and in *The Great Tower Street Tea Co. v. Smith* (*v*), 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 registrable under the present Acts, since they are essentially colour-marks (*x*). A great deal of evidence as to the practicability of providing for their registration and protection was taken by Lord Herschell's Committee, and opposite opinions were expressed by the witnesses upon the subject. In the result, the Committee reported (*y*) 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 registrable alone, and not forming any sentence, will not become registrable by being printed on a plain piece of paper. Thus North, J., said (*z*): "The plaintiffs would not be in any better position at all if they had put the words *Tower Tea* upon a piece of paper, otherwise blank, and fixed it on to their packages, than if they had, as they have done,

(*u*) *Harter v. Sourazoglu* (1875), W. N. 11, 101; *Carver v. Bowker*, Seb. Dig. p. 350 (1877); *Robinson v. Finlay*, 9 C. D. 487 (1877).

(*v*) 6 R. P. C. p. 168 (1889).

(*x*) See above, p. 142.

(*y*) Report of 1888, p. ix., because the headings are essentially colour-marks.

(*z*) *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; 61 L. T. 495 (1889), Kay, J.

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 (a). Romer, L. J., in his judgment in *Re Clement et Cie.'s Trade-Mark* (b), in which the Court of Appeal decided that certain words formed part of a label and not additions to it, said: "I desire to say this, that this judgment will in no way, I think, give rise to any idea that it would sanction the registration of words which in themselves would not constitute a proper trade-mark, merely because some flourishes were put round them to try and make out a distinctive label—a compound label—when, in fact, what was really sought to be registered and intended to be registered were the words alone." Thus, the name of a firm printed in common letters on an ordinary label does not make a distinctive label (c).

Lord Herschell's Committee reported (d) 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."

Phrases and proverbs.

It is doubtful if such phrases are registrable under the present Acts. Possibly, since a mark in order to be registered has only to come within one of the essential particulars designated in sect. 64, which are to be treated as separate and distinct (e), such phrases, if distinctive, may be registered under sect. 64 (1) (e) as "words having no reference to the character or quality of the goods, and not being a geographical

(a) See above, p. 141.

(b) (1900) 1 Ch. 114; 16 R. P. C. 173, 611.

(c) *Price's Patent Candle Co.*, 27 C. D. p. 686 (1884), Pearson, J.; and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J., *Worth's Corsets*, between co-axial ovals. In *The Birmingham Vinegar Co.'s Tm.*, 11 R. P. C. 195; 70 L. T. 646 (1894), Keke-

wich, 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.

(d) Report of 1888, p. xii.

(e) See the judgment of Lord Herschell, in *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476; and *supra*, p. 123.

name (*ee*).” If not registrable as such, it would seem to follow from the judgment of Romer, L. J., quoted above, that a label would not be capable of registration by reason only of the presence of such a phrase, but the phrase might, of course, contribute to make a label distinctive.

Ordinary
arrangement
of common
parts.

An ordinary arrangement of parts which are in common use, each part remaining as a separate feature in the combination, does not form a distinctive label (*f*). So a label for match-boxes, bearing representations of a prize medal, with the words *Bryant & May's Royal Wax Vestas* printed in ordinary type, medals being common marks in the trade, was held not to be distinctive (*g*); and so also was a label bearing two co-axial ovals, with the words *Worth's Corsets* in ordinary type, and four dots arranged as a star at each end printed between them, ovals being common marks in the trade (*h*). 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* (*i*).

The Act permits the registration of a distinctive label, and it is, therefore, a sufficient qualification for a mark that it is such a label, but some difficulty arises when the question what is sufficient to render a label distinctive is considered. Ought the label to be looked at as a whole, or should it be analysed, in order to ascertain whether it contains one or more features which are in themselves distinctive? And, further, what must be the nature of such features? The decisions which have already been cited (*k*) are to the effect

(*ee*) *Uneda* has been held equivalent to “you need a,” and not so registrable: *National Biscuit Co.'s Application*, 18 R. P. C. 170 (1901), Cozens-Hardy, J.

(*f*) Cf. “combination of devices,” above, p. 144, and the passage from the report there cited; also *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898), Byrne, J., and C. A., a passing-off case, in which the Court of Appeal reversed the judgment of Byrne, J., for the plaintiff,

on the ground that the similarity of the get-up of the defendant's goods to that of the plaintiff's was solely due to features common to the trade.

(*g*) *Bryant & May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.

(*h*) *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.

(*i*) 27 C. D. 686; cited p. 151.

(*k*) *Orr-Ewing v. Registrar of Tms.*, 4 App. Ca. 479; *Price's Patent Candle Co.'s Case*, 27 C. D. 681; *Birmingham Vjnegar Brewery Co.'s Application*, 11

that the label must be examined, and that to qualify for registration some separately distinctive feature must be found in it. Some of the decisions (*kk*) seem to go further, however, and to lay down the rule that such a distinctive feature must itself be an "essential particular" (other than a label) within the meaning of the Act. It is submitted, however, that this is not the true view and is contrary to the general rule of construction of the Act laid down by the House of Lords in the *Solio Case* (*l*), and that it is sufficient if there be found some distinctive feature or features in the label, which operate to make it, as a whole, distinctive. The Court of Appeal has not been called on to give a direct decision on the point, but it has on several occasions determined that a label must be looked at as a whole (*m*), and the question seems to be open, so far as that Court is concerned, unless the judgment of Lord Cairns in the *Orr-Ewing Case* (*n*) is, in this respect, binding, and is held to decide the point (*o*).

No disclaimer of any part of a distinctive label is required by the Acts, for the whole label is an essential particular (*p*). Under sect. 64 (2), as amended by the Act of 1888, certain additions to the essential particulars in a mark may be registered, subject to a disclaimer of the exclusive use of the added matter; but, since a distinctive label is itself an essen-

No disclaimer of parts of label.

R. P. C. 195; *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386. See the quotations given above, p. 122.

(*kk*) See the cases in *note (k)*, other than *Price's Case*. Chitty, J., in *Bradley's Tm.*, *note (h)*, expressly distinguished the case of a combination distinctive as a whole.

(*l*) *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476; see *supra*, p. 123.

(*m*) *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C. 137; *Pinto v. Badman*, 8 R. P. C. 181; and *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173 and 611; of these, two were decisions on disclaimers and the

third—*Pinto v. Badman*—on novelty.

(*n*) The passage is cited *supra*, p. 122.

(*o*) The actual decision was that the Registrar should proceed with the application to register the distinctive device on the labels, with the name and address of the Appellant's firm. It being found that the marks contained devices which were *prima facie* distinctive. The case was under the Act of 1875.

(*p*) *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C. 137; *Smokeless Powder Co.'s Tm.*, (1892) 1 Ch. 109; 9 R. P. C. 109; *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173 611; and see *Pinto v. Badman*, 8 R. P. C. 181.

tial particular, that sub-section does not apply to anything forming part of the label (*q*).

Moreover, common words, that is, words which any one is at liberty to use, which appear in a label, need not be disclaimed under sect. 74, for that section applies only to additions to the trade-mark, and the whole label is itself the trade-mark (*t*). 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 (*u*), 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 (*x*). A dictum of Cotton, L. J., in an earlier case (*y*), 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* (*z*), 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

(*q*) It is submitted that this statement of the law is in accordance with and follows from the decision of the Court of Appeal in *Clement et Cie.'s Tm.*, *supra*, note (*p*). In that case the label was registered under the Act of 1883, but the amendment of sect. 64 by the Act of 1888 does not appear to affect the decision so far as it has a bearing on that section. But in *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 193; 70 L. T. 646 (1895), Kekewich, J., affirmed the Comptroller's decision requiring an applicant to state that, not his label, but a device contained in it, was the essential particular of the mark, and to disclaim the exclusive use of the other matter. And in *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J., held that there ought to have been in the application a statement of the essential particular

and a disclaimer of added matter. He did not decide what form the statement and disclaimer should have taken.

(*t*) *Pinto v. Badman*, 8 R. P. C. pp. 188, 191 (1891), and *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173, 611. As to the registration of common marks as added matter or additions, see above, p. 117, and Chap. IX., p. 205.

(*u*) (1891) 2 Ch. p. 233; 8 R. P. C. 137; see also *Atkins' Tm.*, 3 R. P. C. 164 (1886), Bacon, V.-C., C. A.; and *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

(*x*) (1892) 1 Ch. 590; 9 R. P. C. 109. See also *Faulder's Tm.*, 18 R. P. C. 37, (1901) Kekewich, J. (*Silverpan*).

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

(*z*) 8 R. P. C. 207 (1891).

stated above. None of the above-mentioned cases were, however, cited in *Edge's Case*, and it was not cited in the *Smokeless Powder Case*. *Burland v. Broxburn Oil Co.* (a), where, however, the point does not appear to have been argued, and *Thompson v. Miller* (b), are also in conflict with the rule. The point came before the Court of Appeal again in *Clement et Cie.'s Trade-Mark* (c), where the Court refused to order a disclaimer of the words *St. Raphael*, on the ground that the words formed part of and were not an addition to the mark (d). A distinctive label may accordingly be properly registered, although it contains words or names to the exclusive use of which no claim could be maintained (e).

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 *Valvolium* printed across a label with a particular device was allowed, although *Valvoline* was already registered upon a label with a different device (f), *Jessel, M. R.*, holding that each word was merely equivalent to *valve oil*.

Similar common words in another registered label is no objection to registration.

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 (g). 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 (g). But in

Blanks in registered labels.

(a) 6 R. P. C. 482; 41 Ch. D. 542 (1889), *Chitty, J. (Washerine)*.

(b) 13 R. P. C. 35 (1896), *Stirling, J. (Roadster)*.

(c) *Ubi supra*.

(d) Cf. also *Wright, Crossley & Co.'s Application*, note (k), above.

(e) *Hudson's Tm., Atkins' Tm., and Paine & Co. v. Daniells & Sons' Breweries, supra*.

(f) *Re Horsburgh & Co.'s Application*, 53 L. J. Ch. 237 (1878); see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Loftus' Tm.*,

(1894) 1 Ch. 193; 11 R. P. C. 29; *North, J. (unco' guid whisky)*.

(g) *Hammond v. Malcolm Brunner & Co.*, 9 R. P. C. 301 (1892); *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), both *Chitty, J.*; and see Chap. X., p. 236. A possible difficulty might arise if the whole mark, as filled up, were described upon the goods as a "registered trade-mark." See "misrepresentation" below. pp. 407 *et seq.*

considering whether a mark is a proper mark to register, regard must be had to the appearance it will present in actual use (*h*).

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 (*i*).

Word-Marks.

Words as
trade-marks.

Words are highly valued as trade-marks, since when well chosen they combine the necessary quality of distinctiveness with convenience for being remembered and referred to, which is only equalled by such simple devices as, from their resemblance to common objects or to familiar geometrical figures, at once suggest appropriate names; and, while in many of the classes all, or almost all, the suitable devices are either already appropriated or have ceased to be distinctive, the number of new words which may be invented is practically unlimited.

Word-marks were common enough before the Registration 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, the date on which the Act of 1875 came into operation, and also, under sections already considered, for the registration of the name of an individual or firm printed, &c., in some particular and distinctive manner, and of a written signature or copy of a written signature. Except such old marks, names, and signatures, no other word-marks could be registered under the Act of 1875 (*k*). This was altered by the Act of 1883,

(*h*) *Christiansen's Tm.*, 3 R. P. C. 54; 2 T. L. R. 31 (1886), C. A., the *Tændstikker Match Case*. And see Chap. X., p. 234.

(*i*) The words are used alternatively in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479; and *Great Tower Tea Co. v. Smith*, 6 R. P. C.

165.

(*k*) *Exp. Stephens*, 3 C. D. 659 (1876), Jessel, M. R., (*Acilyton*); *Rose v. Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C., (*Limetta*); see per Lindley, L. J., in *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887).

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. These clauses 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."

The portion of the report above referred to, which relates to this subject, was as follows (1):—"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

The report
of Lord
Herschell's
Committee on
word-marks.

Geographical
names.

(1) Report of 1888, p. xi. On a question of construction of the Act of 1888, it is permissible to refer to this report in order to ascertain the evils which the Act was directed to remedy, per Lord Halsbury, L. C., in *Eastman*

Photographic Materials Co.'s Application, (1898) A. C. 571; 15 R. P. C. 476. The passage given in the text was from the words "It is manifest," quoted by Lord Halsbury.

Translated words.

Phonetic equivalents.

lead to difficulty and litigation (*m*). We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale. We would add upon this point that we think that where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. The question has been raised whether a word having the same sound as one entered on the Register, though spelt differently and with a different meaning, should be registered. The question in such a case would seem to be whether the resemblance between the old mark and that applied for was such as to be calculated to deceive; if it were, it ought, of course, to be rejected."

A Fancy Word or Words not in common use (*n*).

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 (*o*), it is necessary to consider the cases. Before the date of the amending Act a definition of *fancy word* had been laid down by the Court of Appeal which seemed to be fairly clear and precise.

Fancy words.

In *Lloyd & Sons' Trade-Mark* (*p*), Chitty, J., in the year 1893, summed up the result of the decisions to that time in the following passage: "To be a fancy word, the word must be obviously meaningless as applied to the article in question. On that principle the Court has held that the term *Gem* (*q*), with reference to a gun, is not a registrable fancy word; with reference to hair restorer, that the word *Melrose* (*r*) is

(*m*) See Chap. II. p. 47.

(*n*) 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).

(*o*) *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J., (*Satinine*); *Paine's Tm.*, 9 R. P. C. 134 (1892), Kekewich, J., and *Re Tm.*

Bovril, (1896) 2 Ch. 600; 13 R. P. C. 382, Kekewich, J., and C. A.

(*p*) 10 R. P. C. 281 (1893), *Carnival* not a fancy word.

(*q*) *Re Arbenz's Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), Kay, J., and C. A.

(*r*) *Van Duzer's Tm.* and *Leaf's Tm.*, *infra*.

not a fancy word; with reference to velveteen, that the word *Electric* (s) is not a fancy word; and with reference to lace, the opinion of Lord Justice Cotton appears to have been that the term *Alpine* (t) was not a fancy word. These are some of the numerous illustrations that may be given of what may be thought by some to be the severe and strict construction which the Courts put upon the 64th section. There is another case, which I may also usefully mention, which is the case of *Jubilee* with reference to note paper." The last-mentioned word was also held not to be a fancy word (u). The severity of construction, of which Chitty, J., spoke, has, however, been somewhat relaxed by later decisions of the Court of Appeal, referred to below, which appear to have the effect of confining the rules laid down by the earlier decisions of the Court to words which were either ordinary English words, or very slight modifications of such words (v), fancifully applied, or, perhaps it would be more correct to say, to words other than newly coined words.

The leading cases are the consolidated appeals of *Van Duzer's Trade-Mark* and *Leaf & Son's Trade-Mark* (x), and the appeal in *Re Trade-Mark Bovril* (y), all in the Court of Appeal. The first case arose out of an application to register the words *Melrose Favorite Hair Restorer*, which had been adopted by the applicants in 1880, and which were identified by reputation with their goods, and with theirs alone. A label containing them had been already registered by the applicants. It was argued that, although *Melrose* happened to be the name of a place, it was registrable because of its secondary meaning, indicating the applicants' goods (z); 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* (a), holding that a

Van Duzer's Case.

(s) *Van Duzer's Tm.* and *Leaf's Tm.*, *infra*. L. JJ.

(t) 34 C. D. p. 639.

(u) *Toungood Bros. v. Pirie & Sons*, 4 R. P. C. 67; 56 L. T. 394 (1887), Chitty, J.

(v) As *Reversi*, see below.

(x) 34 C. D. 623; 4 R. P. C. 31 (1887), Cotton, Lindley and Lopes,

(y) (1896) 2 Ch. 600; 13 R. P. C. 382, Lindley, Lopes and Rigby, L. JJ.

(z) This was sufficient to make the words a trade-mark under the law before the Acts. See Chap. II., pp. 36 *et seq.*

(a) 29 C. D. 877 (1885). The right

word was a *fancy word* if it were fancifully used, was right. The Court of Appeal did not assent to any of these arguments.

The fancy word must be obviously meaningless.

To be a *fancy word*, Cotton, L. J., held, a word must be one "which obviously cannot have reference to any description or designation of where the article is made, or of what character it is." So that it is not enough that it should be shown by evidence that it, in fact, has no such reference, and the incorrect or inappropriate user of a word which is descriptive does not make it a fancy word. Lindley, L.J., said: "To be a fancy word I think the word must either have, to ordinary English people, to whom this Act of Parliament is addressed, no meaning, like the word *Eureka* or the word *Acilyton*, or if it has any meaning at all, it must be obviously non-descriptive (b) when used as a trade-mark"; and Lopes, L. J. (c), 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 & Son's Case* the Court, applying these criteria, held that *Electric* for velveteens was not a fancy word.

The definitions given in these judgments have been cited and were followed in many subsequent cases turning upon the meaning of the expression. Thus, in *Waterman v. Ayres* (d), the Court of Appeal held, that *Reversi* was not a fancy word for a game. Ordinary Englishmen, Cotton, L. J., said, would

of appeal in this case was lost by a slip as to time.

(b) 34 C. D., p. 642; "non-descriptive" was substituted for "meaningless" after a suggestion by Cotton, L. J., of "obviously not

intended to be descriptive," p. 645.

See also *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898), North, J.

(c) Page 644.

(d) 39 C. D. 29; 5 R. P. C. 368 (1888).

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 (*e*).

Whilst, however, there has not been, and could not have been except in the House of Lords, any dissent expressed from the definitions laid down in *Van Duzer's* and *Leaf & Son's Cases* (*f*), a limitation appears to have been drawn in the application of those definitions. In *Densham's Trade-Mark* (*g*), the Court was asked to expunge from the Register the word *Mazawattee* which had been registered in 1887 for tea, and subsequently for other articles, on the ground that the word was not a fancy word not in common use. It appeared that the word had been obtained by joining the Hindoo word *Masadhar*, meaning luscious, to the Cingalese word *Wattee*, meaning garden or growth, and dropping out the syllable "*dhar*." It was contended that the word was descriptive, but the Court of Appeal, affirming Romer, J., held that it was clearly not descriptive, and was a fancy word. Lopes, L. J., whilst adhering to the previous definition of a "fancy word," expressed the opinion that the cases had gone far enough.

In *The Bovril Case* (*h*), which also came before the Courts on a motion to expunge, the word *Bovril* had been on the Register for nine years in Class 42 for substances used as food. The word was new when registered, and had since been applied to meat extract and to other articles of food. Kekewich, J., refused the motion, and the applicants appealed.

The Bovril Case.

(*e*) See also *Edge's Tm.*, 8 R. P. C. 207 (1891), (*Filtered Blue*); and *Hodgson v. Sinclair*, 9 R. P. C. 22; 8 T. L. R. 45 (1891), *Britannia*, for soap.

(*f*) See the judgment of North, J., in *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898).

(*g*) (1895) 2 Ch. 176; 12 R. P. C. 75 and 271, Romer, J., and C. A. (Lindley, Lopes and Kay, L. JJ.).

(*h*) *Re Tm. Bovril*, (1896) 2 Ch. 600; 13 R. P. C. 382, Kekewich, J., and Lindley, Lopes and Rigby, L. JJ. The word is an obvious derivation from *Bos* and *Virilis*. Bovine and virility are ordinary English words. The word "vril" is found in Lord Lytton's novel "*The Coming Race*." It is curious that the Court which rejected *Somatose* (see below, p. 170), should have accepted *Bovril*.

The decisions of the Court of Appeal in *Van Duzer's* and *Leay's Cases* were cited, and it was contended that *Borvil* was not obviously non-descriptive. All the members of the Court (Lindley, Lopes and Rigby, L. JJ.) pointed out that in the cases relied on by the applicant, ordinary English words and not coined words were under consideration; they also all held that as a fact *Borvil* was not descriptive. Lindley, L. J., after saying that it would be wrong to substitute for the word "fancy word" "a non-descriptive word," but that they must ask themselves fairly whether *Borvil* was a non-descriptive word, said: "I think it is eminently and purely a question of fact. Now, I ask myself this: Supposing that a jury were asked whether, on the 2nd of November, 1886, *Borvil* was a fancy word not in common use, and supposing they said, upon a direction from the judge, which I think it would be the duty of the judge to give, that, if they were of opinion that it was really a descriptive word, it would not do, could they, with that direction, screw themselves up to say that it was not a fancy word not in common use? I do not think they could. That really settles the matter." Lopes, L. J., also said: "I say to myself, What would an intelligent jury say if they were asked if *Borvil* was a fancy word? If I had had to try the case I should have told them that they must keep in their minds that this word was placed upon the Register in 1886, and that they must regard it as it stood at that time. I should have told them that to be a good fancy word it must be non-descriptive and meaningless as applied to the article to which it was intended to be applied; and if I had so told them, I do not hesitate to say that I am confident that they would have come to the conclusion that the word was not descriptive, and that it was a good fancy word." It will be observed that, whilst the Court accepted the conditions previously laid down by it as applicable to an ordinary English word, it stated them somewhat less rigorously in the case of a newly coined word. However, in *Meaby & Co., Ltd. v. Triticine, Ltd. (i)*, North, J., held that the principle to be

(i) 15 R. P. C. 1 (1898).

applied in the case of the word *Triticumina*, registered in Class 42, in respect of leaven and wheatmeal biscuits, &c., and derived from *triticum* (*j*), was that laid down in *Van Duzer's Case*, and that the word was not "obviously not intended to be descriptive," and he accordingly ordered it to be expunged. It is difficult to reconcile this decision with that in *The Borvil Case*.

A list of words which have been held not to be "fancy words not in common use" is given on a later page (*k*).

The propositions laid down by the Court of Appeal in the cases cited do not amount to definitions from which tests to show affirmatively that any particular word is within the meaning of the Act can be drawn. They are negative propositions only. "To say that every word is a fancy word because it is unknown to an average Englishman, would be plainly to lay down a proposition which could not be for a moment maintained, (for) there are many good English words descriptive of articles which are unknown to an average Englishman, taking a rather high standard" (*l*).

The decisions are only restrictive.

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 (*m*). The word *Gum*, therefore, having come into use to indicate excellence in the article to which it is applied, is not a fancy word (*n*). 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 (*n*).

Descriptive words.

The Acts are directed to ordinary Englishmen (*o*), and the

Words in a foreign language.

(*j*) Wheat.

(*k*) Page 170, below.

(*l*) 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.

(*m*) "Descriptive" does not necessarily mean accurately so, but descriptive for practical and popular purposes, per Rigby, L. J., in *Reddaway v. Banham*, (1895) 1 Q. B. 297; 12 R. P. C. at p. 91.

(*n*) *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887). So held by the C. A., reversing Kay, J., whose judgment was delivered before that of the C. A. in *Van Duzer's Case*. *Reversi*, *Satinine*, *Carnival*, *John Bull*, *Roadster*, and *Beatrice* are other instances, below, p. 170.

(*o*) See the judgments of Lindley, L. J., in *Van Duzer's Case*, and Cotton, L. J., in *Waterman v. Ayres*, *supra*, and of Lindley, Lopes, and Rigby, L. JJ., in *Tm. Borvil*, *supra*,

question whether the words put forward are obviously meaningless and non-descriptive in regard to the goods for which the mark is to be used, is to be tried, therefore, in the light of such information as ordinary Englishmen may be supposed to possess. It has, nevertheless, been held that *Monobrut*, which is a compound of *brut*, meaning "dry" as opposed to "sweet" in the French wine trade, and which in itself means "very dry," is descriptive, and therefore not a fancy word (*p*). As already stated, *Triticumina*, for wheaten food, was held by North, J., to be "obviously descriptive" having regard to its derivation from *triticum*, wheat, and to its use in advertisements (*q*).

Name of the goods in foreign language.

The name of the goods is not a good trade-mark apart from any objection under the Acts (*r*), and it cannot, of course, be registered under them (*s*). 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 (*t*). "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

and of Kekewich, J., and Rigby, L. J., in *Magnolia Metal Co.'s Tm.*, (1897) 2 Ch. 371; 14 R. P. C. 265 and 621; *Lloyd & Sons' Tm.*, 10 R. P. C. 281 (1893), (*Carnival*); and *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39, *Oomoo*, cited below. Cf. the Report of Lord Herschell's Committee, cited *ante*, p. 157.

(*p*) *Vignier's Tm.*, 6 R. P. C. 490; 61 L. T. 495 (1889), Kay, J. Cf. *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), where Kay, J., rejected the Chippeway Indian word *Kokoko* because it meant *Owl*, which was a common mark; but Romer, J., doubted whether he should have come

to the conclusion that the word was descriptive, see *Densham's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. at p. 82; and *Davis & Co. v. Stribolt & Co.*, *infra*.

(*q*) *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898), North, J.

(*r*) See Chap. II., pp. 34 *et seq.*, and the judgment of Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. 395 (1890).

(*s*) Per Fry, J., in *Waterman v. Ayres*, *supra*, p. 160, note (*d*).

(*t*) *Davis & Co. v. Stribolt & Co.*, 6 R. P. C. 207; 59 L. T. 854 (1888), Chitty, J., (*Bökol* and the Swedish form of that word).

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 (*u*), such as *Sanitas* (*x*) or *Britannia* (*y*), 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 number of Englishmen in this country, to enable me to say it has a meaning" (*z*).

The name suggested by a mark which is common to the trade is not a fancy word, and this rule was held to apply where the word was the name in the unwritten language of an uncivilized tribe, the Chippeway Indians, to whom the trade in the goods in question was not shown to have extended (*a*). It is, however, difficult to reconcile this with the rule already referred to, that the Acts are directed to ordinary Englishmen, or to reconcile with it the case last stated, which was decided a few months later.

Names of common marks.

In *The Singer Cases*, and other cases of word-marks before the Acts, the contest was whether the name was that of the article merely, or whether it had acquired a secondary meaning identifying the article with the owners of the marks (*b*); but under the Acts such secondary meaning, so far as regards the right to registration (*c*), is

Secondary distinctive meaning does not constitute a fancy word.

(*u*) 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. 157.

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

(*y*) *Hodgson v. Sinclair*, 9 R. P. C. 22 (1891), Chitty, J.

(*z*) *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39 (1889); but cf. the case next cited.

(*a*) *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), Kay, J., *Kokoko*, meaning owl; but see *supra*, note (*p*).

(*b*) Chap. II., p. 38.

(*c*) It may have an important bearing upon passing off cases, see *Reddaway v. Banham*, (1896) A. C. 199; 13 R. P. C. 218, and Chap. XVI., p. 477.

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 (*d*) (or an invented word).

Geographical words.

In *Van Duzer's Case* both Cotton and Lindley, L. JJ., refused to hold that no geographical name could possibly be a fancy word. And Lindley, L. J., said (*e*): "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 might come is not registrable (*f*). 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 (*g*). The word *Britannia* (*h*) has also been held to be objectionable on the ground that it is a geographical word.

If a word which would not ordinarily be understood to be geographical is also the name of a place, it is not necessarily to be treated as the name of a place for trade-mark purposes. Apart from special circumstances, as, for instance, a connection between the goods and the place, the question is what meaning the word would bear ordinarily to ordinary people (*i*). Thus, under the Act of 1888, the word *Magnolia* was not held to be a "geographical name," merely because there were several places of that name in the United States, from which country the goods came (*i*). And in *Clement*

(*d*) *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. 140.

(*e*) 34 C. D. p. 643.

(*f*) See also *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J., *Brymbo*, for steel.

(*g*) (1891) 2 Ch. pp. 203, 221; 8 R. P. C. 137, C. A.

(*h*) *Hodgson v. Sinclair*, 9 R. P. C.

22 (1891), Chitty, J. Compare *Paine's Tm.*, 9 R. P. C. 130; 61 L. J. Ch. 365 (1892), Kekewich, J., in which *John Bull Brand* were held not to be "fancy words" because of their reference to England or the English. Kekewich, J., said that he was not sure that the words were not a geographical name.

(*i*) *Magnolia Metal Co.'s Tms.*, (1897), 2 Ch. 371; 14 R. P. C. 265

et Cie.'s Trade-Mark (k), Kekewich, J., held *St. Raphael* not to be geographical, as it was not shown that the words were adopted with the intention of referring to any place of that name. On the other hand, although the primary signification be not geographical, the real or imputed connection of the article with the locality may make the name a "geographical name" for the purpose of the Act of 1888 (*l*). It is submitted that the same considerations would be applicable in deciding whether such a word would be disqualified to be a "fancy word not in common use" by reason of being geographical.

It seems that the name of the factory from which the goods bearing the mark come is not a geographical word within the meaning intended (*m*).

"Geographical words," which can be regarded as descriptive of the place of manufacture or sale of the goods," Lord Herschell's Committee reported (*n*), "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 (*o*). 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 under the present Act (*p*).

and 621, Kekewich, J., and Lindley, Lopes, and Rigby, L. JJ., and see "geographical name," below, p. 182.

(*k*) (1900) 1 Ch. 114; 16 R. P. C. 173; Court of Appeal, 16 R. P. C. 611. There was no decision on this point.

(*l*) *Magnolia Metal Co.'s Tms.*, *supra*.

(*m*) *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.; and see *Hall v. Barrows*, 4 De G. J. & S. 150; 32

L. J. Ch. 548; 33 L. J. Ch. 204 (1863), Romilly, M. R., and Westbury, L. C.

(*n*) The whole passage is cited above, p. 157.

(*o*) See Chap. II., p. 48; and *Seiro v. Provezende*, and *Wo'herpoon v. Currie* and other cases there cited.

(*p*) Sect. 64 (1) (e); and *infra*, p. 182, as to what is a "geographical name" within the Act.

Name of a person.

The name of a person (*q*), even though the person be a mythical person (*r*), is not a fancy word, and the name of an individual registrable under (a) cannot be registered under (c) as a fancy word (*s*).

Combination of words.

A combination of words, each of which is common to the trade, is not a "fancy word" (*t*).

Not in common use.

In order to come within sect. 64 (c) of the Act of 1883 the word or words not only must be a fancy word or fancy words, but must not be in common use. The time to be considered is the date of application (*u*).

In *The Alpine Case* (*x*) 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

(*q*) *Banks & James' Tm.*, 12 R. P. C. 333 (1895), *Shakspeare*, Chitty, J.; and *Harris' Tm.*, 9 R. P. C. 492 (1892), Stirling, J., where *Beatrice*, for shoes, was held not to be non-descriptive; see, however, as to this case, *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 118. The early case in which *The Lawford* was allowed to be registered seems to be clearly in conflict with the later decisions; (1885) W. N. 124, Pearson, J.

(*r*) *Hodgson v. Sinclair*, 9 R. P. C. 22 (1891), *Britannia*, Chitty, J. The C. A., by consent, reversed the order to expunge this mark. And cf. *Paine's Tm.*, 9 R. P. C. 130, where Kekewich, J., held the words *John*

Bull not to be fancy words.

(*s*) *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 16 and 118, North, J., and Lindley, Kay, and Smith, L. J.; the decision was on the amended Act, but the principle appears applicable also to the unamended Act.

(*t*) *Pirie v. Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A.; *Pirie's Parchment Bank*; and see *Perry, Davis & Son v. Harbord*, 15 App. Ca. 316; 7 R. P. C. 336 (1890), (*Perry-Davis' Vegetable Pain Killer*).

(*u*) *Re Tm. Borril*, (1896) 2 Ch. 600; 13 R. P. C. 382.

(*x*) 29 C. D. 877 (1885).

directly with the use of the commodity to which the term has been applied" (*y*). But it is submitted that the condition suggested by the last phrase is not in accordance with the later decisions as to what are fancy words cited above (*z*), and that the construction adopted by Kekowich, J., in the recent case of *Paine's Trade-Mark* (*a*), gives the correct meaning of the Act. "I cannot think," the learned judge said, "it means simply the use applied to this trade only. It cannot mean, I think, that words are not in common use if they are not used in the trade. It must mean something wider and larger than that, and seeing that *John Bull* are two words, or a combination of words, which are in common use wherever the English language is known, I think that I must hold them to be in common use within the meaning of the Act." In a later case Chitty, J., held that *Shakspeare* was a word in common use, as being the name of many living persons (*b*).

Common use, whether in the trade or popularly.

The extent of user which amounts to "common use" has not been defined, but it was decided that the words *Tower Tea*, which were used by the plaintiff and the defendant in the case of the *Great Tower Street Tea Co. v. Smith*, and by three other persons in the tea trade, and of which the word *Tower* was used by several traders in other trades, were words in common use (*c*). 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 (*d*). The phrase may be compared with "common to the trade" in sect. 74 (*e*).

Words which are not entitled to registration as fancy words do not become so entitled by having the definite article "The" prefixed to word.

(*y*) *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.

(*z*) Pages 158 *et seq.*

(*a*) 9 R. P. C. p. 133; 61 L. J. Ch. 365 (1892), (*John Bull beer*).

(*b*) *Banks & James' Tm.*, 12 R. P. C. 333 (1895).

(*c*) *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J.

(*d*) *Burgoyne's Tm.*, 6 R. P. C. pp. 230, 232; 61 L. T. 39 (1889), Chitty, J., (*Oomoo*); and see *Ripley v. Bandy*, 14 R. P. C. 591 and 944 (1897).

(*e*) See Chap. IX., p. 204.

prefixed to them (*f*). This is clear from the definitions cited above. A different view was taken by the Comptroller (*g*) when first the Act of 1883 came into operation, and before the decision of *Van Duzer's Case*.

Examples
from decided
cases.

The following words have been held not to be fancy words not in common use (*h*): ALPINE embroidery, p. 168; 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 (*i*); BEN LEDI whiskey, *Ainslie & Co.'s Tm.*, 4 R. P. C. 212; BÖKOL beer, p. 164; BRITANNIA soap, p. 168; BRYMBO iron (Brymbo being a place in Wales), p. 166; CARNIVAL cigarettes, p. 158; COMPACTUM for umbrellas, *Davis' Tm.*, 14 R. P. C. 903; ELECTRIC velveteen, p. 160; 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. 163; 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. 169; JUBILEE note paper, p. 159; KOKOKO cotton goods, p. 165; MANOR tin-plates, *Thompson's Tm.*, 6 R. P. C. 213; MELROSE hair restorer, p. 159; MONORRUT champagne, p. 164; RED, WHITE AND BLUE coffee, *Hanson's Tm.*, 37 C. D. 112; 3 R. P. C. 130; REVERSI (for a card game), p. 160; ROADSTER (for boots), *Thompson's Tm.*, 13 R. P. C. 35; SANITAS (for a disinfectant), *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166; SELF-WASHER and THE SELF-WASHER soap, *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492; SHAKSPERE (for cigarettes, &c.), *Banks & James' Tm.*, 12 R. P. C. 333;

(*f*) *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A., (*The Self-Washer*).

(*g*) See the *Alpine Tm.*, 29 C. D. 877 (1885).

(*h*) The pages referred to are those

of this book.

(*i*) This was on the ground that a reference to the Princess would be imputed. See, however, *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 118 (*Trilby* for gloves, blouses, &c.).

TOWER tea, *Great Tower Tea Co. v. Smith*, 6 R. P. C. 165; TRITICUMINA (for wheaton biscuits, &c.), *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1; WASHIERINE soap, *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482; ZEPHYR ASIATIC WALNUT PIPE, *Friedlander's Tm.*, (1885) W. N. 85.

The only reported instances of words decided to be within the clause are the words ALPINE (for embroidery), p. 168, *Re Tm. Alpine*, 29 Ch. D. 877 (*k*); BOVRIL (for foods), p. 161, (1896) 2 Ch. 600; 13 R. P. C. 382; MAZAWATTEE (for tea), p. 161, *Densham & Son's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 75 and 271; OOMOO (for wine), *Burgoyne's Tm.*, 6 R. P. C. 227 (1889), Chitty, J.; and THE LAWFORD (for tennis racquets), (1885) W. N. 124 (Pearson, J.). The decision in *The Alpine Case* was subsequently disapproved by the Court of Appeal (*l*), and that in the last case is certainly not in accord with the interpretation subsequently put upon the clause under which the registration was allowed (*m*). Great numbers of words have, however, been registered by the Comptroller as fancy words without objection.

“(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 (*n*). The leading authority on the present clause is *The Solio Case* (*o*) in the House of Lords, in which several points were decided. Lord Halsbury, L. C., in his speech referred to the report of that Committee, and both he and Lord Herschell considered that the decisions on the expression “fancy word” had no bearing on the interpretation of the provisions substituted by the Act of 1888 (*p*). It will therefore be only necessary, in con-

Invented words.

The Solio Case.

(*k*) As to this decision see, however, *Van Duzer's Tm.*, and *Leaf's Tm.*, 34 Ch. D. 623; 4 R. P. C. 31.

(*l*) *Alpine Tm.*, 29 C. D. 877 (1885), Chitty, J.; see above, p. 168.

(*m*) See above, p. 168.

(*n*) Above, p. 157.

(*o*) *Eastman Photographic Materials Co., Ltd.'s Application*, (1893) A. C. 571; 15 R. P. C. 476.

(*p*) This view had been previously expressed by Lindley, L. J., in *The Somatose Case, Farbenfabriken Vormals Bayer & Co.'s Application*, (1891) 1 Ch. 645; 11 R. P. C. 84.

sidering clause (d), to refer to the decisions on the Act of 1888. The House of Lords further overruled the decisions in several earlier cases, including that of the Court of Appeal (q) in *The Somatose Case*, to the effect that clauses (d) and (e) must be read conjunctively, and not as alternatives. *The Solio Case* came before the Courts on an appeal from the Comptroller's refusal to register the word *Solio* for photographic paper, the refusal being on the grounds (*inter alia*) that the mark did not consist of an essential particular, and that it had reference to the quality or character of the goods. Kekewich, J., and the Court of Appeal upheld the refusal to register (r), on the ground that the word suggested the sun, and had reference to the character and quality of the goods, and that therefore (following the decision of the Court in *The Somatose Case*) it was not registrable as an invented word. The Lord Chancellor did not deal with the point explicitly, but all the other members of the House who took part in the decision (s) said that clauses (d) and (e) must be treated as independent clauses, and there is no reason to suppose that the Lord Chancellor differed from their judgments. Lord Herschell said that he could not find any justification for qualifying the provision " (d) an invented word or words " by the condition that they should have no reference to the character or quality of the goods, and he went on to point out that under (e) any word in the English language might serve as a trade-mark, and that different considerations therefore arose under clauses (d) and (e). " If, then, the use of every word in the language was to be permitted as a trade-mark, it was surely essential to prevent its use as a trade-mark where such use would deprive the rest of the

(d) not qualified by (e).

(q) *Farbenfabriken, &c. Co.'s Tm.*, *supra*, note (p), Lindley, Kay, and Smith, L. JJ., all concurring on this point; the other cases overruled are *Meyerstein's Application*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J.; and *Talbot's Tm.*, 11 R. P. C. 77; (1894) W. N. 12 (*Emolliolorum*), in which Stirling, J., followed the decision of Kay, J. In *Densham & Son's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 271,

Lindley, Lopes, and Kay, L. JJ., took the same view, although, having regard to the facts, the point did not call for decision.

(r) 13 R. P. C. 707; (1896) W. N. 158, Kekewich, J.; and 14 R. P. C. 487; (1897) W. N. 48, Lindley, Lopes, and Rigby, L. JJ.

(s) Lords Herschell, Macnaghten, Morris, and Shand,

community of the right which they possessed to employ that word for the purpose of describing the character or quality of goods. But with regard to words which are truly invented words—words newly coined—which have never heretofore been used, the case is, as it seems to me, altogether different; and the reasons which required the insertion of the condition are altogether wanting. If a man has rightly invented a word to serve as his trade-mark, what harm is done, what wrong is inflicted if others be prevented from employing it, and its use is limited in relation to any class or classes of goods to the inventor? So far, then, from seeing no reason for a distinction between the particulars designated in (d) and (e), there seems to me abundant reason for not interpolating in (d) words which the Legislature has used only in relation to (e).”

Since *The Solio Case* the law is therefore settled that an invented word is not debarred from registration as a trade-mark by reason of its referring to the character or quality of the goods. Lord Macnaghten said:—“If it is an invented word—if it is ‘new and freshly coined’ (to adapt an old and familiar quotation)—it seems that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods. I do not think that it is necessary that it should be wholly meaningless.” It was decided that the word *Solio* was an invented word, and accordingly capable of registration; and Lords Halsbury, Herschell and Macnaghten disapproved of the suggestion that the word referred to the character or quality of the goods; in fact, one of the main reasons given by Lord Halsbury for his judgment was that the word did not indicate the character or quality of the goods.

The determination of the standard of invention to be applied is both an important and difficult matter. It is clear from *The Solio Case* that the mere fact that the word exists in a foreign language, whether modern or classical, is not sufficient to exclude a word, if it really is invented. Thus, neither the fact of the existence of an Italian word *solio* meaning throne, or of a Latin word in the ablative case with the same meaning, prevented *Solio*, which had, in fact, been

Quantum of invention.

Foreign word not necessarily debarred.

invented for the purpose of a trade-mark, from being entitled to registration (*t*). On the other hand, the fact that the word is a foreign word does not make it an invented word in England (*u*). It was said in the same case that words which are in sound ordinary English words, but are misspelt, are not eligible (*x*). The following are passages from the judgments in *The Solio Case* on this point. Lord Halsbury said:—"I desire to give my opinion with reference to the particular word, and not to go behind it. I can quite understand suggesting other words—compound words, or foreign words—as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Supposo a person were to attempt to register as a single English word *Cheapandgood*, or even without taking so gross an example, using a word so slightly differing from an ordinary and recognized word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. The line must be sometimes difficult to draw; but, to my mind, the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in substance there has been an infringement of the rule." Lord Herschell, referring to the observation of Kay, J., in *The Satinine Case* (*y*), that there was extremely little invention, said:—"It may be that the word *Satinine*, which was there in question, was objectionable on other grounds, but if the word be an 'invented' one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade-mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses

(*t*) See also *Field, Ltd. v. Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1889), Buckley, J. (*Savonol*).

(*u*) See Lord Herschell's judgment quoted below, p. 175.

(*x*) See especially Lord Halsbury's judgment and that of Lord Herschell. The point had been so decided by Kekewich, J., and the Court of Ap-

peal in *Ripley's Application*, 15 R. P. C. 151, (1898) (*Pirle*). Cozens-Hardy, J., has recently decided that *Uneda* is not an invented word, being a mere mis-spelling of "You need a": *National Biscuit Co.'s Application*, 18 R. P. C. 170 (1901).

(*y*) *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890).

to use the existing vocabulary as he pleases. It may, no doubt, sometimes be difficult to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form (*yy*). Again, I do not think that a foreign word is an invented word simply because it has not been current in our language. At the same time, I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest no meaning except to a few scholars, might not be regarded as an invented word. It is in this respect that I desire to qualify my assent to Lord Justice A. L. Smith's proposition that an invented word can never have a meaning." A passage from Lord Macnaghten's judgment is quoted above (*z*). Lord Shand said:—"I agree in thinking, especially after the decision to be given in this case, that the Comptroller-General will be fully warranted in taking care that there shall not be admitted, under the guise or cover of words called 'invented' by the applicant, words really in ordinary use, which might, in a disguised form, have reference to the character or quality of the goods. There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an 'invented' word, and a word would not be 'invented' which, with some trifling addition or very trifling variation, still leaves the word one which is well known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word." In a recent case (*a*), much

(*yy*) See *Uneda Case*, note (*x*).

(*z*) Page 173.

(*a*) *Field, Ltd. v. Wügel Syndicate*,
Ld., 17 R. P. C. 286 (1900).

reliance was placed on the last-quoted passage by the applicants, who were applying to expunge the registration of the word *Saronol*, which had in 1890 been registered for common and soft soaps. They contended that the French word *saron* was used in the soap trade in this country, and that *Saronol*, being merely the word *saron* with a termination, was not an invented word. Buckley, J., held the word to be an invented word, even although *saron* had been used as alleged, and said that he did not understand Lord Shand as meaning to express anything differing from the other Lords.

Present
practice of
the Office.

Before the decision in *The Solio Case*, registration of a word as an invented word was difficult to obtain, but it has since become the practice at the Patent Office to accept for registration, as invented words, words which have very little invention indeed, but are merely ordinary English words having a slight variation in or a slight addition to them (*b*); in such cases, however, the Comptroller requires a disclaimer of the part formed by the common word, thus *Fireproofine* has been accepted with a disclaimer of "fireproof." There is no express provision in the Act for any such disclaimer, and whether or not the Comptroller has jurisdiction to require such disclaimers—a point which appears doubtful, and which applicants are not, of course, anxious to test—it may be hereafter held that, having regard to the judgments in *The Solio Case*, quoted above (*c*), and to the language of the Act, such a word as *Fireproofine*, for instance, is not an invented word, and that a disclaimer of the kind referred to does not help to qualify a word as an invented word, although it may protect the public from what would otherwise be the consequence of registration.

Whether
applicant
must be first
user.

A further question with respect to the meaning of the expression "invented word" arises when a word has been invented but not invented for the purpose of a trade-mark,

(*b*) See an article entitled "Words as Trade-Marks" in the Solicitors' Journal (1900), Vol. XLIV. 548, in which the following examples are given, namely, *Perfumette* for perfumes, *Enameline* for blacking, &c.,

Detergene for goods in Class 47, *Glazo* for creams and polishes for leather, and *Fireproofine* for a fireproofing liquid.

(*c*) Page 174.

or so used until after its use for other purposes. In *Holl's Trade-Mark (d)*, Kay, L. J., expressed an opinion that if the person who is seeking to register a word as an invented word has not been the inventor, or first user, he is not entitled to register it (*e*), and this is to some extent supported by a passage in Lord Herschell's judgment (*f*). A different view was, however, adopted by Cozens-Hardy, J., in the *Linotype Co.'s Application (g)*, where he also held that it was not necessary, in order that a word may be an "invented word," that there should have been no prior publication of it within the jurisdiction. If this be correct, it would seem to be a question of fact in each case whether such a word has ceased by being so published, to be an "invented word," and has come into such use as to lose that character (*h*).

A word already in existence cannot properly be said to be an "invented word," merely because the person claiming to have invented it was not aware of its existence (*i*).

The following words have been held to be invented words within the meaning of the Act:—KYNITE, *Kynoch & Co.'s Tm.*, 14 R. P. C. 905 (1897); MAZAWATTEE, p. 161, *Densham's Tm.*, (1895) 2 Ch. 176; 12 R. P. C., 75 and 271; SAVONOL, p. 176, *J. C. & J. Field, Ltd. v. Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1900); SOLIO, pp. 174, 175, *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476; TACHYTYPE, p. 177, *The Linotype Co.'s Application*, (1900) 2 Ch. 238; 17 R. P. C. 380.

The following words have been held not to be invented words within the meaning of the Act:—APOLLINARIS, *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C.

(*d*) (1896) 1 Ch. 711; 13 R. P. C. 118 (*Tribby*, the heroine of Du Maurier's book of that name).

(*e*) See also the judgment of Smith, L. J., but Lindley, L. J. (and perhaps Smith, L. J.), decided the point on the ground that the word had become a well-known word. See also the *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486 (1900), where *Formalin* was held to be the name of the article.

(*f*) "Words which are truly invented words—words newly coined—which have never therefore been used," see above, p. 173.

(*g*) (1900) 2 Ch. 238; 17 R. P. C. 380.

(*h*) And see the judgment of Lindley, L. J., in *Holl's Tm.*, *ubi supra*.

(*i*) Per Chitty, J., in *Sir Titus Salt & Co.'s Application*, (1894) 3 Ch. 166; 11 R. P. C. 517 (*Eboline*).

137 (*j*); EBOLINE (*jj*), *Sir Titus Salt & Co.'s Application*, (1894) 3 Ch. 166; 11 R. P. C. 517 (*k*); ELECTROZONE (*jj*), *British Electrozone Co.'s Application*, 13 R. P. C. 447 (1896) (*l*); EMOLLIORUM (*jj*), *Talbot's Tm.*, 11 R. P. C. 77; (1894) W. N. 12 (*m*); FORMALIN (*mm*); PIRIE (*jj*), *Ripley & Sons' Application*, 15 R. P. C. 151 (*n*); SATININE (*jj*), *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (*o*); SOMATOSE (*jj*), *Farbenfabriken, &c. Co.'s Application*, (1894) 1 Ch. 645; 11 R. P. C. 84 (*p*); TRILBY, *Holt's Tm.*, (1896) 1 Ch. 711; 13 R. P. C. 118 (*q*); UNEEDA, *National Biscuit Co.'s Application*, (1901) 1 Ch. 550; 18 R. P. C. 170 (*r*).

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.*”

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 such a reference 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 (*s*).

Test to be applied.

As stated above in reference to clause (d), the Act of 1888 was intended to make a fresh start in regard to word-marks, and therefore the decisions on the unamended section are not to be treated as authorities on the amended section. A large number of the decisions on clause (c) have been in relation

(*j*) *Friedrichshall* and *Hunyadi* were admittedly on the same footing as *Apollinaris*.

(*jj*) Decided before *The Solio Case*.

(*k*) *Eboli* was shown to be the name of an Italian town of 11,000 inhabitants, and the application was for silk goods.

(*l*) The word was admittedly well known in the United States.

(*m*) The word was, in fact, registered under the Act of 1883.

(*mm*) As to the particular ground, see note (*e*), *supra*.

(*n*) This case was decided on the ground of the word being a mere mis-spelling of “pearl” which could not

itself be registered. Kekewich, J., did not decide whether it was an invented word or not, and the decision of the Court of Appeal does not absolutely cover the point.

(*o*) See, however, Lord Herschell's judgment in *The Solio Case*.

(*p*) Lord Herschell, in *The Solio Case*, said that he thought it an excellent illustration of an invented word.

(*q*) That is to say, not at the date of registration.

(*r*) Held to be a mere mis-spelling of “You need a.”

(*s*) *Edge's Tm.*, 8 R. P. C. 207 (1891) (*Filtered Blue*), Stirling, J.

to words which now, under the decision in *The Solio Case (t)*, could be registered as invented words independently of the question whether or not they have a reference to the character or quality of the goods. Thus, in *The Solio Case (u)*, Lords Halsbury, Herschell, and Macnaghten, differing from the view adopted by the Court of Appeal (*x*) that *Solio* would suggest the sun, and had therefore some reference to the character or quality of the goods for which it was used, namely, photographic paper, held that it had no such reference; and, in substance, the House of Lords overruled the earlier decision in *The Somatose Case (y)*, of the Court of Appeal (*z*) that, having regard to the Greek word *σωμα*, meaning *body*, *Somatose* was not a word having no reference to the character or quality of the goods, which included preparations made from meat. On the other hand, the Court of Appeal held that *Mazawuttee*, which was compounded of the Cingalese word for *garden* and part of a Hindustani word meaning *delicious*, had no reference to the character or quality of the goods which included tea (*a*). The decision in *The Solio Case* that clauses (d) and (e) are to be read independently makes the decisions on words of the type of those just mentioned of less practical importance; since that case there has been no decision under clause (e) on any word of such a nature (*aa*). The object of the clause was to permit ordinary English words to be registered subject to the maintenance of the right of the public to employ them in their ordinary meanings; if there would be interference with such right, registration is not to be permitted (*b*). Although the clause makes it a condition of registration that the word should have no reference to the character or quality of the goods, this means that in the general understanding of ordinary

(t) See clause (d), p. 171.

(u) *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476.

(x) 14 R. P. C. 487, affirming *Kekewich, J.*, 13 R. P. C. 707.

(y) *Farbenfabriken Co.'s Application*, (1894) 1 Ch. 645; 11 R. P. C. 84.

(z) *Smith and Kay, L. JJ., Lind-*

ley, L. J., dissenting.

(a) *Densham's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 75 and 271.

(aa) See, however, *The Uneeda Case*, below, p. 181.

(b) See the judgment of Lord Herschell in *The Solio Case, Eastman Photographic Materials Co.'s Application*, quoted *supra*, p. 172.

English people it must bear no such reference (e). And the fact that an ingenious mind, knowing the class of goods to which the word is applied, can find some reference through etymology or otherwise to the character or quality of the goods is not fatal to registration (d). Thus, the suggestion that *Trilby*, the name of the heroine in Du Maurier's book of the same name, when used as a mark for gloves, blouses, &c., would be taken to have a reference to such articles as were fit for such a person as the book describes, was said by Lindley, L. J., to be too fanciful and far-fetched (e). Another example is the word *Kynite*, which has been held not to contain, by reason of the resemblance of the first syllable to the root of the word *kinetic*, a reference to the character of the goods in question, namely, explosives (f). If a word, not originally importing a reference such as the clause contemplates, comes to be known as the name of the article, it does not, by that fact, come to have a reference to the character or quality of the goods within the meaning of the section (g); thus, although *Magnolia* had come to be known as the name of an alloy, it was held not to refer to the character or quality of the goods. But, of course, a word which is descriptive of the goods is not entitled to registration (h). And the business of the proposed user of the word may be regarded as well as the goods; thus, Kekewich, J., held that *Typograph*, a dictionary word meaning a type-

(e) See the judgment of Rigby, L. J., in *Eastman Photographic Materials Co.'s Application*, 14 R. P. C. 407, and of Kekewich, J., in *The Linotype Co.'s Application*, 14 R. P. C. 900, (1897) (*Typograph*).

(d) See the judgment of Lord Herschell in *The Solio Case*, *supra*.

(e) *Holt & Co.'s Tm.*, (1896) 1 Ch. 711; and 13 R. P. C. 118. As to names generally, in 1889 the Office published an official notice to the effect that a mere surname or combination of surname and christian name, or christian name in use as a surname would not be accepted for registration as a new trade-mark unless rendered in some particular

and distinctive manner in accordance with sect. 64, sub-sect. 1 (u); see Appendix, p. 731.

(f) *Kynoch's Tm.*, 14 R. P. C. 905 (1897), Kekewich, J.

(g) *Magnolia Metal Co.'s Tms.*, (1897) 3 Ch. 371; 14 R. P. C. 621, Lindley, Lopes, and Rigby, L. JJ., differing from Kekewich, J., on this point.

(h) Thus, *Filtered Blue* for laundry blue is inadmissible, *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J. *Roadster*, for boots, held not to be a fancy word, in *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J., would probably be sufficiently descriptive not to come within clause (e).

making and type-setting machine, would, if registered by the Linotype Company for metals used in manufacture, have reference to the character or quality of the goods (*i*).

A word that would be understood to be commendatory will not satisfy the condition imposed by clause (e) (*j*), and a word that is a mere misspelling of a word that is not capable of registration is not admissible (*k*).

The following words have been held not to be within (e) on the ground that they could not be said to have no reference to the character or quality of the goods (*l*):—**APOLLINARIS**, for natural mineral waters, *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186, 8 R. P. C. 137 (*m*); **EDGE'S FILTERED BLUE**, for laundry blue, *Edge's Tm.*, 8 R. P. C. 207 (1891) (*n*); **EMOLLIORUM**, for harness, &c., *Talbot's Tm.*, 11 R. P. C. 82; **JOHN BULL**, for fermented liquors and spirits, *Paine's Tm.*, 9 R. P. C. 130 (*o*); **NECTAR**, for tea, coffee and cocoa, *Harrisons and Crosfield's Application*, 18 R. P. C. 34; **PIRLE**, for cloth, &c., *Ripley's Application*, 15 R. P. C. 151 (*p*); **SATININE**, for starch and soap, *Meyerstein's Application*, 7 R. P. C. 114; **SOMATOSE**, for a pharmaceutical product principally consisting of ingredients of meat, *Farbenfabriken Co.'s Application*, p. 179; **TYPOGRAPH**, for metals and certain machinery, *Linotype Co.'s Application*, 14 R. P. C. 900; **UNEEDA**, for biscuits and other goods in Class 42, *National Biscuit Co.'s Application*, (1901) 1 Ch. 550; 18 R. P. C. 170. All the above cases, except the **NECTAR** and **UNEEDA** cases, were decided before the decision of the *Solio Case* in the House of Lords.

(*i*) *Linotype Co.'s Application*, 14 R. P. C. 900 (1897).

(*j*) See the observations of Rigby, L. J., in *Ripley & Son's Application*, 15 R. P. C. 151 (*Pirle*); *Harrisons and Crosfield's Application*, 18 R. P. C. 34 (1901), Byrne, J. (*Nectar*); and *National Biscuit Co.'s Application*, (1901) 1 Ch. 550; 18 R. P. C. 170, Cozens-Hardy, J. (*Unceda*).

(*k*) See the *Pirle* and *Unceda* cases cited in the last note, and the judgments in *Eastman Photographic Materials Co.'s Application*, (1898) A. C. 571; 15 R. P. C. 476.

(*l*) The pages referred to are those

of this book.

(*m*) The mark was intended to be used for water from the *Apollinaris* spring. *Friedrichshall* and *Hunyadi Janos* were admittedly on the same footing.

(*n*) This mark was registered under the Act of 1883; the argument, as in *Talbot's Tm.*, *infra*, must therefore have been that as it was good under the Act of 1883, it ought not to be expunged.

(*o*) The mark was actually registered under the Act of 1883, but see note (*n*).

(*p*) As being equivalent to pearl.

The following words have been held to have no reference to the character or quality of the goods:—KYNITE, for explosives, *Kynoch's Tm.*, p. 180 (i); MAGNOLIA, for a metal alloy known by that name, *Magnolia Metal Co.'s Tms.*, p. 180; MAZAWATTEE, for tea, *Densham's Tm.*, p. 179; SOLIO, for photographic paper, *Eastman, &c. Co.'s Tm.*, p. 179 (k); TRILBY, for gloves, blouses, &c., *Holt's Tm.*, p. 180. In addition to these decisions, in *Pinto v. Badman*, 8 R. P. C. 181, it was objected that the words *El Destino* on a label for cigars indicated, by the fact that the words were Spanish or Mexican, the character or quality of the goods, but this objection failed both at the trial and in the Court of Appeal. Also, Chitty, J., in *Burgoyne's Tm.*, 6 R. P. C. 227, came to the conclusion that, if the Act of 1888 applied, which he held was not the case, the word *Oomoo* would have been capable of registration under it, and presumably, therefore, he considered that it had no reference to the character or quality of the goods.

Not being a geographical name.

It is a further condition that the word should not be a geographical name. The report of Lord Herschell's Committee was to the effect that the registration of such names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale (l), but the Act contains no such limitation of the prohibition. The words "geographical name" are not equivalent to the "name of any place," and a word does not become a geographical name simply because some place of the earth's surface has been called by it. In *The Magnolia Case* (m), it appeared that in the United States, whence the metal had been imported, there were several places known by the name "Magnolia," but it did not appear that the goods had any connection with any of those places. Rigby, L. J., said: "It is, no doubt, shown by the evidence, that there are places in the United States called by the name 'Magnolia,' and if 'geographical name'

(i) The pages referred to are those of this book.

(k) Per Lord Halsbury, L.C., and Lords Herschell and Macnaghten, although this was not the ground of the decision, which was that the word

was an invented word within (d).

(l) Quoted above, p. 157.

(m) *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and Lindley, Lopes and Rigby, L. JJ.

in sect. 64, sub-sect. (e), were equivalent to the name of any place, 'Magnolia,' as the name of places mentioned in the evidence, would fall within the exception. But in our judgment the phrase 'geographical name' in sect. 64, sub-sect. (e), ought not, in general, to receive so wide an interpretation. It must, we think, in the absence of special circumstances, be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word 'Monkey' is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. If, indeed, in its primary and obvious meaning, the word has reference to a locality, as the word *Melrose* in *Van Duzer's Case*, or the word *Eboli* in *Sir Titus Salt & Co.'s Case* (from which Mr. Justice Chitty declined to distinguish the derivative *Eboline*), it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word *Apollinaris*, given to the water from a spring known as the Apollinaris Spring. So, if 'Magnolia' had been the name of a place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the article manufactured in the place having the name" (n).

The prohibition in clause (e) of the registration of a geographical name is not confined to the noun substantive, but extends to the adjectival form (o). But the mere fact that

(n) See also *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173, 611 (1899), Kekewich, J. (*St. Raphael*). On appeal, it was not necessary, in the view the Court took, to decide

the point whether the words were geographical, 16 R. P. C. 611.

(o) *In re Sir Titus Salt's Application*, (1894) 3 Ch. 166; 11 R. P. C. 84, Chitty, J. (*Eboline*).

part of a word is a foreign word, and might therefore have some reference to the country where the word is known, does not make the word a geographical name (oo).

The decisions on the unamended Act of 1883 arising on the question whether a geographical word could be registered as a "fancy word not in common use," will be found referred to above (p).

The following words have been held to be geographical names within the meaning of (e): APOLLINARIS, *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C. 137; EBOLINE, *Sir Titus Salt & Co.'s Application*, (1894) 3 Ch. 166; 11 R. P. C. 517 (q). The following words have, on the other hand, been held not to be geographical names within the meaning of (e): MAGNOLIA, p. 182, *supra*; MAZAWATTEE, *Densham's Tm.*, p. 161, *supra* (oo). Also in *Pinto v. Badman*, 8 R. P. C. 181, the words EL DESTINO were objected to on a label on the ground of being geographical, but this objection was overruled.

Old Marks.

Old marks.

By sect. 64 (3) (ii.) (r) :

"Any special and distinctive word or words, letter, figure (s), or combination of letters or figures, or of letters and figures, used as a trade-mark before the 13th day of August, 1875 (t), 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 subsect. (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 com-

(oo) *Re Densham & Son's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 75 and 271 (*Mazawattee*).

(p) *Ante*, p. 166.

(q) See p. 183, note (e).

(r) Act of 1888, s. 10.

(s) *Figure* means numeral, per Jessel, M. R., in *Exp. Stephens*, 3 C. D. 659 (1876); *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386.

(t) Date of commencement of the Act of 1875.

ination of figures or letters, used as a trade-mark before the passing of this Act may be registered as such under this Act" (u).

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 (r). It has been said that it was the intention of the Act to allow to be registered anything which was protected as a trade-mark under the old law, and could not be registered under the other clauses of the section (y).

But it has been recently decided that the proviso does not extend to all old marks, and that an old mark, consisting of, or even containing, a device, does not come within the proviso, and is not entitled to registration unless it consists of or contains one of the essential particulars enumerated, and that it is, in that case, subject to the requirements of the previous sub-sect. (2) which have already been discussed (z). And, similarly, it would seem that any old mark registered under the Act of 1875 or 1883, if not within the corresponding proviso, must conform to the general requirements of the Act under which it was registered. This decision is contrary to the previous practice of the Patent Office, which had treated all old marks as having a right to registration, and as free from the requirements of sub-sect. (2), and, as pointed out by Byrne, J., in his judgment, some of the results to which the language of the clause leads are anomalous.

The requirement that the mark shall be "special and distinctive" only embodies the old law (a). *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

(u) Act of 1875, s. 10.

(r) *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C., *A.*, for steel pens.

(y) *Barrows' Tm.*, 5 C. D. 353 (18.7), per Malins, V.-C.; *Bodega Co. v. Owens*, 6 R. P. C. 241, Chatterton, V.-C. (1888), in Ireland.

(z) *Wright, Crossley & Co's Application*, (1900) 2 Ch. 218; 17 R. P. C.

386, Byrne, J., who also held that sect. 74 did not apply in that case, if the mark could be registered under sect. 64 (3) (ii). It is settled that if the application is to register as an old mark, the words must have been used alone, see below, p. 191.

(a) *Re Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.; see as to this, *ante*, p. 132.

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" (a). *Distinctive* means that the mark is a distinctive thing which points out that the goods are the goods of A. B. (b). Thus, in *The Eton Cigarette Case*, Fry, L. J., said: "It appears to me, that to satisfy the requirement of (this) definition the word or words must be distinctive in this sense, that they distinguish the manufacture of the person who has registered the trade-mark from the manufacture of all other persons" (c).

The decisions on the word "distinctive," where it occurs in the earlier part of the section, have been already considered (d).

Deceptive
mark not
distinctive.

Where, therefore, a cigarette manufacturer had registered the word *Eton* as an old mark, but had sold the cigarettes in boxes bearing the words *St. Petersburg—P. Marrogordato & Co.*, as well as *Eton*, thereby suggesting to purchasers that the goods were not of his manufacture, but were made in Russia, although the mark was known in the trade as, in fact, indicating his manufacture, it was held that he was not entitled to have it registered, and it was accordingly ordered to be removed (c).

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 (e). 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

(a) See note (a), *ante*, p. 185.

(b) *Richards v. Butcher*, (1891) 2 Ch. p. 536; 8 R. P. C. 249, Kay, J.; and per Halsbury, L. C., in *Perry, Davis & Son v. Harbord*, 15 App. Cas. p. 320; 7 R. P. C. 336 (1890).

(c) *Wood v. Lambert*, 32 C. D. p. 262; 3 R. P. C. 81 (1886), followed

as to the effect of the plaintiff himself putting the name of a third person on the goods by Cozens-Hardy, J., in *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), a passing off case, affirmed on other grounds by C. A., 18 R. P. C. 27.

(d) Above, pp. 132 *et seq.*

(e) See Chap. II., pp. 36 *et seq.*

an old mark in 1877, they were ordered to be removed from the Register, on this as well as on other grounds (*f*).

Before the Acts words which were *prima 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 (*g*); and such words may still be so acquired as a "common law trade-mark" apart from registration (*h*). And it is submitted that wherever such words had 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.

Word with a secondary distinctive meaning.

This was directly decided by Kekewich, J., in a case (*i*), in which 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.* (*k*), 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 (*l*). *The Monopole Case*

(*f*) *Palmer's Tm.*, 24 C. D. 504 (1882), C. A.; and see *Cheseborough Manufacturing Co.'s Tms.*, 18 R. P. C. 191 (1901), Buckley, J., *Vaseline*, registered in 1877, removed from the Register on the ground that it was then descriptive of the goods; also the cases cited below.

(*g*) See Chap. II., p. 36.

(*h*) *Reddaway v. Banham*, (1896) A. C. 199; 13 R. P. C. 218 (*Camel Hair Belting*). See below, p. 477.

(*i*) (1892) 2 Ch. 116; 9 R. P. C. 102.

(*k*) Above, p. 50.

(*l*) Malins, V.-C., in *Barrow's*

was discussed (*n*) on the assumption that the word, though in itself descriptive, could be registered if it were shown to have been used before the Act of 1875 as a trade-mark; and in *The Stone Ales Case* (*o*) the only ground upon which the Court of Appeal proceeded in removing the mark *Stone Ale* was the want of proof of such user.

On the other hand, in *Perry, Davis & Son v. Harbord* (*p*), 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" (*q*). And on the further appeal, Halsbury, L. C., and Lord Morris held that the words in question in the case, *Pain Killer* for a medicine, were not special and distinctive; the Lord Chancellor, on the ground that they were descriptive of a quality attributed to the goods to which they were applied (*r*). This decision is not in conflict with the conclusion stated above, for there was no finding or evidence that the medicine of the plaintiffs was distinguished from the same medicine made by others by use of the words *Pain*

Tm., 5 C. D. 353 (1877), and Porter, M. R., in *Watt v. O'Hanlon*, 4 R. P. C. p. 15 (1887); and Chatterton, V.-C., in *Bodega Co. v. Owens*, 6 R. P. C. 241 (1888), both Irish cases. In *Leonard & Ellis' Tm.*, 26 C. D. p. 295 (1884), Lord Selborne said: "As to the word *Valroline*, 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. 189, note (*s*).

(*n*) Fry, L. J., expressly reserved this question, *Richards v. Butcher*, (1891) 2 Ch. p. 547; 8 R. P. C. 249, Kay, J., and C. A.

(*o*) Page 190, note (*y*).

(*p*) 5 R. P. C. 333, Kay, J., and C. A. (1888); and 15 App. Cas. 316; 7 R. P. C. 336, H. L.

(*q*) The question was also referred to by Kay, J., in *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889), (*Emollio Cream*). Cf. *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131 (1898), where Romer, J., held that *Wright, Crossley & Co.*, which had been registered as an old mark, was not on the face of it an illegal or improper mark. In the Court of Appeal this point was not decided; 15 R. P. C. 377.

(*r*) Cf. *The Nourishing Stout Case*, *Roggett v. Findlater*, L. R. 17 Eq. 29 (1873), Malins, V.-C.

Killer; on the contrary, it appeared that there was no competition in its manufacture. It would appear, 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 as a trade-mark and had acquired a secondary distinctive meaning before the 13th of August, 1875 (s).

The following words have been held not to be special and distinctive words: EMOLLIO cold cream, *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612; 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; VASELINE, *Cheseborough Manufacturing Co.'s Tms.*, 18 R. P. C. 191 (t). Examples of old word-marks.

And the following have been admitted to registration as such: FRIGIDOMO, for a hot-house plant wrap, *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323; 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.

What is use as a trade-mark has already been considered in Chapter II. The following paraphrase by Lord Esher (u) of the judgment of the Court of Appeal in *Palmer's Case* (x) 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 Used as a trade-mark.

(s) 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 Tabacos v. Rehder*, 5 R. P. C. 61 (1887), (*Carité*).

(t) In *Dewar & Sons, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), a Scotch case; Lord Kyllachy said that he was not satisfied that the words *Dewar's Whisky* were sufficiently "special and distinctive,"

but did not decide the point. And in *Dry v. Riley*, 17 R. P. C. 517, the question was discussed but not decided, whether the words "Day & Son's Black Drink" were special and distinctive. Cf. *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854) (*Taylor's Persian Thread* in a label).

(u) *Spencer's Tm.*, 3 R. P. C. p. 74; 51 L. T. 659 (1886).

(x) 24 C. D. 504 (1883), (*Braided Fixed Stars*).

only on them. If we find these words on goods in the market, which are said to be distinguishing marks on the goods, and on the same goods other marks, and never on any goods these words alone, then the conclusion of fact is that what was used upon the goods to distinguish them was all that was on the goods; and we are not going to inquire whether part of what was put on all the goods to distinguish them was at one end of the goods or at the other end of the goods, or whether they were an inch or half an inch apart, or even whether part was at the top and lapping over the side, or whether part was on one side and part on the other. If you find that they are on goods for the purpose of distinguishing the goods, that makes the user one user."

In accordance with these principles, it has been held that words used only as a description of the goods (*y*), 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 (*z*) 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 (*a*), or sauce (*b*), or medicine for animals (*c*), or upon the side of a wine cork where they cannot be seen (*d*), is not a use of them as a trade-mark, since it does not "sell the goods" (*e*), 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 (*f*). But in such cases the

(*y*) *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J., (*Coker Canvas*); *Tullot 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, 145 (*Yorkshire Relish*), Chitty, J., and C. A., aff. by H. L. (1894), A. C. 8; 11 R. P. C. 4.

(*z*) *Harrison's Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J.,

(*Albion*).

(*a*) *Richards v. Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A.

(*b*) *Powell's Tm.*, *supra*.

(*c*) *Day v. Riley*, 17 R. P. C. 517 (1900), Buckley, J.; and see *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600, below, p. 192.

(*d*) *Kinahan's Tm.*, 10 R. P. C. 393, above, p. 30.

(*e*) Chap. II., p. 30.

(*f*) *Powell's Tm.*, *supra*.

boxes go into market and are bought with their contents by the purchasers, to whose attention the marks are directed.

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*).

Where the applicant has another trade-mark.

And, as stated in the passage quoted above (*h*), the mark sought to be registered must have been used, in the form in which it is offered for registration (*i*), and as a separate mark complete in itself (*j*), as a trade-mark before the 13th of August, 1875 (*k*). 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-

Old mark must have been used as registered, and alone.

(*g*) *Powell's Tm.*, (1893) 2 Ch. pp 394, 406, 411; 10 R. P. C. 63 and 195; (1894) A. C. 8; 11 R. P. C. 4, Chitty, J., C. A. and H. L., (*Yorkshire Relish*); *Richards v. Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A., (*Monopole*); *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523; 35 L. J. Ch. 53 (1865).

(*h*) Page 190.

(*i*) *Mecus' 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. 297.

(*j*) *Spencer's Tm.*, 3 R. P. C. 73; 54 L. T. 659 (1886), Chitty, J., and C. A., and the cases next cited.

(*k*) Small user is, of course, sufficient, *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

(*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., and C. A., (*Valvoline*).

(*n*) *Richards v. Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 37, 249 (1891), Kay, J., and 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. and H. L., (*Perry-Davis' Vegetable Pain Killer*); and *John Dewar & Sons, Id. v. J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session, where *Dewar's Whisky* had been registered, but it was held that the name under which the whisky had been sold was *Dewar's Perth Whisky* or *John Dewar's Perth Whisky*.

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 in respect of them that it is an old mark; and if registration is applied for in other classes the application, so far as regards such other classes, must be treated on the footing that the mark was not used before the 13th of August, 1875 (*q*). But use on goods essentially the same as those in the class to which the application relates, although they pass under a different name owing to slight variations in size or shape, is sufficient to qualify a mark as an old mark. Thus a mark used on hatchets and augers has been admitted as an old mark for axes and gimlets (*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 re-shipment and transportation is not sufficient (*s*).

(*p*) Chap. V., p. 96.

(*q*) *Jelley, Son & Jones' Application*, 51 L. J. Ch. 639 n.; 46 L. T. 381 n. (1878), Jessel, M. R.; and see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A., cited pp. 155 and 188; *Harrison v. Woodroffe*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J., and *Batt's Tm.*, (1889) A. C. 428; 16 R. P. C. 411.

(*r*) *Jackson & Co. v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

(*s*) *Mecus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Monck's Application*, 50 L. T. 12 (1884), Chitty, J. In *Jackson & Co. v. Napper*, 35 C. D. p. 177; 4 R. P. C. 45, (1886) Stirling, J., said: "You must make out user in England"; but the learned judge probably used the name of the only part of the United Kingdom in which user had been suggested, without intending to exclude user in Scotland or Ireland. The question whether foreign

user was sufficient was raised as early as *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A. In *The European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), Stirling, J., a foreigner sold to an importer and sent the goods into this country in cases bearing the word *Bull's-eye* and his trade-name, and also used the word in pamphlets sent with the goods; the importer himself sold the goods apart from the cases, and to the public the word had become known only in connection with goods sold by the importer. It was held that there had been such use of the word in connection with the goods in this country as would have entitled the foreigner to oppose the registration of the word by the importer, and the registration which had been effected in the name of the latter was expunged. The case does not decide that there was user of the word as a trade-mark. As to user on cases, see p. 190.

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. Fraudulent 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). Temporary cessation of user.

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 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). Slight evidence of user sufficient.

Where, on a motion to expunge, the owner of the mark does not appear to defend it, the onus is still on the applicant to prove non-user, and he may be in some difficulty in making out such a case (a). But although the onus of proving non-user before 1875 is, at all events in the case of an old trade-mark which has been five years on the Register, on the person attacking the validity of the mark, the onus may be

(t) *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J., (*Hoop L Iron*); *Monck's Application*, note (s).

(u) *Mouson v. Boehm*, 26 C. D. 398 (1884), Chitty, J., cited p. 385; cf. also *Daniel & Arter v. Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134, Barnes, J., a passing off case.

(v) Chap. XIV., p. 338.

(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., and C. A.

The usual evidence is the production of old prints and dies or blocks for printing.

(z) *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(a) In *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J., where the applicants were successful, they showed that they had on first hearing of the mark some years before cautioned a person who represented the registered proprietor against using the mark, and heard no more of it for ten years afterwards.

shifted. Thus, in a Scotch case in which the owners of the mark led in the proof, but called no evidence to show such user, and the mark had not been registered till 1891, and the evidence showed that during the period which it covered, commencing at some date subsequent to 1875, and down to the date of the proceedings a different trade-mark had been used (*b*), it was held that the onus was shifted on to the owners, and that, as they had not discharged it, the presumption was that there had been no user prior to the 13th of August, 1875 (*c*).

Colour.

By sect. 67—

Trade-marks
may be
registered in
any colour.

“ A trade-mark may be registered in any colour [or colours] (*d*), 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] ” (*d*).

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 (*e*).

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 (*f*). An oblong label divided into three sections, which were respectively printed in red, white, and blue, was accordingly held not to be distinctive (*g*). Colour, said Kay, J., is treated as an accident, and if the

(*b*) *Dewar's Perth Whisky*, the registered trade-mark being *Dewar's Whisky*.

(*c*) *John Dewar & Sons, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session.

(*d*) Act of 1888, sect. 11.

(*e*) 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.

(*f*) See above, p. 142.

(*g*) *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J. But the same mark, registered without colours, *i.e.*, as a label with three parallel stripes and the words *red, white and blue*, had been protected from infringement by the use of a similar coloured label comprising the same words, *Hanson v. British Tea, &c. Association* (1884), Bacon, V.-C., and C. A.; Sebastian, 4th ed. p. 338.

mark were registered the applicant might use it in any colours he chose. "You may register a mark, which is otherwise distinctive, in colour, and that gives you the right to use it in any colour you like; but you cannot register a mark of which the only distinction is the use of a colour, because, practically, under the terms of the Act, that would give you a monopoly of all the colours of the rainbow."

The 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 (*h*).

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 (*i*); for instance, a design similar in outline to that of the device in another mark, but filled up in a totally different manner, may have the distinctive filling up obscured by the use of a deep colour in printing (*k*). Again, registration of a mark which contained Oriental words meaning *The Golden Fan Brand*, was refused on account of the presence on the Register of a fan mark, which in use was in gold colour (*l*), and the refusal was upheld by the Court of Appeal. The fact that a registered owner may use his mark in any colour must also be taken into consideration. Thus, the words *red star brand* were directed to be removed from the Register on the ground that they constituted a mark having such resemblance to a star device mark, which might be coloured red in actual use, as to be calculated to deceive (*m*).

Bearing of colour upon the resemblance of marks.

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

(*h*) Above, p. 150.

(*i*) *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. See also *Lever Bros., Ltd. v. Beddingfield*, 16 R. P. C. 453; affirmed as to infringement, 16 R. P. C. 3, (1898) Kekewich, J., and C. A.

(*k*) *Worthington's Tm.*, 14 C. D. 8

(1880), C. A.; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J., *Turney & Sons' Tm.*, *supra*.

(*l*) See *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288.

(*m*) *Société, &c. de l'Étoile's Tm.*, (1894) 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142; Stirling, J., and C. A.

being placed on the Register (*n*). It is, however, doubtful whether the Court would now order registration with such a note (*o*).

(*n*) *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, 4th ed. p. 338.

(*o*) Page 195, note (*l*).

CHAPTER IX.

ADDITIONS AND DISCLAIMERS.

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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. The trade-mark 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 (*c*), 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

(*a*) Chap. VIII., p. 117.

above, p. 100.

(*b*) Cf. sect. 66, series of marks,

(*c*) See, however, below, p. 199.

Acts have provided for such additions; the provision in the present Act (*cc*), 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 to the essential particulars.

“There may be added to any one or more of *these* [the essential] particulars [mentioned in this section] any letters, words, or figures (*f*), or combination of letters, words, or figures, or any of them” (*g*).

Lord Herschell's Committee on additions and disclaimers.

Remarking upon this provision, Lord Herschell's Committee reported as follows (*h*):—“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 (*i*), 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.”

In consequence of the recommendation above quoted, what

(*cc*) Sect. 64 (2), Act of 1888, s. 10.

(*d*) Sect. 10.

(*e*) Sect. 64 (2).

(*f*) “Figures” here means numerals, *Exp. Stephens*, 3 C. D. 659 (1876), Jessel, M. R.

(*g*) 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.

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

(*i*) That is, of course, under the Act of 1883, as unamended.

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—

[“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.”] (j).

Disclaimers to be made in the application to register.

Stirling, J., speaking of sub-sects. 64 (2) and (3) (i), said: “Now, the object of that seems to have been this: that persons who are owners of trade-marks, or desire to have them registered, are to be entitled to register them, not, so to speak, as bare trade-marks consisting of the essential particulars defined by sub-sect. (1); but are to be allowed to make statements with reference to any matters which might occur to them in reference to the goods themselves, obviously with reference to those who manufactured them; obviously also with reference to the place where they were manufactured, and it seems to me to have been the object, having regard to the proviso contained in sub-sect. (3), to enable the owner of the trade-mark to state on the face of the mark who was the owner, that is to say, the manufacturer of the goods to which the mark applied and the place at which they were manufactured, so as to identify the goods denoted by that mark with that particular manufacturer and that particular place of manufacture” (k).

It is noticeable that devices are not expressly included among the things that may be registered as added matter under sect. 64. But there appears to be no reason why they should be excluded by the Act. The only case in which the question whether a device can be registered as added matter has been discussed under sect. 64 is, it is believed, *Re König and Ebhardt's Tm.* (l), where Stirling, J., allowed the mark to be registered with a disclaimer (which the applicants

Devices.

(j) Statements and disclaimers under this section and sect. 74 have since 1891 been advertised with the marks. See Official Notice, Appendix, p. 732.

(k) *Colman's Application*, (1894) 2

Ch. 115; 11 R. P. C. 129.

(l) (1896) 2 Ch. 236; 13 R. P. C. 449. The applicants contended that the crown was a part of their distinctive device, not an addition to it.

The distinction between the treat-

offered) of a crown. If a device can be registered as added matter, it must be by reason of the discretion in the Comptroller, and not of express words under the Act.

Disclaimers in respect of additions which are *prima 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. In that section the additions which it authorizes are referred to as additions to the *mark*. Whether or not there is intended to be a distinction between additions to the *mark* and matter added to the *essential particulars* of it (which is the form of phrase in sect. 64), is discussed below (*l*).

The reason for requiring the essential particulars of a mark tendered for registration to be specified, 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 (*m*); 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. In *Colman's Application* (*n*), Stirling, J., expressed the view that, whilst it might be that when a person came to register a trade-mark, and had to make out that it contained an essential particular, the Act ought to be read in the strictest manner against him, and he ought not to be allowed to register unless he made out clearly that he had one of the

ment of old and new marks under sect. 74 is mentioned below, p. 205. See also *Baker v. Rawson*, 8 R. P. C. 89, in which, the mark having been registered under the Act of 1875, a disclaimer of a common device was

ordered to be entered on the Register.

(*l*) See below, p. 209.

(*m*) See *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n. (1878), Jessel, M. R.

(*n*) (1894) 2 Ch. 115; 11 R. P. C. 129.

essential particulars, as regards the added matter which was to be disclaimed there was no necessity for reading the Act so strictly.

It has been recently decided that this sub-section applies to such old marks as do not come within sect. 64 (3) (ii) (o).

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 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 falling within the proviso contained in sect. 64 (3) (ii).

The "essential particulars" of a registered trade-mark are not necessarily all its distinctive parts.

In *Clement et Cie.'s Tm.* (p) it was contended that the words *St. Raphael* on a registered label should be considered as an addition, and disclaimed under sect. 74, but the Court of Appeal, affirming Kekewich, J., held that, the registered thing being the whole label, the words were not an addition to the mark but part of it (q). In this case the mark as actually used was printed on two separate labels which were affixed to the goods in the same relative position as shown in the mark, one being above the other. The lower label contained the words *Saint-Raphael Tannin Wine*, with a description of the wine, and a signature *St. Raphael*;

Additions to labels.

(o) *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.; and see *supra*, p. 185.

(p) (1900) 1 Ch. 114; 16 R. P. C. 173 and 611, Kekewich, J., and

Lindley, M. R., Sir F. Jeune, and Romer, L. J.

(q) The Court held that there was a label as distinguished from words coupled with mere flourishes and so on. See also below, p. 208.

Romer, L. J. (*r*), expressed the opinion that this label was an addition to the mark within sect. 64 (2).

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 (*s*). The two earlier cases cited were both decided on sect. 74, and in respect of applications made before the Act of 1888 came into operation, and therefore after advertisement of the application; but the terms of sect. 74 and sect. 64 (2), as amended by the last-mentioned Act, correspond, and in *Wright, Crossley & Co.'s Application* (*s*), Byrne, J., put the same construction on the latter section.

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”] (*t*).

Trade-name.

This provision was also added by the Act of 1888. A trader has, as is shown elsewhere (*u*), a right to the exclusive use of his own name, limited by the rights of other traders so to honestly use their own names, or the names which they honestly adopt, as not to pass off their goods as his. This exists independently of the law of trade-marks, and the report of Lord Herschell's Committee 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

(*r*) The mark was registered under the Act of 1883, so no question of disclaimer under sect. 64 arose.

(*s*) *Goodall's Tm.*, 42 C. D. 566 (1889), North, J.; *Re Meus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.; *Players'*

Application, (1901) 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J. See, however, *König and Ebhardt's Tm.*, cited p. 199. As to the Comptroller's power of amendment, see Chap. IV., pp. 78 and 84.

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

(*u*) See Chap. XVI., p. 500.

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 on the rights of a registered proprietor arising out of the saving clause is more limited than that which a disclaimer, if registered, would create. Apart from the Act, as already stated, a trader can only be restrained from using a name which is 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 (*r*). 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” (*x*), and, of course, only for use in connection with the goods for which the mark is registered (*y*).

Effect of the registration of a trade-name as part of a trade-mark.

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 (*z*). And also that it is not necessary that the whole of the applicant’s name should appear in order that he should have the advantage of the proviso. If he is fairly using a part of his name he need not disclaim it (*a*). And this applies to a firm name, at all events in the case where the part of the name enters into the name of each partner (*a*); but it would not, of course, apply in a case in which the mark, by reason of the use of part of the name instead of the whole, was calculated to deceive (*a*). It would seem that the trade-name of an applicant is within the privilege of the proviso (*a*), but not

Descriptive trade-name.

Part of name.

(*v*) *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, and *Valentine Meat Juice Co. v. Valentine Extract Co.*, 17 R. P. C. 1 and 673 (1900). See also Chap. XVI., p. 500.

(*x*) Sect. 64 (3) (i).

(*y*) See Chap. XII., p. 306.

(*z*) *The Smokeless Powder Co.’s Tm.*, (1892) 1 Ch. 590; 9 R. P. C. 109, Chitty, J.

(*a*) *Colman’s Application*, (1894) 2 Ch. 115; 11 R. P. C. 129, Stirling, J. (*Colman’s Mustard*).

Name in possessive case. the name of his predecessor in title, as such, although he be entitled to the exclusive use of such name (aa). The applicant's name in the possessive case occurring in a label need not be disclaimed (b).

Additions which are common to the trade. 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.

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 (c), 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 (d) of the trade-mark, and must

(aa) *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195 (1894), Kekewich, J. Ch. 115; 11 R. P. C. 129, Stirling, J. (*Colman's Mustard*).
 (c) *I.e.*, numeral, p. 198, n. (f).
 (b) *Colman's Application*, (1894) 2 (d) See p. 199, above.

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.] (e)

“ (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.”

The three mark rule.

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 (f).

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 (g), although the fact of registration gave him no right to the exclusive use of them (h), 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.

The registration of common words in a trade-mark confers no monopoly.

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; the distinction is not, as in sect. 64 it has been held to be (i), between old marks falling within sect. 64 (3) (ii) and other marks. As to all old marks, the policy of the Act is to put them upon the

Common additions to old and to new marks.

(e) Act of 1888, s. 16, above, p. 202.

45 C. D. 529 (1891).

(f) As to the effect of the alteration, see below, p. 209.

(h) *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.

(g) The Register might have been rectified by placing a disclaimer upon it. See *Re Hayward's Tm.*, 64 L. J. Ch. 1003 (1885), Kay, J.; and *Baker v. Rawson*, 8 R. P. C. 89:

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

Register exactly as they were used (*j*); and accordingly, while the addition 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 any of them," in the case of new marks, it considerably increases the list in the case of all 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 (*k*) cannot be at the same time "common to the trade," distinctive must here mean *primâ facie* distinctive (*l*), 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 (*m*), or a word which is descriptive of the goods to which the mark is to be applied (*n*), 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

Words used by one trader only.

(*j*) *Phillip's 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. 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. In *Wright, Crossley & Co.'s Application*, note (*h*), *supra*, Byrne, J., took the view that, as to old marks, sect. 74 only applies to additions to the mark as used.

(*k*) See Chap. VIII., p. 135. The word refers back to sect. 64, see the next case.

(*l*) *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J., (*Roadster*); and *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J. (*Silverpan* held not to be distinctive). See also the judgment of Romer, L. J., in *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 611.

(*m*) *Burland v. Broxburn Oil Co.*, *supra*.

(*n*) *Humphries v. The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J., (*Herbalin*).

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—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 (o). 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.”

It was held also in *The Washvine Case* (p) that the phrase in question is not controlled by the three mark rule of sub-
The three
mark rule.
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 (q) 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” (r). 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 (s). 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 (s). But use abroad does not fall within the rule (t).

(o) 41 C. D. 35; 6 R. P. C. 404 (1889).

(p) See note (l), *ante*, p. 206.

(q) As to the right of all or any of concurrent owners of a mark to sue, see below, p. 300.

(r) Per Ch. J., 42 C. D. 280; 6 R. P. C. 42 (1889).

(s) See *Jelley's Application*, 51 L. J. Ch. 639 n. (1878); *The Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394 n. (1877), both Jessel, M. R.; and *Wragg's Trus.*, 29 C. D. 551 (1885), Pearson, J.

(t) See *Münch's Application*, 50 L. T. 12 (1881), Chitty, J.

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 (*t*), although Cotton, L. J., seems to have expressed a contrary opinion in *Hudson's Case* (*u*), for the label does not consist of each particular part of it, but consists of the combination of all the parts (*v*). The rule may now be regarded as settled by the cases cited, but in the earlier case of *Burland v. The Broxburn Oil Co.* (*x*), an order was made that the descriptive word *Washerine*, appearing in a registered label, should be disclaimed; and this was followed in *Thompson v. Miller* (*y*), where a similar order was made as to *Roadster* (*z*). In neither of these cases, however, was it alleged that the mark formed a distinctive whole capable of registration as an essential particular.

Common additions are not part of the trade-mark.

In *The Washerine Case* (*b*) Chitty, J., expressed an opinion that additions registered under sect. 74, are not part of the trade-mark to which they are attached, and Fry, L. J., appears to have held the same opinion (*c*). The Court of Appeal, affirming Kekewich, J., has since adopted that view (*d*). It would seem to follow 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

(*t*) *Smokeless Powder Co.'s Tms.*, (1892) 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 186; 8 R. P. C. 137, C. A.; *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173 and 611, Kekewich, J., and C. A. (Lindley, M. R., Sir F. Jeune and Romer, L. J.).

(*u*) 32 C. D. 311; 3 R. P. C. 155 (1886); see above, p. 154.

(*v*) Per Lord Esher, M. R., in *Pinto v. Badman*, 8 R. P. C. 181 (1891), see Chap. X., p. 230.

(*x*) 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*).

(*y*) 13 R. P. C. 35 (1896), Stirling, J., (*Roadster* for boots).

(*z*) See, however, *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386; and of. also *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195 (1894), Kekewich, J.

(*b*) See *supra*, note (*x*).

(*c*) *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 233; 8 R. P. C. 165; *Pinto v. Badman*, 8 R. P. C. at p. 188.

(*d*) *Clement et Cie.'s Tm.*, *supra*. So, per North, J., in *Rosenthal v. Reynolds*, *infra*.

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.

The decision last referred to related, however, to the Act of 1883, and the section, as altered by the Act of 1888, is more difficult to construe. Sub-sect. 74 (2) as amended adopts the language of sect. 64 as amended; "essential particulars" are to be stated, and "added matter" is to be disclaimed, whereas the disclaimer was formerly of "such common particular or particulars." But in spite of the change of language in sub-sect. 74 (2), the words "addition to any trade-mark" in sub-sect. (1) appear generally to govern the section, and there is the further consideration that if the added matter of sect. 64 and the additions to the mark are synonymous, the provisions of sect. 74, so far as they relate to new marks, are pure surplusage; for if any words may be added subject to disclaimer under sect. 64, it is, on the assumption, unnecessary in sect. 74 to provide in particular for either the addition or disclaimer of distinctive words. Apparently, therefore, notwithstanding the alteration of language, sect. 74 is, under the Act of 1888, still intended to deal with additions to the mark (*e*) and not with additions to essential particulars. The distinction may not, however, be of practical importance.

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 (*f*), so that, for instance, no action for infringement lies in respect of the use or imitation of the disclaimed particulars. In one case (*g*) North, J., refused an interlocutory injunction in a passing off case on the ground

Effect of registration with disclaimer.

(*e*) See Fry, L. J., in *Pinto v. Badman*, *supra*. In that case the mark was registered under the Act of 1888.

(*f*) *Pirie v. Goodall*, (1892) 2 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A., *Pirie's Parchment Bank*, the plaintiffs disclaimed *parchment and bank*, but sought to set up some

right to the combination: as to this see *Hubbuck v. Brown*, 17 R. P. C. 638, (1900) C. A.; also *Baker v. Rawson*, 45 C. D. 529; 8 R. P. C. 89 (1890), North, J.

(*g*) *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J. See also *Puckham v. Sturgess*, 15 R. P. C. 669 (1898), North, J.

that the plaintiff was relying on certain letters the exclusive use of which he had disclaimed. The Scotch Court of Session has, however, refused to follow North, J., on the point, and has held that such a disclaimer does not affect the registered proprietor's common law rights (*gg*). The mere presence of 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) (*h*).

Advantages
of registration
with addi-
tions.

In comparing two marks which are alleged to resemble each other too closely, some account must be taken of elements common to the trade which are included in both (*i*), 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 (*k*). Beyond this, it is difficult to see what substantial bearing upon the proprietor's rights in this country (*kk*) the registration of disclaimed additions 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 (*l*).

Registration
with blanks.

As already stated, traders prefer to register their marks as they are actually used (*m*), 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.

(*gg*) *Baycr v. Baird*, 15 R. P. C. 615 (1898), (*C. B. Corsets*). Cf. also *Thompson v. Miller*, 13 R. P. C. 35 (1896), *Stirling, J. (Roadster)*, with *Burland v. Broxburn Oil Co.*, 6 R. P. C. 482, *Chitty, J. (Washerine)*, and see also *Packham v. Sturgess*, 15 R. P. C. 669 (1898), *North, J.*, and *C. A. (Sparkling Lime Wine)*.

(*h*) *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29, *North, J. (Unco' Guild in each of two quite distinct labels)*; and the cases in note (*f*).

(*i*) See Chap. X. p. 240.

(*k*) And see the passage from the Committee's report above, p. 198.

(*kk*) But in some countries abroad the mark can only be registered exactly as registered in the country of origin, see App. 776.

(*l*) *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. 391.

(*m*) See above, p. 200.

CHAPTER X.

RESTRICTIONS ON REGISTRATION.

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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 that chapter, 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 (aa).

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.

Sect. 71.

Conflicting claims to registration.

It is provided by sect. 71 that—

“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 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.”

(a) Page 115, sects. 64 and 74, see “reasons for refusal,” p. 68.

(aa) Certain restrictions on regis-

tration are contained in the Instructions 28 to 31, App. p. 728. As to the force of such restrictions, *supra*, p. 70, note (n).

It will be observed that, while the former section gives the Comptroller a discretion, the latter is imperative; and that sect. 71 relates to concurrent claims to registration, whilst the limitation contained in sect. 72 is only applicable where at least one of identical marks is already on the Register (*b*).

Where several applicants claim to be proprietors (*c*) 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 (*d*). 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 (*e*), which may be settled if need be by the Comptroller (*f*); 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 (*g*).

Duplicate
claims to the
same mark.

In deciding cases under the sections the Court will consider public interests as well as the rights of the applicants *inter se*, and, unless the former are protected, will not give effect to an agreement for concurrent registrations of identical new marks, at all events in the absence of special circumstances. In *Ehrmann's Trade-Marks* (*h*) the applicants had formerly been partners, and certain marks which were registered had been used by the firm. The partnership was dissolved by an agreement that one partner should carry on business under one trade-name which had been used by the firm, and the others under another trade-name which had also been used by the firm, and each party was to be entitled to use the firm's marks with certain alterations to be made by them respectively, and applications were to be made by each party for registration of such marks; the agreement also provided for the cancellation of the former registrations

(*b*) See *Ehrmann's Tms.*, referred to below.

(*c*) See "proprietor," p. 65.

(*d*) Rule 43, p. 699.

(*e*) Rule 44.

(*f*) Rule 45

(*g*) See Sebastian, 4th ed. p. 344, and *Simpson, Davies & Son's Tm.*, 15 C. D. at p. 527 (1880), Jessel, M. R.

(*h*) (1897) 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

if that should be necessary for the fresh registrations. On the applications for registration being made, the Comptroller required the respective applicants to submit their rights to the Court, whereupon the applicants appealed. On the appeals being referred to and coming before the Court, the Comptroller raised objections to registration—first, on the ground of the existing registrations, but, having regard to the view which the Court took, this was not finally dealt with; and, secondly, on the ground that identical new marks ought not to be registered in the names of different persons—whilst the applicants relied on the special circumstances as giving them a right to the registrations. Stirling, J., held that in such a case the Court should consider the protection of the public, and ought to be satisfied that there was no reasonable probability of harm resulting, and he dismissed the appeals.

Before the introduction of registration, when trade-mark rights could, except in a few special trades and in particular places (*i*), be acquired only by user, the duplication of marks for use in connection with the same description of goods, by use in different districts, was very common, and many duplicate old marks have been admitted on to the Register. A limit was put to the number of such duplicates which would be accepted by the adoption of the three mark rule which has been already referred to (*k*).

The three
mark rule.

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 (*l*), and its 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 (*m*) 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

(*i*) *E.g.*, the cutlery trade in Sheffield.

(*k*) Chap. IX. p. 205; Act of 1883, s. 74 (3).

(*l*) *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.

(*m*) *White Rose Tm.*, 30 C. D. 505 (1885), Kay, J.

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 (n). 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 (o); but the use of a mark abroad did not fall within the rule (p).

“Prior to the passing of the Act of 1883,” say Lord Herschell’s Committee (q), “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 (r), and no alteration has been made in 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.

Lord Herschell’s Committee on the three mark rule.

The rule has never been applied to marks first invented

The rule does not apply to new marks.

(n) *Jelley’s Application*, p. 216.

(o) See *Burland v. Broxburn Oil Co.*, 42 C. D. at p. 280; 6 R. P. C. 274 (1889), Chitty, J.

(p) *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.

(q) Page xiii.

(r) See per Jessel, M. R., *Jelley’s Application*, 51 L. J. Ch. at p. 640, n. (1878).

or used since the 13th of August, 1875 (s), for the Registration Acts make proper registration itself (t) equivalent to public use, and evidence of the registered proprietor's right to the exclusive use of the mark (u). Title to a mark can still, however, be acquired by use, although registration is a condition precedent to any action by the proprietor in respect of its infringement (v). 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 obtains registration the other cannot do so (x). It was suggested to Lord Herschell's Committee that this should be altered (y), 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* (z), Jessel, M. R., said: "I have often had the case of a man in one town not knowing that another man in another town has the same mark, and he has got his trade-mark registered. The second applicant must prove his title, that is all. The leave of the Court mentioned in sect. 6 (a) 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,

(s) *Jackson & Co. v. Napper*, 35 C. D. p. 169; 4 R. P. C. 45 (1886), Stirling, J. And see *Re Ehrmann's Tms.*, (1897) 2 Ch. 495; 14 R. P. C. 665; and p. 213, *ante*.

(t) Under the Act of 1888, application for registration is substituted for registration, see sect. 17.

(u) Act of 1883, ss. 75 and 76; Act of 1875, ss. 2 and 3.

(v) Act of 1883, s. 77; and p. 312, below.

(x) See *Currie's Application*, 13 R. P. C. 681 (1896), Kekewich, J., where the applicants alleged user for eleven years as against thirteen by the respondents, but the mark was refused.

(y) See the evidence of the Comptroller, Sir H. Reader Lack, Q. 3161.

(z) 51 L. J. Ch. 639, n. (1878).

(a) *I.e.*, of the Act of 1875, now sect. 72 (1).

perhaps, forty years, should lose it, because another man who had it for four years had happened to register it first."

Registration of an old mark may be allowed although a similar mark has been on the Register for more than five years (b).

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 (c): "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 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?"

After five years' registration of opponent's mark.

Sect. 72 is not limited by the register classes.

(b) *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. 184 *et seq.*

(c) 41 C. D. p. 291; 6 R. P. C. 311 (1889).

Of course, they are utterly different things, and yet they are put by the framers of these Rules into the same class, so that we cannot be guided by their classification in construing the words 'same goods or description of goods,' which are the words used in sect. 72." And the judges were all inclined to think that wines and spirits were of the same description of goods, although they did not decide the point. And North, J., in a subsequent case, expressed the opinion that beer and rum are the same description of goods within the meaning of the section (*d*). Still more recently (*e*) Romer, J., found as a fact that there was an intimate connection between the bicycle and camera trades, and he ordered a trade-mark, which had been registered in class 22 for bicycles, to be expunged on the application of a company which had used the mark for bicycle cameras and had registered marks containing the word in question in classes other than class 22. On the other hand, in *Braby & 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 (*f*). 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 (*g*)? It has

(*d*) *Turney & Sons' Tm.*, 11 R. P. C. 37; 10 Times L. R. 175 (1893), North, J.

(*e*) *Eastman, &c. Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), (*Kodak*). As to this case see also below, p. 256; and see *Eno v. Dunn*, 15 App. Cas. 252, 7 R. P. C. 311 (1890), where the registration of "Dunn's Fruit Salt Trade Mark Baking Powder" was refused for baking powder in class 42 by reason of a prior use of the words "fruit salt" for a medicinal drink; and *Eno v. Dunn*, 10 R. P. C. 261 (1893).

(*f*) 21 C. D. 223 (1882); and see *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M. R.; see also *Edward v. Dennis*, 30 Ch. 454, where a mark which had been used only for sheet iron was held not to be infringed by use of a somewhat similar mark for wire; and cf. *König and Ebhardt's Tm.*, 13 R. P. C. 449; (1896) 2 Ch. 236, where Stirling, J., allowed registration of a mark in class 39 on the application being confined to account books, ruled paper, and other paper for use in books.

(*g*) See per Kay, J., 41 C. D. at

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 *a fortiori* if the registration as well as the user is limited within the class, cannot by virtue of his registration prevent the use of the mark by other traders upon other descriptions of goods, although they may be included in the same register class (*h*). But the fact that an opponent of an application for registration could not get an injunction to restrain the use which the registration sought is intended to cover, is by no means conclusive upon the question of the right to registration (*i*).

Use or registration for part of a register class.

A second mark has often been admitted to registration by agreement with the proprietor of a mark already registered, who might otherwise oppose it under sect. 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 (*k*). And in the same way marks have been allowed to be registered on the terms of being used in a particular manner, so as not to be confused with a mark already registered (*l*), or for use in a particular district (*m*). And the Comptroller has in some cases been directed to put a note, in accordance with the agreement, upon the Register (*n*). These last-mentioned cases, however, were decided under a Rule not now in existence; and the Court of Appeal has since disapproved of placing any territorial limitations on the Register on the grounds both of the want of jurisdiction to do so, and of the inexpediency of such a course having regard to the duty of protecting the public (*n*). The objection will apply to all cases of annexing conditions to registration, or

Registration of a second mark by agreement.

Note on the Register.

p. 281, in the *Australian Wine Importers' Case*.

(*h*) See p. 97, sect. 65; and see *Margreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

(*i*) See *The Australian Wine Importers' Case*, *supra*, and p. 221, below.

(*k*) See *Re Rabone Bros. & Co.*, Seb. Dig. p. 395 (1879), Jessel, M. R.

(*l*) *Whiteley's Tm.*, 43 L. T. 627, n. (1879), Jessel, M. R.; *Sykes & Co.'s Tm.*, *ibid.* p. 626 (1880), Hall, V.-C.

For restrictions as to colour, see Chap. VIII. p. 195.

(*m*) *Keep's Tm.*, 26 C. D. 187 (1884), Pearson, J.; *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1884), Chitty, J.; *Whiteley's Tm.*, 43 L. T. 627 (1879), Jessel, M. R.

(*n*) *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288 (Lindley, Lopes, and Kay, L. JJ.); and cf. *Ehrmann's Tms.*, *supra*, p. 213.

entering notes on the Register in relation to other limitations, except the description of goods. In the same case it was decided that the consents of proprietors of other marks do not determine the question whether such marks constitute an objection to a proposed registration, but at the most afford some evidence that the proposed registration will not interfere with the trade of such proprietors (*o*). 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 (*p*).

II. Mark resembling a Registered Mark.

Sect. 72 (2),
mark re-
sembling a
registered
mark.

It is further provided by sect. 72 (2) that—

“[Except as aforesaid] (*q*) the Comptroller shall not register with respect to the same goods or description of goods (*q*) a trade-mark *so nearly resembling* [having such resemblance to] (*r*) a trade-mark already on the Register with respect to such goods, or description of goods, as to be calculated to deceive.”

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) (*s*), 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 (*t*).

(*o*) See also *König & Ehardt’s Tm.*, (1896) 2 Ch. 236; 13 R. P. C. 449, Stirling, J. And as to compromise on an application to expunge, see below, p. 274.

(*p*) *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183 (1890), C. A.

(*q*) See above, p. 212.

(*r*) Act of 1888, sect. 14.

(*s*) Page 212.

(*t*) Page 227.

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 (u).

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 (x). But the restriction extends beyond the rule, and it does not follow, because an opponent could not obtain an injunction against the use by the applicant of the mark which he tenders for registration, that it is not calculated to deceive within this sub-section. Thus, in *Speer's Case* (y), Kay, J., said: "I could quite conceive a case in which the similarity would not be such as would induce the Court, on that fact alone, to grant an injunction, but in which the Comptroller would still be entirely within his duty in saying that these marks are so nearly resembling one another, at any rate, that I will not, by allowing the registration, encourage the use of a mark which may lead to litigation hereafter. It seems to me that is a matter which the Comptroller ought to consider." And this is fully in accord with the judgments of the law lords in *The Fruit Salt Case* (z).

The section extends beyond infringing marks.

The restrictions on registration of deceptive marks are not only for the protection of owners of marks on the Register, but also of the public, and therefore, notwithstanding the consents of owners who might oppose the registration, a mark may be refused on the ground of the likelihood of confusion with their marks, and the consents are only some evidence as to the probability of deception (a).

(u) Page 217, above.

(x) *Seixo v. Provezende*, 1 Ch. 192 (1865), Cranworth, L. C.; and see *Cope v. Erans*, L. R. 18 Eq. 158 (1874), Hall, V.-C., and the cases there cited. Deceptive trade-marks are not protected, see Chap. XV. p. 397.

(y) 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.

(z) *Eno v. Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890). See also *Société, &c. de l'Étoile's Tm.*, below, note (c).

(a) *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A.

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 (*b*), falls within the section, and ought, therefore, to be refused registration (*c*). The question has not been directly decided (*d*), but it is submitted that the objection would be sufficient to justify the rejection of the mark, especially as the Courts will not now enter on the Register a limitation of the area of user of the applicant's mark, or even, apparently, any note of an arrangement between the parties for such limitation (*e*). The authorities cited below (*f*) show that probability of deception in England only is not all that is to be considered in cases of infringement; and it cannot be supposed that a mark would be admitted on to the Register if it were shown that the proprietor would forthwith, upon the application of the opponent, be restrained from using it. It is true that, where old marks have been in use simultaneously for years in different markets, the injunctions granted in infringement cases have occasionally been locally limited (*g*), and such limitations have the support of a dictum of Cotton, L. J., in *Johnston v. Orr-*

(*b*) See p. 240, below.

(*c*) In *Société Anonyme des Verriers de l'Étoile*, (1894) 1 Ch. 61; 10 R. P. C. 436, the trades of the applicants for rectification and of the respondents were in fact competing in the colonies, and Stirling, J., held that the use of the applicants' mark on goods shipped in English ports for the colonies was in use in England, where the respondents' main trade was. Aff. by C. A., (1894) 2 Ch. 26; 11 R. P. C. 142.

(*d*) In *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A.,

Lindley, Lopes, and Kay, L. JJ., similar questions were discussed, and it was pointed out by Kay, L. J., that there might be deception in Burma, but the Court thought that there might be deception outside Burma, and proceeded on that ground.

(*e*) See the case last cited.

(*f*) Page 225.

(*g*) *Carver v. Bowker*, Seb. Dig. p. 350 (1877); Little, V.-C.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J., a passing off case.

Ewing (h); but in that case, on appeal, Lord Cairns expressed a doubt whether the rightful and *bond 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 (*i*). And it seems clear that the principle upon which the limitation of the injunctions in the cases referred to was based cannot avail to enable a new mark to be registered, which in any market is deceptive, by reason of the existence of a mark with which it might there be confused. Moreover, as regards registered marks, registration confers rights unlimited as to locality; and, although the owner of a previously registered mark may not yet have extended his trade to the particular market in question, it is open to him to do so (*j*). 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 (*k*). So, too, in *The Jackson Co.'s Case (l)*, registration of a word was refused because it was the name of a common mark in the cotton trade among the Chippeway Indians, to whom the English cotton trade had not then extended. In *Dewhurst's Application (m)*, the Court of Appeal refused registration of a mark, having as an essential particular the words *The Golden Fan Brand* in the Burmese language and characters, on the ground of the presence on the Register, in respect of the same goods, of a fan which in fact, as used, was coloured gold. In this case the owner of the latter mark had consented to the registration, and the applicants were willing to submit to a condition that the mark should only be put on goods exported to Burma, and they adduced evidence that part of

(h) 13 C. D. p. 464.

(i) 7 App. Ca. p. 227. To that proposition, he said, he could not assent.

(j) See *Dewhurst's Application*, *supra*, note (d).

(k) *Paine & Co. v. Daniells & Son's Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217.

(l) 6 R. P. C. 80; 60 L. T. 93 (1888), Kay, J., (*Kokoko*).

(m) (1896) 2 Ch. 137; 13 R. P. C. 288.

the mark was already known there as *The Golden Fan Trade-Mark*. The broad ground on which the Court acted was that a second mark should not be placed on the Register containing a mere verbal description of an existing mark, because of the danger of purchasers being deceived (*n*).

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 (*o*), 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” (*p*), for it must be assumed, until the contrary is shown, that the applicant will make an honest use of his marks (*o*). A trade-mark is calculated, by its resemblance to another already on the Register, to deceive, if in the course of its legitimate use in the trade it is likely to do so.

Two important questions are suggested by the section: A. Who are the persons whom the resemblance must be calculated to deceive? and, B. What rules of comparison are to be adopted in judging whether such resemblance exists?

A. What Persons are to be considered.

Whom the mark must be calculated to deceive.

In accordance with the cases decided in suits and actions for the infringement of trade-marks before the Registration Acts, it is held that the persons to be considered in estimating whether the resemblance between the marks in question is calculated to deceive are all of those who are likely to become purchasers of the goods upon which the marks are used. So

(*n*) The decision expressly left it open for the Comptroller, if he thought fit to do so, to allow the words to be registered as additional words subject to a disclaimer. In the application the words had been claimed as

an essential particular.

(*o*) *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J., (*Carlsbad Salts*); and see the next case.

(*p*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

that, if such persons, using ordinary care (*g*) and intelligence, are likely to be deceived, then the Comptroller ought not to accept the mark.

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 (*r*). 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 (*s*). Nor is the inquiry to be confined to England, or to persons acquainted with the English language, in cases where the goods in question have a foreign market (*t*). It must not be assumed that a very careful or intelligent examination of the mark will be made (*u*), and

The ultimate purchasers.

Foreigners.

Persons of ordinary ability and carefulness.

(*g*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886). See per Esher, M. R., p. 62, quoted below, p. 230.

(*r*) *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. Ca. 15 (1882); and *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; 12 R. P. C. 496; 13 R. P. C. 235; and in the House of Lords, (1897) A. C. 710; 14 R. P. C. 720; especially the judgment of Kay, L. J., 13 R. P. C. 250; and *Hubbuck v. Brown*, 17 R. P. C. 645 (1900), C. A.

(*s*) *Anglo-Swiss, &c. Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.; *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A. "In my opinion the whole gist of the complaint against the defendants is, 'You have sold a weapon calculated to be used fraudulently by the middlemen'" (Cotton, L. J.). If ultimate purchasers do not know who is the manufacturer of the goods which they have been accustomed to

purchase, that circumstance might contribute to make the mark of a rival trader deceptive. Cf. *Powell v. Birmingham Vinegar Brewery Co.*, *supra*, note (*r*); especially Lord Watson's judgment, 14 R. P. C. at p. 730.

(*t*) *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson v. Griffith*, *supra*.

(*u*) "Unwary purchasers": *Wotherspoon v. Currie*, L. R. 5 H. L. 508 (1872), Lord Chelmsford; *The Singer Manufacturing Co. v. Loog*, 8 App. Ca. 15 (1882), Lord Selborne. "Ordinary purchasers purchasing with ordinary caution": *Seizo v. Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L. C. "Ordinary or unwary purchasers": *Powell v. Birmingham Vinegar Brewery Co.*, 13 R. P. C. at p. 258, Lindley, L. J.; not "persons of an ideal character who either are particularly innocent or too easily deceived": *Payton v. Snelling*, 17 R. P. C. at p. 57, Romer, L. J., whose judgment was approved by the H. of L., 17 R. P. C. 628; and see the judgments of Kekewich, J., in *Marshall v. Sidebotham*,

if it were shown that the class of persons who bought the goods were illiterate, that would be a material fact in cases where printing entered into the marks (*v*); but, on the other hand, it can hardly be a bar to the admission of a mark that unusually stupid people (*x*), "fools or idiots" (*y*), may be deceived (*z*). If some parts of the mark are common, one must consider whether people who know the distinguishing characteristics of the opponent's mark would be deceived (*a*). The cases cited are nearly all cases of infringement or passing off, and, as already said, a weaker case than would entitle a plaintiff to succeed in an action for infringement will enable an opponent to successfully object to the registration of a new mark.

B. Rules of Comparison.

What amount of resemblance is calculated to deceive.

It is impossible to discover from the decided cases any criterion as to the amount of resemblance which will suffice to cause the rejection of a mark more definite than that expressed in the section itself, and probably no test could

18 R. P. C. 43 (1901), and *Alaska Packers' Association v. Crooks*, 18 R. P. C. 129 (1901). "The unwary customer is extremely difficult to find": see the last case.

(*v*) See *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492. The proposition is not contrary to the following passages from the judgments in *Singer Manufacturing Co. v. Loog*, where the fact of illiteracy of the customers was not established. "Whatever be the class of persons who buy these things (sewing machines), we must at all events assume that they are persons capable of reading and writing, or of reading, at all events": per James, L. J., 18 C. D. p. 413. "The possibility of such a mistake is not a cause of action (for passing off). The same thing might happen if the defendant issued circulars that his were *not* Singer sewing machines. For however large he printed the *not*, some one might not see it": per Lord Bramwell, 8 App. Ca. p. 42. In one case in which the goods (lemonade

powders) were largely bought by children, and it was suggested that they would be more easily deceived than adults, Byrne, J., expressed the opinion that, having regard to the nature of the goods, which they would be likely to purchase for themselves, they would be less likely to be deceived than grown-up people: *Clark v. Sharp*, 15 R. P. C. at p. 149 (the case was settled on appeal, 15 R. P. C. 268 (1898)).

(*x*) *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, 17 R. P. C. at p. 67, Romer, L. J. (1900).

(*y*) Jessel, 21 R., 2 C. D. at p. 447.

(*z*) See note (*v*), *ante*.

(*a*) See the judgments of Romer, L. J., in *Payton & Co., Ltd. v. Snelling & Co., Ltd.*, 17 R. P. C. at p. 57; and *Same v. Titus Ward & Co., Ltd.*, 17 R. P. C. at p. 67 (1900) (passing off cases); the former judgment being approved by the H. of L. on appeal, 17 R. P. C. 628; also *Alaska Packers' Association v. Crooks*, and *Marshall v. Sidebotham*, note (*u*), above.

usefully be stated (*b*); 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 proving that there is no reasonable probability of deception is cast on the applicant (*c*). In comparing the marks, the Comptroller must, as appears from the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's. The report of Lord Herschell's Committee on this point admirably states what are conceived to be the critical tests, and it shows also what the amendment of the Act (*d*) was intended to effect. It will be useful to set out the whole passage.

1. The "Idea of the Mark" is to be regarded.

"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 (*e*) in relation to these classes is of great importance to the trade. There can be no doubt that the working of the Trade-Marks Act has not given 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

Lord
Herschell's
Committee on
the principle
of compari-
son.

(*b*) "What degree of resemblance is necessary (to constitute an infringement) is, from the nature of things, a matter incapable of definition *a priori*"; per Cranworth, L. C., in *Seizo v. Provezende*, L. R. 1 Ch. 192 (1866).

(*c*) *Eno v. Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890).

(*d*) Substituting "having such resemblance" for "so nearly resembling."

(*e*) *I.e.*, the Act of 1883.

to serve their purpose have not been sufficiently kept in view by the Patent Office. By sect. 72, sub-sect. (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 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 (f). 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,

(f) Cf. *Barker's Tm.*, 53 L. T. 23 (1885), Kay, J. (*Huntsman, or Sportsman's cherry brandy*).

The idea of each mark to be considered.

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."

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 principle is adopted by the Court.

Thus, in *Johnston v. Orr-Ewing (g)*, where both the plaintiffs' and the defendants' marks consisted of tickets bearing pictures of two elephants with a banner between them, the figures being differently arranged, Lord Selborne said (*h*): "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 Two Elephant Case.

(g) 7 App. Cas. 219 (1882).

(h) Page 225. See also *Baschiera's Tw.*, 33 Sol. J. 469; 5 T. 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."

The Taendstikker Case.

And in *The Taendstikker Case* (i), where the Court of Appeal, reversing the decision of Chitty, J., held that a label for match-boxes so nearly resembled an older label registered for the same goods as to be calculated to deceive, the judgment of the Court proceeded on the ground that the net impression produced by both labels was the same. The appellant's label as registered consisted of a black oblong, bearing the word *taendstikker* printed at the bottom, and the word *nitedals* at the top, and a small geometrical device having two overlapping medals on each side of it in the middle. The respondents' label as registered showed the same elements, with the word *medals* instead of *nitedals*, two blank spaces having the same outline as the medals, and a cross instead of the device, the blanks and cross corresponding in size and shape with the medals and device. It was shown that in practice the respondents printed representations of medals over the blanks.

Lord Esher's judgment.

The marks to be compared as wholes.

"The trade-mark," said Lord Esher, "is the whole thing—the whole picture on each. You have, therefore, to consider the whole. Mr. Justice Chitty has looked at the distinguishing features. He, I think, only looked at it to see whether, with that distinction, the whole was like or unlike. That is what he did, but the argument raised by Mr. Romer, and which was not only shadowed but plainly put forward by his skilful cross-examination, was this: the moment there is any distinction in any part, the things are at once unlike. That is his point. Therefore he cross-examined the people thus:—The lamps (j) 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."

And Lindley, L. J., said: "The difference here, looking

(i) *Christiansen's Tm.*, 3 R. P. C. 54 (1886).

(j) *I.e.*, the blank spaces.

There may be general resemblance with many differences in details.

at the boxes, is simply this, that the word *medals* is used instead of the word *medals*, 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" (*h*).

So that, where common marks are included in the trade-marks to be compared, or in one of them, it appears, from the judgments just quoted (*l*), 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 (*m*).

Included common marks are not to be disregarded.

Farrow's Case (*n*) is a good illustration of Lord Esher's rule (*o*). 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.

(*k*) "Though no one particular mark was exactly imitated, the combination was very similar and likely to deceive": Hatherley, L. C., in *Abbott v. The Bakers', &c. Association*, W. N. (1872) 31. Cf. with the *Tuundstikker Case* that of *Lever v. Beddingfield*, 15 R. P. C. 453; and 16 R. P. C. 3 (1899), Kekewich, J., and C. A., in which it was held that there was no infringement of the mark as a

whole, although some features had been taken from the plaintiffs' label.

(*l*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886), above, p. 230; and see *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

(*m*) 4 App. Ca. 479 (1879).

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

(*o*) Page 230, above.

But if the only resemblances between the two marks are in parts which are common, so that the owner of the one has taken nothing which is peculiar to the other, then there is at all events no infringement (*p*), unless possibly the plaintiff had a distinctive arrangement of common elements. Thus, in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, a passing off case, Lindley, M. R., said (*q*) the plaintiffs "must make out that the defendants' goods are calculated to be mistaken for the plaintiffs', and where, as in this case, the goods of the plaintiff and the goods of the defendant unquestionably resemble each other, but where the features in which they resemble each other are common to the trade, what has the plaintiff to make out? He must make out, not that the defendant's are like his by reason of those features which are common to them and other people, but he must make out that the defendant's are like his by reason of something peculiar to him and by reason of the defendant having adopted some mark, or device, or label, or something of that kind, which distinguishes the plaintiff's from other goods which have, like his, the features common to the trade. Unless the plaintiff can bring his case up to that, he fails." And in *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, the same learned Judge said (*r*): "When what is called the plaintiffs' get-up consists of two totally different things combined, namely, a get-up common to the trade, and a distinctive feature affixed or added to the common features, then what you have to consider is not whether the defendants' get-up is like the plaintiffs' as regards the common features, but whether that which specially distinguishes the plaintiffs' has been taken by the defendants. A defendant may take it more or less. It is very seldom that he copies it. Of course

(*p*) *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), C. A., Lindley, M. R., Rigby and Vaughan Williams, L. J.J., reversing Byrne, J.; *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, 17 R. P. C. 48, (affirmed by H. of L. 17 R. P. C. 628); *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, 17 R. P. C. 58, both C. A. (1900), Lindley, M. R., Sir F. Jeune

and Romer, L. J., all passing off cases; *Marshall v. Sidebotham*, and *Alaska Packers' Association v. Crooks*, above, note (*a*) (trade-mark and passing off). See also *Hubbuck & Son, Ltd. v. Brown*, 17 R. P. C. 148 and 638 (1900); and *Wolff v. Nopitsch*, 17 R. P. C. 321 and 18 R. P. C. 27 (1901).

(*q*) 17 R. P. C. 52.

(*r*) 17 R. P. C. 63.

he does not do that, but if he so nearly takes it that when you look at it as a whole you can say that the defendant's goods are calculated to be taken for the plaintiff's goods when properly looked at—if you can say that—then the plaintiff is entitled to succeed." In the former case, Romer, L. J., pointed out that where a person used certain leading features, which are common, another person commencing to use the same leading features ought to be careful that his goods can, by their own distinguishing features, be distinguished. If this is not done the later comer would certainly not be entitled to register his mark.

The fact that there has been actual copying of part of the plaintiff's mark is a matter to be considered, but it does not constitute infringement (s), nor would it necessarily make the new mark deceptive.

The resemblance between two marks must be considered with reference to the ear as well as to the eye. Thus, if a star be registered, the word *star* for the same goods would be calculated to deceive, and further, since the registered proprietor of the device of a star could, under sect. 67, use it in any colour, the words *Red Star* were held to be as objectionable as the word *star* by itself (t). So, also, the words *The Golden Fan Brand* were refused registration as an essential particular of a mark, on account of the presence on the Register of a fan which was in fact coloured gold in use (u); and a mark containing prominently the representation of half an apple on account of the words *Apple Brand* in two registered marks (v).

Ear as well as eye to be considered.

A good illustration of the principle that the idea of the marks must be considered is afforded by the *Currie & Co.'s Application* (x). There the registered mark included the words *The Cock o' the North*, with the picture of a cock in a defiant attitude, and the applicants' mark also included a

(s) *Lever v. Bedingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A., Lindley, M. R., Chitty and Vaughan Williams, L. JJ.

(t) *Société Anonyme des Verreries de l'Etoile's Tm.*, (1894) 1 Ch. 61; 10 R. P. C. 436, Stirling, J.; (1894) 2 Ch. 26; 11 R. P. C. 142, Lindley, Kay

and Smith, L. JJ. (*Red Star Brand*).

(u) *Dewhurst's Application*, (1816) 2 Ch. 137; 13 R. P. C. 288, Lindley, Lopes and Kay, L. JJ.

(v) *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J.

(x) 13 R. P. C. 681 (1896), Kekewich, J. (*Cock o' the North* label).

somewhat similar cock, both marks being for Scotch whisky. They contained other prominent features which were different in the two marks, but Kekewich, J., held that the Comptroller was justified in refusing registration of the applicants' mark, as it included in a central position the thing which caught the eye in the registered mark.

2. The Marks are to be compared as fairly used in Practice.

Marks not to be merely compared side by side on a view;

It is also clear that the 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 (*y*). Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade-mark they are already acquainted with for reasons of their own (*z*).

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 (*a*), 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 (*b*).

(*y*) *Seixo v. Provezende*, 1 Ch. 192 (1866), Cranworth, L. C.; *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J., and Lord Alverstone, M. R., in *Hubbuck v. Brown*, 17 R. P. C. at p. 645.

(*z*) *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882), Lord Selborne, *ante*, p. 229.

(*a*) Jessel, M. R., held, in several cases, that the Register only should be looked at: *Re Jelley*, 51 L. J. Ch. n.s. 639, n. (1878); *Robinson's Tm.*, 29 W. R. 31 (1880); *Mitchell*

v. Henry, 15 C. D. 181 (1880); but in the latter case the C. A. dissented from his opinion and overruled his decision; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), Chitty, J.

(*b*) *Rosing's Application*, 54 L. J. Ch. 975, n. (1878), C. A.; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1885), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138 (1889), C. A. In *Hubbuck v. Brown*, 17 R. P. C. 148 and 638, the plain-

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 (*c*). In the former case, too, the mark will necessarily be used in a small size only (*c*). 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 (*d*). It must not be assumed against the applicant or registered proprietor that he is going to use his mark unfairly, in the sense that he is going to use something different (*e*), by leaving out or obliterating any parts of the mark, for instance, so as to make it more like that of the opponent (*f*), for the Court presumes that a trade-mark will be used fairly and without fraud (*g*). 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 (*h*). Thus he may use the mark in any colour, and in *Worthington's Case* (*i*) 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

Size of mark.

Alteration of mark as used from mark as registered to be considered.

tiffs relied to some extent on the effect of stencilling, and see the judgment of Collins, L. J.

(*c*) See the two cases cited before *Hubbuck v. Brown*, in which, however, the opposition failed; and see *Re Jelley*, 51 L. J. n.s. Ch. 639 n. (1878), Jessel, M. R.

(*d*) *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J.

(*e*) *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.

(*f*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

(*g*) *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 (1889), Chitty, J.; *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*).

(*h*) *I.e.*, making his mark so different as to be practically an un-registered mark.

(*i*) 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. 195.

Variation in the use of the opponent's mark.

Alteration of the opponent's registered mark in use cannot increase the objection.

altered as more nearly to resemble that of the opponent, as, for example, in *The Taendstikker Case* (*k*), 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 (*k*). 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 (*l*), for no one can extend the protection given to his registered mark by departing from the registered form. The fact that the objector uses his mark in a form different from that in which it appears on the Register is, however, no answer to an objection if the mark in question so nearly resembles the objector's mark, as it there appears, as to be calculated to deceive (*m*), 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 (*n*); 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 (*o*), 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.

3. The Essential Particulars are to be specially attended to.

Regard must be specially directed to the essential particulars of the marks to be compared, for the remaining matter in any of them might, subsequently to registration, be changed on an application under sect. 92 (*p*). On this ground, Stirling, J., refused, in *Murphy's Trade-Mark* (*q*), to

(*k*) *Christiansen's Tm.*, cited above, p. 230.

(*l*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

(*m*) *Melachrino v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J.; *Rowland v. Michell*, 13 R. P. C. 457, 14 R. P. C.

37 (1897), Romer, J., and C. A.; all cases of infringement.

(*n*) See *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

(*o*) See *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.

(*p*) See below, Chap. XI. at p. 297.

(*q*) 7 R. P. C. 163 (1890).

allow a mark consisting of a lion carrying a sheaf, together with other matter, to be registered, there being already on the Register another mark comprising a lion bearing a crown, because the lions were the sole essential particulars of both, although each mark had additional matter, and the general appearances of the two were different. The applicants in this case offered an undertaking that they would use their mark only in the form tendered for registration, but this was not deemed sufficient by the proprietors of the opposing mark, and, as the mark was a new one, the judge refused to accept the offer as an answer to the difficulty raised by the resemblance of the essential particulars (r).

Undertaking
not to vary
registered
mark in use.

4. All the Circumstances of the Trade to be considered.

Further, the Court must have regard to all the circumstances of the trade in which the marks in question are employed, or are to be employed, and in particular to the nature of the market, whether a home or a foreign one; to the number of other trade-marks similar to the contrasted marks already circulating in connection with the same description of goods; 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 from 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 con-

Marks
deceptive in
particular
markets.

(r) And cf. *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898); *Clark v. Sharp*, 15 R. P. C. 141 (1898); *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, 16 R. P. C. 283; 17 R. P. C. 48 and 628; and *Same v. Titus Ward & Co., Ltd.*, 16 R. P. C. 424; 17 R. P. C. 58 (1900); all passing off cases, in which

a prominent and distinctive feature of the plaintiffs' get-up had not been taken; also *Marshall v. Sidebotham*, 18 R. P. C. 43 (1901), trade-mark and passing off.

(s) *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J.

trasted mark, and being of about the same length. But if the possible confusion between the marks in a particular market would arise entirely from a device, the use of which is open to the applicant for registration, *e.g.*, the Royal Arms, the opponent would fail (*t*).

The fact that a mark only becomes deceptive owing to the presence in it of words in a foreign language and only when the meaning of those words is understood, will not help the applicant, and the mark will be refused registration if the translation of the words in English would be deceptive, even although the language used is an Oriental one (*u*).

Numerous marks of the same kind on the Register.

In cases where there are a large number of marks similar to the mark propounded on the Register, the Court may think that, though the applicant's mark might be fairly distinguishable from the opponent's if there were no other, and perhaps also from each of the others taken alone, yet the extension of the number of such marks may lead to deception. Thus, in *Hargreaves' Case* (*x*), there being four anchor marks already on the Register in the same class, Hall, V.-C., refused to allow another anchor mark to be added to them, notwithstanding that the new mark was sought to be registered for bacon and hams, while those already registered were used for different articles of food, such as biscuits, potted meat, &c., and that it was said to be distinguishable from them all. But the extent of the class is a matter to be considered (*y*). The registration of other marks belonging to the applicant himself would not generally be material to defeat his application, since a trader often desires to register slightly differing marks

Similar marks belonging to the applicant.

(*t*) *Hubluck v. Brown*, 17 R. P. C. 156, Kekewich, J., an infringement and passing off case, in which the plaintiffs alleged that their goods were known in Spanish-speaking markets as *Dos Leones*, by reason of their use of the Royal Arms. In the Court of Appeal, 17 R. P. C. 638, the decision was affirmed, it being held that there had not been a deliberate copying of the plaintiffs' particular form of the Royal Arms. The particular case could not now

occur with a new mark, see Instructions, p. 728.

(*u*) *Dewhurst's Application*, (1896) 2 Ch. 137; 13 R. P. C. 288.

(*x*) 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. Ca. 479 (1879).

(*y*) *König and Ebhardt's Tm.* (1896), 2 Ch. 236; 13 R. P. C. 449.

to distinguish goods which are of different qualities or prices (ε). 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 (α).

In some cases, on the other hand, the existence of a number of marks, either as common marks or as trade-marks, may operate to render a finer distinction allowable than would otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter. Thus, in *König and Ebhardt's Trade-Mark* (b) the mark applied for included a crown, and the evidence showed that there were twenty-seven marks registered in the same class which consisted of, or included a crown or coronet, but the registration was allowed with a limitation of the goods for which it was registered (c) and a disclaimer of the crown. And in *Mitchell v. Henry* (ε), 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" (d).

The distinction between the marks may be of a well-known kind.

The case just referred to forcibly illustrates the difficulties

Line headings.

(ε) See "series," sect. 66, Chap. V., p. 100; and per Cotton, L. J., in *Mitchell v. Henry*, 15 C. D. at p. 193 (1880); see, however, the decision of Cozens-Hardy, J., in *Players' Application*, 18 R. P. C. 65 (1901), where the Court upheld the Comptroller's refusal to register, one of the grounds being that a previous registration by the applicants covered their proposed registration; see also, North, J., in *Baker v. Rawson*, 8 R. P. C. p. 102 (1891).

(α) See Lord Blackburn's judg-

ment in *The Orr-Ewing Case*, 4 App. Ca. 499; and that of Stirling, J., in *Murphy's Tm.*, 7 R. P. C. p. 166.

(b) *König and Ebhardt's Tm.* (1896), 2 Ch. 236; 13 R. C. P. 449. Cf. also *The Star Tobacco Case*, on p. 245.

(c) See also the judgment of North, J., in *Baker v. Rawson*, 8 R. P. C. at p. 107.

(d) 15 C. D. at p. 194 (1880). The application of this reasoning to the particular case was disapproved by the C. A.

which led Lord Herschell's Committee to recommend that the line headings woven at the ends of lengths of piece goods should not be admitted as trade-marks upon the Register (*dd*). 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 (*e*); 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) (*f*).

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 (*g*), although evidence was given that *Seixo* was a common word in Portuguese. "The

(*dd*) Report of 1888, p. ix.; see Chap. VIII., p. 150.

(*e*) Page 135, above.

(*f*) Per Cotton, L. J., in *Mitchell v. Henry*, 15 C. D. 193 (1880).

(*g*) *Seixo v. Provezende*, L. R. 1 Ch. 192 (1866).

plaintiff," said Lord Cranworth, "had adopted a device or trade-mark which had caused his wines to obtain celebrity under a name descriptive of that trade-mark. The defendants have adopted a trade-mark which could not fail to lead purchasers to attribute to the wines so marked the same name as that under which the plaintiff's wines were known, and so to believe that in purchasing them they would be purchasing the wines of the plaintiff. Against the use of such a trade-mark the plaintiff has, I think, a right to have the injunction of this Court." So where a trade-mark consisting of the full-length figure of a milkmaid carrying two pails, one on her head and one in her right hand, with the words *milkmaid brand* above it, was registered for condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee, and the goods upon which it was used were known as the *milkmaid* or *dairy-maid* brand, and subsequently another trade-mark consisting of a half-length figure of a woman carrying a pail under her right arm, with the words *dairy-maid* at the side of the figure, was registered for butterine and other fatty substances used as food or as ingredients in food, an order was made to rectify the Register by confining the second registration to goods other than those included in the first, and to restrain the use of the second mark upon any of the goods for which the first was registered (*h*).

The Dairy-Maid Milk Case.

(*h*) *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. Ca. 219 (1879), Fry, J., C. A., and H. L. (*Two Elephant Yarn*); *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J. (*Dog, Tower, and Harp Linen*); *Read v. Richardson*, 45 L. T. 54 (1881), C. A. (*Dog Head Beer*); *Baschiera's Tm.*, 33 S. J. 469; 5 T. L. R. 480 (1889), Chitty, J. (*Lion Matches*); *Société Anonyme des Verreries de l'Étoile*, 10 R. P. C. 436; (1894) 1 Ch. 61; 11 R. P. C. 142; (1894) 2 Ch. 26, Stirling, J., and C. A. (*Red Star Glass*); *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J. (*Red Medal Polish*); *Dewhurst's Ap-*

plication, (1896) 2 Ch. 137; 13 R. P. C. 288, C. A. (*Golden Fan Cotton*); *Currie & Co.'s Application*, 13 R. P. C. 681 (1896), Kekewich, J. (*Cock o' the North Whisky*), are to the same effect. In *Cowie Bros. v. Herbert*, 14 R. P. C. 436 (1897), Court of Session, such a case was set up by the plaintiffs, but failed (*El Musjid*), as also did the plaintiffs in *Lever Bros., Ltd. v. Bedingfield*, 16 R. P. C. 3, (1899), where the plaintiffs had a small picture of a laundry-maid on the label, and the defendant had the words *Red Maid*, and the plaintiffs relied (*inter alia*) on that. Cf. also *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand cider*).

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 (*i*).

The cases just cited are cases where the name applied to the opponent's or plaintiff's goods was taken from the device used as a trade-mark. The rule applies also to cases where the name is taken from some word or words appearing upon the mark. *The Osman Towel Case* (*k*) is an illustration of this (*l*); *The Milkmaid Case* (*m*); *The Lion Soap Case* (*n*); and *Currie & Co.'s Application* (*m*), already cited, and *Mecus' Application* (*o*), are instances belonging to both classes.

The cases referred to above include instances both of the applicant's (or defendant's) mark containing (*p*) and of its suggesting (*q*) a word contained in or suggested by the opponent's or plaintiff's mark.

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.

(*i*) *E.g.*, *Ancross* for umbrellas in a new mark, was rejected because there were several old anchor marks: *Thewis and Blakely's Tm.*, 10 R. P. C. 369 (1893), North, J.

(*k*) *Barlow v. Johnson*, 7 R. P. C. 395, W. N. (1890) 110, C. A.

(*l*) So also are *Hodgson and Simpson v. Kynoch, Ltd.*, 15 R. P. C. 465 (1898), Romer, J. (*Lion Soap*), a trade-mark and passing off case, the plaintiff failing as to the former; *Cochrane v. McNish*, (1896) A. C. 225; 13 R. P. C. 100, P. C. (*Club Soda*), infringement and passing off; *Purcell v. Birmingham Vinegar Brewery Co.*, (1897) A. C. 710; 14 R. P. C. 720, passing off. See also *Application*

of *Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand*).

(*m*) *Supra*, note (*h*).

(*n*) See note (*l*).

(*o*) (1891) 1 Ch. 41; 8 R. P. C. 25 (1890), Chitty, J. (*Key Brand Geneva*).

(*p*) *Anglo-Swiss Condensed Milk Co. v. Metcalf*; *La Société Anonyme des Verrieres de l'Étoile*; *Dewhurst's Application*; *Cochrane v. McNish*; *Saxlehner v. Apollinaris Co.*; *Barlow v. Johnson*; *Mecus' Application*; *Purcell v. Birmingham Vinegar Brewery Co.*; *all supra*.

(*q*) *Orr-Ewing v. Johnston*; *Speer's Tm.*; *Read v. Richardson*; *Wilkinson v. Griffith*; *Currie's Application*; *Application of Pomril, Ltd.*

(a) The first objection is really included in the second, but may conveniently be stated separately. It is a question of fact whether the name concerned is the name of the goods or of some quality (r) 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 (s). All the authorities relevant to it before 1890 were discussed and commented on in *The Osman Towel Case* (t) by Chitty, J., and the Court of Appeal. As has been shown elsewhere (u), where a name was first given by a trader to goods in the manufacture or sale of which he had a monopoly, whether as of right under a patent (x), or in fact because he was the first inventor or introducer of the goods (y), the Court will more readily infer that the name is the name of the goods merely, and that it connotes no connection between them and the trader, and the probability that this is the case, is nearly, although not quite, as strong, where, in similar circumstances, the public themselves have taken the name from the trader's marks and applied it to the goods. Of course, it is much more difficult to make out that the name has no such connotation if it is not the only name applied to the goods in the market.

(a) Where the name is descriptive of the goods.

Where the opponent has had a monopoly in the goods.

(r) *E.g.*, excellence: *Arbens' 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*).

(s) Chap. II., p. 36; see per Lord Selborne, in *Singer v. Wilson*, 3 App. Ca. p. 376 (1878).

(t) *Barlow v. Johnson*, 7 R. P. C. 395; W. N. (1890), 110.

(u) Chap. II., pp. 43 *et seq.*

(x) *Wheeler & Wilson Co. v. Shakespeare*, 39 L. J. Ch. 36 (1869), James, V.-C.; *Linoleum Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.; and *Pulmer's Tm.*, 24 C. D. 504 (1882), Chitty, J., and C. A.; *Slazenger v. Feltham*, 6 R. P. C. 531; 5 T. L. R. 365 (1889),

C. A. (*Demon Racquets*) (a case of an invalid patent); *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and C. A. (*Magnolia Metal*); *Mesby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1897), North, J. (*Triticumina biscuits*); *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486 (1900), Farwell, J. (*Formalin*); *Cheseborough Co.'s Tms.*, 18 R. P. C. 191 (1901), Buckley, J. (*Vaseline*).

(y) *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A. (*Valcoline*); *Arbens' 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*).

If the fact is made out that the name suggested by the marks is merely descriptive, and there is no other resemblance which is calculated to deceive, the second mark is not disentitled to registration. Thus, in *Horsburgh & Co.'s* application, Messrs. Leonard and Ellis, in 1873, 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 (z).

(b) Where the name is suggested by matter in the mark common to the trade.

(b) Where the name is suggested by words or devices which are common to the trade and which occur in the trade-mark offered for registration, the words or devices must, if distinctive, in the case of a new mark (a), and unless they form part of the essential particulars (b), be disclaimed in the application (c), 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 (d). The last-mentioned rule may also be applicable if a word or device is saved from disclaimer only by being part of an essential particular, as, for instance, occurring in a distinctive label (e). But the presence of the

(z) 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. 210, note (h).

(a) The same would apply to old marks in cases where statement of essential particular and disclaimer are necessary; as to this, see *supra*, p. 185.

(b) As, for instance, part of a distinctive label, *supra*, pp. 153, 205. Prior to the Act of 1888 they need not be disclaimed if part of the mark. As to the alteration made by that Act, see *supra*, p. 209.

(c) Sect. 64 and Sect. 74. Chap. IX., p. 197; *Mecus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J. (*Key Brand Genera*). Cf. *Player's Application*, 18 R. P. C. 65, Cozens-Hardy, J. (1901).

(d) *Pirie v. Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, C. A. (*parchment bank paper*); *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. corsets*); *Watt v. O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M. R., an Irish case; *Loftus' Tm.*, (1891) 1 Ch. 193; 11 R. P. C. 29, North, J. (*Unco Guid Whisky*); *Hubbuck v. Brown*, 17 R. P. C. 148 and 638 (1900), Kekewich, J., and C. A. See, however, p. 209 above.

(e) *Semble*, per Romer, L. J., dur-

common elements in both marks may be an element in creating a general resemblance between them looked at as wholes (*f*). In one case, however, where there was no disclaimer on the Register, and no application to rectify, North, J., notwithstanding evidence that part of the opponent's registered mark was common to the trade, held that it was used distinctively (*g*).

The opponent cannot rely on disclaimed matter or words in his mark.

The Star Tobacco Mark Case (*h*) 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 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."

Where the name is common to the trade.

In *Hubbuck v. Brown* (*i*) the plaintiffs sought to establish

ing the argument in *Clement et Cie.'s Tm.*, 16 R. P. C. 611 (1899).

(*f*) See p. 230.

(*g*) *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. 287.

(*h*) *Re Dexter's Application, Re Wills' Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J.

(*i*) 17 R. P. C. 148 (1899), Kekewich, J. (*Dos Leones*); affirmed by C. A., 17 R. P. C. 638.

that in certain foreign countries their goods had acquired the name *Dos Leones*, and that the defendant's mark would deceive, but they were in the difficulty that their goods had acquired the name from the presence of the Royal Arms in their mark, and that they could not restrain the use of such Arms by the defendant without setting up a monopoly in them to which they were not entitled (*j*).

(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 (*k*).

The Red Medal Polish Case.

Thus, in *Wilkinson v. Griffith* (*l*), an infringement case, Romer, J., in restraining the defendants from using their label, relied upon evidence that the plaintiff's goods were known as red stamp polish from the figures upon his labels, although it was urged on the defendants' behalf that the plaintiff's claim practically involved a claim to a monopoly in red labelled goods. The judge, however, expressly stated that the plaintiff was not entitled to any such monopoly. "I by no means hold, nor do I think, the evidence as a whole can fairly be said to establish," he said, "that any red mark on a label of the defendant would render that label deceptive. I can imagine many red marks, or even red medals, being so used as to prevent deception." But it is for the applicant for registration of the mark which is alleged to be deceptive to make it clear that such is not the case.

(*j*) Cf. also *Phillips v. Ogden*, 12 R. P. C. 325 (1895), Wills, J., a passing-off case, in which both plaintiffs and defendants had the right to use *Guinea Gold* for cigarettes, and otherwise the boxes were sufficiently distinguished.

(*k*) *Wotherspoon v. Currie*, L. R. 5 H. L. 508 (1872) (*Glenfield Starch*);

Montgomery v. Thompson, (1891) A. C. 217; 8 R. P. C. 361 (*Stone Ales*). It is to be noted, however, that these were both cases of attempted frauds. *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882), H. L. (*Two Elephant Yarns*). See also the last paragraph.

(*l*) 8 R. P. C. 370 (1891), Romer, J. (*Red Stamp Polish*).

Evidence (m).

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 subsection.

Evidence material to the question of resemblance.

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 (n), 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.

Expert evidence as to probability of deception.

The judge must in the end act upon his own view on a comparison of the marks, having regard to the matters of fact referred to above (o); but it is settled that the expert evidence is admissible (p), and in particular cases it may be of import-

(m) As to the evidence upon applications to register generally, see Chap. IV., pp. 89 and 90. 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.

Jessel, M. R. (1878); *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

(o) 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.

(p) In *North Cheshire & Manchester Brewery Co. v. Manchester Brewery Co.* (1899), A. C. p. 85 (a trade-

(n) *Re Jelley*, 51 L. J. Ch. 639, n.,

ance, 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 (*pp*). 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 to be essentially a question of experts (*q*).

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 (*r*).

name case), Halsbury, L. C., said: "Is this name so nearly resembling the name of another firm as to be likely to deceive? That is a question upon which evidence, of course, might be given as to whether or not there was another brewery either in the one place or in the other, or whether there were several breweries nearly resembling it in name; what the state of the trade was, and whether there was any trade-name. All those are matters which are proper to be dealt with upon evidence; but upon the one question which your Lordships have to decide, whether the one name is so nearly resembling another as to be calculated to deceive, I am of opinion that no witness would be entitled to say that, and for this reason: that that is the very question which your Lordships have to try." Referring to this passage, Lord Alverstone, L. C. J., in *The London General Omnibus Co., Ltd. v. Lovell*, (1901) 1 Ch. 135; 18 R. P. C. 74, said: "I am satisfied that the Lord Chancellor did not mean to lay down any general rule that no evidence that

things were calculated to deceive was ever to be required. In that case evidence had been given, and it was merely the comparison of the two names, which, one may say, speak for themselves," and in this case the Court allowed the defendants' appeal, on the ground that (the Judge having viewed the omnibuses) the plaintiffs had given no evidence that the defendant's "get-up" was calculated to deceive. The defendant's omnibus, except for one alteration, had been running for some years. See also *Hedley's Tms.*, 17 R. P. C. 719 (1900), and *Alaska Packers' Association v. Crooks*, 18 R. P. C. 129 (1901).

(*pp*) See *Hubbuck v. Brown*, 17 R. P. C. 148 (1900), Kekewich, J.

(*q*) 15 C. D. p. 195 (1880); and see *Christiansen's Tm.*, 3 R. P. C. 54 (1885), Chitty, J., and C. A.

(*r*) See *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*), and note (*p*), *supra*. In *Turton v. Turton*, Fry, L. J., compared this evidence to the oaths of compurgators in a mediæval trial: 45 Ch. D. at p. 149.

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 (*s*); 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 (*t*), unless the absence of such evidence is explained by the difficulty of procuring witnesses from a distant foreign market (*u*), 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.

Evidence of actual deception.

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.

Examples and illustrations.

Contrasted Devices.

A pointer eating out of a pot, too near for registration to a similar dog standing by a pail with SPANCH beneath it; *Jelley's Application*, 51 L. J. Ch. 639, n. A twisted curved horn, with a twig bearing two roses, too near a similar untwisted horn with a cord having two loops in the same place as the roses in the twig; *Rosing's Application*, 54 L. J.

(*s*) *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L. C.; *Compania Général de Tabacos v. Rehder*, 5 R. P. C. 61 (1887), Kay, J.; *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Paine & Co. v. Daniell & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, C. A.

556; 61 L. T. 138 (1888), North, J.; and *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. at p. 107 (1889), North, J.; *Talbot's Tm.*, *infra*, p. 252; *Phillips v. Ogden*, 12 R. P. C. 325 (1895), Wills, J.; but see *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*, 13 R. P. C. 635, 736 (1896), Kekewich, J., and C. A.

(*t*) *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 Essences Co.*, L. R. 10 Ch. 276 (1875), C. A.; *Lambert's Tm.*, 5 R. P. C.

(*u*) *Wilkinson v. Griffith*, 9 R. P. C. 370 (1891), Romer, J. In *Cowie Bros. v. Herbert*, 16 R. P. C. 436 (1897), the Scotch Court of Session commented on the absence of such evidence.

Oh. 975, n. A triangular frame with words upon it and a church inside, too near Bass's solid triangle; *Worthington's Tm.*, 14 C. D. 8; so also a white diamond within a red diamond; *Turney and Sons' Tm.*, 11 R. P. C. 37. A half-length figure of a milkmaid, with the word *Dairy-maid*, too near a full-length figure of a milkmaid carrying two pails; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28. A woman's head wearing a helmet with ATHENA beneath, not too near a man's head with WAY beneath; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102. A tower in an oval border, with a dog and harp, too near a tower, dog, and harp without any border; *Speer's Tm.*, 4 R. P. C. 521. An oval label containing interlaced triangular frames with a stag's head within them, too near an oval label with three superimposed solid triangles, although the lettering on the marks was conspicuously different; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247. A sheep suspended by its middle, with the words GOLDEN FLEECE, too near a somewhat different sheep with the same words; *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311. A pig in outline, and H. B. & Co., not too near shaded pointer dog, and STANCH; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669. A tobacco pipe and dart, not too near a tobacco pipe alone; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138. A charging buffalo, too near a bull's head, both being placed in silver rings on similar yellow wrappers; *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233. A mark having as its sole essential particular a lion bearing a sheaf, too near a mark having as an essential particular a lion with a crown; *Murphy's Tm.*, 7 R. P. C. 163. An elephant in a border with lettering round it, an infringement of a somewhat different elephant alone; *Upper Assam Tea Co. v. Herbert & Co.*, 7 R. P. C. 183. A label bearing a winged cross surrounded by two circles in its upper third, not an infringement of a similar label, being a lighthouse similarly surrounded and placed; *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89. A label with two red medals and a balloon, an infringement of a similar label with two red medals only, both labels being used for polish known in India, from the latter label, as red medal polish; *Wilkinson v. Griffith*, 8

R. P. C. 370. A label with a cock in the centre, the groundwork being a piece of plaid with the words *Prince Charlie, King o' the Highland Hearts*, in the upper part, too near a label bearing in the upper part the words *The Cock o' the North* with a cock in a central position over a coat of arms, with a Highlander on one side and a horse on the other; *Currie's Application*, 13 R. P. C. 681. A label bearing a representation of the Royal Exchange, Glasgow, and the words *Royal Exchange Whisky* below, refused registration because it would give the right to restrain a label bearing the same representation with the words *Bodega Special Whisky* below; *Rogers' Tm.*, 12 R. P. C. 149. C. B. & Co. and also C. B. D. held to infringe marks, one consisting of the device of a corset and the letters C. B. within a star, and the other of C. B. corsets; *Bayer v. Connell Bros.*, 16 R. P. C. 157 (v). The device of a red deer's head, not an infringement of a trade-mark consisting of a moose head; *Alaska Packers' Association v. Crooks & Co.*, 16 R. P. C. 503, and 18 R. P. C. 129. The device of the cut side of half an apple cut vertically, with the word *Pomril* across it, too near a mark containing a representation of an apple and the words "apple brand," both marks being for cider; *Pomril Ld.'s Application*, 18 R. P. C. 181.

Contrasted Words.

WHITE ROSE, too near ROSALINE; *White Rose Tm.*, 30 C. D. 505. CONDI-SANITAS and SANITANT, infringements of SANITAS; *Sanitas Co. v. Condy*, 4 R. P. C. 195 and 530; 56 L. T. 621. BOYD'S UNRIVALLED HARNESS COMPOSITION, in a label with the Arms of the City of Dublin, not an infringement of PROPERT'S IMPROVED HARNESS COMPOSITION in a label, with a fox's head, the labels being similarly got up; *Beddow v. Boyd*, 4 R. P. C. 310. APOLLINIS, an infringement of APOLLINARIS; *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478. STEINBERG, an infringement of STEINWAY, the words being used with devices showing a general similarity; *Steinway v. Henshaw*, 5 R. P. C. 77. EMOLLIO, too near EMOLLINE; *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612. EMOLLIOLORUM, not too near MOLLISCORIUM; *Talbot's Tm.*, 11 R. P. C. 77. SWIFT'S SPECIFIC occurring in a trade-mark,

(v) In Ireland before Porter, M. R. See also *Bayer v. Baird*, 15 R. P. C. 615 (1897), So. Ct. of Session.

not calculated to deceive merely because the words were descriptive of the opponent's drug; *Swift Specific Co.'s Tm.*, 6 R. P. C. 352. OOMOO, not too near EMU; *Burgoyne's Tm.*, 6 R. P. C. 229; 61 L. T. 39. KOKOKO, too near the common word COCO; *Jackson Co.'s Tm.*, 6 R. P. C. 80. DEMOTIC, an infringement of DEMON; *Slazenger v. Feltham*, 6 R. P. C. 531. DUNN'S FRUIT SALT BAKING POWDER, too near ENO'S FRUIT SALT; *Eno v. Dunn*, 41 C. D. 439; 15 A. C. 252; 7 R. P. C. 311; subsequently held to be an infringement, 10 R. P. C. 261. EL DEVINO, an infringement of EL DESTINO; *Pinto v. Trott*, 8 R. P. C. 173. Label with EL DESTINACION, an infringement of a similar label with EL DESTINO; *Pinto v. Badman*, 8 R. P. C. 181. Label with LONDON PICKLES, an infringement of similar label with LONDON PICKLE CO.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301. STAFFORD, an infringement of TRAFFORD; FORT of FORTRESS; NEW MISTRESS, but not NEW MATRON, NEW MASTER, or MASTER, of MISTRESS; but SOUTH AFRICAN not an infringement of a mark consisting of a negro's head and the word AFRICAN; *Smith and Wellstood v. Carron Co.*, 13 R. P. C. 108. VINCALIS, not too near WINCARNIS, the goods being different in appearance and use; *Coleman & Co., Ld. v. Brown & Co.*, 16 R. P. C. 619 (passing off). TRITICUMINA, not infringed by TRITICINE; *Meaby & Co., Ld. v. Triticine, Ld.*, 15 R. P. C. 1. Signature ROBERT CRAWFORD, not infringement of signature DANIEL CRAWFORD; *Crawford v. Bernard & Co.*, 11 R. P. C. 580. MARGARITA, an infringement of LA FLOR DE MARGARETTA; *Benedictus v. Sullivan, Powell & Co.*, 12 R. P. C. 25. SAVOLINA, an infringement of SAVONOL; *Field, Ld. v. Wagel Syndicate, Ld.*, 17 R. P. C. 266. IVORY, calculated to be confused with IVY; *Goodwin v. Ivory Soap Co.*, 17 R. P. C. 689 (r). NIGHT CAP, not too near RED CAP or MOTHER RED CAP; *Hedley's Tms.*, 17 R. P. C. 719. VALTINE, too near VALENTINE; *Valentine Meat Juice Co. v. Valentine Extract Co. Ld.*, 17 R. P. C. 673, passing off (and see 18 R. P. C. 175). S. GRIFFITHS, three stars and I. X. L., not infringed by E. GRIFFITHS and three stars, the stars being common marks of quality; *Marshall v. Sidebotham*, 18 R. P. C. 43.

(r) The action was dismissed on other grounds.

III. Deceptive Marks.

It is provided by sect. 73 that—

Sect. 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 (*y*), be deemed disentitled to protection in a court of justice, or any scandalous design.”

Deceptive marks.

This proviso is taken from sect. 6 of the Act of 1875, except that in the last line “justice” is substituted for “equity,” “disentitled” is substituted for “not entitled,” 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 claim the exclusive use, but the use of which might nevertheless be calculated to deceive, and so be disentitled to the protection of a court of justice.”

“Exclusive use.”

The restriction laid down by 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 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 (*z*); and it was held, by Jessel, M. R., that their operation was confined to cases where the marks were in themselves inherently deceptive (*a*); but the Courts have held that the restriction is of wider scope than the old rule, or than this construction would suggest (*b*). The leading case in point is *Eno v.*

The section extends beyond the old rule of estoppel by misrepresentation.

The Fruit Salt Case.

(*y*) See p. 261, below.

Ch. 237, n.; 50 L. T. 23, n. (1878) (*Valroleum*).

(*z*) See Chap. XV., p. 297; and Lord Macnaghten’s judgment in *Eno v. Dunn*, *infra*.

(*b*) See the judgment of Cotton, L. J., in which the majority of the law lords concurred, in *Eno v. Dunn*,

(*a*) *Horsburgh’s Application*, 53 L. J.

41 C. D. p. 448.

Dunn (c), in which the House of Lords (Lord Halsbury and Lord Morris dissenting) overruled the judgment of the Court of Appeal (Lindley and Fry, L. JJ., Cotton, L. J., dissenting), and restored that of Kay, J. The question in that case was whether the words *Fruit Salt* occurring in a mark consisting of the words *Dunn's Fruit Salt Trade-Mark Baking Powder*, and in a mark consisting of a distinctive label, quite different in character from the device used by the opponent, Eno, and bearing the words *Dunn's Fruit Salt Baking Powder*, were calculated to deceive, having regard to the well-known use of the words as the name of Eno's Fruit Salt. Eno, in the first instance, based his opposition to Dunn's application to register his marks partially upon his title as the owner of the mark *Fruit Salt*, registered as "a proprietary medicine for human use," and also as a "dry preparation for making a non-intoxicating beverage"; but finding that he could not prove user of that mark before 1875, and that the words were consequently not capable of registration, 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,

Doubtful
new marks to
be rejected.

Lord Her-
schell's judg-
ment.

(c) 15 App. Cas. 252; 7 R. P. C. 311; *Dunn's Tm.* (1889), subsequently an injunction was granted to restrain Dunn & Co. from using the words *Fruit Salt*: *Eno v. Dunn*, 10 R. P. C. 261 (1893), Kekewich, J.

as if he had an absolute right to have any trade-mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. I do not so read the statute. Those sections prohibit the registration of a trade-mark in certain specified cases; but there is no duty cast upon the Comptroller of registering every other trade-mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases fairly conferred." And Lord Macnaghten said of the marks: "They are calculated, and I think designed, to create a confusion in the minds of those persons to whom Mr. Dunn's advertisements are addressed, and to lead the ordinary run of such persons to suppose that his baking powder is in some way or other connected with Mr. Eno's preparation"; and he held, therefore, that the marks ought to be rejected, for the "Comptroller ought to reject words which involve a misleading allusion or suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood."

Lord Macnaghten'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

Lord Watson's judgment.

that a batch of badly made baking powder might seriously injure the credit of the effervescing powder" (*d*).

Two recent cases deserve special notice. In *Dehurst's Application* (*e*) the words *The Golden Fan Brand* in Burmese characters were refused registration as an essential particular of a mark, there being on the Register for the same goods a fan which in use was coloured gold; and Kay, L. J., expressly based his judgment on sect. 73, holding that the words would, in Burma, be calculated to deceive, in the event of the owner of the registered fan trading there. In *Eastman Photographic Materials Co. v. John Griffith's Cycle Corporation* (*f*), the last-named company had registered *Kodak* as a trade-mark for cycles, and the plaintiffs, who moved to remove the mark from the Register, had identified that name with themselves and their goods, and in particular with bicycle cameras, and the name was comprised in several of their trade-marks, but none of them was registered in class 22, which includes bicycles. Romer, J., held that the defendants intended, by the use of the name, to cause the public to think that they were connected with the plaintiff company, or that their goods were those of the plaintiff company, and, following *Eno v. Dunn*, he ordered the mark to be removed, as, when registered, being likely to deceive. Since, however, sect. 73 only relates to words proposed to be registered as part of or in combination with a trade-mark, and the defendant company's word was registered by itself, it would seem that the learned judge referred rather to the general discretion to refuse a deceptive mark than to any particular section of the Act (*g*).

Mark contain-
ing name of
the oppo-
nent's goods
not necessa-
rily deceptive.

A mark is not calculated to deceive merely because it contains an ordinary description of an article of commerce which is occasionally used to describe a rival trader's

(*d*) See above, p. 69, "the Comptroller's discretion."

(*e*) (1896) 2 Ch. 137; 13 R. P. C. 288. See *supra*, p. 223.

(*f*) 15 R. P. C. 105 (1898), Romer, J.

(*g*) The case of a word-mark being deceptive otherwise than under sect.

72 seems to be a *casus omnisus* under the Acts, although it is an *à fortiori* case to that dealt with in sect. 73. *Quære*, however, whether "as part of" should not be read as equivalent to "in." The reference to *Eno v. Dunn* in the judgment of Romer, J., seems to show that sect. 72 was not relied on.

goods (*h*). To hold otherwise would certainly be, as Fry, L. J., said in *The Fruit Salt Case*, to allow the objector "to enclose and appropriate as private property certain little strips of the great open common of the English language" (*i*). Thus, where *The Smokeless Powder Co., Ltd.*, had registered a label bearing a target, with their name printed prominently upon it, supported on one side by the figure of a sportsman and on the other by that of a rifleman, an unsuccessful attempt was made by a rival powder-making company to have the mark removed from the Register, or to have a disclaimer of the words *Smokeless Powder* added to the registration. The application failed as to the disclaimer, because the words were not distinctive, and also because they were not additions within the meaning of 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 (*j*), and held that the use of the words in the mark was not calculated to deceive (*k*). 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* (*l*) 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 concerned were the ordinary words which anyone would choose to describe the goods both of the applicants and the respondents, and words which, apart from the Acts, could never have become, for such goods, the subject of exclusive rights (*m*).

*The Smokeless
Powder Co.
Case.*

(*h*) See *Dexter's Application*, (1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J. (*Star Tobacco*), above, p. 245.

(*i*) 41 C. D. at p. 455.

(*j*) See Chap. VIII., p. 154, "Label."

(*k*) So also in *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J., held that "Silverpan" in a mark registered for jam was descriptive and

K.

not calculated to deceive.

(*l*) (1891) A. C. 218; 8 R. P. C. 361.

(*m*) Chap. II., pp. 34 *et seq.* In *Faulder's Tm.*, *supra*, the respondents were seeking to restrain the applicants from using the word "Silverpan," but on the motion they stated that they did not claim any exclusive use by reason of their registration.

Device suggesting the name of the opponent's goods.

And as the presence of a common word in a label does not make the label deceptive, although the word is used of the opponent's goods (*n*), so neither does the presence of a device which suggests such a word. Thus, in *Kutnow's Case* (*o*), a label which included a picture of the Deer-leap rock at Carlsbad—a well-known and remarkable object in the environs of the town—was allowed to be registered for use with Carlsbad Salts, the name of the salts being common property, and applicable both to the natural product of the springs at Carlsbad and to artificial imitations of it. The opponents in the case were the Municipality of Carlsbad,—who own both the springs and the rock in question,—and their lessees of the springs. They sought to show that the use of the picture by the applicant would be calculated to lead purchasers to believe that the goods upon which it appeared were their goods; but the judge held that it would only suggest that the goods were Carlsbad Salts. And this would be true if, as he was bound to anticipate, the applicant used his mark honestly. The opponents had no monopoly in Carlsbad Salts.

Trade-mark attached to part of the mark only may be deceptive.

In *The Apollinaris Case*, Fry, L. J., in delivering the judgment of the Court of Appeal, expressed an opinion that a label which bears the word "trade-mark" so printed upon it as apparently to refer only to a device which forms part of the label, the whole label being, in fact, the trade-mark, is calculated to deceive (*p*), notwithstanding that the objection might have been, but was not, taken in the earlier case of *Hudson's Trade-Marks* (*q*), 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 (*r*). This objection caused considerable uneasiness to proprietors of trade-marks, and led to several applications to the Court, under sect. 92, for leave to amend registered marks, for the word

(*n*) See above, p. 242.

(*o*) 10 R. P. C. 401 (1893), North, J.
Cf. also *Hubbuck v. Brown*, 17 R. P. C. 148 and 638.

(*p*) (1891) 2 Ch. at p. 233; 4 R. P. C. 478.

(*q*) 32 C. D. 311 (1886).

(*r*) (1893) 2 Ch. 262; 10 R. P. C. 269. The order was made subject to an application to amend being made within a reasonable time, but no such application was made.

Trade-Mark is often printed upon labels and other trade-marks; but it is to be observed that it is only objectionable where its presence apparently implies that part of the actual mark is the whole trade-mark. In the mark to which Fry, L. J., was directly referring, the word was placed immediately under a red disc, which was the most prominent feature in the label. "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." (s). In *Colman's Trade-Marks* (t), 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 (u). But in a later case (x), 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 (c). In *Re Wills' Trade-Marks* (y), the mark was ordered to be expunged unless an application to amend was made within a reasonable time, but in *Day v. Riley and Whittaker* (z), Buckley, J., refused to give such an opportunity.

Alterations of marks to remove trade-mark.

Fry, L. J., also suggested, in *The Apollinaris Case* (a), 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

Threats of prosecution in the mark may be deceptive.

(s) Per Chitty, J., in *Hammond & Co. v. Malcolm, Brunner & Co.*, 9 R. P. C. p. 307; and the observation of the same judge in *Gordon & Dilworth's Tm.*, 13 R. P. C. p. 634.

(t) (1891) 2 Ch. 402; 8 R. P. C. 209.

(u) Cf. sect. 64 (2); and see Chap. IX., p. 199.

(x) *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.

(y) *Supra*, note (r). The mark was a new one registered under the Act of 1883, as also was the mark referred to in the case next cited.

(z) 17 R. P. C. 520 (1900).

(a) *Supra*; (1891) 2 Ch. p. 226.

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 (a). It may be noted that the Comptroller refuses to register the words "registered," "registered design," "copyright," "entered at Stationers' Hall," or "to counterfeit this is a forgery" (b). And in the case of the word "registered" this refusal has been supported by the Court (c).

The Comptroller refuses registered, copyright, &c.

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 (d).

Deceptive representation as to origin of goods.

The questions—Who can register a trade-mark? (e), and, What is the implication of a trade-mark with regard to the origin of the goods? (f) 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 (g).

The case of *Hill's Trade-Mark* (h) 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

(a) *Supra*; (1891) 2 Ch. p. 226.

(b) Instructions, 29, p. 728.

(c) *Meikle's Tms.*, 46 L. J. Ch. 17 (1876), Hall, V.-C. In *Wright, Crossley & Co. v. Dobbin*, 15 R. P. C. 21; and *MacSymons' Stores, Ltd. v. Shuttleworth*, 15 R. P. C. 748, it has been held both in Ireland and England that "registered" in a mark means registered in the United Kingdom.

(d) Instructions, 31; see *ante*, p. 98.

(e) Chap. IV., p. 65.

(f) Chap. II., pp. 52 *et seq.*; see also Chap. XV., p. 358, "Joint trade-marks."

(g) *Jones' Tm.*, 53 L. T. 1 (1885), C. A.

(h) 10 R. P. C. 113 (1893), Chitty, J.

judge held that the mark was calculated and intended to deceive (*i*).

On the other hand, a suggestion that "Mazawattee" was deceptive, as leading people to suppose from the character of the name that the tea came from a particular estate, did not prevail (*k*).

A mark which has been used fraudulently, or for the purposes of a fraudulent trade, if offered for registration, is open to the objection that its further use will tend to continue the old deceptions, and it is therefore a deceptive mark, and registration of it should be refused (*l*).

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 were, however, under the Act of 1875, held to be sufficient to exclude the registration, as part of a trade-mark, of words which are merely descriptive of the article upon which the mark is to be used, whether they are merely descriptive from their nature, or whether they have become descriptive by the course of the trade and in the market (*m*). 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. In the Act of 1883 the word "disentitled" was substituted for the expression "not entitled," and in a very recent case (*n*) the decision referred to was distinguished on the ground of the different wording of sect. 73 of the Act of 1883, and it was held that, although the word "Silverpan" was descriptive when used for jam, it was not thereby "disentitled" to protection within the meaning of this section.

(*i*) Its use was unquestionably an offence under the M. M. A. 1887; see Book II., Chap. I., p. 584. It appears from the report of *Thorneloe v. Hill* that the Comptroller afterwards refused to register the tree alone on account of its having been part of a fraudulent mark.

(*k*) *Densham's Tm.*, (1895) 2 Ch. 176; 12 R. P. C. 75 and 271; and *supra*, p. 184.

(*l*) *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. 397 *et seq.*

(*m*) *Anderson's Tm.*, 26 C. D. at p. 415 (1884), Chitty, J. (*Brand Baron Liebig*).

(*n*) *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J.

"Or otherwise."

CHAPTER XI.

RECTIFICATION OF THE REGISTER.

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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. XIV., p. 349.

1. Rectification under Sect. 90.

Section 90.

Sect. 90 (*b*) is in the following terms:—

“(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 to rectify applicable to every particular which ought to be entered upon the Register.

(*b*) Cf. Companies Act, 1862, s. 35, and the Copyright Act, 1842 (5 & 6 Vict. c. 45), s. 14.

(*c*) Act of 1888, s. 23.

(*d*) Appendix, p. 685.

(*e*) Except that appeals from the Comptroller on applications to register are now governed by a separate

section, sect. 62; see *Normal Co.’s Trm.*, 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.

Who are persons aggrieved.

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 the more recent judgments, the phrase in the section has been very liberally construed, and except, perhaps, in the case of a mark consisting of a name (*h*), 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 (*i*).

All persons substantially inconvenienced if the registration is wrong.

One of the leading cases on the subject is that of *The Apollinaris Co.'s Trade-Marks*. In that case, Fry, L. J., in delivering the judgment of the Court of Appeal, said: "We approach this question (Are the applicants persons aggrieved?) on the assumption, which is necessary, of course, to answer this question, that the trade-mark was wrongly on the Register; and, further, with these two observations: in the first place, that the question is merely one of *locus standi*; 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 (*j*); but that they must not be so read as to make evidence of great and serious damage a condition precedent to a right to apply. Further, we are of opinion that, wherever one trader, by means of his wrongly registered trade-mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with

The Apollinaris Case.

The question is one of *locus standi* only.

(*h*) See *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131 and 377, cited below, p. 267.

(*i*) Per Bowen, L. J., in *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 195.

(*j*) See Lord Selborne's judgment, in *Rivière's Tm.*, 26 C. D. at p. 54 (1884), and the judgments of Lindley and Fry, L. JJ., on the subsequent hearing of the same case, 55 L. J. Ch. 545.

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, 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). They further held that an alleged infringer of a mark is always a person aggrieved by its registration (m). "The practical conclusion of this view," said Fry, L. J., "is, we think, a sound one. It will stop the practice, of which we have seen instances in this case, of a trader registering his mark without justification, using it as a means to intimidate or coerce other traders, and then, at the bar, alleging that the threat was idle, and the persons against whom it was used are not aggrieved thereby" (n).

Any person
intimidated
or harassed
by the regis-
tration.

Powell's Case.

The words in question have received their most liberal interpretation in the subsequent 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 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

(k) (1891) 2 Ch. p. 224; 8 R. P. C. 137.

(l) *Ibid.* p. 228.

(m) See also *Baker v. Rawson*, 45 C. D. 579; 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.; followed in *Talbot's Tm.*, 11 R. P. C. 77 (1894), Stirling, J.

mark. Lord Herschell, in giving judgment, said that although the words were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer, it was undoubtedly of public interest that they should not be unduly limited; and also he said: "Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade-mark, and wherever the trade-mark, if remaining on the Register, would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register he could not lawfully do that which but for the existence of the mark upon the Register he could lawfully do, it appears to me he has a *locus standi* to be heard as a person aggrieved." Lord Watson, in his judgment, said that the fact that a trader deals in the same class of goods, and could use the mark, was, *prima facie*, sufficient evidence of his being aggrieved, which could only be displaced by the person who registered the mark, upon whom the onus lay, showing that there was no reasonable probability that the objector would have used it, although he were free to do so.

But the grievance of the applicant must be substantial, and a fanciful suggestion of grievance is insufficient. Thus, in *Wright, Crossley and Co.'s Trade-Mark* (*p*), a firm had registered their firm-name of "Wright, Crossley and Co." as an old trade-mark, and a company, called the Royal Baking Powder Company, trading in the same trade, applied to remove it. There had been considerable litigation between the applicants and the registered owners as to the words "Royal Baking Powder," and it was suggested that the applicants had an interest as the mark was being used by the owners in connection with those words, and that there was a possibility of a wrongful user of the words "Trade Mark." It was also suggested that the applicants might at some time acquire the right to trade under the name Wright, Crossley and Co., or part of it. But Romer, J., and the Court of Appeal came to the conclusion that the suggestions

(*p*) 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

of possible injuries to the applicants were fanciful, and that the applicants were not persons aggrieved. Rigby, L. J., pointed out that the judgments in the House of Lords in the *Yorkshire Relish Case* did not support the contention that the mere fact that a man was in the same trade was sufficient to make him a person aggrieved. It is not necessary, however, for an applicant to show that he is interested in the sense of deriving any profit from his trade (*q*); and it is sufficient to constitute trading if he is trading by his agents (*q*).

Defendant in a passing off action.

A defendant charged in an action with passing off his goods as those of the plaintiff (*r*) is aggrieved by the registration of a trade-mark referred to in the plaintiff's pleadings, although no case of infringement is set up (*s*); and so also a trader who wishes or may wish to use the registered mark, not as a trade-mark, but as a description of his goods (*t*). And it is not necessary that the applicant should actually trade in the goods for which the mark is registered; it is sufficient if there is such a close connection between the business in those goods and the applicant's business that there is a probability that he may wish to extend his business to the other goods (*u*). 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 (*v*); 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

Offer of a disclaimer is no answer to an application to rectify.

(*q*) *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

(*r*) See Chap. XVI., p. 446.

(*s*) *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

(*t*) *Ralph's Tm.*, 25 C. D. 194 (1883), Pearson, J. (*Homewasher*); *Rose v. Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C. (*Limetta*); *Powell's Tm.*, *supra*; *Talbot's Tm.*, 11 R. P. C. 77; 63 L. J. Ch. 264 (1894), Stirling, J. (*Emolliolorum*).

(*u*) *Eastman, &c. Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J. There was no express finding, however, as to the applicants being persons aggrieved; but it was held that they could have successfully opposed the registration.

(*v*) *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.

exists if at the time when the application is launched the registration is such as to occasion it.

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 (*y*).

Exporter
aggrieved by
mark for
home trade.

And a foreigner may be a "person aggrieved" by the registration of a mark. This was decided by the Court of Appeal, overruling the judgment of Pearson, J., in *Rivière's Case* (*z*), where the applicants, who carried on business in India, but did not trade or intend to trade in England, alleged that, on their request to register the mark in question for them, the registered proprietors had wrongfully registered it in their own names; and the Court, in holding that the applicants might be aggrieved, assumed, but did not decide (*a*), that, as foreign traders, the applicants could not themselves have registered the mark.

Foreigner.

On the further hearing of the case just cited (*b*), 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 and Co.* had commenced

Wider view
now taken
than in the
earlier cases.

(*y*) *Société Anonyme des Verres de l'Etoile*, (1894) 1 Ch. 61; (1894) 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

(*z*) 26 C. D. 48 (1884), decided on the Act of 1875. Also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600; 75 L. T. 63 (1896), Stirling, J.,

where the applicants' predecessor had used the mark in England.

(*a*) 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.

(*b*) 55 L. J. Ch. 545; 53 L. T. 237 (1895).

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 (c). In subsequent cases the section, and the phrase "person aggrieved," has been more stringently construed against the registered proprietor; and although there is no conflict between this decision (d) and the decisions cited above, it is plain that in them a view was taken of the section different from that acted upon in it.

Purity of
the register.

In a recent case it was suggested that, although the applicant was not a person aggrieved, the Court would, in the interests of the public, rectify the Register if the mark was bad (c); but, even if the Court would, under any circumstances, take such a course in the absence of a person aggrieved (f), it would only do so in the case of a registration which was on the face of it illegal or improper (g).

Applicant
entitled as
successor of
proprietor.

A refusal by the Comptroller to cause the name of a person who had become entitled by assignment, transmission, or other operation of law to a registered trade-mark to be entered as proprietor of the trade-mark in the Register under sect. 87 would constitute such person a "person aggrieved" and give the Court jurisdiction under sect. 90 to

(c) *I. e.*, sect. 6 of the Act of 1875.

(d) Because the Court held that the mark was properly registered.

(e) *Wright, Crossley & Co.'s Tm.*, *infra*, note (g).

(f) See the judgment of Bowen, L. J., in *Paine & Co. v. Daniells &*

Sons' Breweries, quoted *infra*, p. 272.

In that case, however, the defendants, being sued, were clearly persons aggrieved.

(g) *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131, 377 (1898), especially the judgment of Romer, J.

order the entry to be made (h). But if a person applies to the Comptroller for an alteration in a case for which the Acts do not provide, and it is refused, he is not a "person aggrieved" (h).

The Exercise of the Jurisdiction under the Section.

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 (i), it ought to exercise, even under circumstances in which the applicant is precluded from exercising the right with which the registration interferes. Thus, in *The Stone Ales Case* (k), 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.

Where the mark was incapable of registration it must be removed.

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

The conduct of the applicant is irrelevant.

(h) *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 620; 13 R. P. C. 475, North, J. See also *Intent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.

(i) See Chap. VIII., p. 115.

(k) *Thompson v. Montgomery*, 45 O. 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 *Ivcell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 105; (1894) A. C. 8; 11 R. P. C. 4; Chitty, J., O. A. and H. L. (*Yorkshire Relish*), above, p. 266.

upon an inquiry whether the conduct and the trade of the applicant were tainted with fraud, as the respondent alleged. "I state my opinion," he said, "that directly it is apparent that any part of the trade-mark is calculated to deceive, it is the duty of the Court to order it to be removed" (l).

So an agreement by which the respondents, the registered proprietors of a mark, appointed the applicants sole agents for the goods which they sold under the mark, and the applicants agreed to sell no goods but those of the respondents under the mark, was held to furnish no answer to an application to remove the mark from the Register, and Chitty, J., said: "This is not a question of equity; this is a question of right under the statute; and the defence, which I find really a difficulty in appreciating, appears to me to fail altogether. I am at a loss to discover how any such agreement as this can displace the applicants' right to have the Register of trade-marks disencumbered of that which is not a trade-mark at all" (m).

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 case of *Paine & Co. v. Daniells & Sons' Breweries* (n), 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 of the application to rectify. And it was assumed by the Court that these persons might have successfully

(l) *Hill's Tm.*, 10 R. P. C. 113 (1893); see also *Eno v. Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890).

(m) *Ainslie & Co.'s Tm.*, 4 R. P. C. 212 (1887).

(n) (1893) 2 Ch. 567; 10 R. P. C. 71, 217. See also *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

opposed the registrations had they known of them and thought fit to do so. In the view which the Court of Appeal took, the defendants had been guilty for years of deliberate infringement of the plaintiffs' trade-mark. The Court refused to direct the marks to be removed, and the following passage from the judgment of Bowen, L. J., fully explains the grounds of their decision:—

“The 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* (o). As a rule, the Court, on being seised of the matter, would doubtless put an end to the existence of a trade-mark which could not possibly be justified by law. But the matter is wholly different when the trade-mark complained of is one which is not in itself illegal or improper, although at the date of registration its registration might have been, perhaps, successfully opposed by some third party who did not in fact oppose it. In such a case, the defect in the Register is not a defect of which the law is bound to take cognizance at the instance of every complainant. Consent by the *Sheffield* company would, in the present case, have removed all difficulty in the registration of the plaintiff's trade-mark (oo). 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 not bound under sect. 90 of the Act of 1883, on the application of an unmeritorious applicant, to displace

The Court has a discretion.

(o) *Supra*, p. 271. Any interest which the public may have in the matter is to be considered: *Harness' Tm.*, 17 R. P. C. 40 (1900).

(oo) The Sheffield company had not registered *John Bull* beer, and therefore the question of conflicting registered marks would not have arisen.

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 (*p*).

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* (*pp*) by the distinction suggested in the judgments in *Paine v. Daniells* (*q*) 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 (*r*). And, in an earlier case (*s*), Kekewich, J., allowed an order expunging a mark from the Register to be varied (subject to any objection being made by the Comptroller) with the consent of the applicant, although he held that, having been used to

(*p*) *Mouson & Co. v. Boehm*, 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J.

(*pp*) See note (*k*), ante, p. 271.

(*q*) See note (*n*), ante, p. 272.

(*r*) *Hodgson v. Sinclair*, 9 R. P. C. 22 (1892).

(*s*) *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.

indicate a design, and not as a trade-mark, it ought not to have been registered.

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 (*t*); but an applicant for rectification is in a somewhat less advantageous position than an opponent to registration (*u*).

The Comptroller's decision is no bar to rectification;

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 (*v*).

nor is five years' registration;

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 (*x*), and marks have been removed or varied after being registered for long periods to the knowledge of the applicant (*y*). But where the objection alleged to a mark is that it is the same as that of the applicant, or that it has such resemblance to his as to be calculated to deceive, it will be some evidence against the applicant, on whom the burden lies of showing that the registration was made without sufficient cause, if he has stood by and allowed the registered proprietor to use the mark objected to for a length of time, especially if no case of actual deception is proved (*z*). Where an opposition to an application to register on such a ground would have been successful two things are to be considered: first, what was the reason of the delay in the application to expunge; and, secondly, whether any substantial injury has

nor, generally, is delay in making the application to rectify;

but delay may have a bearing on the evidence.

(*t*) *Arbenz' Application*, 35 C. D. p. 260; 4 R. P. C. 143 (1887), C. A. (*Gem*).

(*u*) See *Société, &c. de l'Etoile's Tm.*, note (*x*), and cases on delay.

(*v*) Chap. XII., p. 309.

(*x*) *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165 (1889), North, J.; *Société, &c. de l'Etoile's Tm.*, (1894) 1 Ch. 61; 10 R. P. C. 436; (1894) 2 Ch. 26; 11 R. P. C. 142; *Talbot's*

Tm. (1894), W. N. 12; 11 R. P. C. 77, Stirling, J.

(*y*) For instance, in *The Apollinaris Case*, some of the marks removed had been registered for fourteen years; (1891) 2 Ch. 186; 8 R. P. C. 137, C. A. See also *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

(*z*) *Talbot's Tm.*, *supra*, note (*x*).

been caused by the delay to the person who has registered (a). Thus, if the objection depends upon proof of a state of facts at a given time—for instance, upon the question whether an old mark was used before the 13th of August, 1875, in the form registered—after a long lapse of time, and especially if important witnesses have died, the Court will receive the evidence of the applicant upon the point with hesitation (b).

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 (c). 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 (d). And in *The Apollinaris Case*, in dealing with the objection that the company, when only importers, had registered marks belonging to the producers of the goods as their own, Fry, L. J., said (e): “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

Judgment of Fry, L. J., in *The Apollinaris Case*.

(a) *Eastman Photographic Materials Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105, at p. 111 (1898), Romer, J. In *Société, &c. de l'Etoile's Tm.*, *supra*, three years' delay, which was explained by want of knowledge of the registration, was held by Stirling, J., and the Court of Appeal not to disentitle the applicant to relief.

(b) *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(c) 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).

(d) *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890).

(e) (1891) 2 Ch. p. 230; 8 R. P. C. p. 163.

we say nothing, we are of opinion that the course suggested is rendered impossible by the statutory provision for advertisements. To allow a mark which ought not to have been on the Register to remain on by reason of some intervening event would be to preclude the public from challenging the new title of the applicant for registration."

But the rule 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 (*f*).

The Court of Appeal has recently taken the view that an order can be made under the section to remove from the Register a mark the presence of which on the Register is not legitimate, even although the original registration was proper. In *Batt's Trade-Marks*, Lindley, M.R., delivering the judgment of the Court, and referring to the words "entry made without sufficient cause in any such register," said: "We are not disposed to put a narrow construction on this expression, nor to read it as if the word 'made' were the all-important word, and as if the words 'made without sufficient cause' must be read as if they were 'made without sufficient cause at the time of registration,' so as to be confined to that precise time. If any entry is at any time on the Register without sufficient cause, however it got there, it ought, in our opinion, to be treated as covered by the words of the section" (*g*). It is, however, to be noticed that, as pointed out in the judgment referred to, in the view taken by the Court of the facts the decision of the point was not necessary to the decision of the case, and no order has been made, it is believed, for the removal of a mark originally rightly registered (*gg*). In a case decided under sect. 5 of the Act of 1875, where, after an application for

Whether entry, originally rightly made, may be varied.

(*f*) See note (*c*) and the instances cited below, pp. 280 *et seq.*

(*g*) (1898) 2 Ch. 432; 15 R. P. C. 534, Lindley, M. R., Chitty and Collins, L.J.J. The case was affirmed in the House of Lords, but no decision was given on this point.

(*gg*) In *Valentine Extract Co.'s Tm.*,

18 R. P. C. 175 (1901), Farwell, J., the trade-mark *Valtine* was ordered to be removed from the Register, an injunction having been granted at the instance of the applicants against its use (Appendix, p. 760), but they could no doubt have successfully opposed the registration.

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. The proper course to be adopted was the registration of a transmission of title (*i*).

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, 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 (*k*). 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 (*l*). So far

New marks cannot be registered under the section.

(*i*) *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 347 (1881), Hall, V.-C., and see below, p. 283.

(*k*) *The Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. C. 123 (1886), Chitty, J., and C. A.

(*l*) *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. 283; and cf. p. 276. 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 an application to proceed under sect. 62. It seems to

as actual marks are concerned, the reference to entries to be made upon the Register must, therefore, notwithstanding the words quoted above, be taken to refer only to the variation of marks already registered by addition to them.

(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. (m), 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 (n). The proprietor of a registered mark stands, however, in a better position than an applicant for registration, since the Comptroller's discretion (o) 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 (p).

Total removal.

Reasons for removal.

The reasons for removing a mark may be classified as follows: namely, that the registered proprietor is not the person entitled to use it (q); the mark was not capable of registration (r), or it fell within the restrictions forbidding registration contained in the Acts (s); the registration was

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.

(m) Page 69.

(n) *Mouson v. Boehm*, 26 C. D. 398 (1884), Chitty, J.; *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, above, p. 272.

(o) Chap. IV., p. 70; but see above, p. 275.

(p) See *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J. But the onus may be shifted in the course of the hearing: *Dewar & Sons, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session.

(q) Chap. IV., p. 65.

(r) Chap. VIII., p. 115.

(s) Chap. X., p. 211.

procured by a material misstatement (*t*); or the person who registered had no *bonâ fide* intention to use the mark (*u*).

Alteration of circumstances subsequent to registration.

Abandonment or misuser of mark.

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, unless the presence of the mark on the Register has become illegitimate (*x*). The Court of Appeal has held that the words "made without sufficient cause" do not relate merely to the date of registration (*y*), and that there is jurisdiction to rectify although there has been no mistake or error in the original registration (*y*). It has, however, been decided that no events subsequent to the date of registration can be appealed to by the registered proprietor to defend his mark (*z*). It would seem, therefore, that if a registered proprietor ceases to carry on business, or abandons all further intention to trade in the goods for which the mark is registered (*a*), or in any other way renders it improper that the mark should remain on the Register, it can be removed.

Partial removal.

(3) If part only of a composite mark is objectionable, that part may be removed. This course was adopted in *Biegel's Trade-Mark* (*b*), 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

Deceptive mark wholly removed.

(*t*) *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.; *Gordon & Dilworth's Tm.*, 13 R. P. C. 629 (1896); *Eastman, &c. Co. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), cited p. 256.

(*u*) Chap. VIII., p. 119.

(*x*) See the judgment of the Court of Appeal in *Batt's Tms.*, (1898) 2 Ch. 432; 15 R. P. C. 534; *supra*, p. 277.

(*y*) *Batt's Tms.*, see *supra*, p. 277; *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 317 (1881), Hall, V.-C., was to the contrary effect.

(*z*) Above, p. 276.

(*a*) Cf. *Batt's Tms.*, *supra*, p. 277; and as regards the removal of an abandoned mark, see below, p. 348.

(*b*) 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*,

Forrest above and *London* below printed in large letters, and the proprietor, being a Coventry watchmaker, having no connection with the business formerly carried on by *Forrest* in London, the mark was deceptive, *Chitty, J.*, directed the whole mark to be struck out, but without prejudice to any application the respondent might make to register the fir tree alone (c).

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.

(4) Registration with a disclaimer has already been discussed (d). *Edge's Trade-Mark* (e) 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. Mr. Justice Stirling held that the word *filtered* was either descriptive or deceptive, and that the respondent could have no exclusive right to use it. He accordingly directed the first mark to be removed from the Register, and the exclusive right to the use of *filtered* in the other to be disclaimed. So, an order for the disclaimer of the exclusive use of the words *white zinc* or the word *patent* or the Royal Arms was made in the case of an old mark (f). It has in some cases, at the instance of the Comptroller, been made a condition for granting leave to

Registration
of a dis-
claimer.

(c) *Hill's Tm.*, 10 R. P. C. 113 (1893). Such an application was made, but refused: see the report of *Thorneloe v. Hill*, 11 R. P. C. 67.

(d) Chap. IX., p. 197.

(e) 8 R. P. C. 207 (1891), *Stirling, J.* (see above, p. 154); *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), *Chitty, J.* (*Washerine*); *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), *Kay, J.*; *Thompson v. Miller*, 13 R. P. C. 35 (1896),

Stirling, J. (*Roadster*), are other instances. But see *The Smokeless Powder Co.'s Tm.*, (1892) 1 Ch. 590, 9 R. P. C. 109, *Chitty, J.*; *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173, 611, *Kekewich, J.*, and *C. A.* (*St. Raphael*), and *Faulder's Tm.*, 18 R. P. C. 37 (1900) (*Silverpan*), where disclaimers were not ordered.

(f) This appears in the report of *Hubbuck v. Brown*, 17 R. P. C. 148, where the mark is shown,

make alterations in a mark, that an entry be made of a statement of the essential particulars and a disclaimer of the exclusive use of the added matter (*g*); the principle being that the applicants should put themselves in the same position as if they were registering under the Act for the time being in force. As a rule the Comptroller opposes the registration of a disclaimer not authorized by the Act under which the mark was registered (*h*).

Limitation of the registration—
to particular goods;

(5) A limitation restricting the registration of a trade-mark to those goods for which the registered proprietor actually used the mark, and to which alone the goodwill of the business transferred to him with the mark by the former proprietor extended, was adjudged to be notified upon the Register in *Edwards v. Dennis* (*i*). And in *The Milkmaid Brand Case* (*k*), where the defendant's mark too nearly resembled the previously registered mark of the plaintiffs, it was ordered that the registration of the former should be confined to goods for which the plaintiffs' mark was not registered. In *Banks and James' Trade-Mark* (*l*) the registration of a mark registered for cigars, cigarettes, and tobacco was, on a motion to rectify, and with the consent of the proprietor, ordered to be limited to cigars (*m*).

to particular market.

So the Court has under the section ordered 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 (*n*).

Variation in form of mark.

(6) The only variation in the form of a registered mark

(*g*) *Colman's Tms.*, (1891) 2 Ch. 402; 8 R. P. C. 209, Kekewich, J.; *Orlando Jones & Co.'s Tms.*, 12 R. P. C. 278 (1895), Stirling, J.

(*h*) See *Clement et Cie.'s Tm.*, 16 R. P. C. at p. 176.

(*i*) 30 C. D. 454 (1885), C. A.

(*k*) *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.

(*l*) 12 R. P. C. 333 (1895), Chitty, J.

(*m*) And in *Batt's Tms.*, 15 R. P. C. 534 (1898), one of the marks was

only expunged as regards goods in one class.

(*n*) *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1885), Chitty, J.; cross undertakings for local user. As to entering such undertakings or at all events those referring to locality, on the Register, see *Dawhurst's Tm.*, (1896) 2 Ch. 137; 13 R. P. C. 288, and *supra*, p. 219; and *Eastman, &c. Co., Ltd. v. J. Griffiths' Cycle Corporation, Ltd.*, 15 R. P. C. at p. 109 (the Comptroller's objection).

ordered under sect. 90 which occurs in any reported case is variation by striking out part of the mark (*o*). 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 (*p*), and which had not been approved by the Comptroller.

(7) A variation of the date of registration was directed in *Hayward's Case* (*q*). 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 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 date of entry.

(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 (*r*). 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 (*s*). 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

Variation of name of proprietor.

Registration in the wrong name.

(*o*) See above, p. 280; and as to alterations under sect. 92, see below, p. 297.

(*p*) See above, pp. 276 and 278.

(*q*) 54 L. J. Ch. 1003 (1885), Kay, J.

(*r*) *Rivière's Tm.*, 55 L. J. Ch. 545, cited above, p. 269; *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

(*s*) *Marler's Tm.*, 44 L. T. 98, n. (1878). In the case of a design the name has been altered in the absence of fraud: *In re Grocott's Design*, 17 R. P. C. 139 (1900); but different considerations apply in the case of designs, and the case does not affect the practice as to trade-marks.

instead of his firm's (*l*), or by an agent acting for two principals, in the name of the wrong principal (*u*). 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 (*r*). 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" (*r*); 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 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 (*y*). But in a later case, North, J., held that on an alteration of the name of a limited company, the proprietors of a trade-mark, the Comptroller can enter the new name of the proprietors on the Register under sect. 87; and unless he refuse, the Court cannot order rectification under sect. 90 (*z*). In *Re The Australian Wine Co.* (*a*) 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

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

(*u*) *Kingsford & Son's Application*, 6 R. P. C. 413; 41 L. T. 426 (1880), Kay, J.

(*r*) *Greenlee's 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.

(*r*) *Rust's Tm.*, 44 L. T. 98, n. (1880).

(*y*) *Plumbago Crucible Co.'s Tm.*, 7 R. P. C. 282 (1890); followed by Kekewich, J., in *Buryon v. Wilkinson*, 40 Sol. J., p. 336 (1894); cf. applications under sect. 92, below, p. 297.

(*z*) *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 520; 13 R. P. C. 475.

(*a*) 61 L. T. 427, n. (1885).

in lieu of that of the purchaser of the consignee's business, on the ground that the mark had been registered for the benefit of the owner of the vineyard, not for that of the owner of the business.

And in a case where the registered proprietor of a mark had assigned her business and the use of the mark for six years to the respondents, and they had procured the registration of their own names as assignees, upon their application it was ordered that the Register should be rectified by removing their names and restoring that of the original proprietor (*b*).

Where an assignor by mistake purported to assign a mark and goodwill after a previous agreement to assign to a third person, and the assignee was registered as proprietor, his name was expunged on the application of the executors of the person with whom the agreement had been made, the second assignment being inoperative by reason of there being no goodwill to assign (*c*).

Procedure on an Application under sect. 90.

"The Court" in England is Her Majesty's High Court of Justice (*d*), or, with reference to marks of which the registration was applied for in the Manchester Trade-Marks Office (*e*), the Palatine Court of Chancery (*f*); and those Courts have jurisdiction to rectify a registered mark, whether the registered proprietor is domiciled or resident in England, or in Scotland, or Ireland, or elsewhere (*g*); although where he is domiciled or resident in Scotland or Ireland, the Scotch or Irish Courts have, perhaps, a concurrent jurisdiction (*h*). This last point has not, however, been decided by an English Court, but it has been held in Ireland that

(*b*) *Re Arril*, 20th April, 1888, *sect. 20.*
Stirling, J.; *Sebastian*, 4th ed. pp. 374, 382.

(*c*) *Harnes' Tm.*, 17 R. P. C. 40 (1900), *Farwell, J.*

(*d*) *Sect. 117.*

(*e*) *Chap. VII.*, p. 112.

(*f*) *Sect. 112a; Act of 1888,*

(*g*) *Re King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350, *Keke-wich, J.*, and C. A. As to notice of motion in such cases, see below, p. 289.

(*h*) See the case last cited, and *sect. 111 (2).*

the jurisdiction is a special one conferred only on the High Court of Justice in England, and that the Irish Courts have no jurisdiction (*i*). In Scotland, however, although the jurisdiction was assumed in one case without objection (*k*), the point has not been otherwise decided, but it has been held that, assuming that the Scotch Courts have no jurisdiction under sect. 90, they have, nevertheless, jurisdiction to make a declaration as to the invalidity of an entry in the Register, and that an entry ought to be expunged, and that on such declaration sect. 111, sub-sect. 2, becomes applicable (*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 originating summons, or by notice of motion (*n*). There is no reported English case where the application has been made by action (*l*); 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 ex-

(*i*) *Bayer v. Connell Bros.*, 14 R. P. C. 275 (1897), Porter, M. R.

(*k*) *Cowie Bros. v. Herbert*, 14 R. P. C. 436 (1897), Lord Kincairney (Lord Ordinary).

(*l*) *Dewar & Sons, Ltd. v. J. H. Dewar*, and *J. H. Dewar v. Dewar & Sons, Ltd.*, 17 R. P. C. 341 (1900), Lord Kyllachy (Lord Ordinary) and the Inner House (The Lord President

and Lords Adam, Maclaren, and Kinnear). There was a claim for reduction of the entry in the Register, which the Court thought to be unnecessary.

(*m*) As in *Pinto v. Badman*, 8 R. P. C. 181 (1891).

(*n*) Per Kay, L. J., in *King & Co.'s Tr.*, (1892) 2 Ch. p. 488; 9 R. P. C. 350.

pensive, would have to pay the extra costs incurred, even though he were successful.

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.

Not by counterclaim.

Applications under the section are frequently made both by originating 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, they direct it to be placed in the non-witness list.

By summons or motion.

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*).

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.

Notice to the Comptroller.

It is proper, when the registered proprietor of the trade-mark in question is resident within the jurisdiction, to serve

Service on the registered proprietor.

(*o*) Ord. 5, r. 9 (b); Rules of P. C. 350. Form, p. 742.
1893, Ord. 54, rr. 4 (b) to (c).

(*q*) Ord. 52, r. 5.

(*p*) Ord. 5, r. 9 (b) (c); *King & Co.'s Tm.*, (1892) 2 Ch. 469; 10 R.

(*r*) See *King & Co.'s Tm.*, *supra*, note (*n*).

Where the proprietor is resident abroad.

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.

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, nor is it necessary to enable the Court to entertain the application in question (*s*). 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 solo respondent, but that information of the application should be given to the company (*t*). This course was adopted and approved in *King & Co.'s Case* (*u*), 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 (*r*). 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

(*r*) See *King & Co.'s Tm.*, *supra*, note (*n*).

(*s*) See *King & Co.'s Tm.*, *supra*; and *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J. And the steps taken by the applicant in *Ashton's Tm.*, 48 W. R. 389 (1900),

where the registered proprietor, resident abroad, could not be traced.

(*t*) (1891) 3 Ch. 451; 8 R. P. C. 446.

(*u*) *Supra*, note (*n*).

(*x*) Cf. Ord. 52, r. 3.

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 (y). He said, "If you go down to the root of the argument there is nothing in it except a false analogy based on the supposition that, because the notice of motion is marked by an English judge, the parties interested must be technically named at the foot of it as respondents, and you must get leave to serve them if they are to be affected by it. It appears to me that all that they want for the purposes of this Act is notice, and that they have had" (z).

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 (a); but if he appeal from an order made on the motion, he may be ordered to give security (b).

Security for costs by foreigner.

The Court has in several cases refused to allow actions for infringement to be brought or proceeded with in England where it has considered the Scotch or Irish Courts to be more convenient, notwithstanding that motions to rectify were pending in it with regard to the same matters (c).

Action for infringement in Scotland or Ireland.

Evidence on the Application.

The evidence is, in accordance with the usual rule, generally given in the first instance by affidavit, subject to cross-

(y) (1892) 2 Ch. p. 482.

(z) 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.

(a) *Société, &c. de l'Étoile's Tm.*, 10 R. P. C. 290 (1893), Stirling, J.; *Miller's Patent*, W. N. (1894) 4; 11 R. P. C. 55, Kekewich, J.

(b) In *Société, &c. de l'Étoile's Tm.*, 11 R. P. C. 142, an order was made by consent, the appellants having no place of business in England. On the other hand, in *Re Apollinaris Co.'s Tms.*, (1891) 1 Ch. 1, a foreign applicant who appealed was not ordered to give security, he having ample assets within the jurisdiction.

(c) *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.

examination of the deponents if ordered by the Court or a judge (*d*). But applications under the section are very frequently heard upon *virâ voce* evidence given in Court. And the Court has, by the terms of the section (*e*), 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. Where an action is pending by the proprietor of the mark against the applicant, it is very usual, especially in cases where the application to rectify depends on questions of fact, to order the application to stand over until the trial, and to come on to be heard with the action, with leave to use the affidavits and cross-examine on them, and to adduce oral evidence.

Declarations
of the pro-
prietor.

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 (*f*).

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., announced that he would not allow the rule to be departed from by permitting evidence to be filed subsequently (*g*).

Discovery.

In a proper case discovery of documents may be ordered to be made by either party to the application (*h*). In *Wills' Trade-Marks* (*i*), on an application by notice of motion to remove certain marks from the Register, and after the evidence had been completed (except as to the cross-examination of two witnesses, which was to be taken in Court), the applicants took out a summons for an order for discovery of documents by the respondents, the proprietors of the marks. Kekewich, J., required the applicants to make a statement in writing of the grounds upon which they sought to have the

(*d*) Ord. 38, r. 1.

(*e*) Sect. 90 (2).

(*f*) *Thewlis & Blakey's Tm.*, 10 R. P. C. p. 373 (1893), North, J.

(*g*) *Jackson & Co. v. Napper*, 35 C. D. p. 166 (1886).

(*h*) Ord. 31, r. 12; see *Re Norwich Town Close Estate Charity*, 40 C. D. 310 (1889).

(*i*) (1892) 3 Ch. 301; 9 R. P. C. 346.

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 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.

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 (*k*). Particulars.

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 (*l*). 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 (*m*). Order to be served on the Comptroller.

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

(*k*) *Humphries v. The Taylor Drug Co.*, 39 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J., an action for infringement. See also *Whitstable Oyster Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461 (1900), Buckley, J., a passing off case.

(*l*) Rule 46.

(*m*) Rule 50.

as between party and party were given as damages (*n*); but these cases were overruled (*o*); and, though it has since been held (*p*) 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.

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 (*q*).

Certificate.

A certificate that the right to the exclusive use of a trade-mark has come in question can only be granted under sect. 77 (a) in an action for infringement of the mark; but where the defendant in an action for infringement moved to expunge the plaintiffs' trade-mark, and the action and motion were ordered to be heard together on the same evidence, and the plaintiffs' trade-mark was held to be properly registered, it was held that, although the mark had been registered for five years, and the right to the exclusive use of it could only be challenged on the motion to expunge it, a certificate could, under the circumstances, be granted (*r*).

(*n*) *E.g.*, *Anderson's Case*, 17 C. D. 373 (1881).

(*o*) *Corkburn v. Edwards*, 18 C. D. 449 (1881); *Buckley on the Companies Acts*, 7th ed. p. 155.

(*p*) *Andrews v. Barnes*, 39 C. D. 133 (1888), *Kay, J.*, and C. A.

(*q*) *Ottos Kopje Diamond Mines, Ltd.*, (1893) 1 Ch. 618, a company case.

(*r*) *Field, Ltd. v. Wager Syndicate, Ltd.*, (1900) 1 Ch. 651; 17 R. P. C. 266, *Buckley, J.*; and see Chap. XV. p. 436.

Costs (s).

The ordinary rule that the unsuccessful party must pay the costs of the proceedings is rarely departed from (*t*), 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 (*u*); and costs were refused to applicants who had asked by their notice of motion not only for the expunging of the proprietor's name, but also for the entry of their own names on the Register, and they were ordered to pay the Comptroller's costs (*v*); also, 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 (*x*). 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

(s) See also Chap. IV. p. 93; and Chap. XV. p. 429.

(*t*) *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878); *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878), both Jessel, M. R.; and where the mark is expunged costs may be given not only against the registered proprietor, but against another person who has claimed to be interested in the mark and brought proceedings in consequence: *Davis' Tms.*, 14 R. P. C. 903 (1897), North, J. (*Compactum*). As to whether an order for rectification is a "final judgment" within sect. 4, sub-s. 1 (8) of the Bankruptcy Act, 1883, cf. *Re Owen*, Sol. J. Vol. 45, p. 103, Dec. 8, 1900.

(*u*) *Humphrics v. Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); see also *Perry Davis' Tm.*, 5 R. P. C. 337; 58 L. T. 695 (1888), Kay, J.

(*v*) *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

(*x*) *Gianaelis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889); and in *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J., whilst giving the costs of the motion to the defendant in the action, added a direction that such costs were not to include the costs of the affidavits used, except so far as should be directed at the trial,

given, because the objection was not urged in the Court below, and the rest of the appeal was dismissed with costs (*y*).

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 (*z*).

In *Talbot's Trade-Mark* (*a*), 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. 289.

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 (*b*), except under the Supreme Court of Judicature Act, 1899 (*c*), under which the consent of all parties is requisite. The appeal must be brought within fourteen days, and must be by a fourteen days' notice of motion (*d*).

The Court may stay execution of its order to rectify pending an appeal, and it will sometimes do so (*e*), but the

Stay of
execution.

(*y*) *Thompson v. Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1888); Chitty, J., and C. A. (*Stone Ale*).

(*z*) 10 R. P. C. 113 (1893), Chitty, J.

(*a*) W. N. (1894) 12; 11 R. P. C. 77, Stirling, J. (*Emoliolorum*).

(*b*) *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.

(*c*) 62 Vict. c. 6. As to the necessary consents, &c., see *Re Hope*, 43 Sol. J. 649; W. N. (1899) 113.

(*d*) Ord. 58, rr. 3, 9 and 15; see *Re Blyth and Young*, 13 C. D. 416 (1879); and *Onslow v. The Commis-*

sioners of the Inland Revenue, 25 Q. B. D. 465 (1890); and cf. *Arbens' 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).

(*e*) *Harrison v. Woodroffe*, 7 R. P. C. 25; 42 C. D. 691 (1889), Kekewich, J.; see also *In re Tm. Borril*, 13 R. P. C. 387; 74 L. T. 805 (1896), where Kekewich, J., said that if he had decided that the mark ought to be removed he should have stayed execution.

appeal itself does not act as a stay (*f*). In *Re Palmer's Application* (*g*) the Court of Appeal, having reversed the decision of the judge of first instance on a preliminary objection, refused to stay the proceedings on the merits before the judge pending an appeal to the House of Lords against their decision.

Security for costs of the appeal may be ordered under special circumstances (*h*).

2. Correction and Cancellation of Entries at the Proprietor's Request.

By sect. 91 (b) and (c) (*i*) 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—

“The Comptroller may, on request in writing accompanied by the prescribed fee (*h*)— Sect. 91.

“(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 (*l*) 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.”

Rule 48 directs the Comptroller to enter any alteration of the address of the registered proprietor on application (*m*) and payment of the prescribed fee (*m*). Alteration of address.

(*f*) Ord. 58, r. 16.

(*g*) 22 C. D. 88 (1882).

(*h*) Ord. 58, r. 15. Security was ordered *In re Tm. Borril*, 13 R. P. C. p. 387. As to such security in the case of foreigners, see *supra*, p. 289.

(*i*) Sub-sects. (a) and (d) deal with the correction of errors in or in con-

nection with an application to register, and the omission of any of the goods referred to in it.

(*k*) 5s.

(*l*) Rule 61. Forms O. and P., Appendix, p. 710.

(*m*) 5s. Form M., Appendix, p. 709.

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.

Amendment
or cancella-
tion only at
the proprie-
tor'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.

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 (*n*), 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.

Where the registered proprietor is desirous of cancelling the mark only with a view to another registration, as, for instance, a registration on dissolution of partnership, the existing registration being an obstacle to the intended registration, it is doubtful whether he could make an application under sub-sect. (c) for the cancellation conditional on the other registration being effected; but in the course of the proceedings for registration of the new mark the result might perhaps be arrived at, assuming no other objection to be taken by the Comptroller, by an acceptance by him conditional on the proper application for cancellation being made (*o*).

(*n*) Thus, on a dissolution of partnership, the partners might wish to get rid of a mark registered in the partners' names, in order to give effect to some arrangement between

them on the dissolution, and this could no doubt be done under this section: *Ehrmann's Tms.*, (1897) 2 Ch. 495; 14 R. P. C. 665.

(*o*) The matter was considered in

3. Alterations in Non-Essential Particulars.

Sect. 92 provides that—

“(1) The registered proprietor of any registered trade- Sect. 92.
mark may apply to the Court for leave to add to or alter
such mark in any particular, not being an essential par-
ticular 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 (*p*), 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. It appears to be confined to altera-
tions in a mark and not to extend to any alteration of an
entry in the Register (*q*).

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 (*r*), 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 (*s*). What is an
essential
particular.

As regards an old mark registered under sect. 64 (3) (ii.), Alteration of
old marks.
no part of the mark is specified as an essential particular, and

Ehrmann's Tms., *supra*, where the
Comptroller refused to accept an
undertaking to cancel the existing
marks.

(*p*) 10s.

(*q*) *New Ormonde Cycle Co.'s Tm.*,
(1896) 2 Ch. 521; 13 R. P. C. 475,
North, J. See, however, *National
Wholesale Tea Supply Association's
Tms.*, 10 R. P. C. 164, (1893) Chitty,
J.; and *Patent Plumbago Crucible*

Co.'s Tms., 7 R. P. C. 282 (1890),
Stirling, J.

(*r*) 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, there-
fore, cannot be altered, above, p. 131.

(*s*) Chap. VIII. p. 124.

“essential” must therefore be read as equivalent to “substantial” (f) 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 (g). In the absence of special circumstances, therefore, no alteration at all should be permitted (x). 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 an old mark where the proprietors had assigned their rights to a company bearing their old firm name with that addition (y); 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 (z); and has allowed the addition of *and Son* to a name, and the substitution of new addresses for former ones (a); and in *Orlando Jones & Co.’s Trade-Marks* (b), it allowed certain words to be added to two marks registered as old marks. But the Court has refused to expunge *trade-mark* so printed upon a label as to suggest that part only of the matter of the label was the trade-mark (c), in a case where the mark had stood for twelve years on the Register (d); or to strike out *patent* printed as part

“Trade-mark.”

“Patent.”

(f) *Adams’ Trade-Mark*, 11 H. L. 171, 40 L. J. 110 (1872), *Wheeler, J.* Cf. per Lord Cairns in *The King v. The Registrar of Trade-Marks*, 4 App. Cas. 410 (1910).

(g) *Phillips’ Trade-Mark*, 11 H. L. 171, 40 L. J. 110 (1872), *Wheeler, J.* Cf. *Adams’ Trade-Mark*, 11 H. L. 171 (1872).

(h) *Phillips’ Trade-Mark*, 11 H. L. 171, 40 L. J. 110 (1872), *Wheeler, J.* Cf. *Adams’ Trade-Mark*, 11 H. L. 171 (1872).

(i) *Phillips’ Trade-Mark*, 11 H. L. 171, 40 L. J. 110 (1872), *Wheeler, J.*

(j) *Stevens’ Trade-Mark*, 11 H. L. 171, 40 L. J. 110 (1872), *Wheeler, J.* The Comptroller objected to inserting out, were to leave blank space.

(k) 11 H. L. 171, 40 L. J. 110 (1872), *Wheeler, J.* The words added were “The label is owned only by the King & Co., Ltd.” There appears to have been no objection by the Comptroller. Presumably the matter had been raised with the Comptroller, but he had not objected.

(l) *Phillips’ Trade-Mark*, 11 H. L. 171, 40 L. J. 110 (1872), *Wheeler, J.* The Comptroller had no objection to the

the application, while on applications under sect. 92 he is himself the applicant, and there is usually no respondent other than the Comptroller.

Fourteen days' notice of the intended application must be given to the Comptroller (r), 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 (y). 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 (z).

Notice of the application and order to 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 (a).

Advertisement by the Comptroller.

The Comptroller is entitled to appear and to be heard 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 (b) 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 inducing the Court to accede to the application.

The Comptroller may appear on the application.

The applicant is always directed to pay the costs of the Comptroller, if the Comptroller appears (c).

The applicant must pay his costs.

(r) Sect. 92 (2), and Rule 61, p. 700.

(y) Rule 61.

(z) Rule 60.

(a) Rule 60.

(b) See *Reed's Law*, 2d Ed. p. 201.

supra, p. 200, note 1.

(c) *Practice as to costs, see above*,

p. 200.

CHAPTER XII.

EFFECT OF REGISTRATION.

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Object of the
Act

The principal object of the Registration Act was not to
create new rights, but to regulate the use of, and the mode

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—

Scot. 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

Hudson’s Case.

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 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

(g) Chap. II. p. 28
 (h) *Hudson’s Case*, 32 L. T. 311, 312 (1876), 31 L. T. 102 (1876), 1 L. A.
 (i) Act of 1875, s. 75
 (k) *Id.*, the principal Act, the Act of 1875, see Act of 1875, s. 75
 (l) Report of 1875, p. 10
 (m) *See Hudson’s Case*, 32 L. T. 311, 312 (1876), 31 L. T. 102 (1876), 1 L. A.
 (n) 32 L. T. 311, 312 (1876), 31 L. T. 102 (1876), 1 L. A. The application was made, and the case was decided, under the Act of 1875
 (o) *Id.*, of the Act of 1875

the judgment, said: "Although sect. 75 of the Act of 1883 said that 'registration of a trade-mark shall be equivalent to public use of the trade-mark,' this language, even when in force, did not and could not mean that continued registration was equivalent to continued use. So to construe the language would lead to the irrational conclusion that a man might properly register a trade-mark for any goods he chose, although he carried on no trade or business in them at all. . . . Sect. 75 was addressed to the time of registration; it substituted registration for previous user and reputation gained by it." And it was pointed out that the alteration of the section by the Act of 1888 made the matter still plainer.

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 *prima 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 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 (a); the provision of sect. 65 that a trade-mark must be

(a) *Trade-Mark Act, 1875, s. 3; Jackson v. Phillips, 21 Q.B. 339; and see also Dyer v. Carter, 11 Q.B. 339; 11 Q.B. 339; and see also Dyer v. Carter, 11 Q.B. 339; 11 Q.B. 339.*

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 (x).

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 (y), 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 (z).

Further, if the mark is actually used for certain descriptions of goods only, although registered for others also, the exclusive rights conferred by the section do not extend to the latter. Thus, where the plaintiff in an action was the assignee of a mark registered for "unwrought and partly wrought metals used in manufacture," and, in fact, he only used it upon sheet iron goods, his business being confined to such goods, and the defendant was the agent of the proprietors of a similar mark subsequently registered for steel and iron wire, and had sold wire with the latter mark upon it, it was held that the plaintiff had no cause of action, and an order was made that the registration of the plaintiff's mark should be rectified by confining it to sheet iron (a).

In the case just cited the plaintiff was assignee of the registered mark, and the decision turned to some extent upon the rule that a registered mark can only be assigned in connection with the goodwill of the business concerned in the

Right limited to goods for which the mark is registered.

Registration restricted to goods for which the mark is used.

Edwards v. Dennis.

below, p. 310, and the "three mark rule," Chap. X, p. 214.

(x) See p. 300.

(y) *Hart v. Cell*, 11 C. D. 103, 7 R. P. C. 34 (1890), South, J. "The right of opposing an application for registration of another mark relates, however, to the same description of goods, not to the same description of goods, see p. 310, Chap. X, p. 214.

(z) *Day v. Miller*, 19 R. P. C. 610, 11 R. P. C. 100 (1890), Hickson, 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 facts of the case are stated below.

Edwards v. Dennis, 11 R. P. C. 100 (1890), A.

goods for which it has been registered (*b*), 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 (*c*). This opinion was subsequently adopted and followed by Chitty, J., in the case of *Hargreaves v. Freeman* (*d*); and in *Batt & Co.'s Trade-Marks* (*e*), the Court of Appeal considered that the principle of the decision in *Edwards v. Dennis* was that the original proprietor ought not to have registered the mark for goods with which he had no concern, and, applying it to the case before them, they upheld the removal of certain marks from the Register on the ground that there had been no user and no intention to use them (*f*).

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 (*g*) of registration of his mark, and that will be *prima facie* evidence of his title (*h*).

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 (*i*). Thus, in the case just cited (*h*), 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

(*b*) Sect. 70.

(*c*) *And see Hudson's Trs.*, 32 Q. B. at p. 310 (1880), and *supra*, p. 306.

(*d*) (1891), 3 Ch. 39; 8 R. P. C. 237.

(*e*) *See supra*, note (*c*).

(*f*) The decision was affirmed in the House of Lords. *See supra*, note (*c*).

(*g*) Sect. 76, sub. 60.

(*h*) *Paty v. Hudson*, 8 R. P. C.

161 (1891), C. A.

(*i*) Thus, in *Lever v. Hudson*, 30 C. D. 1; 4 R. P. C. 402 (1880), Chitty, J., held that the words *Salf Washer*, although they had been two years on the Register, were not a trade-mark. The case nevertheless succeeded on the ground of passing off. *See further* the chapter on Infringement, p. 301, note *d*.

(*h*) *Paty v. Hudson*, *supra*, note (*h*).

without assigning the goodwill of the business. It followed, therefore, that the assignment was a nullity (*l*), and, as the registration was less than five years old, the *primâ facie* title conferred by it was consequently rebutted by the evidence furnished by the plaintiffs' own case.

If the Register shows that the registration was five years old at the date when it is put in evidence (*m*), 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 the registration has been made without sufficient cause (*n*), 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 (*nn*). But as regards Scotland this statement as to the effect of five years' registration is subject to a qualification occasioned by a decision of the Court of Session to the effect that the Scotch Courts have jurisdiction, notwithstanding that a mark has been five years on the Register and that there is no application before the Court to remove it, to make a declaration that the registration of the mark was invalid (*o*). The decision was put upon the ground that the words "subject to the provisions of this Act" preserved, under sect. 111, to the Scotch Courts a jurisdiction to make such a declaration.

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 of the Act of 1875, notwithstanding the dictum to the contrary of Jessel, M. R., in *Hyle's Trade-Mark* (*p*), 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

Five years' registration.

Register may be rectified at any time.

(*l*) Sect. 70, and Chap. XIII. p. 324.

(*m*) Chap. XI. p. 264.

(*n*) See *Haguard's Case*, 64 L. J. Q. B. 1003 (1886), Kay, J., where a note protesting the registration was inserted in the Register, cited above, p. 264.

(*nn*) Above, note (*k*).

(*o*) *Hewer & Sons, Ltd. v. J. H. Hewer* (1900), 17 R. P. D. 341. See *supra*, p. 260.

(*p*) 7 Q. B. 726 (1876).

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 year 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 removed, *Hill's Tm.* (*ante*, p. 260), and *Wills' Tm.* (*ante*, p. 258); device of anchor, removed, on the ground of being common to the trade when registered, *Hughes and Young's Tm.*, 10 R. P. C. 369 (1893), North, J.; SHAKSPERE, removed, because not a fancy word not in common use, *Banks and James v. Anstie*, 12 R. P. C. 333 (1895), Chitty, J.; rectification of registration of mark containing ROADSTER by disclaimer of that word, *Thompson's Tm.*, 13 R. P. C. 35 (1896), Stirling, J.; marks removed on the ground that they had not been used before the Act of 1875, although registered as so used, *Gordon and Dilworth's Tm.*, 13 R. P. C. 629 (1896), Chitty, J.,

and *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J.; COMPACTUM, and a mark containing that word, removed, because that word was descriptive of an article formerly patented, *Davis' Tms.*, 14 R. P. C. 903 (1897), North, J.; TRITICUMINA, removed, because not a fancy word not in common use, *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898), North, J.; marks removed as to one class on the ground that there had never been any *bonâ fide* intention of using them on goods in that class, *Batt & Co.'s Tms.* (*ante*, p. 305); DAY & SONS' BLACK DRINK, expunged, because not used before the Act of 1875 as a trade-mark, but registered as having been so used, *Day v. Riley and Whittaker*, 17 R. P. C. 517 (1900), Buckley, J.; mark expunged on proprietor's admission that it could not be supported, being deceptive, *Day v. Riley and Whittaker, supra*; VASELINE, removed, because it was the name of the article, *Cheseborough Manufacturing Co.'s Tm.*, 18 R. P. C. 191 (1901), Buckley, J.

In most of the earlier 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 *Eaker 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 (*q*), 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.

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 (*r*).

Sect. 76 is subordinate to sect. 90.

Registration conclusive if no application under sect. 90.

(*q*) *Wragg's Case*, *ante*, p. 310, was decided under the Act of 1883.

(*r*) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; see also

Leahy, Kelly and Leahy v. Glover, 10 R. P. C. 141 (1893), H. L. See as to Scotland, however, the case cited in note (*o*).

3. Registration as 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) (s) an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate (t) that such registration has been refused.”

The corresponding sections of earlier Acts.

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.”

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 (u); and by the Act of 1876 (x), 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

(s) *Sic*, without the brackets.

(t) See p. 315.

(u) 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.

(x) 39 & 40 Vict. c. 33, s. 1.

the policy of the Acts to preserve old trade-mark rights substantially without alteration (*y*).

By the Act of 1877 (*z*), 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.

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 (*a*). 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. Act of 1688.

The prohibition of the section does not in express terms extend to (a) any new (*b*) 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.

(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 (*c*), shall not be the subject of trade-mark rights, yet the general words of prohibition, as also the savings contained in the section, plainly show that this was the result contemplated by the draftsman. And the Acts have always

New marks,
incapable of
registration,

(*y*) See per Lord Blackburn, *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. p. 498 (1879); see Chap. XI. p. 298.

(*z*) 40 & 41 Vict. c. 37.

(*a*) Act of 1888, ss. 27 and 28.

(*b*) *I.e.*, not used as a trade-mark before 13th August, 1875.

(*c*) Chap. IV. p. 63.

been regarded as limiting the classes of symbols in respect of which trade-mark rights can be, or since they came into operation can have been, acquired and enforced (*d*) by the descriptions comprised in their several definition clauses (*e*).

are within the prohibition.

Thus, Cotton, L. J., said, in *Van Duzer's Case* (*f*): "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."

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" (*g*) by the use of his trade-mark (*h*). The question has, however, so far as the writer is 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 (*i*).

But it has been held that trade-marks, whether capable of registration or not, may be acquired apart from registration (*j*), although proceedings for infringement cannot be taken.

(*d*) A trade-mark can still be acquired by use: *Sen Sen Co. v. Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137; but the trade-mark rights cannot be enforced except as provided by sect. 77.

(*e*) In *The Normal Co.'s Tm.*, 35 C. D. 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 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."

(*f*) 34 C. D. 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.

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

(*h*) Chap. XVI. p. 446.

(*i*) *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, Lindley, L. J.

(*j*) *Sen Sen Co. v. Britten*, (1899)

It will be noticed that the wording of the first saving in terms refers only to marks capable of being registered under the Act of 1883, and does not expressly extend to marks capable of registration and registered under a repealed Act; but by sect. 114 the former Register is continued and the intention clearly seems to be to include all such marks (*k*). Moreover, the Act of 1883 is in only one respect (*l*) narrower, as regards the marks capable of registration, than that of 1875.

(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 single letters and figures and combinations of letters and figures excluded by the Act of 1875, as old marks, are now admitted to registration (*m*).

Old marks
refused
registration.

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 (*n*); but the suggestion was not adopted. The fees payable for the certificate of refusal

Certificate of
refusal.

1 Ch. 692; 16 R. P. C. 137, Stirling, J.; and see *infra*, p. 316.

(*k*) See also sect 113.

(*l*) In respect of signatures.

(*m*) Lord Blackburn, in his judgment in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 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 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. And, indeed, the word "other" in the latter section only seems to be satisfied by being read as referring to marks incapable of registration under the Act of 1883. If such be the correct construction the second saving only extends to old marks incapable of registration which have been refused, old marks capable of registration falling under the first saving if registered. It may be, however, that the words capable of being registered under this Act refer only to marks capable of being registered as new marks, and that any old mark might come under the later part of the section.

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

are 1*l.* for one mark, and 10*s.* in addition for each mark beyond the first. The form of application is Form L. (o).

It was suggested by Malins, V.-C., in *The Twentsche Stoom Bleekery Goor v. Ellinger & Co.* (p), 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 (q).

Registration
a condition
precedent to
action;

The section makes registration, in the cases falling within it, a condition precedent (r) 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 (s). 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 (t).

not to acqui-
sition of a
trade-mark.

The section does not enact that a man shall not have a trade-mark until he registers (u), and it has been compared (u) to sect. 24 of the Copyright Act, 1842 (v), which is satisfied by a registration made subsequently to the wrongful act complained of, but before the commencement of the action. If a person has adopted and used words as a trade-mark in this country, but has not registered them as a trade-mark, it does not necessarily follow that, by describing such

(o) Appendix, p. 709.

(p) 26 W. R. 70 (1877).

(q) See *Goodfellow v. Prince*, note (s); and Chap. XV. p. 357.

(r) Per Lord Blackburn in *Orr-Ewing's Case*, note (m).

(s) *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

(t) *Hargreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; cf. *Jay v. Ladler* and *Hart v. Colley*, cited below, p. 319, note (j). That

the registration was blocked by delay at the office was considered to be no excuse: *Hazzopulo v. Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.

(u) *Sen Sen Co. v. Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137, Stirling, J.; and per Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. at p. 405 (1890). See also Cotton, L. J., in *Hudson's Tms.*, 32 C. D. at p. 320; 3 R. P. C. at p. 161 (1886).

(v) 5 & 6 Vict. c. 45,

words on the goods as his trade-mark, he is making a misrepresentation (*x*).

Only the registered owners, or the assignees of the registered owners, of the trade-mark can sue in respect of an infringement of it (*y*), but it is not necessary that an assignee should have registered the assignment before commencing his action (*z*).

Only the registered proprietor or his assignee can sue.

The judgment of North, J., in the case last cited seems to go further and to be founded on the view that an unregistered assignee can sue. In *The Magnolia Metal Company v. Atlas Metal Company* (*a*), however, Collins, J., dismissed the action as to trade-mark on the ground that the plaintiffs had not at the date of judgment been registered as proprietors of the marks sued on (*b*). *Ihlee v. Henshaw* (*z*) does not seem to have been cited, and the two cases appear to conflict, for sect. 77 expressly refers to the institution of proceedings, and therefore, if registration of an assignment is necessary at all, it would appear to be necessary before the action is commenced.

The Prohibition does not affect Passing Off Actions.

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

(*x*) *Sen Sen Co. v. Britten*, *supra*, note (*n*), distinguishing and explaining *Lewis v. Goodbody*, 67 L. T. N. S. 194, Kekewich, J. See observations of Kekewich, J., on the last-mentioned case, in *Hubbuck v. Brown*, 17 R. P. C. at p. 156 (1900).

(*y*) *Richards v. Butcher*, 7 R. P. C. 288; 62 L. T. 687 (1890), Kay, J. Action by sole purchasers from registered proprietors. Leave to add

the proprietors.

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

(*a*) 14 R. P. C. 389 (1897).

(*b*) It appears from the report of *Magnolia Co.'s Tms.*, 14 R. P. C. at p. 266, however, that the plaintiffs were registered as proprietors on the day before the trial; but it is presumed that this fact was not in evidence in the action.

Distinction
between
trade-mark
and passing
off cases.

they are the plaintiff's goods (c)? 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* (d), the defendant was restrained "from infringing the plaintiff's said trade-mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade-mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats (the only goods for which the trade-mark was registered), or otherwise using the said trade-mark in that connection," and he was also restrained "from using the device of a lady and bear (the trade-mark in question), so as to deceive the public," that is, so as to lead the public to believe that the goods of the defendant were the goods of the plaintiff.

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 (e), 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 (f).

Unregistered
trade-marks
practically
protected.

*The Stone Ales
Case.*

It is no defence, therefore, to an action for passing off the defendant's goods as those of the plaintiff, that the grant of an injunction would practically confer on the plaintiff trade-mark rights in an unregistered trade-mark. This is well shown by *The Stone Ales Case*. There the plaintiffs had registered the words *Stone Ale* as a trade-mark, and they had other registered marks which comprised the same

(c) *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. 451.

(d) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(e) See Chap. I. p. 1.

(f) *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Singer, &c. Co. v. Loog*,

8 App. Ca. 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*); *Reddaway v. Bannham*, (1896) A. C. 199; 13 R. P. C. 218; *Lever Bros., Ltd. v. Beddingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A.

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 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 (g) 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."

"The respondents," Lord Herschell said (h), "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" (i).

Lord
Herschell's
judgment.

In the case just quoted the deception was practised by the use of the trade-name of the plaintiffs' goods 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 (j),

Passing off
by the imi-
tation of an
unregistered
trade-mark.

(g) (1891) A. C. p. 218.

(h) (1891) A. C. p. 220.

(i) See also *Birmingham Vinegar Co. v. Powell*, (1897) A. C. 710; 14 R. P. C. 720, where the words *Yorkshire Relish* had been expunged from

the trade-marks Register: and *Reddaway v. Banham*, (1896) A. C. 199; 13 R. P. C. 218 (*Camel Hair Belting*). These cases are fully discussed below in Chap. XVI.

(j) *Jay v. Ladler*, 40 C. D. 649;

or an essential part of the get up (*k*), might have been, but is not, registered under the Acts.

In *Thorneloe v. Hill* (*l*), where the plaintiff sued on trade-name, Romer, J., expressed the view that, as the name had been used only as a trade-mark the plaintiff could not sue on it, as it had not been registered; but a distinction seems to have been there made between setting up a pure right of property in a name and seeking protection from passing off by means of the name, and the latter ground of action failed for other reasons.

In *Birmingham Vinegar Co. v. Powell* (*m*), Lord Halsbury, after quoting Lord Justice Turner's words in *Burgess v. Burgess* (*n*), "that no man can have any right to represent his goods as the goods of another person," stated that that was the only question of law which could arise in such cases; all the rest were questions of fact.

Pinto v. Badman.

In the case of *Pinto v. Badman* (*o*), 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

6 R. P. C. 136 (1888), Kekewich, J.;
Hart v. Colley, 44 C. D. 193; 7 R. P.
C. 93 (1890), North, J.

(*k*) *Great Tower Street Tea Co. v. Langford*, 5 R. P. C. 66 (1887), Stir-

ling, J.

(*l*) 11 R. P. C. 61 (1894).

(*m*) See note (*i*).

(*n*) 3 Do G. M. & G. 204 (1853).

(*o*) 8 R. P. C. 181 (1891), C. A.

book (*p*), 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* (*q*), 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 (*r*).

The Registration Acts have altered the old law to this extent that, after five years' registration, they give the registered proprietor of a mark, so long as he remains registered, the exclusive right to the use of the mark on the goods for which it is registered, so that if it, or an essential part of it, is appropriated by another trader the proprietor can interfere to restrain the appropriation (*s*). But where the complaint is not the appropriation but the colourable imitation of his mark, the test to be applied is still—Is the defendant's mark, by its resemblance to the registered mark, calculated to pass off his goods as the goods of the plaintiff (*s*)?

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 (*t*), 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

(*p*) Page 1.

(*q*) 3 My. & Cr. 338 (1838); Chap. I. p. 4.

(*r*) *Hall v. Barrows, Leather Cloth Co. v. American Leather Cloth Co.*, cited below, p. 373; and see Lord Blackburn's judgment in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. at p. 494 (1879).

(*s*) 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. 373.

(*t*) *Orr-Ewing v. Johnston*, 13 C. D. 434, C. A.; 7 App. Ca. 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. Ca. p. 228.

registration as equivalent to public use of the registered mark (u).

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 (x); accordingly, the presence of fraud does not constitute a material distinction between cases where actions in respect of the unlawful imitations of trade-marks do or do not fall within the prohibition of sect. 77.

Failure to register only deprives the proprietor of the advantages of the Acts.

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 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 (y).

Goodfellow v. Prince.

The case of *Goodfellow v. Prince* (z), which is the only

(u) Sect. 75.

(x) Chap. I. p. 4, and *Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420, (1900), Farwell, J. See Chap. XVI. p. 451.

(y) See the judgments in *Montgomery v. Thompson*, (1891) A. C. 217;

8 R. P. C. 361; *Reddaway v. Banham*, (1896) A. C. 199; 13 R. P. C. 218; and *Powell v. Birmingham Vinegar Co., Ltd.*, 11 R. P. C. at p. 572; 12 R. P. C. at p. 517.

(z) 35 O. D. 9 (1887), C. A.

reported case (a) 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.

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 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 (b).

Unregistered
trade-marks
and the
Merchandise
Marks Act,
1887.

(a) But see *Thorneloe v. Hill*, *supra*, p. 320.

(b) Sect. 3 (2); see Book II., Chap. I. p. 589.

CHAPTER XIII.

ASSIGNMENT AND DEVOLUTION OF TRADE-MARKS.

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A trade-mark
is assignable
only with the
goodwill.

TITLE to a trade-mark cannot be assigned or devolve in gross; but, unless the mark connotes a personal connection between its original owner and the goods in connection with which it is used, it may be assigned and transmitted, together with the goodwill 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 assign-

ment and transmission, was identical in terms with the corresponding section of the present Act here set out.

By 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). Sect. 70.

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.

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); but it is a question of intention, to be gathered from the assignment as a whole, whether the trade-marks do or do not pass, and an intention not to assign them may appear notwithstanding the use of the word “goodwill” in the assignment (e). Transfer by implication with goodwill.

The leading cases on the subject are, *Hall v. Barrows* (f), and *The Leather Cloth Co. v. The American Leather Cloth* *Hall v. Barrows.*

(a) As to the last clause of the section, “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), *Thur- low, L. C.*; and *Motley v. Downman*,

3 My. & Cr. 1; 6 L. J. Ch. N. S. 308 (1837), *Cottenham, L. C.*

(d) *Shipright v. Clements*, 19 W. R. 599 (1871), *Malins, V.-C.*

(e) *Roger's Tm.*, 12 R. P. C. 149 (1895), *North, J.*

(f) 32 L. J. Ch. 548; 33 L. J. Ch. 204; 4 De G. J. & S. 150, *Romilly, M. R.*, and *Westbury, L. C.*

Co. (g). They were decided at the same time, in 1863, by Lord Westbury, and his judgment in the latter case was affirmed by the House of Lords; in the first case, the question at issue was whether, in determining the sum to be paid by the surviving partner of a firm who took over the partnership assets at a valuation under the articles of partnership, the value of the trade-mark used in the business ought to be taken into account, and the Lord Chancellor, reversing the decision of Romilly, M. R., held that it ought to be so taken, the valuation being made, however, on the footing that the surviving partner was entitled to carry on a similar business and to use the trade-mark in it without payment (*h*). The trade-mark consisted of the letters B. B. H. (the initials of the partners composing the original firm), surmounted by a crown, and the Master of the Rolls had held that it could not be sold, because it designated the firm which manufactured the particular goods. "It would," he said, "obviously be a fraud on the public if the Court of Chancery were to attempt to sell to another person the right of holding out to the public that the goods manufactured by him were, in fact, goods manufactured by another and distinct firm." And he distinguished the mark in question from marks indicating the manufacture of a particular factory, which might rightly be transferred with the factory. Lord Westbury 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 comprising the name of the original proprietor.

Lord Westbury's judgment.

(*g*) 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., 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.

(*h*) As to this, see also the cases discussed in Chap. XVI. below, pp. 496 *et seq.*

trade-mark belonged to the partnership as part of its property, and might be sold with the business and works.

In *The Leather Cloth Case* (i), the plaintiffs sued the defendants for an alleged infringement of their trade-mark, and Lord Westbury, reversing the decision of Wood, V.-C., dismissed the suit on the ground that the trade-mark of the plaintiffs contained material misrepresentations. The plaintiffs had purchased the marks from an American company—the Crockett International Leather Cloth Co.,—who were the successors of Crocketts & Co., and the marks contained the names both of the company and of the firm, as well as an American address which was not the address of the plaintiffs. The presence of the names and address amounted, in Lord Westbury's opinion, to a representation that the goods on which the mark was used were the goods of the original firm or of the American company, and the marks, therefore, could not be properly used by the plaintiffs, and consequently could not be validly assigned to them. And this judgment was fully indorsed by the House of Lords, although Lord Cranworth and Lord Kingsdown, on the appeal, based their judgments chiefly on the ground that there was in fact no infringement, and Lord Westbury placed his upon wider grounds than those he had adopted on the appeal from the Vice-Chancellor, namely, that the alleged trade-marks were in fact only advertisements and not trade-marks at all.

The Leather Cloth Case.

The mark is unassignable if deceptive when used by an assignee.

The following passage from Lord Kingsdown's judgment in the House of Lords (j) shows the principle upon which the assignment of trade-marks and trade-names, as well as the limitations restricting such assignment, are based:—"By the usage of trade, the name of a firm is understood not to be confined to those who first adopted it, but to extend to and include persons who had afterwards been introduced as partners, or persons to whom the original partners have transferred their business. The name of a firm continues to be used in many cases long after all the original traders have died, or have ceased to have any interest in the concern—as in the great banking houses of Child and Coutts, and many

Lord Kingsdown's judgment in *The Leather Cloth Case.*

(i) Note (g). The case is further stated at p. 50, above.

(j) 35 L. J. Ch. p. 64; 11 H. L. C. 523.

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 (*k*)) 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" (*l*).

The mark used by the assignee must indicate what it indicated when used by the assignor.

In the recent case of *Pinto v. Badman* (*m*), 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 original proprietor, or of any of the former owners of the business (*n*). But in special cases, as for instance where the reputation of goods depends on the personal skill of an artist or artizan, the use of his name or mark by a successor might be a misrepresentation, and in such a case the name or mark is not properly assignable (*o*).

(*k*) *I.e.*, a symbol or emblem, come by use to be recognized in the trade as the mark of the goods of a particular person (above, p. 24).

(*l*) 35 L. J. Ch. p. 61.

(*m*) 8 R. P. C. 181 (1891), C. A.

(*n*) *Hall v. Barrows*; *Bury v. Bed-*

ford, above, p. 326. See also *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

(*o*) Per Lord Kingsdown in *Leather Cloth Co. v. American Leather Cloth Co.*, *ubi supra*, and per Romer, J., in *Thorneloe v. Hill*, 11 R. P. C. at

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 (*p*), or the right to the use of a brand for cigars, without the factory and business of the manufacturer who first acquired it (*q*); and where a mark contains a special indication of the locality of the origin of the goods, it could not be properly assigned so as (using Lord Justice Fry's expression) to be divorced from such place of origin (*r*).

As already stated, an assignment of a trade-mark is inoperative if the assignor has no goodwill to assign (*s*). And the goodwill must be that of a business in the United Kingdom (*t*). The question whether an assignor has a goodwill of a business in the particular goods to assign may, of course, give rise to difficult questions of fact; but the words of the section as to goodwill are not to be construed narrowly (*u*). Thus, where a mark was registered for anti-friction metal bearings, but the registered proprietors, who were an American company, had never sold such bearings in the United Kingdom, but they had imported specimens and also ingots of the anti-friction metal, with the mark on them, for making bearings, such ingots being purchased by an English firm; and the American company had a special agreement with the English firm, under which, as the Court held, the latter were in some respects, and particularly as to trade-marks, agents of the company, and the goodwill was to revert on the determination of the agreement to the company; it was held that the

There must be a business to assign in the United Kingdom.

p. 70 (1894). See also the judgment of Lord Westbury in *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199, as to marks becoming deceptive on assignment.

(*p*) *Cotton v. Gillard*, 44 L. J. Ch. 90 (1874), Jessel, M. R.

(*q*) *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

(*r*) See judgment of Lord Westbury referred to in note (*g*), *supra*, and judgment of Fry, L. J., quoted on p. 328, and *Mason v. Queen*, 23 Sc.

L. R. 641 (1886).

(*s*) *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J., is an example of an assignment being held inoperative on this ground. Cf. *Linotype Co., Ltd.'s Application* (No. 2), 17 R. P. C. 380.

(*t*) See *Magnolia Metal Co.'s Tms.* below, note (*u*), where the point is assumed both by Kekewich, J., and C. A.

(*u*) Per Rigby, L. J., in *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 621,

company had a business concerned with metal bearings sufficient to support an assignment by them of the trade-mark and goodwill (v). "The main object," Rigby, L. J., said, "of the restrictions upon assignments imposed by the Act was to prevent confusion or deception by suggesting that the articles to which the mark is applied continue to have some connection or other with the original registered owner."

Sale of trade-marks with the goodwill or part of the business.

Trade-marks used in a part of a business may be sold with the goodwill of that part only, and if the goodwill sold is restricted to some only of the goods in which the vendor dealt, the purchaser will only obtain the right to use the trade-marks assigned to him upon the goods in question, even though they be registered for other goods. Thus a mark was registered for "unwrought and partly wrought metals used in manufacture," and the proprietors assigned it together with their goodwill "in the trade or business of 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 (x).

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 (y), 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 the mark has been registered by mistake or accident in the name of a person other than that owner (z).

(v) *Magnolia Metal Co.'s Tms.*, above, note (u), Lindley, Lopes, and Rigby, L. JJ., reversing Kekewich, J., on this point. See also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600, where Stirling, J., held that there was user of the word *Ball's-eye* by a foreign importer in connection with cameras in this country, he having imported the cameras in cases which had the word on them,

and having sent therewith to the consignee pamphlets containing the word. See above, p. 192.

(x) *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

(y) *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

(z) See Chap. XI. p. 283; *Greenlees' Tm.*, 9 R. P. C. 93 (1892),

Upon the dissolution of a partnership, in the absence of special agreement (a), the trade-marks of the firm are part of its assets, and are saleable as such with the goodwill (b); 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 (c). Similarly, upon the death or bankruptcy (d) of a trader, his trade-marks may be sold with the goodwill of his business by his executors or trustees.

Trade-marks on bankruptcy and dissolution of partnership.

The Register of trade-marks comprises notifications of assignments, and of transmissions of trade-marks (e), and it is provided by sect. 57 that:—

“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 pro-

Sect. 87. Registration of assignments.

Stirling, J.; *Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.; and see last note.

(a) 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). This topic is fully discussed below, Chap. XVI. p. 496.

(b) *Hall v. Barrows*, above, p. 326.

(c) See the last case, and *Hookham v. Pottage*, L. R. 8 Ch. 91 (1872), C. A.; *Thynne v. Shore*, 45 C. D. 577 (1890), Stirling, J.; and *Burchell v. Wilde*, (1900) 1 Ch. 551, Byrne, J.,

and C. A. Where a business is conducted at two places and the goodwill at each is sold separately without special stipulations, the purchasers might have concurrent rights to the use of the trade-name. In *Townsend v. Jarman*, 17 R. P. C. 649 (1900), Farwell, J., it was contended that such was the case, but in the particular case the defendant failed to establish a concurrent right with the plaintiff.

(d) *Hammond v. Malcolm, Bruncker & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

(e) Sect. 78.

visions of this Act, and to] (*f*) 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."

No notice of any trust is to be entered on the Register, or to be receivable by the Comptroller (*g*).

The proviso keeps all equities open, so that they may be enforced in like manner as in respect of any other personal property (*h*). Therefore in a patent case licensees who took their licence with notice of an agreement for assignment by the licensors and registered the licence were held not to have obtained a valid licence against the assignees, although the actual assignment was made subsequently to the licence, and no notification of the agreement was entered on the Register at the date of the licence (*h*).

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 (*i*).

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 (*k*) 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

(*f*) Act of 1888, s. 21, see below, p. 323.

(*g*) Sect. 85, Chap. III. p. 58.

(*h*) *New Ixion Tyre and Cycle Co., Ltd. v. Spilsbury*, (1898) 2 Ch. 137, 484; 15 R. P. C. 380, 567, Kekewich, J.,

and C. A.

(*i*) The old Rules were 23 to 29 of the former code. The more important provisions of these have been incorporated in the Act.

(*k*) Form K. Appendix, p. 708.

respectively duly authorized to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorized in like manner.

“**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 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.”

Contents of request.

“**39.** Every such request shall be accompanied by a statutory declaration (*l*) to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade-mark as claimed by such request.”

Declaration to accompany request.

“**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.”

Further proof of title if required.

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 (*m*).

“Subject to the provisions of this Act.”

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

Refusal to register an assignment.

(*l*) See Rule 61, Appendix, p. 702. And as to the Comptroller's power to dispense with evidence, Rule 53,

p. 701.

(*m*) Cf. sect. 76 above, p. 306.

Alteration of name of company.

business has been transferred to him (*n*), and that he is otherwise entitled to use the mark. Where a company which is the registered proprietor of a trade-mark changes its name, the Comptroller has power to enter the new name on the Register, and on his failing to do so the Court would have power to rectify the Register under sect. 90 (*o*).

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 (*p*).

Alteration of registered mark in consequence of assignment.

In some cases the assignment of a trade-mark to new proprietors makes an alteration in its form necessary or advisable. In the case of registered marks, such alteration may be allowed by leave of the Court obtained under sect. 92, provided that the mark is not altered in an essential particular (*q*). Thus in *Guinness & Co.'s Trade-Mark* (*r*), Chitty, J., allowed the word *limited* to be added to the name upon an old mark, the business and trade-marks of the old firm having been taken over by a company bearing the name of the firm with "limited" added to it, and in other cases the same alteration has been allowed in new marks (*s*). 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 & Co.* (*t*), 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

(*n*) *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J.

(*o*) *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 520; 13 R. P. C. 475, North, J.; and see Chap. XI., p. 284.

(*p*) *Ihlee v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1884), North, J.; *Richards v. Butcher*, 7 R. P. C. 288

(1890), Kay, J. See, however, *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, and above, p. 317.

(*q*) *Murphy's Tm.*, 7 R. P. C. 163 (1890), W. N. 84.

(*r*) 5 R. P. C. 316 (1888).

(*s*) See Chap. XI. p. 299.

(*t*) (1892) 3 Ch. 549; 9 R. P. C. 449.

for some years in Havanah, and had been extensively used by the applicants in England (*u*).

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 (*x*); illegal if it were to be put upon any other goods (*y*). 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 quoting sects. 70 and 87, they say (*z*): "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.

Licence to use a trade-mark.

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

Lease of goodwill and trade-marks.

(*u*) See further, Chap. XI. p. 298.

(*x*) See Chap. II. p. 32.

(*y*) *Oldham v. James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862); and see remarks of North, J., in *Roger's Tm.*, 12 R. P. C. at p. 158; and *Thorneloe*

v. Hill, 11 R. P. C. 61. The principle of sect. 70 would seem to be as applicable to a partial assignment as to an absolute assignment.

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

made (a). Where a company, that had carried on business at Glasgow and elsewhere, sold its Glasgow businesses, and agreed not to carry on business there during ten years from the assignment, and expressly licensed the assignee to use certain trade-marks during that term, and the assignee applied to register a trade-mark containing a representation of Glasgow Town Hall similar to one that had appeared on labels for whisky bottled at Glasgow by the assignors (the label not being expressly mentioned in the assignment), and the assignors opposed the registration, as they did not admit the applicant's right to the exclusive use of the device, although they did admit his right to use it, the application for registration was refused (b).

Although if the whole goodwill of a business is leased, the lessor cannot as a rule use the trade-marks during the lease; yet where a foreigner, who had registered trade-marks for metal bearings, entered into an agreement with persons in this country under which they were during a term of years to purchase the particular alloy for the bearings from him, and were to have the exclusive sale in this country, and the agreement contained clauses under which the goodwill was on the determination of the agreement to revert to the foreigner, it was held that he had sufficient goodwill in bearings during the continuance of the agreement to support an assignment by him of the trade-marks and such goodwill (c).

Action by
licensee.

The sole 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 (d). But a true licensee of the rights, if there can lawfully be such a person, could not sue either (e).

On an assignment for value of trade-marks and goodwill

(a) *Re Arril*, Stirling, J., 20th April, 1888; Sebastian, 4th ed. p. 374, cited above, p. 285.

(b) *Rogers's Tm.*, 12 R. P. C. 149 (1895), North, J.

(c) *Magnolia Metal Co.'s Tms.*, (1897) 2 Ch. 371; 14 R. P. C. 265

and 621; see above, p. 329.

(d) *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J.

(e) *Heap v. Hartley*, 42 C. D. 461; 5 R. P. C. 603 (a patent case); *Woolley v. Broad*, (1892) 1 Q. B. 806; 9 R. P. C. 208, 429 (a design case).

the *ad valorem* stamp duty applicable to a conveyance or transfer on sale is payable.

In one case it was held that in the case of a foreign trader who had no place of business in the United Kingdom, but had registered a trade-mark here, and had sent goods into this country, the trade-mark and right to use it and the business connection here were property within sect. 59 of the Stamp Act, 1891, and, moreover, were not "property locally situate out of the United Kingdom" within the exception contained in the same section, notwithstanding that they were assigned with freehold premises in America (*f*). But the Court of Appeal has subsequently held that where goodwill and the exclusive right to use a trade-name are assigned with premises entirely situate out of the United Kingdom, the goodwill is *primâ facie* annexed to the premises, and is, in the absence of facts rebutting the *primâ facie* presumption, property locally situate out of the United Kingdom (*g*).

Stamp on assignment of goodwill and trade-marks, &c.

(*f*) *Brooke & Co. v. Commissioners of Inland Revenue*, (1896) 2 Q. B. 356, Pollock, B., and Bruce, J.

(*g*) *Muller & Co.'s Margarine, Ltd. v. Commissioners of Inland Revenue*,

(1900) 1 Q. B. 310; distinguishing *Smelting Co. of Australia v. Commissioners of Inland Revenue*, (1897) 1 Q. B. 175 (sole licence to work patent).